

**HOUSE COMMITTEE ON THE JUDICIARY, COURTS, IP, AND THE INTERNET
SUBCOMMITTEE**

**THE PATENT TRIAL AND APPEAL BOARD AFTER 10 YEARS: IMPACT ON
INNOVATION AND SMALL BUSINESSES**

JUNE 23, 2022

Questions for the Record from Chairman Hank Johnson

1. You testified that the PTAB judges are burdened with heavy dockets. In your view, how many trials should a judge be responsible for each year?

I cannot provide a numerical answer to this question. The APJs themselves are probably best positioned to provide detailed guidance on how best to ensure their workloads are reasonable. Qualitatively, however, it is important to practitioners and the parties that the judges be provided adequate time to fully understand and analyze the case, given the importance of the issue before them. The evidentiary record and briefs submitted in a case can easily amount to tens of thousands of pages, and parties typically are given only 45 minutes to present their case at oral argument. To instill confidence in the system, stakeholders need assurance that the APJs' workloads provide them with adequate opportunity to fully consider the evidence and arguments.

2. Do you think live testimony from experts should be granted by right? If not, under what circumstances do you think live testimony should be granted?

While I do not currently submit that live testimony from experts should be granted by right, I submit that it should be more widely available to help the PTAB properly assess the weight to be given to the expert's testimony. For example, limited live testimony should be considered when an expert has been evasive or obstructionist on cross-examination on issues that are important in the case, particularly where the expert has offered direct testimony on related issues in support of the party that retained him/her. The prospect of live testimony may curb some of the bad behavior witnesses sometimes engage in on cross-examination.

3. In your view, why are so many patent claims allowed by examiners later found invalid the PTAB? In your view, is there a difference between the technical expertise of APJs and that of examiners?

As I see it, the issue is multi-fold: Patent Examiners have limited time to examine an application, and they may not fully appreciate the teachings of the prior art presented to them. And in some instances, the most relevant prior art is not provided to the Examiner, or it is not closely considered by the Examiner. In other instances, the Examiner does not appear to fully understand the law that is relevant to the facts at hand. Petitioners in an IPR have more opportunity and resources to develop unpatentability arguments than an Examiner has, and APJs generally understand the relevant law better than Examiners do. From my perspective, most Examiners are at least as technically competent as most APJs, but the Examiners assess a patent in light of a different record than the record before the APJs.

4. In your view, what would be the advantages and disadvantages of having a reexamination “off-ramp” for amendments?

An advantage is that such a system may allow the patentability of amended claims to be assessed in a manner more akin to original examination, i.e., as an iterative, ex parte process involving an Examiner who routinely assesses the patentability of similar technology. Such a process could give patent owners a fair opportunity to obtain patent claims of an appropriate scope in light of art identified in an IPR, thus allowing the patent system to reward innovation. However, if such a system were to create significant delays in the ultimate adjudication of original or amended claims of a patent, it could be disadvantageous to stakeholders seeking speedy resolution of patent rights.