

The American Association of Patent Judges

presents

A Conversation with

Hon. Bruce H. Stoner, Jr. (BPAI¹: CAPJ² 1995-2003)

Hon. Michael R. Fleming (BPAI: CAPJ 2004-2010)

Hon. James T. Moore (BPAI/PTAB³: Acting CAPJ 2010-2011;
DCAPJ⁴ 2012-2014)

Hon. James Donald Smith (BPAI/PTAB: CAPJ 2011-2015)

Hon. Nathan Kelley (PTAB: Acting CAPJ 2015-2016; DCAPJ
2015-2016)

Hon. David P. Ruschke (PTAB: CAPJ 2016-2018)

Hon. Jacqueline W. Bonilla (PTAB: DCAPJ 2019- ; Acting DCAPJ
2018-2019)

Hon. Scott R. Boalick (PTAB: CAPJ 2019- ; Acting CAPJ 2018-
2019; DCAPJ 2016-2018; Acting DCAPJ 2014-2015)

Moderated by James T. Carmichael, former Administrative Patent Judge (APJ), now with Carmichael IP, PLLC.

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Hosted by The American Association of Patent Judges (AAPJ). Murriel E. Crawford, President (2020-2021).

Many thanks to the 2020-2021 AAPJ Planning Committee (James Carmichael, Lora Green, former APJ (now with Wilson Sonsini), and Russell Cass, APJ).

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James T. Carmichael (00:00:00)

Hello everyone. My name is Jim Carmichael. I am one of the planning committee co-chairs here at the AAPJ, the American Association of Patent Judges, with our President Murriel Crawford presiding and our President-Elect Judge Hubert Lorin.

For this meeting we have in attendance not only the current Chief and Deputy Chief Administrative Patent Judges of the PTAB but every living former Chief as well. We are so grateful for the participation of all of these leaders of the Board past and present.

We're holding this meeting to honor their service and gain a historical perspective of the Board including the development of AIA trial procedures. I cannot think of a group of people that has done more to promote the progress of the useful arts than this group here tonight this is especially important today as the useful arts have run to the rescue of the entire planet in the battle against the COVID-19 pandemic. A heartfelt thanks to all of the leaders of the Board that got us to this moment.

Tonight each speaker will provide about 10 minutes of remarks in chronological order beginning with Bruce Stoner and ending with Deputy Chief Judge Bonilla and then Chief Judge Boalick.

First up. Bruce Stoner was the Chief Judge of the Board from 1995 to 2003. He is now an attorney with Greenblum and Bernstein. Judge Stoner take it away.

Hon. Bruce H. Stoner, Jr. (00:01:48)

Thank you and thanks to the committee for inviting me to participate in this event. Good to be here. "Here," in quotation marks, with you in this virtual manner. It is a strange manner in which we have grown accustomed during the last very strange year.

As a visitor from another century [] let me tell you that I joined what was then the Patent Office in June 1970, which is now nearly 51 years ago. I suspect that was before at least so many in the audience were born. It was 35 years ago around this time of year that I began my duties at the Board as an Examiner-in-Chief - using that old title; more than 25 years ago that I

became Chief APJ; not quite 18 years ago I graduated to whatever my present state might appropriately be called.

I wanted to comment on that photo that accompanied the flyer for this meeting. It was taken sometime in 1998 in advance of the International Patent Appeal Examination Symposium in Tokyo when it was decided that I needed an official photograph - made over at the Department of Commerce, cameras and flags to not yet having crossed the river to Crystal City. In comparison between that photo and what you see on your screen today reinforces the reality of the passage of time.

In the course of this talk I will undoubtedly mention a handful of people that I worked with - there are many others who are worthy of mention. Not naming each is a risk I take knowing full well that any success the Board had during my time depended on a whole host of people of all position descriptions. I am and will remain eternally grateful for all the wonderful people I've met and worked with during my years at the Board and for those others as well.

I began learning the patent trade when I joined the Office as an examiner in Group 310, a mechanical examining group - handling patent applications where I became a primary examiner in 1977 and later became an SPE in 1983. Like so many others I attended law school while working at the PTO. I was selected to the Board in 1986 not long after the merger of the old Board of Appeals and Board of Interferences when Saul Serota was acting Chairman of the Board. It was a very interesting time because it really foreshadowed the kind of organization the Board would become. I had good fortune to serve under Ian Calvert. Ian Calvert was then the Vice Chairman and was formerly Chairman of the Board of Patent Interferences, later Saul became the first Chairman to have the title Chief Judge and Ian was the first to be called Vice Chief Judge. Fred McKelvey succeeded Saul in 1994 as Chief Judge. Beginning in May 1995 I served as one of three Vice Chiefs under Fred McKelvey along with Rick Schafer and Gary Harkom. I think Fred and Ian always liked to think that it took three of us to replace Ian and it was actually true. When we sat down and figured out what all the duties were we were astonished at how much that had to be divided up to be done. I became acting Chief upon Fred's retirement - that's actually Fred's first retirement, I don't know how many of those there were - but that was at the end of September 1995 and that selection was made as permanent as such

things are in March of 1996. I served there until October 2003, when I retired and entered private practice with Greenblum and Bernstein in Reston.

There's a temptation to start spinning stories about the folks that I worked with at the Board. Getting the opportunity to work with Fred was in many ways life changing. He had a comprehensive knowledge of how the PTO worked, knowledge spanned the PTO's relationship with other parts of government and burrowed down to the details of how even obscure parts of the PTO worked. His knowledge of the personalities of people in the Department of Commerce, Department of Justice, in the courts, at home in the PTO, and what all of that meant in terms of getting things accomplished for something I had not previously witnessed in close-hand and when he provided the three new Vice Chiefs with a pamphlet about managing the boss I was convinced he was reading our minds. I've looked in vain for that document in my files and have not found it but hope abounds. We'll leave those stories for another time.

Our unifying topic today as I understand it is Post-Grant Review, in its various forms, and how we, the Board, if you will permit the possessive reference, got there as an organization. I would encourage all of you to contemplate this matter to remember interferences as they were used and administered after the change of law in 1984 and an appreciation of that time is helpful in understanding what the Board did at least initially with Post-Grant Review.

Fred, Ian and others had a vision of what interference could be at a unified Board that was capable of deciding and charged with deciding both priority and patentability and that was first expressed in the MPEP about 1984 in a document that was largely written by Fred. The reality of the practice in the 80s and early 90s was somewhat different as a result of the transition from separate Boards to a unified Board and that was to be expected from bringing group of diverse folks together to take on obligations and duties that they hadn't had previously even though they were capable of doing them. It was a time where there were some some disconnects and struggles. But the creation of the trial section in the late 90s was an act that actually brought that vision to reality; it was a reality that I believe was hastened by the evolution in practice from one that was principally focused on determining priority - as we all learn to think of interferences - to one that was increasingly focused on patentability, a change that was driven by the parties who appeared before the Board.

As a young primary examiner in the late 70s and early 80s I had an interest in reissue and when it came into effect ex parte reexamination as well. It helped that I was willing to take on such cases while most of my colleagues knew better than to volunteer. Volunteering provided me a lot of opportunities and a lot of headaches during my career and indeed I was lucky enough to be involved in some of the early contested reissue proceedings under what was known as the Dann amendments - those of you who want to delve into the past there is one for you.

At the Board I had the fortune to author a number of decisions on reexamination, including a few of those in which the then office of the Assistant Commissioner for Patents through an entity colloquially known as the fraud shop made rejections for violations of the duty of disclosure. The major public complaints associated with ex parte reexamination back then in the early 80s was, one, reexamination took too long, special dispatch notwithstanding, and, two, the examiners gave up too readily, especially since early on reexaminations like reissues went back typically went back to the same examiner to examine the underlying patent application. This is of course well before the idea that reexams should be assigned to someone other than the original examiner, much less before the central reexamination unit came into existence to provide expertise in the special handling of reexamination procedure. It was also before the time that third party requesters got a serious chance to explain why the patent owner was wrong in opposing the requester's proposed rejections and to have that clash of ideas that we have come to understand.

So the first glimmers of inter partes reexam arose from dissatisfaction with ex parte reexamination. Interferences were being increasingly used as patent cancellation proceedings rather than priority contests and this led to a point which the Office got sufficiently interested in the late 80s and early 90s to invest some time and money in formulating a process and writing some draft rules - those of you will remember Al Smith, the mechanical group director, Al and I were charged with writing the first crack those rules. We basically cribbed them from the ex parte rules but nonetheless we were trying to set up an inter partes process at that point. That effort really went nowhere for a number of years and then surprisingly the law enabling inter partes reexam was adopted in 1999 and Al and I were tasked with dusting off those rules, tuning them up, and sending them off to the rest of the Office to weigh in.

As I recall it was finally adopted was pretty close to what we had written earlier but that's only because there was a mandate to make inter partes look like ex parte but with opportunity for the requester to respond to patent owner's arguments.

You have to understand that there weren't very many reexaminations in nearly years. Although the office expected reexamination - what we now call ex parte reexamination - to be a big deal and it geared up to handle as many as 10,000 proceedings per year back in 1981 in fact turn out to be 2010 before the total number of reexams actually reached 10,000. So it took about 30 years to get off the ground. In my time, and in most years before the late 2000s, there were at most a few 100, two 300 ex parte reexams filed each year. By 2009 that annual number had reached nearly 700 and when coupled with roughly 300 or so inter partes reexams being filed annually which were just then hitting their stride there were about 1000 or so reexamination cases per year. Interferences of course had fallen to a few 100 and then down to a handful. Add that number has continued to decrease. Historically there's been about 1000 reissue applications filed annually. So that's kind of the universe of these kind of cases that people were looking at. Everybody knows I think the statistic on inter partes reexamination - there were ultimately less than 2000 that was filed in their 12 years of existence and some of those of course are still pending, demonstrating that it was a cumbersome process. All those numbers play a roll in later calculations and perhaps miscalculations of the expected popularity of Post-Grant proceedings

As inter partes reexams began to slowly phase in and were found to take forever and that was in the very end of my time, it became clear both internally and externally that something more robust and quicker was going to be needed. Also it became clear to me that in the decline of the number of pending interferences as resolved with the streamlined procedures piloted by Frederick McKelvey and the other members of the then newly organized trial section, as well as a turning tide on the number of pending ex parte appeals at that particular point in time, the Board might have the resources and know how to make Post-Grant Review happen entirely at the Board. The fact that other parts of the Office - notably patents operations - were already thinking about new programs provided added impetus for the Board to get involved at the outset when it might shape the process, not after a new process was in place.

All this of course was when the thought was that there would be a program that mirrors present day PGR program of Post-Grant Review. Inter partes reexams would go away - we weren't at that point envisioning inter partes process as it exists today. Ex parte reexam would remain.

What I expect everyone else will talk about is the rest of that story within their own times of influence. But you need to know that we began pulling the other today's procedures back in 2000 and 2001 before the 1st version of the 21st Century Strategic Plan was published in June 2002 and that was of course in response to user feedback that we had at that time solicited from the AIPLA and the IPO. There's probably no doubt in anybody's mind that those plans were founded on interference practice that came to be in trials as such.

I guess at this point I need to say I'll reserve whatever time remains to me for rebuttal later on and again thanks for inviting me to participate. Jim.

James T. Carmichael (00:15:57)

Thank you Judge Stoner. I'm impressed at the foresight you had to get started working on trial proceedings way back when I was there with you and frankly I thought it was a little premature but it turned out not to be because it all came to pass. So well done.

Next we have Mike Fleming. Mike was the Chief Judge of the Board from 2004 to 2010. He is now an attorney with Irell and Manella. Judge Fleming...

Hon. Michael R. Fleming (00:16:34)

Thank you Jim. To start off I would say I appreciate having a chance to be part of this program and it's also interesting that I think it's important that somehow maybe the Board might consider a more formal way of writing up the history of the Board and its impact on the greater scheme of helping our industries be competitive in the world.

And I also would like to thank Bruce for laying a good foundation for when I took over. And I want to start on the outset to say I'm going to refer to "we" - what "we" did during my time - just as Bruce mentioned that it was a huge team of people working together to accomplish what we accomplished

during the time that I was Chief Judge. I'm not going to try to name all the names because it was so many but just remember when I say "we" that's many many people.

To add to the story of how we ended up with Post- Grant Review and IPR's is that what Bruce didn't mention was the politics that were happening on the Hill and the politics was is that we had one industry which was the software industry which wanted to abolish all patents and then we had the pharmaceutical industry that wanted to strengthen patents and to this day those two competing industries are grinding away at how our process is going to be. And by no means is it over. The Post-Grant Review is going to be ever changing depending on how the politics are such.

But when I became, just before I became Chief Judge, I was called into the Director's office and there were representatives from the White House and they were sounding the alarm. They really felt that the software industry was gaining traction down on the Hill and they wanted to know if there was anything that we could do to go down on the Hill to explain that maybe we could craft a process and what Bruce has said is that we did have a process that worked and that was revamping of the interferences where the first year was essentially a Post-Grant Review. So I had something I could sell. I went down to talk to those people down on the Hill showing how we had a success in having an inter party review of a patent in an interference and that we could do it in a year - because what Bruce didn't mentioned was that before the interferences were redone it was taken 20 years on some of them and we were able to consistently have these interferences with a patentability being decided in one year and and priority decided in in the second year. So that was our start of crafting this law and it gave us an end because it allowed us to have a voice down on the Hill in crafting this statute and there was again many people that were working with me on coming up with specific language to address each of the stakeholder's concerns and it was quite an effort but my main objective was to come away with us with a statute that was doable for the Board. I was representing what "we" could do.

And there's a couple things that were very important. One is we learned from our mistakes on the statute for inter partes reexams. Everything was hardwired - everything was in statute - there was no way that we could change anything and I went down there saying that we want to have strong rulemaking ability and not to hard wire the process, allow the Director to

promulgate rules that would establish what the process would be. That was a very hard sell but we were able to get it done.

Another important part of the statute that I thought we fought very hard for was the idea that these things could be done in a year and many and so how could we make sure that this was going to be done in a year. It was important that by the statute that the process really had to be an upfront process where the petition brought forth all the arguments and that then the patent owner had the ability to respond. So it was a very compact way of doing things and that has survived to this day - that concept of indeed you know you're gonna have to bring forth what and you can't just hide and wait at the last minute and spring something on somebody. That was important 'cause that was the only way it was going to be done in a year.

So having working with the statute that was one aspect of what we did during that time. Another aspect is we had to prepare the Board to be able to in fact be ready when Post-Grant Review happened and there was a number of initiatives first thing was to reorganize the Board to in particular I don't remember exactly our organizational chart but it essentially it was divisions where we had lead APJs that led each of the divisions and that we were able to provide a organizational way in which the Board could become bigger and the information could be brought to all the APJ's in a uniform fashion

Another aspect was that we had to go from paper to electronics. The electric and that was a huge effort and it cost a awful lot of money because we had to scan all these paper files into the system and that we had to be able to provide equipment so that APJ's could work as well as we I assume you were working now so that you weren't having to pass a paper file from desk to desk. I can't tell you what a big effort that was.

The other aspect was we were going to need to hire a whole lot of APJs and how we're going to recruit all these APJs. It was not going to be possible in our assessment that say we're going to find all these APJ's in the Washington area. So we needed but we also realized a lot of people weren't going to be interested in living in the Washington area. So Fred had retired but he wanted to come back but he didn't want to leave Hawaii so I said to Fred OK you come back but you can live in Hawaii but we're going to have this pilot program where you can work remotely from Hawaii. And I saw that upper management saying look at if Fred can do this from Hawaii then we could

definitely do it from anywhere in the United States and so the Board was the very first organization that actually had this work at home idea or work anywhere in the United States and it was through that pilot program. Thank goodness we did that because with COVID I'm not sure how the PTO would have been able to function. But again that was awful lot of work on Fred's part as well as all the all IT people that worked with Fred to figure out a way to get that done. The technology back then is not nearly as robust as it is today so there was a lot of glitches that had to get through.

The other aspect was just flat out hiring APJ's and that was a difficult task because we needed and I don't remember exactly the numbers but because we had whole lot of retirements right then in the beginning when I took over and but I do remember I think that we ended up hiring more than 100 through the time. But we also have a lot of people leaving during that time. So in any event I don't remember exactly how many APJ's were by the time I left but it set the stage for the next Chief to ramp up, to be able to have the necessary number of APJs and resources to be able to do the Post-Grant Review as well as the huge ex parte appeals that we had.

One of the challenges during my time was is that we had an increasing number of appeals arriving at the Board and this was because of the then administration pushing for the thought that you weren't going to be able to file a continuation. So that left no other opportunity but to go to the Board and so we had an avalanche of appeals because of that - which led to another initiative and that was to rewrite the ex parte appeals rules, which that was a big effort and as a result it did it was able to streamline the process and lay the groundwork so that the number of appeals could be reduced.

And then finally there was a big worry about whether or not we increased the Board size - how are you going to ensure the quality of the work that is done at the Board - and how are you going to ensure that everyone is making consistent decisions and that's where we initiated the precedential opinion process which was present at the Board but was used at a limited basis and we ramped it up during my time to be able to communicate to the Board and have everyone on the Board to understand certain policies that the Director wanted to make sure we implemented in a consistent way

The other aspect was that through the organization we could have these divisions team meetings in which those folks could meet regularly and so that we could discuss certain decisions and whether or not this should be the

make sure that everyone on across these teams were acting in a consistent manner

So with that I will again reserve my time for any rebuttal or questions in the end.

James T. Carmichael (00:30:50)

Thank you Judge Fleming and thank you for accepting the duty of being my official mentor when I joined the Board way back when. I appreciate that.

Now after Chief Judge Fleming, Jay Moore was the acting Chief Judge of the Board from 2010 to 2011 and Deputy Chief from 2012 to 2014 but notably Judge Moore was also the President of this association and is currently an Administrative Patent Judge. Judge Moore ...

Hon. James T. Moore (00:31:24)

Thank you very much. I have I guess the privilege of having been the last Vice Chief Judge of the Board of Patent Appeals and Interferences and then the first Vice Chief Judge of the Patent Trial and Appeal Board. I guess and also the first Deputy Chief and it was kind of that whole switch is just one of those momentous things in life and career that you always remember. But I feel like listening to Chief Judge Stoner and Chief Judge Fleming that clearly I was amongst the presence of giants.

Thank you first of all the Chief Judge Stoner for having the courage to hire me one of the first not the first but in that first tranche of folks who came in to the PTO from the outside to the Board. I think that bringing in some of the outsiders over the years especially in my instance helped a lot in our desire to have a litigation sort of style kind of proceeding here at the Board and one of the reasons for that is my first real boss in a law firm, Rudy Hutz at Connolly Bove in Wilmington Delaware he got me heavily involved in litigation and interference work and I really did enjoy that in addition to doing prosecution but when Chief Judge Stoner decided to hire me I think he may have told Judge McKelvey all of this and he then after a few years to make sure I could actually live in Richmond and commute to Crystal City every day I think he decided that it might be okay to draft me into the interference section and then I was also in the presence of giants Judge Schaefer, McKelvey, Torczon, Lee, Lane, Medley all of whom were

wonderful mentors in teaching how to conduct an interference from the inside. The system that was set up was so incredibly efficient and effective I was I was wholly impressed when I just started and I really hoped I didn't disappoint folks.

Chief Judge Fleming and Harkcom actually persuaded me to lead the trial section only probably because Jamison wouldn't listen to my pleading that he would be much better at doing it but certainly Fred when he retired for the first second third or fourth time left a trial section in really good order and it was very easy to run.

In 2008 Vice Chief Harkcom retired or 2007 I guess and 2008 I was fortunate enough to have Chief Judge Fleming appoint me to be his Vice Chief Judge and boy was that a whole different series of things that we had to undertake. Of course the Board did have a somewhat of an inventory of ex parte appeals that we were trying to get through, so we had a lot of hiring to do. And from early on the legislation went through several rounds. We were constantly year after year providing background information and proceed processes and our predictions on costs and how long it would take and what sort of staff we would require and that was actually one of the more fascinating parts of being Vice Chief Judge at that time - managed to put together a team of people without which it could never have happened, bunch of the Lead Judges shortly thereafter, how we're gonna do this, what kind of rules are we going to make, how is this all going to function, and just assembling that team to get that done.

You know the Vice Chief Judge is the guy who gets it done behind the scenes. I'm not the idea person. I mean I'm the first thing he tries to put together the actual operations of the system. And we certainly when I was briefly acting we we didn't have a whole lot of internal impetus to make too many changes because for that period of time I was the singular executive at the border. I think at one point I had 107 direct reports. So it got kind of interesting there for a while. But once the AIA actually passed things got pretty interesting quickly. We went downstairs to talk to the CIO and said hey we need a system and the CIO said huh and that was a very interesting year or two of what can we do to create a system.

The Lead Judges were especially involved with the rule process and all sorts of other things to make this actually happen. To me that was part of the real challenge of it.

But you know simultaneously on top of all that we had the fun of opening all of these new offices and hiring Judges into them and that, designing offices figuring out how to equip hearing rooms how are we going to link them how are we going to schedule them how are we going to do all this and do trials and do appeals hearings and can continue to do the interferences as long as they lasted. Fascinating fascinating we had a heck of an interesting time doing that. Special shout out to Commissioner Focarino who at that time. She just was wonderful and helping us share the new office space, helping us design it out. Detroit, Denver, Dallas, personally involved in working all of those places to something which could work.

And that leads to one of my favorite stories about working at the PTO. I for a brief period of time was the only PTO employee in the Denver office. For a few days it was just me and the reason for that is there there were no permanent employees and we had opened the temporary office in the middle of the winter; it's February, it's cold, it's negative 8 degrees, it's high up there in the hills. And I fly in by myself. That office has all been set up wonderfully by the people in the Office of Administrative Services but it's empty and I get there early in the morning and I wander over to the GSA office there on site and they were really happy to have you here and "here's the keys." "By the way the heating plant is turned off. You have to turn it on." It's February and it's in Denver. I get into the office I could see my breath and it was just so strange being here by yourself opening a new office, it's like a pivotal moment in the agency and it was a ton of fun. And we got everything up and running and obviously we ended up with beautiful facilities in Detroit and in Dallas and in Silicon Valley. But my part of it I feel is not was not as the big architect of how do we get to AIA or at the end of it but really kind of just the person who was in the middle helping to get it done and setting up the teams, trying to find the resources, and enjoying that.

So that's about my little piece of it and I want to thank you for letting me manage speak to that and tell you my little anecdote about being shivering in the office in February.

James T. Carmichael (00:39:32)

And thank you Judge Moore. Interesting story about being the only employee at the Denver office briefly and now with COVID you can be the only APJ at your own office (in beautiful Delaware).

The next Chief Judge of the Board was James Smith. Judge Smith was the Chief Judge from 2011 to 2015, making him the first Chief Judge of the PTAB and the first Chief Judge in the Post-AIA era. Judge Smith is currently the Chief Intellectual Property Counsel at Ecolab. Judge Smith ...

Hon. James Donald Smith (00:40:12)

Good afternoon. Thank you for having me.

I may... I'll begin with a little bit of personal recollection as well and my recollection may differ and call into conflict some of former Vice Chief Judge Moore's recollection. I'll touch on that in a second and after a brief moment in the personal space I'll move to something I think more thematic before getting back to some other things - perhaps also more infected with the personal space.

Much is made now of the fact that there are these four additional offices of the USPTO: Detroit, Denver, Dallas, and as we first called it, Dan Jose, so there would be 4 D's; San Jose is it actually is. And much is made of the Patents Operation sharing space with us in those offices. The fact of the matter is, and Judge Moore's recollections touch on this, we realized at the Board before others did and this also goes to something Judge Fleming, Chief Judge Fleming was speaking about, we realized that having an adequate core of Judges made necessary having operations not in Washington alone. And because we realized that we actually went with the officials of the PTO to Congress to talk about what the implementation of their plan in the AIA would mean if we added to Detroit, four more offices, the locations of which were not even decided at the end of 2011. We engaged in the conversation with them about the selection of those officer having in mind as much where good Administrative Patent Judges could be found as where other personnel would be found for other positions at the Patent Office. And what Jay Moore and I shared actually is a very intimate with experience with those offices that predate some of their permanent locations and the peopling of them by anybody other than Board personnel.

I actually was with Judge Moore with the first week of January actually shortly after the new year in Colorado that we trudged through the snow to open that office. It was not in the grand Denver office with the USPTO has now and the 13th, 14th, and 15th floors of a leads quality tower in gleaming downtown Denver. The first space we acquired and we actually negotiated

this with the government the Board led the effort. It was a bunker essentially at an old military facility about 6 miles due West of downtown Denver - which required, you member Jay, a drive through a very winding path between military installations and other government offices before you got to the concrete layer our Denver Judges first occupied when the USPTO opened its office in Denver. The office was established and up and running there primarily with Administrative Patent Judges before the addition of different personnel and eventually the move downtown to the large tower only after the government had completed the refurbishment of the three floors that we came to occupy there.

Similarly, Jay and I hung out in the Detroit office. That office you will know is about a mile, between a a half a mile and a mile, east of the Renaissance center in downtown Detroit. An old Pabst brewing facility that then came to be owned by Schering Drug, a building also in need of substantial refurbishment. When Jay and I first were hanging out in that office, again well before it was peopled by other people in the PTO, we were dealing with one of the problems not yet addressed at the building which was - because of some of the things not quite fixed yet in the heating system, if you were there on the wrong afternoon and we're on the south side of the building the temperature might be 85 degrees while the rest of the floor was at 69 degrees - problems we worked through with extraordinary quick and able help from people at the PTO and from government office that handles those kinds of affairs.

Similarly in in Dallas. Maybe a good year before the permanent facility opened, Jay and I were in another federal building , one building over from the federal courthouse, and occupied by several other government agencies, and we turned the key on the opening of that office and were the first two people actually to help the various people install the computer, see the printers were running, and we did all of this while we also did our regular jobs.

This was true also in California. California, we now have a lovely facility in San Jose. That's not where it started. It started again the opening of the USPTO, not with other personnel but with a APJs. That started on a facility somewhere between Palo Alto and Menlo Park in a facility mainly occupied by the US Geological Survey. The back end of I think their tenth building, building X on that campus, also in need of refurbishment but very adequate in space and there were days when on evenings late evenings we would

leave Dulles airport land early evening, go there for work, work among other things to so let's help select the Judges who would serve in that office, put in a full day in California, fly back on the red-eye, and begin our duties the next day in Alexandria. Again well before the very well appointed facility in San Jose open.

Meanwhile of course Washington was, not the DC office or campus in Alexandria, was augmented with a facility in Shirlington where we also had Judges. I don't know if Judges are still located there - I'm assuming that probably, well there are no Judges in Shirlington now [due to COVID restrictions] but for reasons not related to the great assistance that additional location provided for us even in having more space for the DC operation.

All of these personal recollections tie actually to what I think is the biggest theme - which is this, who would have imagined that the BPAI in with it's very solid foundations built by people who have you have heard from already in this meeting, forward looking people who thought about things like what what purpose might the rules have to serve eventually, what kind of information gathering and recollection system ultimately serves the purposes of the Board Board 10 years out, how do you keep the various stakeholders in industry and in the economy happy with the operations of the decision makers at the BPAI. The very solid foundation built by the people at the BPAI made for a world where the BPAI in becoming the PTAB has resulted in this extraordinary thing.

If you ask the nine justices of the US Supreme Court have you heard the phrase PTAB - with the acronym PTAB - what would be their answer? Their answer would be "yes." Because somehow magically this tribunal that is near and dear to all of us has become the central government entity for this big question: how quiet ought title to be for a patent and not just the patent but the rights associated with the patent which are fundamental for in determining how to conduct business whether it's in the IT and computing world or in the pharmaceutical world. It's the same big question for them - will I be able to assert my rights, will others be able to assert rights against me, how strong are these rights, and can they be challenged. And which entity now has more control of that outcome than any in the country. We know the answer. It's PTAB. This is an extraordinary thing and the significance that the PTAB has taken on with respect to these issues means that the work performed by this group of people, these Vice Chiefs, Deputy APJ's and all their colleagues now in the backward look of history and even

looking forward has a glimmer to it that perhaps would have been unimaginable for PJ Federico sitting in his office as Chief Examiner-in-Chief decades ago when he was helping Judge Rich write section 103 of the current patent statute. It's an extraordinary thing and that we arrived at that place did not come about easily.

I of course can speak to the challenges we faced during the time I was there. I don't mean to suggest that these were in any way greater challenges than those faced by others but they perhaps were unique. Chief Judge Fleming spoke about the number of Judges at the Board at his departure. I can give you the number, it was 95. And at my departure it was 255; a whole lot of Judges between 95 and 255. Here is the big thing though - the increase number of Judges is almost less a matter of historical marvel, then this thing. Again Judge Fleming is correct - hard to look at any of these facts as progression of history without also referring to the political backdrop. The political backdrop around 95 APJ's at the time Chief Judge Fleming left the Board to go on back to making real money. The interesting thing at that time is one of the big things going on in government and the political discourse was why ought the federal government to have even one more employee in 2011 than it had in 2010. What was the result? We were not permitted as a Board to grow. The 95 Judges was not merely the number, it was the ceiling. Now progress a little bit into that and you'll recognize the enormous challenge that faces. We were on our way to an eventually had 27,000 plus ex parte appeals. We were expecting 350 Post-Grant cases - I use that term generally to refer to the add a trials what happened is we did in fact reach the 27,000 ex parte appeals and in the first year we had more than 1500 new trials to hear. How then is that square was a 95 Judge ceiling on the size of the Board. Another - here I I just think it appropriate to get into another recollection that is a bit more personal. At one point the then Under Secretary Director and I, we were looking at the numbers. I remember it so well. It was November of 2011 and we've been talking a lot about Board size and what we do with the challenges that are facing us and considering among other things - one element I now know to blame Judge Fleming for: the requirement that AIA cases be finished in 365 days, thank you for that. Only I think it's the right thing, I think it's done wonderful things for the results we're talking about here which is the preeminence of the PTAB. But imagine not only that you have 95 Judges when there's work that's going to occupy easily 255, you have an embargo against growing, and when the work comes you can't push it off in time because there will be a congressional requirement as to when you finish it. Under Secretary Kappos

and I - it was a second or third weekend in November and there was debate going on about the next continuing resolution in Congress for spending because of course we know our Congress still can't come up with a budget for the last quarter century, they operate with these continuing resolution things and are forever behind in figuring out how we spend our money - and it was not going to be possible even if we were allowed to have the appointment of more Judges, to actually pay their salaries unless Congress authorized us to do so and the continuing resolution that would control the period going forward was under discussion and Under Secretary Kappos was in discussions with the Office of Management and Budget of the White House - is to how we handle all of that and we came upon the realization we are in serious trouble. We're done. If we don't both get the money and the authorization for the Judges, 27,000 ex parte appeals are going to grow to 35,000 in about 6 to 8 months, we won't meet any AIA deadlines, and the PTAB, the BPAI, whatever this organization is, will have been declared a complete and utter failure as a way in which the patent world and the USPTO handles these issues. We were in talks with the White House for a good month before that continuing resolution included two things that were revolutionary: no ceiling at all on Judges other than is necessary to meet the requirements of doing the work and whatever money was required to make it happen - that changed so much. What that led to was over the course of 24 months 2300 applications for people wishing to serve as APJ's; 1600 that made it through to detailed consideration; 650 interviews of Administrative Patent Judges; and, the eventual appointment of about 160 of them. Completely game changing. Now you might say well okay we overcame the problems and again this is just one of many kinds of things we were confronting.

Here's another enormous headwind that I at least never anticipated. There were those folks at the USPTO who said okay you need lots of Judges and the opening of the offices and the authorization that you're looking for there's a way around that. After an examiner has served two years and if that person has a law degree and took a third year trial practice class, they should be suitable for appointment right? To me that was about as outrageous a thing as I've ever heard because of course those who have done this work know the years of experience, judgment, study of the law, required to have a clue of judges who can do what these judges do. I wish I had a dollar for every piece of hate mail I received on the notion that the Judges, the Administrative Patent Judges at the PTAB, need to be at a level where what they write, how they write, is able to be an exhibit, not merely an exhibit, but

part of the file of cases when they go to the US Supreme Court. If that's so wild a notion, well if it's wild then actuality is wild, because some of the biggest cases in intellectual property law have had as their primary document for review the work done by the PTAB. I could easily go on about the history of the P tab at least in from my little slice of time there for a long time but I'm already over time.

I would state one thing very emphatically that the others who have spoken have said. PTAB success and I'll call what we've achieved all together as that, rather than PTAB failure. PTAB success is definitely a team sport. There is no way you make this thing come together and cause the PTAB to be what it is without a whole lot of people working very hard, a whole lot of people working very hard. There are people who argue about what they think the PTAB does, how it decides cases. I've yet to hear any argument about the PTAB being equal to this task.

And as my last personal note and I maybe should have the discipline not to say this but I don't, at least not at this moment. During a period between 2013 and early 2015 my average work day started at 9:00 AM, had dinner about 9:00 PM maybe 8:00 PM, went back to work, went to the gym across the street from the PTAB from about 10:00 to 11:00 PM, came back at to the office and worked the 11:30 to 2:00 AM shift and often slept in my car and took a shower in that same gym before starting the next day. That's how much work we had to do and there are a lot of people who worked that way to make this thing happen. I will say this, I am extraordinarily grateful that the people and the and the circumstances allowed little old me to have any hand in what the PTAB has done. Jim.

James T. Carmichael (01:02:46)

Thank you Judge Smith for that fascinating perspective on the birth of the PTAB, the hiring of Judges from among thousands of applicants, and the PTAB's current significance. We appreciate your comments and your remarkable service and remarkably long hours to get the PTAB started and on course for the AIA and the PTAB success. And I join you in calling it that.

Following Judge Smith, Nate Kelley was the acting Chief and the Deputy Chief from 2015 to 2016. He is currently a partner at Perkins Coie. Judge Kelly ...

Hon. Nathan Kelley (01:03:28)

Thanks Jim. Just as it was five years ago, I guess six years ago, Chief Judge Smith is a hard act to follow.

I feel today like a little bit like I felt at the Board which is something of a substitute teacher - getting us from one real Chief Judge to the next. You know there's this joke that I'm sure a lot of you have heard which is that the best two days in a boat owners life is the day to get their boat in the day to get rid of the boat. You know the worst two sort of emotional days in my professional career was the day I came to the Board and then the day I left. I came to the Board it was sort of a shock to the system to my system I'm sure to the Board system. I found out the week before. It was sort of made public basically the Friday before and I was at a conference in California Federal Circuit Bar Association conference. Chief Judge Boalick was there and it's just I showed up on Monday and I was at the Board and I just have never felt more uncomfortable in my life. And thanks to people like Krista Flanagan and Ken Barrett and Mike Tierney and now I'm naming people and I'm going to forget and of course Scott Boalick you know and Allen Cogswell, it all worked out from my perspective. And then by the time I left it was very hard to leave you know. I kind of liked it after awhile. It took a while but I got there. But while I was there I felt like my job at the Board was kind of like my job before - which was to defend the Board - like I'm just going to defend it. And that's kind of what I felt like when I was there because during that time 2015 to 2016 there was a lot going on, right, so we sort of reached our cruising altitude. Heard about the ramp up of Judges. When I got there there were these vacancy announcements, they were like every 30 days. We were like on vacancy announcement 40 or something. And there was like this system, right - there were the teams that were doing the paper review; there were the teams that were doing the in-person interviews, and then there was like, you know, people would filter through and then get to me and I looked at something called the unified plan or something like that that Chief Judge Boalick understands completely and I never really understood and just stopped it. I said oaky that's good you know. Chief Judge Smith did an amazing job and couldn't have been done without those satellite offices - that is completely true with those - I'm not suppose to say satellite offices - with the regional offices. We got the resources but more importantly the talent pools that were not in DC, not that DC doesn't have talent but I think everybody gets what I am saying - and that's what got us to 250 and then ultimately like 275 or something. But that was enough and so we stopped

that and then we kind of had to adjust to that size and that size was uncomfortable I think at first it might be still uncomfortable I don't know but I felt like there were a lot of fires I had to put out with respect to what was going on with these Judges and those Judges and I felt like that was my job just to keep everybody happy and keep it going.

But a couple of other things sort of manifested themselves at that time and they're still around and there was like a fundamental shift in the Board I think and Mike Fleming mentioned this when he talked about the idea of giving the Board rulemaking authority and more power to sort of shape what would happen. And indeed you know that's what happened right. There's some policy room, there's some space within which now the Board can operate. But with that came this pressure like how would we do it. Would we do it through precedential opinions - which is how we had always done it and how we tried to keep doing it. It was difficult to get that many Judges to vote one way or another on something and I know the front office pushed me to get that done and I know they pushed my successor to get that done and I imagine he had this hard time with it as I did. The downside of that though is we got this big change right - we gotta change about who was making this policy and how the policy would be made with - I'm sure the Board's input and everybody else's input - by a single person, by the Director, which is declared that's precedential, that's not precedential. And I don't know if that's the best place to be or not but I think it puts the Board in more of a policy position and I don't know that that's a more comfortable position to be . Because what it means is the policy to start going one way and then it can start going another way and then politics comes into play and judging becomes that much more difficult.

And that brings me to the other thing that happened to the Board and maybe maybe this was always there and I've just never perceived it before. You know there was this spotlight, this like white hot spotlight. I'm sure Chief Judge Smith felt it when he was there. I certainly felt it and it has not dimmed at all and it is it is great to be so important but with that importance comes a lot of heat and a lot of people watching and a lot of people criticizing. And even today like this week I got an email from someone I've never heard of you know won't respond to and it was basically like hate mail about my life at the PTO and what I caused to have happened. And I didn't cause anything as far as I know except to keep everything running on time for 10 or 11 months until I could you know pass things along to Chief Judge Ruschke. But that attention you know that's just something I don't think the

Board felt before and maybe some of the Board did but now I mean I have a lot of meetings talking about the PTAB, asking me what I think the PTAB will do, where it will go, and how will this be resolved. And it is now like the dominant and most important policy part of the agency - it's what people care about, it's what litigants care about, it's what everybody thinks about as soon as they get sued, and it's what everybody thinks about before they they decide to take their valuable patent and assert it. And that's just a difference and it's a difference that the PTAB is, I don't know if I wanna say stuck with, but.

I guess I'll wrap up and say that I felt a little envy when Chief Judge Smith was talking about this cement bunker 5 miles away from the city center and there would have been times when I was at the Board when I would have liked to have been in such a bunker and my guess is that there are people at the Board that would enjoy such a bunker today, not that it's necessary but maybe it's just me, I just want to keep my head down and do my job and get it done right and all of the attention was not the greatest thing in the world but I think it's it's at least a change I saw happen while I was there. So I think as a substitute teacher I took more than my allotted time and I will turn it back to you again.

James T. Carmichael (01:11:13)

Thank you Judge Kelley, great perspective and I'm sorry about the hate mail.

The next Chief Judge of the PTAB, as Judge Kelly mentioned, was David Ruschke who served as the Chief Judge from 2016 to 2018. Judge Ruschke currently heads up the Central Reexamination Unit, the PTO's other post-rant organization. Judge Ruschke...

Hon. David P. Ruschke (01:11:45)

Thanks Jim and thanks everybody. It is great to be with this group and again, if I start mentioning names and I leave people out I want to apologize in advance for that.

I guess I'll start just the remarks - I know we're running a little bit behind and please feel free to cut me off Jim as we go - but one of the things I think that I looked at my tenure as being in some ways kind of tumultuous and sort of follows on to what Nate was talking about having the spotlight on you. It

almost got to the extent that every single morning when you would look at the news clips you were going to be wondering what article or what criticism of PTAB was going to be leveled at you and because you knew that that would result ultimately in somebody from the 10th floor giving you a call asking "so what are we going to do about this, how can we respond to that" and so the spotlight was definitely out there. I don't know if you all recall but this was also during the time period where a number of the inventor groups, the stakeholders, were quite upset with PTAB and they leveled a lot of criticism at PTAB. In fact they actually came onto campus and burned patents in front of the building at one point. They used to, they would attend PPAC meetings and they would be downstairs in the Madison auditorium during the presentation pacing, sending questions, very very pointed questions to us as we were trying to answer them during the presentation. So it was a very very difficult time in some respects.

Fortunately I would like to say that I think a lot of that calmed down and certainly has calmed down significantly with Andre [Iancu] coming on Board. But there still is like you say there's still email that you'll get. You'll still hear about it and there still articles being written of course. And there's still constitutional challenges that the Supreme Court that have to be fought.

I think the other reason it was a little tumultuous I might say as well just because of the change in leadership. So I remember people asking me - why do you want to go and start a job at the government when there's another presidential election coming up in four months and you don't know who's going to be elected and who's the new director going to be etc. etc. you know. And so we had a situation of course where I finished out [Director] Michelle Lee's quote unquote first term, she was extended into her second term, into the Trump administration, and then we had to wait essentially 13 months before Andre came on board and we had Joe Matal as our interim Director and then Andre came on in February a year following the inauguration and that created a lot of difficulties because as we were talking about earlier how do you create policy and how do you have consistent opinions on the Board when the person in charge of the Board is changing or is in an interim position and it was very very difficult for us to do and, as Nate mentioned, one of the levers we had - since rulemaking would have been preferable in many situations and many of the Judges wanted to do rulemaking - we had precedential opinions and I think Mike said early on you know that was one way of doing consistency which is absolutely true but we had a difficult on the Board because you know, if you remember,

sovereign immunity, joinder, a lot of these very fundamental issues were coming down exactly on the opposite sides: one panel versus another. And we would run straw polls as to how the Judges would feel about certain issues and there were issues that literally came down 50:50, so when we have that the precedential opinion process of having to have a vote of the Judges it was almost impossible to get things through. We got a few things through but I too was tasked with coming up with a new process to create that consistency which would of course help the messaging and help the stakeholders understand what they could expect when they came to the Board and also help the Judges understand how they would have to deal with this and that was really important for us to do that and that took about two years. We did a number of iterations internally to try to come up with different systems. Ultimately it was replaced with the SOP [Standard Operating Procedure] right at the end of my tenure and I think for better or for worse there's certainly a lot of precedential opinions out there now that allow stakeholder interaction or input but also Director ratification which I think has been very very positive for the patent community generally. Although as Nate mentioned the new Director can come in and that could potentially create some changes to existing precedent as we've been living with it for the last two or three years. So that was probably one of the biggest things during my tenure was to try to come up with a precedential opinion process that made sense, that would be visible, and that would also help the notice requirement and make sure that everybody understood where the policy was headed.

I would like to say, you know, the other thing that was a little tumultuous that we were talking about is that we started up at the Supreme Court. I was lucky enough within one month of starting Cuozzo was decided - well that wasn't maybe necessarily a significant sea change for us - ultimately we had Oil States and SAS and then we had Aqua Products at the Federal Circuit - so we had a lot of cases going on with the Supreme Court getting involved in as James said it was definitely true when the when the Supreme Court knows what PTAB stands for and if you'll indulge me, Jim, I'll say one little anecdote. When we were up there for oral argument - and Nate you were in front of the bar during the SAS-Oil States argument and when the solicitor was giving an argument on and trying to explain to the justices about how the expanded panel process used to work, he was explaining how the Chief Judge of the tap has authority to expand panels to which Justice Roberts interjected immediately and said "Chief Judge? Chief Judge? You mean the employee" and so I always thought it that is sort of like my 5 seconds or 10

seconds of fame in front of the Supreme Court that at that point in time he was referring to the Chief Judge of the PTAB as an employee and of course we have *Arthrex* out there which is now going to be a telling us exactly what kind of employees APJ's are.

But I think that brings the perspective around perfectly of the spotlight and what the PTAB means out there. I mean there's more cases obviously to be decided. I'm not going to go too much into it.

I just want to say a couple more points. One of the things because we didn't have a permanent director in place for so long period of time, one of the things I'm very proud of that we did at the Board was pull together a lot of people - Judges, patent attorneys, admin folks - to pull together statistics because we always thought you know instead of just arguing with people and trying to be on panels and trying to put our best face forward let's just pull together the real data that we have at the PTO and let's present that as frequently and as often as we can and I really appreciate all the hard work that the teams did. I gave many many speeches on data as did Jackie and Scott and among number of the team members and I hope that that really helped - particularly with respect to multiple petitions, expanded panels, use of 325(d), multiple proceedings, things like that. I think that's really helped I'm glad to say that the Board has really done a great job since my time keeping going on that because it really I think makes a difference out there and people actually have the reality of the P tab as opposed to the mythology of the PTAB.

Lastly I know I didn't have to hire like James did, we did do a re-org if you will we sort of had grown up at That point when I came on Board and Scott and I spent many many many many hours in interviews as we were trying to move the Judges around into a structure that actually made sense. And I really wanted to thank Scott and Jackie was the recipient of that - she was essentially our first Vice Chief Judge at the time and you know obviously done a great job up there and that was really important I think for the Board to have some sort of firm structure going forward since they had that huge growth spurt underneath James and that was a tough tough thing to do so nothing that I had to do was rose to that extent but I do remember we weren't sure what the new president was going to do and Scott and I were frantically trying to get enough of the hires in on January 19th before the new president came in because he wanted to make sure that we could hire and do a reorg to

make it as functional as possible as we could over the next two to two to three years.

And finally lastly one of the things you know that Nate talked about - some very very you know important days in his career - I have to tell you that there was two things that happened with me and they they were really with PTAB initially and that was we hadn't over time really done official swearing-in ceremonies for the Judges and so very early on in my tenure we had a big ceremony in Alexandria - but we also want to other regional offices and swore in the new Judges that hadn't been sworn-in - that was so meaningful for them because they were able to bring their families, their children, dignitaries, we had other Judges in the area come in, and that was really really important.

And the second big piece that we had was our in person All Hands meeting that we had - where we brought 400 every single person from the PTAB came on campus in Alexandria for three days - you know I never got a chance to meet every single person individually up until that time and now of course in this time of COVID when everybody is doing Zoom and not meeting in person, I look back on that with an extreme extreme pleasure that that was something that was very important to bring you know continuity to the Board, bring everybody together, get a chance for them to have lunch together, have a drink, go on a walk and that to me was probably one of the biggest accomplishments when I look back at my tenure was being able to do that for the Board.

I'll leave it that Jim and thanks again for setting this up. It's a great program.

James T. Carmichael (01:22:24)

Thank you Judge Ruschke. The change from straw polls to precedential opinion process certainly provides some needed certainty and the development and publication of statistics really did help with understanding the reality of the PTAB as opposed to mythology. The swearing in process and the All-Hands meetings were also important developments. Thanks to COVID, obviously we can't do the All-Hands meeting but at least people are no longer burning patents on your doorstep.

Next we have Deputy Chief Judge Jackie Bonilla. Judge Bonilla has been the Deputy Chief of the PTAB since 2019 and was acting Deputy Chief starting in 2018. Deputy Chief Judge Bonilla, take it away ...

Hon. Jacquelline W. Bonilla (01:23:12)

Thanks. I just want to say that it is really such an honor to be here with everybody who is speaking today. To the extent I had any doubt—which I already did not—you all have underscored the magnitude of the giants that preceded us. Your forward thinking was extraordinarily. Honestly, I can tell you, and I'll talk a little bit about this in a moment, I benefited from your great work. We all did at the Board, it's just quite incredible. So thank you for that. And thank you for including me as part of this conversation.

I was trying to think of what I could cover that would be different from what other speakers might say today. And with that in mind, I thought I would talk about two things. The first one is my perspective coming to the Board as an APJ in 2012. It was an interesting time to arrive, not to mention what we have experienced up through today. Second, if I have time, I thought I would talk a little bit about the history of women at the Board.

Regarding the first topic, I obviously was hired as part of the big wave of hiring that happened at BPAI in 2012, and at what became PTAB soon after. I started in January 2012, along with Judges Erica Franklin and Debbie Katz. They had started a few weeks before me in December. We were the first APJs to be hired after the AIA passed in September 2011. Notably, earlier that fall was the first time APJ positions were open to people that I would call “general public” practitioners. Prior to that time, it was very difficult to get hired at the Board from private practice or even from the federal government outside the USPTO. It did happen, you saw it, but it was so rare that most people didn't know about it or they thought it was impossible. I know I did.

When I started at the Board, I was literally Judge #100. I still have a piece of paper that shows the list of the Judges at the Board on the day I was hired—I was exactly #100 on that day. Soon thereafter, as you know, PTAB obviously skyrocketed in hirings. As others have already talked about, the number of judges at the Board was at its highest level at, I believe, a little over 270 in 2016. That's an increase of 170 Judges since I arrived in 2012. Obviously, a large majority of those new Judges came from the outside,

outside of the USPTO. That was a big change. Just to keep it in perspective, from somebody who was in private practice before I arrived, that's the equivalent of hiring a mid-sized law firm, done piecemeal over a few short years. That is just incredible when you think about it. I'm overwhelmed with awe at the lift that such a hiring involved. After that time, by around 2016, the Board started to plateau in size, and then went down slightly. So right now, due to natural attrition and retirements, we're at about 250 Judges.

But when I arrived in 2012, it was a really incredible time to come to the Board. I met so many fun, brilliant people, both new and experienced at the Board. Especially when I very first arrived, that first year, there were so many people, so many new Judges arriving all at once. And everybody was super excited to be there. People were thrilled to grab lunch, thrilled to go to somebody's office and chat. I mean, I honestly think the experience was like participating in a fun summer camp for smart patent attorneys. And then, of course, as already mentioned, around the same time, all the regional offices opened. The PTAB led the charge in that capacity, and we met lots of new friends that way too.

So, in 2012, the Board was plugging along, the ex parte backlog was huge but it was coming down. AIA cases were getting started in earnest. And, as people touched upon already, all of a sudden PTAB was in IP news a lot. Being in the press was both good and bad, especially because the news reported things that were both true and frankly untrue. Everybody wanted to know what was going on at the Board, and lots of people had something to say about it. This kind of attention was a huge change because even in 2011 when I applied, the Board—who worked there, what they did, how they did it—it was a black box. I remember I did my own diligence to find out what I could about the Board when I applied for the position. There was very little to find out. But, as Nate said, by 2015, we had started seeing all sorts of press about the Board, including a lot of inaccurate perceptions and misinformation. We can all speculate as to why that happened, but I think one reason was because all the sudden the Board was issuing far more decisions that had a really big impact on IP litigation. The impact wasn't rare or below the radar, like it had been before—it was happening a lot. And big name IP litigation firms and big name IP litigators were taking notice and talking about it. Being noticed in this way was a big change. And a lot of people don't like change, they like things to keep things status quo. So, the change of being watched intensely was a big deal.

One example of an early perception issue was the label of the Board as a “patent death squad.” I think it's really interesting to keep in mind that Judge Rader coined that term at a presentation that he gave at AIPLA in October of 2013. Notably, in October of 2013, the PTAB had not yet issued a single final written decision or found a single claim unpatentable in an AIA trial. The Board’s very first final written decision issued in November of 2013, a month later. So, you can see that some people already had a bias about what we were doing and how we were doing it, before we ever actually did anything.

It was in this environment of change, meanwhile, that I became a Lead Judge of a brand new section at the Board in 2015. At that time, we needed a bunch of new sections because of growth. I think Judge Fleming talked about how they had set up the Board structure so it could grow. And I can tell you, I saw it first hand, the capacity for the Board to grow. Later on, I became a Vice Chief in December 2016. This was a part of an entirely new structure at the Board. David talked about how he and Scott had put together a new structure of Board executive leadership. That structure comprised five Vice Chief Judges and our Board executive. From my own perspective in Board management, it has been extremely valuable to have been a regular Judge—doing the ex parte cases and interferences—I was lucky enough to do those early on—and doing AIA work, and also being mentored over the years by so many experienced and newer Judges. Especially in relation to AIA work, everybody was learning as we went—a lot of it was just so new. It is unbelievably valuable and incredible that everybody at the Board is so smart, thoughtful, and amazingly congenial. It’s been such a phenomenal time to be at the Board, I have to say.

So with that, if I have time, I'll pivot a bit to give a little history about women at the Board. This was something I was interested in, so I looked into it. I talked to some people on this call, as well as other Judges, to learn more. First off, I'll say that in 2012 when I was hired, as it is today, the Board generally has held steady at about one-third women. But in terms of the overall history of the Board, which has been around in some form since at least the 1860s, having any women at all is relatively new. The first woman at the Board was a woman named Brett Sturtevant, who was appointed by President Nixon in 1971 as an Examiner-in-Chief. Back then, the Board was small enough that it was only 15 people. She actually got a call from the White House about her job—just to get a perspective of how things happened back then. Judge Meredith Petravick gave me a website of a

Penn State recording and transcript of an interview with Brett Sturtevant. Maybe she can pass along that website because it's fascinating to read about Brett Sturtevant's life, how she came to the Board, and many other things about her professional life. [Many thanks to Meredith for providing this website: <https://libraries.psu.edu/about/collections/few-good-women/biographies/brereton-sturtevant/brereton-sturtevant-interview>.] I highly recommend that read.

After Brett Sturtevant came to the Board in 1971, two more women were appointed in 1974, and two more came in 1985 in 1986, respectively. And just to give a little bit more perspective, many of you probably know Adriene Hanlon. She has been at the Board for a long time. Interestingly, she is approximately my age, and currently is my contemporary and colleague. Notably, in 1994, Judge Hanlon became the sixth woman at the Board in its history. And Murriel Crawford, one of our colleagues on the phone right now, she became the first woman of color at the Board in 1996. Murriel also was the first woman to sit on mechanical/electrical panels. Up to that point, women APJs had been in the chemical-bio area. It's just stunning to me to learn this history because it was not that long ago. From my own perspective I finished graduate school in 1995 and law school in 1998. In other words, this Board history is not that long ago for me personally. And, just to give another perspective, having women in leadership at the Board in any capacity, that's new, too. It started with the formation of the Lead Judge position in the mid-2000s. Judges Linda Horner and Sally Lane became Lead Judges in 2007 and 2008, respectively, and a number of other women became Lead Judges in 2011. Around that same time, Lead Judges started acting as direct supervisors of sections. Linda Horner also served as an Acting Vice Chief, starting in 2013. She was the first woman to serve in any executive role, in an Acting capacity or otherwise, at the Board. After her, Barbara Benoit and Miriam Quinn served as Acting Vice Chiefs from 2014 to 2015. And the Board saw its first woman in an SES role (non-Acting) when Janet Gongola became Vice Chief in October 2016. Grace Obermann and I followed soon after in December of 2016.

I bring this up because it is worth keeping in mind how things were at the Board, not very long ago at all. Diversity and inclusion are important, and I think we've made great strides through hard work, involving a lot of champions, including people on this call. But we still have some ways to go. Keeping our history in mind, and talking about it, really helps.

So with that I will pass the baton and thanks again for including me.

James T. Carmichael (01:34:35)

Thank you Deputy Chief Bonilla. I started at the Board not too long after Judge Adrienne Hanlon and so I'm stunned to hear that she was only the sixth woman on the Board. And your remarks about the summer camp environment certainly sounds nicer than death squad.

Now to cap it all off we have Chief Judge Scott Boalick. Chief Judge Boalick was acting Deputy Chief of the PTAB from 2014 to 2015, Deputy Chief Judge from 2016 to 2018, acting Chief Judge from 2018 to 2019, and has been the Chief Judge of the PTAB since 2019. Chief Judge Bullock has been a good friend to the AAPJ and we're very grateful for that. Judge Boalick...

Hon. Scott R. Boalick (01:35:30)

Thank you Jim.

I do apologize because I realized I'm already late here; we are over time and I'm tempted to just quote Salvador Dali and say that I'll be so short that I've already finished. But sadly I will say a few things here just in case. I'm really surprised - I've been watching that participant number and it's holding steady so far - we'll see how long that lasts.

But anyway there's there's been you know a couple of folks I know you know both Jay and Jackie talked about kind of standing on the shoulders of giants and I really do feel that way both you know for myself, my career at the Board - in a sense the AIA is that way too as Bruce Stoner and Mike Fleming recalled in the early days in the early history of how it came to be. I just have to say that really I do owe my career here at the Board to Mike Fleming and Gary Harkcom - who is unfortunately I guess not here tonight - they you know they hired me and you know I have some of my mentors in my early days are on the phone including Ken Hairston - I spent many hours in Ken's office learning the trade and Al McDonald's not on the phone but I also spend a lot of hours in Al's office you know learning what to do and what not to do now just you know great folks all around. All of my

predecessors in the executive ranks here at the Board have been folks that I've just learned so much from starting with Mike Fleming and going all the way up through you know to David I feel like you know I've learned so much and really regard them all as mentors and friends. It is really a you know a special position that I you know I just feel like it's kind of the honor and the challenge of a lifetime - you know running the Board - I often thought probably the easiest job there ever could be 'cause you've got all these really smart talented people but if as we've heard from you know the other speakers here tonight, believe me there are plenty of challenges, some of them sounding quite familiar, does seem that history repeats itself in some form. Since I joined and came to the position I'm in now I think I have occupied every position that a Judge could have at the Board - including an APJ, and what we had for a while as a supervisory APJ when when Eric Chen reported to the Board as a patent attorney, and then thanks to Jay and James I've got into management and became a Lead Judge and then a Vice Chief Judge at times and at times an acting Vice Chief Judge. I think I was the entire other executive. I do recall what Jay said brings back memories of signing lots and lots of reviews in October in April. I think at the time I had about 200 there - so April and October were not my friends in those days. Luckily we've grown and we've made up.

So right the Board I was number 53 when I joined and as you heard from Jackie where we're now we grew past 250 but were back down to around 250. We've grown as you heard in not only in size but in locations spread out across the country. We're now in a position where well you know telework was normal even before the pandemic and now it's totally normal. You know the ways that we work have evolved. I do recall some legacy paper files when I first arrived and there are a number of them still in a filing cabinet somewhere on the floors of the Board but you just don't see those anymore. I just have to say that you know you really don't know what you're getting into as you rise up through the organization and you know looking back now I really do appreciate so much more all that that my predecessors have done and how much they really dealt with that you never know or never find out and that's kind of a good thing that I have sort of viewed part of the position as trying to be a firewall so that the Judges can just concentrate and do their jobs but as you've heard there's a lot going on both within and outside the PTO and I sort of feel my job's to absorb that and not let it bog down the Judges in doing the job that they have to do. Now you don't get to do that alone. Without the team that I have I would never succeed and so I really am so fortunate to have a great leadership team and you know so many wonderfully talented Judges on the Board you know - I just have to I run the

risk of the Academy Awards of leaving somebody out I'm sure that that I will and I do apologize but you know the team we've got really in my mind is second to none - I've never worked with a better team including Jackie as the Deputy Chief Judge with Mike Tierney and Scott Weidenfeller, Janet Gongola, and Mike Kim as our Vice Chief Judges and Troy Tyler's our Board Executive but also behind the scenes really without people like Krista Flanagan and Andrew Melvin the Board doesn't work. They truly do keep things going as well as our executive assistants and we have now 2 senior lead Judges: Kal Deshpande and Melissa Haapala who are also kind of helping us - as well as all of the lead Judges who now have become too numerous to really name here in one sitting but they all really contribute so much as well as the very talented and wonderful Judges and patent attorneys and staff of the Board operations division. So as I say it really is a great team. We have our challenges but you know I really wouldn't have it any other way.

Shifting to the AIA, the thing that I think is really interesting about this as I you know sort of did see it I remember you know watching the voting and for a while it really seemed like that sequence of Charlie Brown with Lucy and the football of Congress taking a run at it and it didn't work and then in 2011 it finally did and just you know being there as part of the activity and watching that whole thing transform - it really was remarkable. But I guess what I've learned is you're never done and I don't think we ever will be there's always issues that come up that you never would have anticipated - I mean who knew that we'd ever have to look up sovereign immunity after law school you know - who knew that an appointments clause would be a thing - so many issues - who knew that we'd get 6 trips to the Supreme Court including one day when the entire hearing session of the Supreme Court were two back-to-back PTAB cases - so just kind of remarkable and then on top of that now we have a global pandemic on top of all of that and the amazing thing is because of the hard work of my predecessors and the team here now and all the Judges and staff of the PTAB we didn't miss a beat you know. They locked up the PTO on a Friday and on Monday we opened virtually with a complete set of hearings and we really never looked back. So I think that speaks a lot to the spirit you know and the just determination to get things done of the people at the Board and I think you know it's been that way and you know it continues to be that way.

I don't want to keep everybody here. I could tell tales all night long just because it is the place that I care a lot about and I think we all do. The fact

that you're still here and I've only lost two people during my speech tells you that that's not too bad. Anyway thanks so much Jim for putting this program together. I thought it was really great, brought back tons of you know good memories, and you know we'll we'll see what the next chapter holds in store for us but you know I just I just know it's going to be exciting. So thanks.

James T. Carmichael (01:45:45)

Thank you and thank you for your gracious acknowledgement of everyone making the PTAB the well oiled machine it appears to be and we won't hold you to the Academy Awards standard but you're right it's difficult to name everybody that is pulling together as terrific team that that you have put together.

And Chief Judge Boalick your contributions cannot be overstated and I think I speak for everyone when I say I hope you and Vice Chief Judge Bonilla continue running the PTAB for a long, long time.

This has been a very informative session and it is the first true history of the PTAB from the leadership perspective. The AAPJ is grateful to all of you for your participation and your exceptional service to your country. You have made the world a much better place and we thank you for it.