

UNITED STATES OF AMERICA
ERIT SYSTEMS PROTECTION BOARD
WASHINGTON REGIONAL OFFICE

MICHAEL FITZPATRICK v. U.S. DEPARTMENT OF COMMERCE

Case No. DC-1221-21-0423-W-1

HEARING (VOL. 1)

BEFORE:

ANDREW NIEDRICK
Administrative Law Judge

Alexandria, Virginia

Monday, May 11, 2022

1 PARTICIPANTS:

2 On behalf of Appellant:

3 JOHN L. ABRAMIC, ESQUIRE
4 ROBERT KAPPERS, ESQUIRE
5 Steptoe & Johnson LLP
6 227 West Monroe Street, Suite 4700
7 Chicago, Illinois 60606
8 (312) 577-1300

9 CHRISTOPHER A. SUAREZ, ESQUIRE
10 Steptoe & Johnson LLP
11 1330 Connecticut Avenue, NW.
12 Washington, D.C. 20036
13 (202) 429-8131

14 On behalf of Agency:

15 WILLIAM HARRIGAN, ESQUIRE
16 U.S. Patent and Trademark Office
17 U.S. Department of Commerce
18 600 Dulany Street
19 Alexandria, Virginia 22314
20 (571) 272-3000

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C O N T E N T S

WITNESS:	DIRECT	CROSS	REDIRECT	RECROSS
Michael Fitzpatrick	9	156	255	
Phillip Kauffman	260	282	296	
Susan Mitchell	303	347	383	385

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1 P R O C E E D I N G S

2 (8:40 a.m.)

3 JUDGE NIEDRICK: You all set Ms. Dodson?
4 Can we go on the record, please?

5 COURT REPORTER: Yes. The time is 8:39
6 a.m. and we are on the record.

7 JUDGE NIEDRICK: Good morning. Today's
8 date is May 11, 2022 and it's approximately 8:40
9 a.m. Eastern, United States America Merit Systems
10 Protection Board has before it the appeal of
11 Michael Fitzpatrick. The caption is Michael
12 Fitzpatrick versus the Department of Commerce, the
13 MSPD docket number is DC-1221-21-0423-W-1. My
14 name is Administrative Judge Andrew Niedrick and
15 I've been assigned by the Board to handle this
16 appeal.

17 The hearing today is being conducted via
18 video teleconference using the Zoom for government
19 platform. The appellant, Judge Fitzpatrick is
20 present along with his representatives of records,
21 John Abramic, Robert Kappers and Christopher
22 Suarez.

1 The Agency's representative, William
2 Horrigan, is also present as is our court
3 reporter, Ms. Shandra Dawson. Ms. Dawson will
4 make a digital recording of the proceeding and
5 that recording will be uploaded into the record
6 probably seven to 10 days after the hearing is
7 complete.

8 This appeals stems from the appellant's
9 allegations that the Agency retaliated against him
10 because he made several protected whistleblower
11 disclosures. My jurisdictional findings
12 discussing the specific disclosures and/or related
13 personnel actions are founded in the appeal file
14 at (inaudible) Cab30. The only material issues to
15 be decided in this appeal to the exclusion of all
16 other issues are, number one, did the appellant
17 prove by preponderant evidence that he engaged in
18 whistleblowing activity by making one or both of
19 the protected disclosures at issue? Two, did the
20 appellant prove by preponderant evidence that any
21 proven disclosure was a contributing factor to any
22 of the (inaudible) or personnel actions at issue?

1 And the third and final issue is if the appellant
2 satisfies his burdens as discussed herein?

3 Did the agency prove by clear and
4 convincing evidence that it would have taken the
5 same personnel actions in the absence of any
6 protected disclosure? If the appellant prevails
7 in the merits of this appeal, I'll conduct a
8 separate proceeding to discuss the damages in this
9 case.

10 Yesterday, the appellant through his
11 attorneys advised that he was withdrawing his
12 request to call James Harpin (phonetic). And this
13 morning the Agency advised that it is withdrawing
14 its request to call Jacqueline Bonia (phonetic)
15 and Susan Mitchell. Anything from the parties
16 before we proceed with our first witness? Mr.
17 Abramic?

18 MR. ABRAMIC: No, Your Honor.

19 JUDGE NIEDRICK: Okay. Mr. Horrigan,
20 anything?

21 MR. HERRIGAN: A slight correction on
22 the thing with Ms. Mitchell. We did not withdraw

1 anything. We said to the opposing counsel here,
2 if he didn't call them then we would call, but
3 that was the extent of what we reached.

4 JUDGE NIEDRICK: I'm sorry. I thought
5 you said this morning that you were withdrawing
6 your request on Bonia and that you weren't going
7 to call Mitchell.

8 MR. HERRIGAN: No, sir. What I said was
9 that the question was posed to me whether if they
10 don't - if Mr. Fitzpatrick doesn't call Ms.
11 Mitchell in this case in chief, will you? And my
12 answer was no. But that was the extent of my
13 commitment.

14 JUDGE NIEDRICK: So what? Are you
15 calling Mitchell then?

16 MR. HERRIGAN: If they call Ms. Mitchell
17 then I will examine her.

18 JUDGE NIEDRICK: Okay. Are you calling
19 her on direct for your case in chief or are you
20 just cross examining her?

21 MR. HERRIGAN: I reserve the right to
22 treat her as a witness called by the Agency.

1 JUDGE NIEDRICK: Okay. So why don't you
2 just tell me that? The Agency is calling Ms.
3 Mitchell as a witness?

4 MR. HERRIGAN: If that's - okay.

5 JUDGE NIEDRICK: Okay. All right. One
6 moment here. Okay. So what we're going to do now
7 is Judge Fitzpatrick, I'm going to go ahead and
8 swear you in and then we'll proceed.

9 Can you please state and spell your
10 first and last names for the record?

11 MR. FITZPATRICK: Michael Fitzpatrick.
12 It's M-I-C- H-A-E-L, F-I-T-Z-P-A-T-R-I-C-K.

13 JUDGE NIEDRICK: Okay. And do you have
14 any objections to swearing an oath?

15 MR. FITZPATRICK: I do not.

16 Whereupon,

17 MICHAEL FITZPATRICK
18 was called as a witness and, having been first
19 duly sworn, was examined and testified as follows:

20 JUDGE NIEDRICK: Great. Thank you. So
21 as we go along if there's an objection by either
22 side, please (inaudible) hold your answer. I'll

1 rule on the objection and then instruct you on how
2 to proceed, okay?

3 And do you have any materials or
4 anything open in front of you right now?

5 THE WITNESS: Not yet, but I do have a
6 binder that's currently closed. It contains
7 exhibits in this case.

8 JUDGE NIEDRICK: Okay. Just don't
9 reference those unless, you know, we ask you to do
10 so. And I think unless there's anything else, Mr.
11 Abramic, your witness.

12 MR. ABRAMIC: Thank you, Your Honor.

13 DIRECT EXAMINATION

14 BY MR. ABRAMIC:

15 Q Judge Fitzpatrick, thank you for being
16 here. Can you please describe your post-high
17 school education?

18 A Yes. I went to the University Illinois
19 and got a degree in bioengineering. I graduated
20 in 1998. And then I went immediately to law
21 school at the University of Virginia, graduated in
22 2001.

1 Q And what did you do after law school?

2 A I took the bar and passed and became a
3 patent attorney in Chicago in a boutique named
4 McAndrews Illinois (phonetic).

5 Q And when was that?

6 A That was - I mean, I was started in
7 September 2001. I'm not sure I was sworn as an
8 attorney yet, but the Fall of 2001 I started.

9 Q And how long were you at the McAndrews
10 firm?

11 A Ultimately, it will be 10 years, but I
12 was there for a year and then I left to clerk for
13 Chief Judge Charles Kocoras of the U.S. District
14 Court. It was a commitment that I had wanted and
15 obtained while I was still in law school, but
16 there was a delay in doing the clerkship.

17 Q And so, after the clerkship you returned
18 to McAndrews?

19 A Yes. I'd say I worked there for another
20 about nine years.

21 Q Could you generally describe your
22 practice while you were at the McAndrews firm?

1 A Yes. It was mostly patent litigation in
2 federal court. The vast majority of it was at - I
3 also had some experience practicing before the
4 Board of Patent Appeals and Interferences which is
5 actually the predecessor's name of the PTAB which
6 is what I now sit on. So I did a couple of
7 interferences before that Board during my time at
8 McAndrews.

9 Q Anything else that was a part of your
10 practice?

11 A Sure. I did, you know, all kinds of
12 counseling for clients that had to do with IP.
13 Sometimes copyright, trademark, but - and then I
14 also did ex parte appeals which are - I'm sorry,
15 prosecution I did. That's what we call working on
16 behalf of clients that are seeking patent
17 protection in the for instance. Helping them deal
18 with the Patent Office.

19 Q Okay. Thank you. And you use an
20 acronym IP. Were you referring to intellectual
21 property?

22 A I was.

1 Q And when did you leave the McAndrews
2 firm?

3 A It was May of 2012.

4 Q And why did you leave?

5 A I left because I was - I had applied for
6 and was received a job at the Board. I was going
7 to be appointed Administrative Patent Judge on
8 this Board of Patent Appeals and Interferences.
9 Again, the name would soon change to Patent Trial
10 and Appeal Board.

11 Q And when were you appointed?

12 A It was May of 2012 and I was appointed
13 by John Bryson was then the Secretary of Commerce.

14 Q And you were appointed an Administrative
15 Patent Judge; is that right?

16 A Yes.

17 Q And is that sometimes referred to by the
18 acronym APJ?

19 A It is.

20 Q What was your role as an APJ when you
21 started at the - can I call it the PTAB?

22 A Sure. Yep. My role was to do ex parte

1 appeals and that was the role of new judges.
2 That's where all new judges started. And ex parte
3 appeals that's when we would sit in groups of
4 three, panels of three, three judges, three APJs.
5 And we would decide whether to affirm or reverse
6 rejections of patents that clients or that, you
7 know, inventors had - alleged inventors had
8 appealed.

9 So they'd try to get a patent. The
10 Patent Office may reject it and if they appeal, it
11 would come to us.

12 Q And how long did you work on ex parte
13 appeals?

14 A Not very long. By the end of that year
15 or at least by January 2013, I was transitioning
16 to AIA cases, America Invents Act cases.

17 Q And what's that type of case? The AIA
18 case?

19 A So the AIA refers to the America Invents
20 Act that was, I think, passed in September of
21 2011. And one of the things it did was create new
22 types of cases at the Board.

1 Those cases were set to begin and did
2 begin in September of 2012, a year later. And so,
3 you know, four months after I started working at
4 the Board, these cases started to come in. And
5 those were inner parties reviews and then to a
6 lesser extent (inaudible) post-client reviews.

7 Q And are those types of proceedings
8 commonly referred to by acronyms as well?

9 A They are. Sometimes, we call them IPRs
10 and PGRs and collectively AIA cases.

11 Q What's more common? PGRs or IPRs?

12 A IPRs are a lot more common, a lot more
13 common numerically just way more common.

14 Q Can you generally describe how an IPR
15 works?

16 A Sure. So there - as the name suggests,
17 it's between two parties. The parties are a
18 patent owner and a petitioner. And a proceeding
19 starts with a petition filed by the petitioner in
20 which they argue that claims of a patent are
21 unpatentable or invalid you might say in lay
22 terms, but the Patent Office always used the term

1 unpatentable.

2 And they file this petition. They don't
3 just - they can't just file a complaint like in
4 federal court and then the patent owner has an
5 obligation to respond. The patent owner doesn't
6 have an obligation to get involved in this
7 proceeding unless and until the PTAB decides to
8 institute the proceeding.

9 So what happens is the petition get
10 filed. The patent owner may file a preliminary
11 response if he wants to. It's not obligated to.
12 Once that briefing closes, a panel of three judges
13 again, we always work in - almost always work in
14 panels of three. The panel of three judges would
15 decide whether to institute. If they denied
16 institution that was it. It was over subject to a
17 request for rehearing, that's it.

18 If they institute it then there will be
19 a trial. And during the trial, you know,
20 arguments and evidence would come in. You know,
21 witness maybe deposed. All kinds of things would
22 happen and ultimately the panel would issue a

1 final decision. And this is typically a year long
2 process.

3 Q Thank you. How did you come to work on
4 IPRs?

5 A So I requested it. And even when I was
6 applying - or the reason I applied to work there
7 at the Board was I was excited about these
8 American Invents Act cases that were going to be
9 new. I wanted to be a part of it. I had, as I
10 said, I practiced before the Board a couple of
11 times from the outside on what were called
12 Interference matters. And I wanted to be involved
13 in the IA cases. That was my motivation for going
14 to the Board.

15 As soon as I got to the Board - I should
16 say, as soon as cases started to be filed in
17 September of 2012, I started asking management if
18 I could work on those cases? If I could be
19 assigned those cases?

20 Q You mentioned that APJs typically work
21 in panels of three when hearing and deciding these
22 cases. Do the three judges always agree?

1 A Most times they do, but not always, of
2 course.

3 Q What happens if there's a disagreement
4 among the panel?

5 A So there may be an ultimate disagreement
6 or there may be like an initial disagreement. So
7 sometimes, there will be disagreements while we're
8 conferring. While the judges - like my
9 co-panelist are conferring and we work it out.
10 And one judge may take a view and the other judge
11 may ask what's the basis of this dispute?

12 And we kind of ask the defendant. And
13 they work through the case and maybe they end up
14 reaching a consensus. And there is no ultimately
15 disagreement. But sometimes there is a
16 disagreement and then a judge may want to file a
17 concurring or dissenting opinion.

18 Q Are dissents and concurrence encouraged?

19 A I don't think they are, no.

20 Q Okay. We'll get back to that issue.

21 How many IPRs approximately have you handled?

22 A I worked on them from the beginning of

1 2013 until May of 2018. And in that time, I
2 worked on over a 100 of these cases.

3 Q And did you enjoy working on IPRs?

4 A Very much. I loved it.

5 Q Why is that?

6 A This was - so to give an example. I
7 would have to contrast it with the other work that
8 I started with and worked - and it's also the work
9 that I've been returned to.

10 So the IPRs and sometimes PGRs. These
11 AIA cases, they're very involved. They're big
12 kind of - they're big deals. They are patents
13 that have been issued. They're valuable enough
14 that party is going to spend money trying to
15 challenge it for us. So you have two sides that
16 tend to be very well represented.

17 It's a - from the beginning of the
18 petition to the final decision maybe a year and a
19 half. It's usually - it's about probably about a
20 year and a quarter or a year and a half. It's a
21 very long process. And a lot of issues come up.
22 It's very challenging at times. It's

1 intellectually stimulating. It's satisfying.

2 And I was litigator. And this is
3 litigation and so I enjoyed it. Now, ex parte
4 appeals I said I would contrast it. Those cases,
5 from the moment I pick up a file, I will typically
6 within two to three days contact the other judges
7 on the case and tell them I'm ready to confirm
8 upon it.

9 And maybe another two days will go by to
10 give them time to look at the file and we'll have
11 a conference and we'll agree on what to do.
12 Almost always, we reach, you know, some sort of
13 unanimous consent. If not, will, you know, there
14 will maybe there will be a conferring opinion.
15 But we'll decide how we want to rule and then a
16 week later the decision will go out.

17 So literally, from the day I pick up the
18 file to the day that a decision gets entered, it's
19 about two weeks. So these cases are much smaller.
20 They go much faster and they tend to be - in their
21 briefs are of much poorer quality. I'd say it's
22 true. There are complete with typographical

1 errors, grammatical errors, things like that.

2 Q You mentioned the complexity of IPRs
3 when you're contrasting it with ex parte work.
4 Can you expand on that a little bit? And why you
5 prefer IPRs in that sense?

6 A So in addition to, you know, the cases
7 that were longer and more involved and more
8 challenging intellectually what comes along with
9 that is the opportunities for collegiality with my
10 co-panelists and also interaction with the outside
11 counsel. The counsel that are representing the
12 two parties. It's fun. I enjoyed that. I
13 enjoyed having hearings, presiding over arguments
14 and making rulings. I enjoyed conferring the
15 panel multiple times during the course of a case.

16 So an ex parte almost always can
17 conference case just once. And in an IPR, we many
18 times were brought together.

19 Q Can you describe for me your
20 understanding of your job performance at the PTAB
21 for the time that you were working on AIA trials?

22 A Yes. I had a good track record and I

1 was a good judge.

2 Q And how do you know that you have a good
3 track record?

4 A Well, the Agency would appraise our
5 performance every six months and give us written
6 documents evidencing the appraisals. And they
7 were always favorable of me. They were never
8 negative.

9 Q I'm going to turn to an exhibit. This
10 is the first time so we'll see how this goes.
11 Judge Fitzpatrick, I'm going to refer you to tab
12 two of your binder.

13 MR. ABRAMIC: And, Your Honor, I'm
14 referring to Appellant's Exhibit B which is tab 33
15 in the record at pages 101 to 213.

16 JUDGE NIEDRICK: And that worked
17 perfect. Thank you.

18 BY MR. ABRAMIC:

19 Q Can see the document, Judge Fitzpatrick?

20 A Yeah, yeah. It's a big document. So I
21 was flipping through it, yep. Okay.

22 Q Okay. So do you see the first page

1 which is page - designated 101 on the bottom right
2 and the front of the page says Exhibit B?

3 A I do.

4 Q What is this collection of documents?

5 A This is - these are documents from my
6 electronic official personnel file.

7 Q And how do you know that?

8 A I downloaded these maybe two weeks ago,
9 something like that from the government's - they
10 call it the EOPF system, the Electronic Official
11 Personnel File. So I logged into my account and
12 downloaded my documents.

13 Q And what does your electronic personnel
14 folder contain?

15 A All kinds of records. So it has records
16 about kind of my - it even has like a college
17 transcript and law school transcript. It has my
18 job application to become an APJ. The hiring
19 documents, health insurance, things like that.

20 But then it has maybe more meaningful
21 documents, it's got my performance appraisals that
22 we were just mentioning. It has records of when I

1 received cash bonuses. There's a performance
2 award. It - I'm sure there's other things that
3 are in here as well.

4 Q Okay.

5 MR. ABRAMIC: Your Honor, at this point
6 this is one of the few exhibits that we will be
7 going over with Judge Fitzpatrick today that isn't
8 in the record yet. So I would move - I'd like to
9 move Plaintiff's Exhibit B which is tabbed at
10 pages 101 to 213 into evidence.

11 JUDGE NIEDRICK: Any objection, Mr.
12 Horrigan?

13 MR. HARRIGAN: No objection.

14 JUDGE NIEDRICK: All right. That's
15 admitted without objection.

16 MR. ABRAMIC: Thank you. And I'm just
17 going to do this with the rest of his personnel
18 file.

19 BY MR. ABRAMIC:

20 Q So, Judge Fitzpatrick, could you turn to
21 tab three of your binder, which is Appellant's
22 Exhibit C. Record tab 33 at page 214 to 300.

1 A Yes.

2 Q And what is this document, Judge
3 Fitzpatrick?

4 A This is more documents from my
5 Electronic Official Personnel file. I also -
6 these are documents I also downloaded. I
7 downloaded all of them at the same time.

8 MR. ABRAMIC: And, Your Honor, I'd move
9 Appellant's Exhibit C, tab 33 at 214 to 300 into
10 the record.

11 JUDGE NIEDRICK: Any objection, Mr.
12 Horrigan?

13 MR. HERRIGAN: No objection.

14 JUDGE NIEDRICK: All right. That's
15 admitted without objection.

16 BY MR. ABRAMIC:

17 Q One more here. Judge Fitzpatrick, tab
18 four of your binder, Appellant's Exhibit D, record
19 tab 33 at page 301 through 357. Do you see that
20 document?

21 A I do.

22 Q And what is this document?

1 A This is - this is the last portion of my
2 electronic official personnel file. And I'm just
3 glad that I - when I downloaded it, it downloaded
4 as three chunks and this is how the documents were
5 maintained by the office or by the government.

6 Q Thank you.

7 MR. ABRAMIC: Your Honor, I would like
8 to move Appellant's Exhibit D which is tab 33 at
9 pages 301 through 357 into the record.

10 JUDGE NIEDRICK: Any objection, Mr.
11 Horrigan?

12 MR. HERRIGAN: No objection.

13 JUDGE NIEDRICK: All right. That's
14 admitted.

15 MR. ABRAMIC: Thank you.

16 BY MR. ABRAMIC:

17 Q So I'd like to go back, Judge
18 Fitzpatrick, to Appellant's Exhibit B which is
19 your binder tab two and which is record tab 33 at
20 pages 159 to 162 of that exhibit.

21 A Okay.

22 Q What are pages 159 through 162?

1 A This is my year end review for the year
2 of 2017. And we go by fiscal year so that's why
3 it's coming in October.

4 Q Okay. Could you turn to page 159?

5 A Yes. I'm there.

6 Q And do you see on that page close to the
7 top there's a reference to element one and it says
8 quality. Do you see that?

9 A Yes. I do.

10 Q And then down below on the page there's
11 a reference to element two production. Do you see
12 that?

13 A I do.

14 Q And on the next page which is 160,
15 there's a reference to element three. Do you see
16 that?

17 A Yes. Affording the mission slash
18 leadership.

19 Q And then on page 161, there's an element
20 four. Do you see that?

21 A I do.

22 Q What are those elements?

1 A So each year we're given by the Agency a
2 performance appraisal plan by which we will be
3 appraised. And they are - they told us in that
4 that there's four elements by which we will be
5 appraised and they are these four.

6 And they also tell us the percent weight
7 that they give me to our overall grades. So the
8 first two are each worth 35 percent and then -
9 element one and element two are 35 percent each.
10 Element three is worth 10 percent. Element four
11 is worth 20 percent.

12 Q Okay. So if you could turn back to page
13 159, element quality. Could you just talk a
14 little bit about what that covers? Quality?

15 A Sure. Quality refers to like first and
16 foremost quality of my work product. Quality of
17 the decisions that I write. And I think it also
18 would include the quality of my collaborative
19 process with other judges when they are the
20 authoring judges. How much helpful insight I give
21 them, things like that.

22 Q And underneath quality, there's a text

1 portion that starts with the APJ ensured quality
2 decision making. And there's a bit of a narrative
3 there. What is that?

4 A Yeah, this is the management's
5 description or narrative assessment for how I
6 performed in this element in quality.

7 Q Do you see the sentence in that
8 narrative description that says, the APJ has been
9 recognized by colleagues as being reliable and
10 providing timely, accurate feedback to their
11 decision. Do you see that?

12 A Yes.

13 Q What's your understanding of the
14 reference to colleagues?

15 A So reference colleagues is - I
16 apologize. They are adjusting the thermostat.
17 Someone just walked in so that's why I looked over
18 there.

19 The reference to colleagues is a
20 reference to a peer review survey that used to be
21 administered by management. So they don't do this
22 anymore, but for years they did it and including

1 in this year. Well, what happened would be it was
2 head of the yearend reviews. So maybe in
3 September it would be.

4 They would send out a list of questions
5 to all of us and say, we want you to answer these
6 questions with respect to all the judges that you
7 worked with during the relevant timeframe. And to
8 form the question - I'm sorry to form the answer
9 that was requested would be numerical, one to
10 five, with five being best.

11 And so, this I presume that their
12 conclusion here that I've been recognized by
13 colleagues as being reliable for my timely and
14 accurate feedback to their decisions is in
15 response to, you know, my colleagues giving me
16 high numbers in the questions that informs on
17 that.

18 Q So to your understanding who has input
19 on APJ performance reviews?

20 A So at this time certainly my colleagues
21 did because they could answer the peer review
22 survey. But in management certainly did and still

1 does because they implement the whole review
2 process and they - you know, they have access to
3 the data that's received from the survey. And
4 they correlate the data and - did I answer your
5 question?

6 Q Yes. Thank you. You referred to
7 management --

8 COURT REPORTER: Judge Fitzpatrick, did
9 you say something?

10 THE WITNESS: The last thing I said was
11 did I answer your question?

12 MR. ABRAMIC: I think there was some
13 feedback from me.

14 COURT REPORTER: Okay. Mr. Fitzpatrick,
15 will you speak closer to the microphone?

16 THE WITNESS: Sure. I'm going to move
17 this binder.

18 COURT REPORTER: It may cut some of the
19 feedback off.

20 THE WITNESS: Okay. Yes.

21 COURT REPORTER: Please proceed, Mr.
22 Abramic.

1 MR. ABRAMIC: Thank you.

2 BY MR. ABRAMIC:

3 Q You referred to management. What do you
4 mean when you refer to - is that PTAB management?

5 A Yes.

6 Q What do you mean when you refer to the
7 PTAB management?

8 A So there's - the Board, the PTAB has
9 about - has over 200 judges. I'm not sure exactly
10 how many. Maybe somewhere between 200 and 250, I
11 think.

12 And about at least 30 of these judges
13 are management judges. And they come in the form
14 of one chief judge, one Deputy Chief Judge, four
15 Vice Chief Judges. I'm going into descending
16 order. I think that's obvious of rank. So one
17 chief judge, one Deputy Chief Judge, four Vice
18 Chief Judges and then about 30 leading judges some
19 of whom are designated as senior lead judges. And
20 then everybody else is not mentioned.

21 Q Do management judges also serve on IPR
22 panels?

1 A They do sometimes. They don't get as -
2 they get a reduced docket. So they don't tend to
3 work on panels as often as judges without
4 management responsibilities do.

5 Q Okay.

6 A But they do serve on it so.

7 Q Thanks. So can we go back to the
8 exhibit we were looking at. On page 159, you had
9 described what quality covered. Element two says,
10 production. Can you describe what production is
11 about?

12 A Sure. Production is a measure of - I
13 work for my authoring work product. And not all
14 of our proceedings are the same as I was trying -
15 a big contrast between ex parte appeals and AIA
16 cases before. So this time in this year, ex parte
17 appeals, if you wrote a decision it was worth one
18 decisional unit. You see here there's kind of
19 decisional units. And there was a productivity
20 goal of having 84 decisional units that year.

21 And I had authored opinions that were
22 worth 121 decisional units. Now, I didn't write

1 121 decisions because I was working on AIA cases.
2 AIA cases because they're so complex and time
3 consuming and involved, management has recognized
4 that they're a lot more work and they should be
5 awarded more decisional units.

6 So to put this in perspective, when you
7 weren't on an IPR, if you're the authoring judge,
8 you're probably going to earn at least 10
9 decisional units for that case. Four for the
10 institution, six for the final decision and then
11 you're going to earn some units along the way as
12 you - with interlocutory orders and other things.

13 In contrast, an ex parte appeal, you'll
14 get one decisional unit. So this is measuring it
15 and this year, you know, I seated like 37
16 decisional units, something like that.

17 Q If you could turn to the next page, page
18 160.

19 A Yes.

20 Q Can you describe what element three
21 which is supporting the mission?

22 A Yes. Here things are - the things that

1 are taken into account here tend to be not things
2 that are necessarily can be objectively measured.
3 It's management grades you based on your perceived
4 support for leadership of the Board and the
5 mission of the Board.

6 And the ways that you can pitch in that
7 I've been told is by volunteering to serve on - to
8 do additional work that is not measured by your
9 production. It's one of the things over the years
10 that I've done that falls in this category is I
11 served on the training committee.

12 I've also served on an all-hands
13 committee. A committee that was expanding a big
14 conference of all the judges. We were all going
15 to meet physically in person and I was on the
16 committee that was planning that.

17 Q And if you turn to the next page, page
18 161. Can you briefly describe what element four
19 covers?

20 A So this is, it's called
21 internal/external stakeholder interactions. I
22 think sometimes it's called customer service in

1 some of these documents. But this is a lot of the
2 data that's going to go into reaching the
3 conclusions that are made are based again on that
4 peer review survey.

5 So there are questions that ask judges
6 to - to this judge, the judge you work with, for
7 example, Michael Spature (phonetic) was he, you
8 know, courteous and respectful during hearings,
9 right? So that would mean relevant to external
10 stakeholders. And then they would ask questions
11 about how was he during conferences of the panel?
12 And he has to confirm about that case? Was he
13 collegian and things like that? And if your
14 peers, you know, gave you higher marks, it
15 presumably would show up here.

16 Q Do you see the second sentence in the
17 narrative - I guess the second and third sentence
18 it says in the narrative that says, the APJ
19 addressed almost always without exception
20 questions or comments or requests from internal or
21 external stakeholders courteously, appropriately
22 and properly.

1 For example, the APJ responded to
2 requests from panel members or conferences and
3 almost always without exception reviewed decisions
4 promptly and thoughtfully. Do you see that?

5 A I do.

6 Q Do you agree with that assessment?

7 A Yes. I think it's fair. I always tried
8 to be respectful and courteous to both my
9 colleagues and the counsel that would appear
10 before us.

11 Q Does that mean you always agree with
12 your colleagues?

13 A No, not necessarily. When it comes to
14 the legal reviews some times we would have
15 disagreements.

16 Q Do you like the disagreements?

17 A No. Actually, I enjoyed talking them
18 over and trying to research and defend positions
19 and they look at things from different angles.

20 Q Could you turn to page 162 of the
21 document? And if you see about three quarters of
22 the way down the page, you'll see it's signed by

1 two individuals. First a rating official and then
2 an approving official signature. Do you know who
3 they are?

4 A I do. That is - so the rating official
5 is Susan Mitchell, my lead judge at this time and
6 still currently. And the approving official, I
7 believe that's Scott (inaudible) Ledenfeller and
8 he is Vice Chief Administrative Judge and I
9 believe my second line supervisor at the time. He
10 has left the Agency since.

11 Q Could you turn to page 139 of the same
12 exhibit? 139?

13 A All right.

14 Q What is this document?

15 A This is midyear review for the year
16 2018. So remember I said they would do it every
17 six months, it would be a midyear. And there
18 would be a year at the yearend. It would be more
19 comprehensive and take into account all 12 months.
20 Whereas this was just a midyear. It would only
21 take into account the six months, but we were
22 judged by the same four elements.

1 I'll note that, for example, the fourth
2 element here, it says customer service that's
3 synonymous with the internal/external stakeholder
4 interactions. As you can see, the review itself
5 is not as detailed, but it is favorable. It said
6 that I meet or exceed standards in all these
7 categories.

8 Q Thank you. Does your personnel file
9 contain every single one of your reviews over the
10 years?

11 A I don't think so. So when I downloaded
12 this, I looked for them and I couldn't find a few
13 of them. I don't know why.

14 Q For the ones that are --

15 A I just got it.

16 Q I'm sorry.

17 A It got a lot of them.

18 Q Okay. For the ones that are in your
19 personnel file are they easy to find in these
20 documents?

21 A They aren't. It's scattered. They
22 weren't necessarily arranged in the electronic

1 file in chronological order or in the most
2 (inaudible) order.

3 Q Okay. So just to make things easier for
4 the Board then, I would like to quickly identify
5 them for the record. So we're going to stay on
6 the same exhibit, which is tab 33 at pages - I'm
7 going to direct you to page 210 through 212.

8 A I'm there.

9 Q What's that document?

10 A It's just my yearend review for 2013.

11 Q Can you turn to page 196 of the same
12 document?

13 A I'm there and this is my midyear review
14 for 2015.

15 Q Can you turn to pages 194 to 195?

16 A Yeah. So this is my yearend review for
17 2015, but there's a third page if you jump
18 forward. This is part of my yearend review, the
19 two pages you asked me about.

20 Q Okay. Go ahead and explain the issue.

21 A Okay. So page 194 and 195 are a
22 narrative and more detailed description of

1 performance in these four elements. And then the
2 next page, page 196 is my midyear of 2015. I
3 don't know why it's intervening there.

4 Then you have to jump over to the next
5 page 197 to see the kind of like my full report
6 card for the full year, for this year, the year
7 2015. You can see it says I was commendable. And
8 if you flip to page 198, that's the same document
9 as 197 except it's signed also by me now
10 acknowledging that I received it.

11 So, you know, it's signed by my lead
12 judge, the rating official, Thomas Jean Eddie
13 (phonetic) and that it's also the approving
14 official is Vice Chief Administrative Judge. I'm
15 not sure. I can't tell whose signature that is
16 so.

17 Q Okay. Can you go to page 174? 174.

18 A Yes. This is a midyear review for 2016.

19 Q Now, turn to 175 through 178.

20 A Okay. Those pages are my yearend review
21 for 2016.

22 Q Now, page 158.

1 A This is my midyear review for 2017.

2 Q Now, pages 159 to 162.

3 A This is my yearend review for 2017.

4 Q Now, page 139.

5 A That's a midyear review - that's my
6 midyear review for 2018.

7 Q Now, page 140 to 143.

8 A This is a yearend review for 2018.

9 Q Page 119?

10 A This is a midyear review for 2020.

11 Q And pages 120 to 122.

12 A That's a yearend - to 122? Yeah, so 120
13 to 122 is my yearend review for October 2020 - I'm
14 sorry, for the year 2020. It was given to me in
15 October of 2020.

16 Q Okay. Thank you. We're almost done
17 here, but now I'm going to turn to another exhibit
18 which we've already put into evidence which is
19 Appellant's Exhibit D. Judge Fitzpatrick, it's
20 your binder tab for record tab 33 at 301 to 357.
21 Can you turn to page 315, 315 of that exhibit?

22 A Okay. This is my midyear review. I'm

1 sorry, this is my midyear review for 2014.

2 Q Okay. Can you turn to page 313 to 314?

3 A Okay.

4 Q What is this?

5 A Similar to another issue. So this is
6 part of my yearend review for 2014, the narrative
7 assessment part.

8 Q Can you locate the other part of that
9 review?

10 A Yeah. It misses a couple of pages.
11 Yeah, it's on page 317. So page 313, 314 and 317
12 for my yearend review for 2014.

13 Q Thank you. We're done with that. Judge
14 Fitzpatrick, in all of your years as an APJ have
15 you ever received a negative performance appraisal
16 to your knowledge in any of your formal biannual
17 reviews?

18 A No.

19 Q Can we turn back to Appellant's Exhibit
20 B, which is your binder tab too, record tab 33 and
21 go to page 103?

22 A Okay.

1 Q What is this document?

2 A This is a document that was put into my
3 personnel file to document that I had received a
4 bonus. If you look at box 20 here, it shows my
5 bonus was \$7,500.

6 Q How often do you receive bonuses?

7 A It has varied over the years. But I've
8 received many bonuses over the years. Sometimes,
9 multiple bonuses in the same year.

10 Q And what are those bonuses based on?

11 A I believe they are all based on one or
12 two things. Either production purely or my
13 performance generally. And performance, of
14 course, includes the element of performance.

15 Q Thank you. I want to get back to
16 talking a little bit about IPRs. And what I'd
17 like to talk about is what you as a judge rely on
18 for your decisions in IPRs. What are the types of
19 legal authority that an APJ at the PTAB must rely
20 on in rendering decisions?

21 A Sure. There's the statutes that the IPR
22 specific statutes and the other patent law

1 statutes in Title 35. There's rules that are
2 published in the Code of Regulations and the
3 Federal Register and there's precedential case
4 law.

5 Q What is precedential case law in an IPR
6 proceeding?

7 A Well, our cases - our decisions are
8 appealed to the federal circuit. So federal
9 circuit cases are precedential binding us and the
10 same with the Supreme Court. And then there's
11 also PTAB decisions can be precedential.

12 Q Okay.

13 A Rarely are but if there are some
14 precedential PTAPs.

15 Q And how are PTAB decisions made
16 precedential?

17 A That process has changed over the years,
18 but I believe the director ultimately controls
19 that.

20 Q Is there any other authority that APJs
21 have to follow?

22 A Yes. There's also with the - there's

1 also guidance. With (inaudible) obviously the
2 person whose guidance was published from the
3 director. And that might be - that might be
4 published in the Federal Register but it might not
5 be like in the Code of Federal Regulations, for
6 example.

7 Q Is there any other type of guidance?

8 A There is and it's called internal
9 guidance or confidential guidance. It's this -
10 it's kind of in an amorphous thing. It's
11 something that the Patent Office - the PTAB
12 management will refer to, to try to get - to try
13 to influence judges to rule certain ways.
14 Sometimes, even change their decisions.

15 Q And what form does that guidance come
16 in?

17 A It can come in many. None of which seem
18 very, you know, none of which I would call formal.
19 It could be edits into your decision. So like a
20 panel drafts it, you know, decides how it wants to
21 rule and it gets reviewed by other judges that are
22 not on the panel and on behalf of management.

1 And edits maybe put in via redlining or
2 comments in the margins. So the guidance, this
3 internal guidance maybe referenced there. To say,
4 hey, you should make these changes because it's,
5 you know, we want to speak with one voice. And we
6 want to say this on this issue.

7 Other forms are phone calls. For
8 example, if you are in a disagreement with making
9 the redline edits, you know, you may have a phone
10 call with someone. And they will explain to you
11 what they are deeming to be guidance and binding
12 on you, and you need to follow it. And it could
13 be in an email. It could even be as part of like
14 an announcement at one of our meetings. A member
15 or management may say, this is how we're going to
16 do X, whenever. This is how we're going to handle
17 this issue whenever it arises and you should all
18 do this in your cases.

19 Q And what is your understanding of the
20 source of that guidance?

21 A The source? It's always derived - it
22 always comes from someone within management. So a

1 management level judge and they frequently will
2 say that it is on behalf of the director. Or
3 that, you know, it comes from the director. Or
4 the director wants this or the director wants
5 that.

6 They will never provide evidence of that
7 assertion, though, and I've asked for it. You
8 know, I've asked to see it and not been provided
9 with it.

10 Q You mentioned that PTAB management uses
11 those guidance to influence or change judge
12 decisions. Why do you think PTAB management does
13 that?

14 A PTAB management wants uniformity of
15 decisions. And they have their preferred legal
16 views and I think they don't like to see other,
17 you know, panels or even just a singular judge in
18 an concurrent or dissenting opinion take a view
19 that undermines or undercuts their preferred view.

20 Q Of every single legal opinion?

21 A Can you rephrase the question? What was
22 the first question which --

1 Q Sure. No, I guess I'm trying to get at
2 are there other certain issues that they care
3 about versus - or is it every issue that they have
4 a defined legal view.

5 MR. HERRIGAN: I'm going to object.
6 Calls for speculation.

7 JUDGE NIEDRICK: Please rephrase your
8 question.

9 MR. ABRAMIC: Okay. Go ahead and
10 rephrase?

11 BY MR. ABRAMIC:

12 Q Did you have an understanding, Judge
13 Fitzpatrick, as to whether or not management seeks
14 to use this type of guidance as to every legal
15 issue across all of IPRs or whether it's limited
16 to specific issues?

17 A It's somewhat limited. So some of the
18 issues that come up are whether - the law of
19 anticipation (inaudible). These are just patent
20 law concepts for which there's a ton of juris
21 prudence at the federal circuit and the state,
22 some at the Supreme Court so those things are just

1 settled.

2 But IPRs were new in September of 2012.

3 So there's IPR specific legal views that are -

4 there's IPR specific legal concepts that arise.

5 And it's those views, I think that they are overly

6 sensitive about. Someone having a different view

7 about.

8 Q How can management in your experience
9 identify decisions that it might want to
10 influence?

11 A It's very easy for them to identify them
12 because they have a review process set up to
13 review every single major AIA decision that goes
14 out. So all institution decisions, all final
15 decisions, all decisions involving a motion to
16 amend, all the big decisions in the AIA case get
17 reviewed by a committee before they are allowed to
18 go out.

19 Q What committee is that?

20 A That committee is the AIA review
21 committee. Sometimes, known as Arc, A-R-C, Arc.

22 Q Okay. And you said it's AIA review

1 committee?

2 A Yes.

3 Q And what do they do?

4 A They review decisions before they go out
5 and they frequently - I mean most of the cases are
6 - you know, they're just - they're looking at it
7 and they'll have edits that are not about these
8 legal views that we've been talking about.

9 They're just helpful comments, insights
10 sometimes letting you know about another PTAB case
11 maybe you didn't know about that went out and
12 said, hey, you might want to look at this decision
13 that went out last month because, you know, they
14 see all these cases so they can bring that to your
15 attention. So, you know, it's a helpful process.

16 Q And what else does Arc do in addition to
17 those types of helpful comments?

18 A So what they also do is flag cases to be
19 kind of escalated to a second level review. A
20 review by management, explicitly by management.

21 Q Do you have an understanding of who is
22 on the Arc committee?

1 A Yes. I never at one time - I would
2 never know the identity of the folks that were on
3 it. I just didn't know it. I didn't ask and I
4 didn't know, but it's my understanding it was
5 eight judges that serve on it. These judges are
6 on it because they found (inaudible) and the chief
7 judge appointment to it, you know, from the pool
8 of volunteers. And it rotates over time. I think
9 every six months two judges roll off and two judge
10 roll on.

11 Q You mentioned that sometimes Arc might
12 flag a decision for management review. What's
13 your understanding as to why Arc might flag a
14 decision for management review?

15 A Well, they flag every single case, every
16 single decision that has concurrent opinion or
17 dissenting opinion just on that basis alone.
18 They, at the time at least, I don't think they do
19 this anymore, they would flag before Aqua products
20 came out, a federal circuit case that talked about
21 motions to amend. Before that case came out, they
22 would always flag any decision involving a motion

1 to amend.

2 And then they would also flag any
3 decision really that they thought management might
4 be interested in. They might think management
5 might want to know about what's being opined here.

6 Q You mentioned that there were times
7 where management will use guidance to influence a
8 decision. What can happen if a judge does not
9 adopt management's guidance?

10 A So in the first instance, it might just
11 kind of escalate a little bit. It might be that
12 the instructions kind of to change your opinion
13 are electronically, you know, redline edits in
14 your decision, in your opinion.

15 And you're expected to tell them you're
16 adopting them or like you need to resolve it
17 before you're allowed to enter the decision one
18 way or another. So you either I'm accepting them
19 or there were times where I just disagreed with
20 them and I would ask them what's the basis for
21 this?

22 You know, is there an authority for

1 this? And then the next step might be a phone
2 call that I received from management or often
3 times from an intermediary. A lots of time or
4 there are many times, I would receive a phone call
5 from someone other than the management official
6 who was making the edit and wanted the edit.

7 JUDGE NIEDRICK: Sir, can I interject
8 just for a second. I have a quick question. I'm
9 a little bit confused as to the sort of redline
10 edits, the internal guidance that you're getting
11 from management officials and then the sort of
12 helpful, I guess guidance that you're getting from
13 the Arc. Are they two different things?

14 THE WITNESS: They are, Your Honor. So
15 there's - so assuming that this is a case with
16 like a concurrence, for example. It gets flagged
17 for a second review by the management review
18 committee. So you're going to go through two
19 steps of review.

20 At the first level, whichever one it
21 goes to, whichever decision it goes to - every
22 major decision goes to. Arc will review it and

1 they'll write edits and comments. And in my
2 experience the vast majority of those are helpful.
3 You know, sometimes they will flag the legal - the
4 different legal view issue. And so, when they do
5 that I don't know whether I would consider it
6 helpful because ultimately it's something that I
7 don't want to adopt.

8 But then it gets escalated to management
9 and management reviews it. And then I receive
10 another reviewed copy of my decision.

11 JUDGE NIEDRICK: So as far as the Arc.
12 When the Arc makes a comment. Say the Arc looks
13 and says, hey, you would know about this other
14 panel's decision that's coming out or that just
15 came out so that you can be aware of the arguments
16 raised therein or whatever. Do they send you a
17 redlined sort of note on that issue? Or does
18 everything go up to the next level and then any
19 guidance that you get is sent from the management?
20 Does that make sense?

21 THE WITNESS: I think I know what you're
22 asking and the answer is that Arc will, in fact,

1 put in the - so I will submit like it's
2 (inaudible). I'll submit a Word file of our
3 decision and then I'll email Arc and I'll say,
4 hey, this decision, this final decision in
5 such-and-such is sitting in the Arc review folder
6 for you guys to review. Or I'll give them a
7 hyperlink to it or both.

8 Then they know. They go in there and
9 they look at it. They will make edits. They'll
10 make redlined edits to the decision. They don't
11 always but they have. And then in addition or
12 alternatively there will be comments in the
13 margin. You know, like you can use that feature
14 where you add a note.

15 And then they'll send us an email
16 saying, hey, Arc's review is done and we know
17 where to go now. It's in a review complete
18 folder, the Arc review complete folder. And you
19 go in there and you grab your decision in there.
20 And then the authoring judge is kind of the one
21 whose interacting with Arc for this.

22 So if I was the authoring judge, I would

1 take that decision. I would circulate it to my
2 co-panelists and I'd say, hey, here's Arc's -
3 here's what Arc is saying. Here's their review of
4 our decision. You know, and then sometimes the
5 best way to deal with it is to say, hey, do you
6 want to have a call to talk about this stuff?

7 And so, if it's edits - proposed edits
8 to, you know, a unanimous decision were all three
9 of us are signing it, you know, we'll confer as to
10 whether we agree with implementing those edits.
11 If it's, for example, edits to a concurring
12 opinion of mine. Well, that portion of Arc review
13 is kind of up to me to decide what I want to do.

14 JUDGE NIEDRICK: Okay. So then how do
15 you get the redline edits from management? Where
16 does that fit into that whole process?

17 THE WITNESS: So we submit the Arc - Arc
18 kind of obligates us to submit it to - to send an
19 email. To say, hey, we want to submit this to
20 management because it's got a motion to amend or
21 because it's got a concurrence for example. And
22 then we submit it. Again, it's typically the

1 authoring judge, not always, but the authoring
2 judge will probably then take the decision and
3 submit it to management. And management --

4 JUDGE NIEDRICK: Okay. So Arc is
5 typically the ones that are telling - that group
6 is telling you to send it to management?

7 THE WITNESS: Yes.

8 JUDGE NIEDRICK: Okay. Thank you.

9 BY MR. ABRAMIC:

10 Q We were talking about management
11 guidance and the process for delivering that
12 guidance. What is your understanding of what can
13 happen to an APJ who ultimately refuses to accept
14 the guidance?

15 A Well, according to management, you're
16 not allowed to not follow even internal
17 confidential guidance. And so, if you don't
18 follow it, you can be punished including up to
19 termination. And I know this because they told us
20 this.

21 There was a meeting in late 2017 that
22 management put on for all the judges. And they

1 made this point explicitly. They stated that
2 guidance includes any instructions from a higher
3 ranking judge. And you need to follow it or
4 you're insubordinate and could be terminated.

5 Q Other than threats are there any other
6 things that management has done to influence
7 decisions?

8 A Yes. They've expanded the panels. And
9 the way that would work, it's kind of like two
10 different - I don't know if I can say, it's only
11 two - maybe two major ways of how it would occur.
12 One would be a decision actually got out the door
13 and maybe they weren't aware of it or, you know,
14 maybe they changed their mind and only later they
15 regretted that it went out and they disagreed with
16 it.

17 And so, they would expand the panel on
18 rehearing with judges that I believe they knew how
19 they would rule. And they were overturn the
20 initial decision.

21 And then there was - they would also
22 expand panels before that unfavorable decision

1 even went out. And that had the effect of just
2 keeping a decision from going out. It would just
3 delay it indefinitely.

4 Q Going back to Arc just one point of
5 clarification. You mentioned that all decisions
6 that have a dissent or a concurrence make their
7 way to management, but then there's also certain
8 legal issues that Arc has awareness that they
9 ought to push up to management. What's your
10 understanding as to how Arc knows about those
11 particular sensitive legal issues?

12 A Management has - there were meetings in
13 this timeframe where management told us what were
14 hotline issues. In fact, there was a document
15 that they called, I think AIA checklist or AIA,
16 you know, something like that. Where they gave
17 judges mixed signals of whether it was obligatory
18 or not. But it was a form that they provided to
19 all the judges that worked in the AIA cases.

20 And they said, hey, if you're submitting
21 a decision to Arc, it has one of these things.
22 Please check the box. And I mean there were boxes

1 on there for like it's got a concurring opinion,
2 it's got dissenting opinion, it's got a motion
3 amend. It talks about estoppel. That was another
4 one that was issued. Oh, a joinder that was a
5 very big one that they were interested in.

6 And so, that was on this checklist. So
7 Arc was obviously completely aware of this
8 checklist because they would receive completed
9 checklists in the form. The form was prepopulated
10 with the items that management considered to be,
11 you know, of special interest.

12 Q So you've had some disagreements with
13 management. Do you think that the PTAB means to
14 do away with APJ management?

15 MR. HARRIGAN: Objection. Relevance.

16 JUDGE NIEDRICK: Overruled. Please
17 answer.

18 THE WITNESS: No. I don't. I think,
19 you know, there's - as I said, there's more than
20 200 of us. We are government employees and we
21 need to be held accountable. And so, I have no
22 problem with the concept of being managed or any

1 of the official management and I have completed
2 complied with and done well with the existing
3 performance appraisal process.

4 MR. ABRAMIC: So let's - Your Honor,
5 could we do maybe a five-minute break?

6 JUDGE NIEDRICK: Sure.

7 MR. ABRAMIC: I'm about to change of
8 topic. I just figured it might be - or I'd check
9 with witness to see if he wants to take a break.

10 JUDGE NIEDRICK: Sure. Why don't we
11 come back - it's again 9:49. Why don't we come
12 back at 9:55 so a seven- minute break?

13 MR. ABRAMIC: Sure.

14 JUDGE NIEDRICK: Ms. Dodson. Can you
15 complete that we're off the record?

16 COURT REPORTER: We are off the record
17 at 9:47 a.m.

18 (Recess)

19 COURT REPORTER: We are back on the
20 record at 9:54 a.m.

21 JUDGE NIEDRICK: We're going to continue
22 with Judge Fitzpatrick's testimony. Judge

1 Fitzpatrick, please remember you're still under
2 oath.

3 BY MR. ABRAMIC:

4 Q Judge Fitzpatrick, let's turn to the
5 disclosures that you made that are specific to
6 this appeal. What is the basis for what you
7 believe are the protected disclosures that you've
8 made that are relevant to your appeal?

9 A Well, they're all rooted in an IPR that
10 I worked on. I call it the Nike IPR. I believe
11 it's IPR 2013-00067.

12 COURT REPORTER: Mr. Fitzpatrick, can
13 you repeat that?

14 THE WITNESS: I'm sorry. Yes. I
15 believe the number? Is that what you wanted or --

16 COURT REPORTER: You cut out at the
17 number.

18 THE WITNESS: It's IPR 2013-00067.

19 COURT REPORTER: Thank you.

20 BY MR. ABRAMIC:

21 Q And what happened in the Nike IPR?

22 A Well, originally nothing too

1 significant. There was three judges on it. I was
2 one of them. Judge James Harpin, he goes by Jim.
3 He was the authoring judge and Josiah Cox was the
4 third judge. And we had a trial. There was a
5 motion to amend. The pend. The pend that was
6 there was a motion to amend it. And we entered a
7 final decision at the end of the trial and we
8 denied the motion to amend.

9 And then it went up to the federal
10 circuit because the patent owner, Nike, I believe
11 it was Nike appealed with respect to our denying
12 them these four substitute claims they wanted to
13 add to the patent. And the federal circuit
14 vacated our decision. They didn't reverse it.
15 They vacated that and told us to redo - redecide
16 the issue of whether or not those four substitute
17 claims could be added to the patent so then it
18 came back down to us.

19 Q And so, then what happened after the
20 case came back down to you?

21 A So then the same three judges, Josiah
22 Cox, James Harpin and I, we conferred. We looked

1 over the same briefs that we did the first time,
2 right? And then the same evidence and then we
3 also this time further guided by the fed circuit
4 decision and we decided the case. How we wanted
5 to rule.

6 We again decided to deny Nike those four
7 claims, the substitute claims. But I wanted to
8 concur because I didn't want to join part of the
9 majorities reasoning.

10 Q Okay. Can you turn to your binder tab
11 16, which is Appellant Exhibit EA, record tab
12 seven at 154, 154?

13 A I'm there.

14 Q What is this document?

15 A So this is - so after we conferred and
16 decided how to rule. We - and I told you I was -
17 I drafted a concurring opinion. We took that
18 decision and this is Harpin submitting it to Arc,
19 the AIA review committee. And he's saying that
20 the decision is ready to be reviewed by Arc.

21 And he also noting two things that we
22 all understood management had a heightened

1 interest regarding. And that is that this
2 decision focuses on the treatment of motions to
3 amend and also it that it includes a concurrence.

4 Q And so, as of this date, September 30,
5 2016, the decision and the opinion of the panel on
6 remand was done?

7 A Yes.

8 Q Okay. Could you turn to your binder
9 tab, 15, 15 that's Appellant Exhibit DZ, which is
10 record tab seven at pages 110 through 153.

11 A I'm there.

12 Q What is this document?

13 A This is the decision that we wrote and
14 wanted to enter and that Jim in the prior exhibit
15 that Jim had told Arc was ready for them to
16 review.

17 Q And you mentioned that this decision
18 contained a concurrency that you authored. Can
19 you just try to describe your concurrence at a
20 high level?

21 A Sure. So I was voting to deny the
22 patent owner for substitute claims that he was

1 seeking just as the majority would rule. But I
2 didn't want to say - well, one of the requirements
3 of getting substitute claims in a motion to amend,
4 which one of the requirements that was announced -
5 sorry.

6 Let me put it this way. One of the
7 requirements, a patent owner must satisfy in
8 moving to amend in an IPR is that the number of
9 claims that it is proposing is a reasonable
10 number. A reasonable number of substitute claims.
11 And I didn't agree with how the majority were
12 handling - were deciding it. They were applying a
13 - what I thought was a rigid and ultimately
14 counterproductive test that had been announced in
15 Idle Free. And I didn't want to follow that. I
16 thought it was a reasonable number for other
17 reasons.

18 Q And you mentioned Idle Free. Is that
19 another case?

20 A Yes. Idle Free was another IPR and my
21 reference to Idle Free was specific to an order
22 that was entered during that case. I was on the

1 panel and we entered an order and providing
2 guidance to the parties on what to brief.

3 But in that case, it was early on in the
4 case and the patent owner said they wanted to file
5 a motion to amend. We entered this order
6 basically telling them what they need to prove.

7 Q And so, you were on the panel on the
8 Idle Free case. I believe you just said that,
9 right?

10 A Yes.

11 Q And this concurrence that you wrote in
12 the Nike case was choosing not to follow the Idle
13 Free case. Is that what I heard you just say?

14 A Yes.

15 Q And so, if you were on the panel of Idle
16 Free why didn't you want to follow it?

17 A Well, I had - my view had changed. It
18 had evolved. And it wasn't just that my review
19 had changed, but Idle Free had become de facto
20 precedential. It was treated - I had no idea when
21 I signed onto that opinion. I couldn't foresee
22 all what happened in the future. And that was

1 after I saw parties start briefing motions to
2 amend. And I looked at the statutes and the rules
3 more closely, I think at that point. My views had
4 changed.

5 Q You mentioned precedential. So was Idle
6 Free actually a precedential decision?

7 A It was not, no. Because I had never
8 designated precedential.

9 Q So you mentioned that your decision was
10 submitted to the Arc committee. What happened
11 after that?

12 A My memory is that the next step is that
13 Arc replied and said, please submit this to
14 management for their review because it had a
15 concurring opinion and/or because of the motion to
16 amend. That's my memory.

17 Q Okay. Could you go to your binder tab
18 17, which is Appellant Exhibit EB, record tab
19 seven, pages 155 through 157?

20 A Yes.

21 Q And what's this document?

22 A So this is an email string kind of it

1 originates the first email chronologically on the
2 last page. Is that email, I guess that we already
3 looked at that Jim submitted in the decision to
4 Arc. And then the next email is a response from
5 Arc stating, you know, asking us to submit it to
6 the chief judge and Deputy Chief Judge. And they
7 note because the decision includes a concurrence.

8 The next thing on here is an email from
9 Arc doing that submitting it to Chief Judge
10 Ruschke and Deputy Chief Judge. I'm at the top of
11 page 156 now. And then going up to page 155.
12 Let's see. So Jim submits it to - I'm sorry. I'm
13 going back to page 156, Jim's email submitting it
14 to management was on October 14th. The date is
15 actually on page 155. I'm bringing you back
16 there.

17 So he submits on October 14th, 10 days I
18 think went by and we didn't hear anything. And so,
19 then this next email is also from Harpin to Chief
20 Judge Ruschke and Deputy Chief Judge Bullock
21 asking or noting, you know, that in six days or
22 seven days, you know, before is going to be the

1 seventh month anniversary of the fed circuit's
2 mandate. It's going to be over eight months since
3 the actually federal circuit decision vacating and
4 remanding. And it is just saying that he would
5 really like to submit this decision soon, by
6 Friday, October 28th.

7 Q Why do you --

8 A And the last --

9 Q I'm sorry. Why do you believe that you
10 wanted to submit it sooner?

11 A I know that Jim was uncomfortable with
12 the delay. He thought it reflected poorly on the
13 panel, but in particular himself because he was
14 authoring judge and it was already known that he
15 was the authoring judge because he wrote the last
16 final decision and the institution decision, I
17 think. But it was known that he was the authoring
18 judge. And so, it was presumed that he would be
19 authoring judge of this decision. So he thought
20 the delay reflected poorly on him.

21 Q Okay. At the top of page 155, there is
22 an email from AIA review committee and that's Arc?

1 A Yes.

2 Q And that --

3 A You can see it says - go ahead. I'm
4 sorry. I just want to connect a dot here. So at
5 the top, it says from AIA review committee that's
6 the email group that they use. And you can see
7 it's signed shorthand Arc. So I just want to show
8 - point out those are synonymous, Arc and AIA
9 review committee.

10 Q Okay. Thanks. And do you see in that
11 email from Arc at the top of the page of 155, it
12 states, we understand that David and Scott are
13 reviewing this decision. Who do you believe are
14 David Scott?

15 A That would be David Ruschke and Scott
16 Bullock, respectively, the Chief Judge and Deputy
17 Chief Judge.

18 Q And then it says, and they have conveyed
19 they have some concerns. Do you see that?

20 A Yes.

21 Q Can you go to your tab, binder tab 18?
22 This is Appellant Exhibit EC, record tab seven,

1 pages 158 through 162. Do you see that this is an
2 email exchange?

3 A I do.

4 Q And at the top of page 158, the email
5 from Scott Bullock. What's your understanding of
6 what this is referring to?

7 A So this is the Deputy Chief Judge
8 informing us that the panel is being expanded at
9 Chief Judge David Ruschke and himself and the
10 Deputy Chief Judge Scott Bullock. This is the
11 Nike case, the same case we've been talking about.

12 Q So does that mean that at this time the
13 public or the parties know that the panel had been
14 expanded?

15 A No. And they were never notified that -
16 of the panel expansion.

17 Q Can we go to your binder tab 26, which
18 is Appellant Exhibit EL, record tab seven, page
19 193 to 194?

20 A Yeah. I'm there.

21 Q And if you look on the page on 194, it's
22 an email from Jim Harpin. What's your

1 understanding of what Judge Harpin is saying in
2 this email?

3 A So this is after the panel was expanded.
4 And now, the anniversary, the first one he is
5 referencing is the six- month anniversary of our
6 third conference of this case. He's referring to
7 the conference of the expanded panel. We're
8 seemingly getting nowhere in getting this decision
9 out.

10 It's also the 14-month anniversary of
11 the fed circuit's mandate. So this is many months
12 later and the decision is still not out. And then
13 in the second paragraph - and this is one of those
14 times where Jim told me and everyone, you know,
15 that he - yeah, that he's concerned with the delay
16 here. That it looks bad and reflects poorly on
17 him. Can I read from it? Is that - can I read
18 this out loud?

19 I mean he says, what is he saying here?
20 He says, the original panel has tried to be
21 patient, but the time for you to act is overdue.
22 Further - and he's addressing this to Chief Judge

1 Ruschke and Deputy Chief Judge Bullock.

2 Further, because you have prevented us
3 from informing the parties that the panel has been
4 expanded, it looks to all the world as if the
5 original panel has, and in particular I as APJ1,
6 have been improperly delaying a decision to remand
7 of this case. As judges, our reputations are
8 essentially to our effectiveness. Further delay
9 in this case, is unfair to the parties and is
10 unacceptable to the original panel.

11 And then he asks them for, you know, to
12 get moving, I think on the case.

13 Q And did you have - also have any
14 concerns about the panel expansion?

15 A Yes. I shared the same concerns that
16 are in that statement that I just read that are in
17 Jim's email. And in addition, I add concerns
18 about due process. That the parties' due process
19 was being violated.

20 Q Why?

21 A Because they didn't know who is on the
22 panel that was presiding over their case. Putting

1 it another way, they knew that Judge Cox, Judge
2 Harpin and I - they were told that the three of us
3 were exclusively presiding over their case. And
4 yet, they didn't have a decision. And yet, the
5 three of us had a decision. We wanted to enter a
6 decision.

7 JUDGE NIEDRICK: And can I ask you real
8 quick? You said that you expressed those same
9 concerns that were outlined here in the email.
10 Who did you express them to? And when?

11 THE WITNESS: Many times, during
12 conferences with the expanded panel. I think
13 maybe I maybe I hit it - I mean there was this
14 same document it looks like no one responded or
15 Chief Judge Ruschke and they both didn't respond.
16 And I wrote an email.

17 JUDGE NIEDRICK: On page what?

18 THE WITNESS: You want to take a look?
19 This is page 193. Can I take a look at it, Judge,
20 to see if some stuff is in there to answer your
21 question?

22 JUDGE NIEDRICK: I'll let Mr. Abramic

1 circle back to that. That gives me an idea
2 though. So you expressed it to the panel that at
3 that point included Bullock and Ruschke?

4 THE WITNESS: Definitely. I mean if the
5 due process aspect is actually - ultimately would
6 get into my later concurring opinion in this case
7 and so they got it from that. But I think there's
8 a lot of documents showing, you know, emails where
9 we're trying to get the Chief and the Deputy Chief
10 Judge to either let us rule. Let us three judges
11 rule or notify the parties that you're on the
12 case.

13 JUDGE NIEDRICK: Okay. Thank you. I'll
14 let Mr. Abramic fill in those gaps.

15 BY MR. ABRAMIC:

16 Q Let's turn to tab - your binder tab 28,
17 Judge Fitzpatrick. Appellant Exhibit EN. This is
18 record tab seven at pages 198 through 200.

19 A Yes, I have that before me.

20 Q And can you go to page 199 at the bottom
21 of that page? Do you see that?

22 A Yes.

1 Q Where Judge Harpin is sending an email.
2 What's he doing here?

3 A So this if February 24, 2017. So about
4 - I mean this is - I don't know. This is four
5 months after the panel was expanded. Judge Harpin
6 is asking management if he can enter an order that
7 he had drafted. A notification of panel
8 expansion. And he's noting that Judge Cox and I
9 approve of this order going out. Yeah, that's -
10 and he's including a copy of it, a hyperlink to a
11 copy of his order.

12 Q And what was the result of his request
13 to issue that notification?

14 A His request was denied by the Chief.

15 Q Were aware of any policy at the PTAB of
16 not notifying the public of expanded panels?

17 A No.

18 Q So we just looked at a couple of emails
19 that express concern about the delay and
20 frustration with the failure to notify the public
21 of panel expansion. Is that the only time members
22 of the Nike panel raised those concerns?

1 A No. The delay would ultimately go on
2 for almost two years, the delay in ruling in this
3 case and there were numerous and consistent emails
4 and telephone conversations about the frustration
5 with the delay.

6 Q So after months and months of delay, why
7 did you believe that it was being delayed?

8 A I believe it was being delayed because
9 management did not want my concurring opinion to
10 go out, to become public.

11 Q Why not?

12 A Well, because it was critical of Idle
13 Free, which is a management's preferred views
14 regarding motions to amend. And it was a
15 particularly sensitive time because a case at the
16 federal circuit that had involved a motion to
17 amend was granted. We'd be hearing en banc. And
18 so, the full Court of Appeals, the federal circuit
19 was going to decide --

20 COURT REPORTER: Mr. Fitzpatrick, could
21 you begin that answer again? You cut out twice.

22 THE WITNESS: I'm sorry. I'll take this

1 binder out of the way. So I'm going to start with
2 - I don't know where - I'm going to start with I
3 think Mr. Abramic asked me - can you, Mr. Abramic,
4 can you ask me that same question?

5 BY MR. ABRAMIC:

6 Q Sure. I had asked you why you believe
7 that management would want to prevent your
8 concurrent opinion from becoming public? And you
9 were talking about the Idle Free case that you
10 mentioned, I think, another case.

11 A Yes. So I believe management did not
12 want my opinion to become public or to go out the
13 door so to speak because it was critical of Idle
14 Free. Idle Free was management's preferred legal
15 views on motions to amend. And so, if my decision
16 went out, it would undercut it. In addition, this
17 was say, perhaps more - or an extra sensitive time
18 for something like this to happen because a case
19 that was at the federal circuit that had been
20 decided in about the motion to amend, rehearing
21 was granted.

22 And they told the public it was going to

1 rehear that case en banc. So it was going to be
2 the full federal circuit ruling on a motions to
3 amend. And the office wanted to intervene in that
4 case and defend its viewpoint on this issue of
5 (inaudible), motions to amend. How they should be
6 decided. And they ultimately did intervene and
7 they defended the views that are set forth in Idle
8 Free.

9 And it would have I think, you know,
10 made their job perhaps harder if my opinion was
11 publicly issued.

12 Q What ultimately happened in the Aqua
13 Products case?

14 A Aqua Products actually --

15 Q I'm assuming Aqua Products is the case
16 that was en banc before the circuit? The federal
17 circuit, the federal circuit.

18 A Right. Yes, it was en banc and so the
19 en banc decision - is that what you're asking, Mr.
20 Abramic? The en banc decision took the same
21 position, held, held the position that I was
22 taking in my concurring opinion.

1 Q Okay. So, I want to talk about what
2 happened in the Nike IPR after the Aqua Products
3 decision. So could you turn to your binder tab
4 33. And that's going to be Appellant Exhibit EU,
5 record tab seven at 310 through 315.

6 A I have it.

7 Q And if you could turn to page 312. At
8 the top of the page there's an email from Judge
9 Harpin here where he's explaining the ball is and
10 has been entirely in our court. I firmly believe
11 that the CASC's decision on Aqua Products should
12 have no effect on this remand decision so no
13 additional briefing is necessary. What's he
14 talking about with this additional briefing?

15 A So after Aqua Products came down, the en
16 banc decision, management was pushing us and
17 ultimately instructed us to grant a briefing by
18 the parties. And say, hey, do you want to further
19 brief the motion to amend in view of Aqua
20 Products? And we didn't want to do that. Jim has
21 pointed out that he didn't want to do it. And I
22 didn't want to do and neither did Judge Cox, at

1 least originally.

2 And the reason is, is because we didn't
3 think it - we knew that it couldn't be relevant to
4 deciding the motion to amend before us. So and
5 that's because we had already decided that even if
6 the Petitioner or the burden to prove that the
7 claims are unpatentable and a motion to amend
8 which is something that Aqua Products declare is
9 their burden. We had already decided that the
10 record in the case met that standard.

11 So not only did patent owner not prove
12 that his claims are patentable, but petitioner
13 went above and beyond what was then the burden and
14 had proved that the claims were unpatentable. And
15 so, there was no briefing that could really change
16 our decision. That is what Jim is referring to.

17 Q Okay. And then on page 311 there's an
18 email from Jacqueline Bonia. Who is Jacqueline
19 Bonia?

20 A She's a Vice Chief Judge of the PTAB.

21 Q And could you kind of briefly explain
22 what she's saying here?

1 A So this is, yeah. She's --

2 JUDGE NIEDRICK: I'm sorry, Mr. Abramic,
3 what page was that?

4 MR. ABRAMIC: 311.

5 JUDGE NIEDRICK: Thank you.

6 THE WITNESS: She's relaying
7 instructions to an extent from David. It looks
8 like David Ruschke. David Ruschke is out of town.
9 But she's telling us, the three judges, to proceed
10 with a certain course of action. That is to have
11 a conference call with the parties to discuss the
12 impact of Aqua Products and see if they want
13 briefing.

14 BY MR. ABRAMIC:

15 Q And that's something that the three
16 panel members did not want to occur, right?

17 A Correct.

18 Q Okay. And further on down in the email,
19 it states in this case, David has indicated that
20 the original three judge panel can proceed. Do
21 you see that?

22 A Yep.

1 Q But David, at this point, is on the
2 panel, right?

3 A He's on the panel, but the parties and
4 public don't know that.

5 Q Okay. And also, Scott is on the panel
6 but there's a reference here that says, I'll let
7 Scott indicate whether he would like to be a
8 silent participant. What's your understanding of
9 that?

10 A I mean so for the part that you just
11 read right before that she suggests that Scott be
12 - she's tell us they have a conference call with
13 the parties. Perhaps with Scott be on the phone
14 as a silent participant without mentioning the
15 panel expansion yet.

16 Q So at this point was Scott on the panel?

17 A That's Scott Bullock. He's on the panel
18 but the parties don't know it.

19 Q Okay. And ultimately did you go through
20 - end up going through with this call and extra
21 briefing despite the original three panel members
22 objecting to that process?

1 A We did not end up having the call
2 because the parties responded. So we were
3 instructed to contact the parties as you see at
4 point number one. And in response to that the
5 parties kind of bypassed the call. They said that
6 they had met and conferred and they wanted
7 briefing and they agreed to a schedule for the
8 briefing.

9 Q Okay. Can your turn to your --

10 A We never had that --

11 Q All right. Go ahead.

12 A But we never had the conference call
13 that's being contemplated here.

14 Q Can you turn to your tab, binder tab 37,
15 Appellant Exhibit EY, record tab seven at 321
16 through 324?

17 A Okay.

18 Q And on page 321 at the top of this page,
19 you have an email where you write, I vote no
20 briefing. But if I'm outvoted and the parties are
21 permitted to brief, they should be told who their
22 panel is. What are you saying here?

1 A I'm very succinctly - well, I'm pointing
2 out that first of all that I'm against briefing.
3 And a majority of the panel - well, the publicly
4 presiding panel, the three judge panel, didn't
5 want the briefing. So the only way we're getting
6 outvoted here is by management flexing its muscle
7 or Bullock and Ruschke, you know, participating as
8 panel members to kind of out number us.

9 And I'm putting up that if I am outvoted
10 because I don't know - I mean like there's no
11 rules for this. I don't know what's going on. If
12 it's best of three or best of five. It's totally
13 unclear to me and I'm just letting everyone know
14 where I stand. I'm against briefing. And if I'm
15 against - if briefing is authorized, the parties
16 should know who they're briefing. The parties
17 should know who their panel is.

18 Q Okay. Could you turn to tab 41 of your
19 binder, Appellant Exhibit FD, record tab seven,
20 333 through 338?

21 A Yes.

22 Q And I'm directing you to page 333. This

1 is an email from you to Judges Cox, Harpin,
2 Ruschke, Bullock and Bonia. Do you see that?

3 A I do.

4 Q As part of the email you're addressing
5 this issue that the panel didn't want briefing.
6 Do you see that?

7 A Yes.

8 Q And down at the bottom of the email,
9 there's a paragraph that's numbered three. What
10 are you explaining in that email paragraph?

11 A All right. So in three, I'm pointing
12 out that - so this is an email on October 31,
13 2017. And I'm pointing out that the panel has
14 been expanded now for almost a year. And if the
15 expansion of the panel is yet to be disclosed to
16 the parties and it has prohibited by the Chief
17 Judge disclosing that to the parties. In that we
18 are now it seems going to be authorizing briefing
19 without disclosing that there's five judges
20 sitting on this panel and who they are.

21 And I'm also expressing that I have due
22 process concerns. I say, I think due process

1 requires the parties to be to informed that they
2 are addressing an expanded panel.

3 Q And so, after this email did the parties
4 ultimately brief the issue?

5 A They did file a post-Aqua Products
6 briefs addressing, you know, who should win given
7 what Aqua Products states.

8 Q And what did you do next?

9 A So I revised my concurring opinion. So
10 I had to remove stuff because some of it was
11 expressing my views of what the law, I thought
12 should be on motions to amend and Aqua Products
13 pretty much implemented it. And so, it was kind
14 of - it was mooted almost by Aqua Products.

15 So I removed that and then added
16 material. And the added material was about the
17 panel expansion itself. I explained that it - you
18 know, the history of it and why it was improper.

19 Q Can we return to your binder tab 23,
20 Appellant Exhibit FG, record tab seven at pages
21 391 through 471. Do you see this?

22 A I don't. Can you - what tab for me?

1 Q Sure. Your binder tab 43, 43.

2 A Okay. Let me search it. Okay. So I'm
3 looking at it's page 391 to 471?

4 Q Correct.

5 A Okay.

6 Q And what is this document?

7 A This is our decision after Aqua Products
8 had come out. So after we revised our decision.
9 It now has an opinion written by the Chief, Chief
10 Judge Ruschke. Harpin has now converted what was
11 his majority opinion into a concurring opinion.
12 I'm sure there was some revisions to it. He
13 didn't just change the title. And there's a
14 concurring opinion by me.

15 Q Okay. If you go to page 425 of the
16 exhibit. Do you see that?

17 A Yes. This one is my - this is the
18 beginning of my concurring opinion.

19 Q Okay. Thank you. And then turning to
20 page 430. Do you see that?

21 A I do.

22 Q There's a section at the bottom of 430

1 that starts with a heading, Procedural History.

2 Do you see that?

3 A Yes.

4 Q And can you just kind of generally
5 describe what you're writing in that section?

6 A So I'm pointing out that the panel is
7 only first - with the filing of this document,
8 which of course this document didn't actually get
9 entered. But I'm contemplating that this will be
10 entered. And that will be the way the parties
11 learned that they had an expanded panel.

12 And I'm also stating when the panel was
13 expanded on November 4th. And I have to look for
14 more information. Although the files, I need to
15 look at this.

16 Q Sure. That's okay. And would you agree
17 that your concurrence included your views on why
18 the panel expansion was improper?

19 A Yes. I think there is great details of
20 my views in there.

21 Q Okay. And just to quickly run through
22 them. If you look at page 434. At the top

1 there's a heading that says, expansion of the
2 panel was not authorized by the director, do you
3 see that?

4 A Yes.

5 Q And then on 435, there's a heading that
6 says, expansion of the panel was not authorized by
7 statute and is inconsistent with the statutes. Do
8 you see that?

9 A Yes.

10 Q Okay. And is it your recollection that
11 you explained that there are due process concerns
12 in here as well?

13 A I think so. I definitely talk about
14 this Alapatrice (phonetic) decision where circuit
15 judges expressed concern about --

16 Q Can you turn to page 438. That's all
17 right.

18 A 438, okay.

19 Q In the middle of 438, you see there's a
20 sentence there that says, thus, neither parties
21 had an opportunity to argue that the expansion is
22 inconsistent with due process. Do you see that?

1 A Yes.

2 Q Okay.

3 A So what I'm pointing out there is I'm
4 not coming to like an ultimate conclusion on it
5 because it wasn't briefed. And the reason wasn't
6 briefed because the parties didn't even know to
7 argue it because they didn't even know the panel
8 was expanded. So it's kind of chicken and egg
9 there, but I'm pointing out that, you know, I have
10 concerns. I'm just not opining it on the very
11 detail because there's no briefing.

12 Q Can you go to your binder tab 44? And
13 this is Appellant Exhibit FH, record tab seven at
14 472.

15 A I have it.

16 Q And what is this email?

17 A This is Judge Cox is submitting a
18 decision to the AIA review committee or Arc. The
19 decision being one that we just looked at.

20 Q That has your concurrence, correct?

21 A Yes. It's got Harpin's concurring
22 opinion. It's got mine. And it is the version now

1 that talks about panel expansion and why it is
2 improper.

3 Q And that's being disclosed to the full
4 AIA review committee and all of the cc's on this
5 email, all right.

6 A Agreed. Well, yeah. We're telling -
7 we're identifying or Judge Cox is telling the AIA
8 review committee and everyone on here that this
9 decision is ready for review by Arc. And the way
10 it works is it is submitted into a folder. So
11 it's like on this folder, it's a PTAB that any
12 judge can look at.

13 Q Okay. And that's dated March --

14 A March 20, (inaudible) 2000.

15 Q Okay. I want to talk about draft
16 opinion, but I want to shift gears for a minute
17 just to something else quickly. So if you could
18 go to your binder tab 60?

19 A 60, yes.

20 Q This is Appellant Exhibit GA, record tab
21 seven at 685 through 764. And referring to page
22 685. Do you see this? It is an email that you

1 sent to Judges Ruschke, Bullock, Cox, Bonia and
2 Harpin.

3 A I do. And it is an email, yes.

4 Q And in the first sentence, you're
5 referring to a case that says, Oil States? What
6 was Oil States about?

7 A Oil States was a case about challenging
8 the very constitutionality of IPRs, of this
9 process. That the patent owner - that he was
10 arguing that it was unconstitutional under article
11 3 and also under the Seventh Amendment for a body,
12 the PTAB to be the ones that are taking away a
13 patent potentially.

14 Q And what were saying?

15 A That it was constitutional. In Oil
16 States and it wasn't a unanimous decision but the
17 majority held that it was constitutional.

18 Q And what were you pointing out in this
19 email?

20 A So for the court rule, of course, there
21 was oral arguments. And I'm pointing out that the
22 Chief Justice, John Roberts, he asked a specific

1 question to the attorney representing the Patent
2 Office in this proceeding. I don't know. I think
3 it was someone with the U.S. Solicitor's Office as
4 opposed to somebody at the Patent Office, but this
5 Mr. Stewart.

6 And so, I'm pointing out that the Chief
7 Justice specifically inquired about changing the
8 composition of the adjudicatory body, which I take
9 to be changing the membership of a panel. And he
10 says, does it comport to due process to change the
11 composition of the adjudicatory body halfway
12 through the proceeding?

13 And through its attorney, the USPTO
14 said, this has been done on three occasions. It's
15 been done at the institution stage. Later on, you
16 know, shortly later actually. I think it's two
17 pages later in the transcript of the oral
18 arguments, Mr. Stewart then stated that panel
19 expansion or changing the composition of the
20 adjudicatory body has not been done at the merit
21 stage, if you will, when patentability was
22 actually being determined.

1 So I took that to be a clear
2 representation that panel expansion has never
3 occurred after institution. And yet, that's
4 exactly what happened in Nike. And so, it was a
5 misrepresentation to the court.

6 Q And why did you disclose the
7 misrepresentation?

8 A I thought the Patent Office had an
9 ethical obligation to correct the misstatement of
10 court.

11 Q Can you turn to page 687 of this
12 exhibit. What is this document?

13 A So this an attachment to the email we
14 were just looking at. And the attachment is a
15 copy of the transcript of the oral arguments in
16 Oil States, which was held November 27, 2017.

17 Q And so the attachment went along with
18 your email?

19 A It did.

20 Q Did anyone respond to your email?

21 A No.

22 Q So what did you do?

1 A So I - if you look at the last - you
2 know, in that email that we just look at, at the
3 end of it, I asked if - I asked the Chief please -
4 one of the things I asked him was please let me
5 know if you have any concern with me informing Mr.
6 Matol (phonetic) of the situation?

7 Mr. Matol is Joseph Matol. He's at the
8 time the acting director of the Patent Office,
9 okay. I didn't get any response. So I didn't get
10 any response to my email to the Chief. I then, in
11 fact, email Joseph Matol. And I also email the
12 Chief of Staff for the Patent Office.

13 Q Okay. Can you turn to your binder tab
14 61? This is Appellant Exhibit GB, record tab
15 seven at 765 through 767.

16 A Okay.

17 Q And looking at 765 is this the email to
18 Joseph Matol you were referring to you?

19 A Yes. And that Chief of Staff
20 individual, his name is Brendon McCommas
21 (phonetic).

22 Q I'm sorry. What did you say his name

1 was?

2 A Brendon McCommas. I'll spell it.

3 M-C-C-O so I'm sorry. M-C-C-O-M-M-A-S.

4 Q Okay. And did you get a response to
5 this email?

6 A I did not.

7 Q And what did you do next?

8 A Nothing immediately because this was
9 kind of the end of the road, but then we had a new
10 director come in. You know, one appointed by the
11 President, confirmed by the Senate. Andrew Yonko
12 (phonetic). He came in February and almost
13 immediately after he was sworn - I don't know
14 maybe like two days after he was sworn in,
15 something like that, I then reported these - the
16 same material, the same information to him.

17 Q Okay. If you could turn to your bind
18 tab 62? This is Appellant Exhibit GC, record tab
19 seven at 768 through 771. What's this document?

20 A This is me disclosing the information to
21 Director Yonko. I have, you know, a short
22 paragraph to him but then I include my prior

1 emails to Acting Director Matol and Chief Judge
2 Ruschke. And then I also included the transcript
3 of the oral arguments.

4 Q In the Oil States case?

5 A Yes. As an attachment. If you see it
6 says it shows there in the attachments at the top
7 of this page. It's not part of this exhibit maybe
8 but I did attach it.

9 Q And just to make one point clear. If
10 you turn to page 769 in the middle of your email.
11 You're identifying the Adidas and Nike case there,
12 right?

13 A Yes.

14 Q And so, what happened next after you
15 sent this email to Director Yonko?

16 A He didn't reply to the email. I still
17 got no reply to the email, but I did get at
18 request to have a phone call with him.

19 Q Okay. Could you turn to your tab,
20 binder tab 63, Appellant Exhibit GD, record tab
21 seven at 772?

22 A Yep. I'm there.

1 Q And what is this?

2 A Yeah. This is - I don't know what
3 Outlook calls it, but this is a printout from
4 Outlook showing a meeting that I was going to have
5 with Director Yonko. It shows he's the organizer.
6 The subject of it is meet with Judge Michael
7 Fitzpatrick and it's set for March 6th at 1:00
8 p.m. And my memory though is that after I
9 received this invitation, he and I actually spoke
10 on the phone earlier in time, maybe a few days
11 earlier.

12 Q And what did you talk about during that
13 conversation?

14 A Oil States and the Nike case.

15 Q And who did the talking?

16 A I mean we both did, but he asked me
17 questions. He asked me questions about the
18 procedural history of Nike.

19 Q Do you recall anything else from the
20 phone call?

21 A And I answered his questions so that's
22 what it was about.

1 Q Do you recall anything else?

2 A No.

3 Q Did you ever speak to Director Yonko
4 again?

5 A No. I attempted to a couple of more
6 times, but I didn't succeed in speaking with him.

7 Q And to your knowledge, did anyone ever
8 correct the representation that was made in the
9 Oil State's case?

10 A To my knowledge, no one ever did.

11 Q Okay. Let's go back to the draft Nike
12 decision that we were talking about that had been
13 sent to the Arc committee.

14 A Remind me of the tab?

15 Q We're going to go to a new one. Go to
16 your binder tab 49 and this Appellant Exhibit FN,
17 record tab seven at 646 - I'm sorry, 644 through
18 646.

19 A Okay.

20 Q And if you go to page 645, there's an
21 email there with some highlighting from the AIA
22 review committee or Arc. Do you see that?

1 A I do.

2 Q And what is essentially the first
3 sentence in that highlighted section say?

4 A Are you asking me to read it or
5 paraphrase it? I'm sorry.

6 Q You can paraphrase it. What is Arc
7 saying here essentially?

8 A Arc is telling us even though the top
9 management officials are actually on the panel,
10 still send it to management review because that's
11 our standard process whenever there's a motion -
12 whenever there's a concurring opinion.

13 Q Okay. And so, then your opinion was
14 sent. The opinion that had your disclosures about
15 the panel expansion was then sent to PTAB
16 management review?

17 A Yes. And I think it's like the next
18 email that bridges those two pages.

19 Q Yeah. The bottom of page 644, if I
20 could direct you to that?

21 A Yeah. That's from Josiah Cox, Judge
22 Cox. He's the one who submitted it this time. He

1 submitted our Nike decision to management review
2 on April 9th.

3 Q Okay. And who is on this group that's
4 called PTAB management review?

5 A The group - I don't know the outer
6 boundaries of the group, okay? But I do know that
7 it would include the Chief Judge, the Deputy Chief
8 Judge and the multiple Vice Chief Judges. It may
9 also include some Lead Judges, I'm just not sure.

10 Q Okay. And if you look up in response to
11 Judge Cox's email on page 644, there's a response
12 that comes from PTAB management review. Do you
13 see that?

14 A I do.

15 Q And it's signed by Scott W. Who's that?

16 A That would be Scott Weidenfeller.

17 Q So that would mean he was a member of
18 PTAB management review, right?

19 A Correct. And he's a Vice Chief Judge at
20 that time.

21 Q So then he had access to your
22 disclosure?

1 A Yes.

2 Q So at the top of this page, at the top
3 of page 644, you're discussing edits to your draft
4 opinion. What's your recollection as to what
5 those edits are referring to?

6 A So and we just mentioned on April 9th,
7 it was submitted to management a decision. And
8 then my memory is on a day before is April 20th
9 emails here. On April 19th, my lead judge Susan
10 Mitchell contacted me and said, hey, I want to
11 talk to you about some stuff in your concurring
12 opinion that management has deemed confidential.

13 And I think she said, and would like to
14 omit. And would like you to omit it because it's
15 confidential.

16 JUDGE NIEDRICK: I'm sorry. What date
17 was that?

18 THE WITNESS: April 19th, I believe.

19 JUDGE NIEDRICK: Thank you.

20 THE WITNESS: Definitely April 9th and
21 April 20th, I believe it was April 19th.

22 MR. ABRAMIC: Judge, could you go to

1 your tab, binder tab 48? And this I believe it's
2 tab seven, page 559.

3 JUDGE NIEDRICK: Okay.

4 MR. ABRAMIC: I believe it's tab seven,
5 but I'm hoping I have the right - well, I'm hoping
6 the judge --

7 JUDGE NIEDRICK: Yes, yes. That makes
8 sense. I see it. It's April 19, 2018 from Susan
9 Mitchell.

10 MR. ABRAMIC: Okay. Thank you. All
11 right.

12 BY MR. ABRAMIC:

13 Q So, Judge Fitzpatrick, you were kind of
14 explaining what had happened when Judge Mitchell
15 was asking you about these edits.

16 A Yes. And I apologize. What was the -
17 so I just toggled over to 48. What was the other
18 document that we were on?

19 Q It was your tab 49.

20 A Thank you. Oh, just the next one, okay.
21 And sorry, what was the question about just now?

22 Q I had asked you what - to describe what

1 had happened with these edits and you were kind of
2 explaining your answer.

3 A So it was April 19th. She sent me that
4 email that we just saw and then we had a telephone
5 call. Ahead of the telephone call, I looked at
6 the highlighted material from my concurrent
7 opinion.

8 I didn't agree that this stuff was
9 confidential and mandatory to remove, but I also
10 was willing to remove it because it seemed like
11 this was the last - was going to be the last hold
12 up to get this decision out. If I removed this
13 information, it would go out. And so, I agreed to
14 that.

15 Q And did the Nike decision then go out?

16 A It did not.

17 Q Okay. Can turn to your tab 54, binder
18 tab 54. This is Appellant Exhibit FS, record tab
19 seven at 656 through 661? And at the top of page
20 656, you are writing an email to Judge Ruschke
21 copying Judges Bullock, Cox and Harpin. And --

22 JUDGE NIEDRICK: I'm sorry. I missed

1 the citation. It froze on me for a second. What
2 are we looking at?

3 MR. ABRAMIC: Sure. Record tab seven at
4 656 through 661. And I was referring to page 656.

5 JUDGE NIEDRICK: Thank you.

6 BY MR. ABRAMIC:

7 Q And, Judge Fitzpatrick, this is an email
8 from you to Judges Ruschke, Bullock, Cox and
9 Harpin on May 10, 2018 after you said that you had
10 agreed to remove certain material from your
11 opinion. And what are you explaining in the first
12 paragraph of your email here?

13 A Well, the expanded panel had a
14 conference call on May 7th and during it, Chief
15 Judge David Ruschke stated in no uncertain terms
16 that no decision would ever go out in Nike and
17 have my concurring opinion in it so long as it
18 continued to discuss panel expansion.

19 Q Did he say it can't go out because of
20 confidential information?

21 A No.

22 Q And so, after you memorialized this

1 phone call, did any of the panel members ever
2 respond to this email to say that your description
3 of that telephone call was incorrect?

4 A No. No one ever disputed it. Nobody
5 every replied.

6 Q Okay. I want to switch gears again just
7 for a minute and go back to Director Yonko because
8 this is all kind of happening at the same time.

9 Your binder tab 52. This is Appellant
10 Exhibit FQ, record tab seven at 654. What is this
11 document?

12 A This is an email I sent on April 24,
13 2018 to Director Yonko. This is four or five days
14 after I agreed to remove the allegedly
15 confidential information from my concurring
16 opinion. Stuff that Scott Weidenfeller had asked
17 me to remove and which I thought if I did would
18 result in the decision going out. But the
19 decision didn't go out and now I'm frustrated that
20 the Chief and the Deputy Chief are never going to
21 let it go out. And so, I'm trying to get the
22 Director to intervene, to resolve the issue.

1 Q Did you get a response to this email?

2 A No response.

3 Q Could you go to your binder tab 55,
4 Appellant Exhibit FT, record tab seven at 662? Do
5 you see this document?

6 A I do.

7 Q And what's the date on it?

8 A May 15, 2018.

9 Q And what is this?

10 A This is our - this is an instant message
11 that I sent to the Director. I saw that his light
12 was green, which indicates he's available and
13 until I sent him this message. Director, may we
14 speak? I am free right now and later today.

15 Q And did he respond?

16 A He did not.

17 Q And what happened next?

18 A The next thing that happened was like
19 the next day or two maybe three days later. The
20 next one to three days another judge, Phil Kaufman
21 called me. And he wanted to inform me that he had
22 heard that the Director wanted to terminate me.

1 Q I'm sorry. Your mike --

2 MR. ABRAMIC: Did the court reporter get
3 that?

4 COURT REPORTER: Yes, I did.

5 MR. ABRAMIC: Okay. Thank you.

6 BY MR. ABRAMIC:

7 Q And did Judge Kaufman say anything else
8 to you in that conversation?

9 A He did. I mean he explained to me that
10 a management level judge - a management judge
11 heard - was at a meeting where Director Yonko - it
12 was a PTAB management meeting and Director Yonko
13 was there.

14 And Director Yonko expressed a desire to
15 terminate me. And this management judge had
16 witnessed it because this person was there. And
17 this person wanted Judge Kaufman to confidentially
18 relay that to me because this individual wanted me
19 to know.

20 Q And at that time did you know who this
21 management official was?

22 A I did not. I didn't ask. Judge Kaufman

1 didn't volunteer it. And it was clear he didn't
2 want to. And I never asked him at that time who
3 it was because I felt like he was already
4 uncomfortable with the situation. And I was
5 appreciative that he was willing to pass on this
6 information. I didn't want to get greedy so to
7 speak and ask more sacrifice of him.

8 Q Did there ever come a time where you
9 learned who that person was?

10 A I did.

11 Q And when?

12 A Last week.

13 Q And how did you learn who that person
14 was?

15 A So I called Judge Kaufman to tell him
16 that he would be testifying in this case. And I
17 told him or I reminded him because I had told him
18 once previously that I had identified him, Judge
19 Kaufman, in response to an interrogatory request
20 in this case.

21 The Agency asked who was the judge who
22 relayed the threat to me? And I answered I served

1 an interrogatory response to that interrogatory
2 and I answered Phil Kaufman. So I reminded him of
3 that and then I said, but I'd never known and I
4 never asked you who it was that told you? And I
5 said, I need to know that now. Will you tell me?
6 And he told me, it was Janet Gongola.

7 Q Can you spell that last name?

8 A Sure. It's G-O-N-G-O-L-A, I think. I'm
9 pretty sure that's it.

10 Q Who is Janet Gongola?

11 A She's a Vice Chief Judge on PTAB.

12 JUDGE NIEDRICK: Do you know how to
13 spell the first name?

14 THE WITNESS: Janet, it's J-A-N-E-T.

15 JUDGE NIEDRICK: Thank you.

16 COURT REPORTER: I have the spelling of
17 the last name. I just found it.

18 BY MR. ABRAMIC:

19 Q Judge Fitzpatrick, can we turn to your
20 binder tab 56. And this is Appellant Exhibit FU,
21 record tab seven at 663.

22 A Yes.

1 Q What's this document?

2 A This is an invite that I received on May
3 29th for a Webex audio meeting with Scott
4 Weidenfeller and Susan Mitchell that was to be
5 held and was held the next day at 4:30 p.m. on May
6 30th.

7 Q Okay. Can you go to your tab 57, binder
8 tab 57? Appellant Exhibit FV, record tab seven at
9 665.

10 A I'm there.

11 Q And this is an email during that day of
12 May 30, 2018. What is going on in this email?

13 A So this is one of many similar emails I
14 received on May 30th. This is, you know, sent to
15 - as you can see, four judges. So it's about one
16 particular IPR. The IPR is listed there
17 2017-00359. And it's from this paneling group.
18 And it's telling the judges that I'm unavailable
19 to serve on the above case and I'm being replaced
20 by Judge Christa Zoto (phonetic).

21 Q And you had mentioned - I guess, I want
22 to ask you were you unavailable to serve on those

1 panels?

2 A No. I was available.

3 Q In the previous exhibit there was phone
4 call that had been set up for May 30th between you
5 and Judges Weidenfeller and Mitchell. Did that
6 phone call take place?

7 A It did.

8 Q And what happened on that phone call?

9 A Judge Weidenfeller removed me from AIA
10 cases. He assigned me to ex parte appeals.

11 COURT REPORTER: Can you repeat the last
12 sentence?

13 THE WITNESS: Yes. Judge Weidenfeller
14 removed me from AIA cases and reassigned me to ex
15 parte appeals.

16 BY MR. ABRAMIC:

17 Q Okay. Could you go to your binder tab
18 66? Appellant Exhibit BI, record tab six at 11
19 through 13?

20 A I'm there.

21 Q Okay. What's your understanding of what
22 this document is?

1 A This is a document that I understand the
2 Agency has --

3 JUDGE NIEDRICK: I'm sorry. Mr.
4 Abramic, I just want to make sure I'm on the right
5 thing. Is this Exhibit O it says?

6 MR. ABRAMIC: Correct. That's the first
7 page.

8 BY MR. ABRAMIC:

9 Q And so, maybe what you can do, Judge
10 Fitzpatrick, is talk about this document with
11 reference to page 12?

12 JUDGE NIEDRICK: Thank you.

13 THE WITNESS: Okay. So page 12 - well,
14 so this document is something that I think the
15 Agency referred to as notes for the May 30th
16 meeting, May 30th that telephone call. They're
17 not my notes.

18 And the typewritten portion here on page
19 12 looks like a script pretty much of what
20 Weidenfeller told me on the call.

21 BY MR. ABRAMIC:

22 Q Okay. And right under the heading you

1 see where it says, pre-performance summary?

2 A Yes.

3 Q It says if I were to rate your
4 performance today based on the information about
5 which I am aware, I would rate your as marginal in
6 the element of internal/external stakeholder
7 interaction. Do you see that?

8 A Yes.

9 Q And did Judge Weidenfeller say that to
10 you on the May 30th call?

11 A Yes.

12 Q Okay. Now, do you see the reference to
13 internal/external stakeholder interaction?

14 A Yes.

15 Q I just want to refer you back quickly to
16 - if you could go to your binder Exhibit 2, binder
17 tab two? So it's tab 33 at page 139.

18 A Okay.

19 Q And what is this document again?

20 A This is my midyear review for the year
21 of 2018.

22 Q Okay. And what's the last element on

1 that midyear review?

2 A It's customer service, which is the same
3 as internal/external stakeholder interaction.

4 Q Okay. And this is dated April 25, 2018?

5 A Yeah. That's the day that I probably
6 received it because that's when I initialed it.
7 My lead judge, she signed it April 24th.

8 Q Okay. So let's go back to the phone
9 call, which is May 30, 2018. And back to the
10 exhibit we were just at, which is record tab six
11 at page 12. I believe you had just said that the
12 typewritten portion of page 12 appears to be an
13 accurate reflection of what you were told on the
14 call?

15 A Yes.

16 Q Now, if you turn to page 13 of the
17 document. Do those typewritten notes look to be
18 an accurate reflection of what was said on the
19 call?

20 A No. This is definitely - this doesn't
21 look familiar with respect to what was said on the
22 call.

1 Q But page 12 looks accurate to you?

2 A It does.

3 Q Did Judge Mitchell talk at all during
4 the call?

5 A She may have said hello. She did say
6 hello. And she may have said good bye. But that
7 is literally it. She said nothing subsequent on
8 the call.

9 Q Okay. Let's go to page 12 of the
10 document. The first bullet on the document. Do
11 you see where it says problems with timeliness are
12 too frequent and too serious to ignore. Do you
13 see that?

14 A Yes.

15 Q And so, did Judge Weidenfeller tell you
16 on the call that you had frequent timeliness
17 problems?

18 A Yes. I think he read that sentence to
19 me.

20 Q So up until this point in your entire
21 career at the PTAB have you ever heard from anyone
22 at the Agency that you had a timeliness problem?

1 A No.

2 Q And what did Judge Weidenfeller base is
3 timeliness criticism on?

4 A One case. It's referenced here
5 IPR-2018-00019.

6 Q And do you see the bullet, the first sub
7 bullet where it says that you submitted an
8 institution decision to your colleagues less than
9 12 business days before the statutory due date?

10 A I do.

11 Q What's your understanding of what that
12 12 day refers to?

13 A Okay. So starting with the statutory
14 deadline, there is a statutory deadline by when we
15 need to rule on institution decisions. It's
16 triggered by the closing of the briefing on that.
17 So whatever date that is management asks us to try
18 to circulate our, yeah, our draft opinions to our
19 colleagues that are on the panel with us 12 days
20 ahead of that date.

21 Q Okay. Is this 12 days a requirement
22 that sets forth in the APJ performance appraisal

1 plan?

2 A No. The Agency says it's part of
3 something that they call PAP support document, but
4 to my knowledge it's not in the performance
5 appraisal plan.

6 Q Okay. Did you miss the 12-day goal in
7 this particular case?

8 A Yes.

9 Q And do you commonly miss this 12-day
10 goal in all your years of working on AIA trials?

11 A No. This may have been the only one.
12 There may have been another, but I have no memory
13 of this being a problem.

14 Q Do you recall others ever failing to
15 miss this 12- day goal?

16 A Yes, yes. Even though I - there were
17 some judges that sometimes, you know, would
18 circulate these decisions very close to the
19 statutory deadline.

20 Q And when that happened did you complain
21 to management?

22 A I did not.

1 Q Why not?

2 A I didn't think it was a big deal for
3 starters. I recognize the demands of the job
4 because I was doing the same job. We're all busy
5 and I also know that each case is not a cookie
6 cutter thing each case is different. Some cases
7 take longer. The deliberations take longer.
8 There might be further deliberations after this
9 articulation of the opinions. And sometimes, just
10 things just take longer.

11 So I didn't think it was something that
12 would be appropriate to complain about.

13 Q Are you aware of any other APJs whoever
14 had been punished for missing this 12-day goal?

15 A I am not.

16 Q Let's turn back to the notes from the
17 call. This is record tab six, page 12. Do you
18 see in that first sub bullet talking again about
19 this one particular IPR-2018-00019 do you see the
20 sentence that says neither of your colleagues
21 agreed with your approach? Do you see that?

22 A I do.

1 Q And did Judge Weidenfeller tell you that
2 on the call?

3 A He did.

4 Q Is that accurate?

5 A It is not accurate, no.

6 Q Can you describe for me what happened in
7 that case leading up to the institution decision?

8 A Sure. We conferred. We have this
9 pre-draft conference where --

10 Q Who? Sorry, who's we?

11 A We, so Judge Christopher Paulraj and
12 Judge Zhenyu Yang (phonetic).

13 COURT REPORTER: Can you repeat the
14 first name, Mr. Fitzpatrick? The first name you
15 gave?

16 THE WITNESS: Well, it's spelled, yes.
17 It's spelled Z-H-E-N-Y-U.

18 COURT REPORTER: Yes, thank you.

19 BY MR. ABRAMIC:

20 Q Okay.

21 A So the three of us were - we were the
22 panel. And we conferred. I was the authoring

1 judge. I was assigned the authoring judge so I
2 kind of led the conference before I drafted the
3 decision.

4 And I remember talking about multiple
5 issues in this case. One of the issues was real
6 party in interest. I had - I was convinced that a
7 real party of interest of the petition was
8 estopped from bringing an IPR. And there's a
9 statute about that. But I couldn't convince Judge
10 Yang and Judge Paulraj that that was the case.
11 They weren't so sure that this party was estopped
12 from bringing an IPR.

13 So Judge Yang said, you know, why don't
14 we move on from that issue and talk about
15 something else in the case? And then I raised the
16 issue that I didn't think the petition complied
17 with a very significant rule that we have for
18 petitions. And that is the petitioner is supposed
19 to set forth a claim construction for the patent
20 that they're challenging. And then explain why
21 the claims of the patent are on unpatentable given
22 that construction.

1 And the petitioner didn't do that. It
2 was trying to avoid, I think taking a position on
3 the true scope of the claims. And I recognized
4 this deficiency and we all did actually. I mean
5 we agreed to deny the petition on that basis.

6 And I then drafted a decision that there
7 was, you know, true to that consensus and I
8 circulated it. After Judge Paulraj received the
9 opinion, he had second thoughts and then he told
10 me this. He called me to tell that he was having
11 second thoughts. And then ultimately, he thought
12 about it, I believe over the weekend and then
13 ultimately decided to dissent.

14 And Judge Yang, she requested an edit on
15 my decision to remove a case like this, she didn't
16 like. She didn't like the case. She didn't want
17 to talk about it and it was a perfectly reasonable
18 request. And so, I removed it. And then Judge
19 Yang and I issued our decision and Judge Paulraj
20 dissented.

21 So here we're - Weidenfeller is telling
22 - is saying that neither of the colleagues agree

1 with my approach. It's just not true. Judge Yang
2 agreed with me always and Paulraj actually agreed
3 with me until he changed his mind.

4 Q Just how do you view this kind of the
5 story that you just told of what happened leading
6 up to the institution decision, you know, how do
7 you view the events in that particular IPR as
8 compared to conferences, deliberations, and
9 decision making that you've had in other IPR
10 proceedings?

11 A I thought it was pretty typical. I
12 didn't think there was anything too unusual about
13 it. I certainly didn't -- I had no resentment or
14 ill feelings towards someone switching their
15 minds. That happens. I had done that before.
16 And, you know, I was shocked when during the May
17 30th call when this was brought up as a basis for
18 punishment, I was absolutely shocked.

19 Q Okay. Let's turn to -- going back to
20 the notes of the call on page 12, there's the
21 second black bullet there. It starts out with the
22 judge is expected to. Do you see that?

1 A I do.

2 Q And then underneath that bullet, there's
3 a sub-bullet that says, you have repeatedly
4 showed a lack of discretion and judgment as to
5 when to compromise with your fellow judges. Do
6 you see that?

7 A I do.

8 Q And is that something that Judge
9 Weidenfeller told you on the call?

10 A It is.

11 Q And then underneath that sub-bullet,
12 there's another sub-bullet. The first one talks
13 about the case that you already just talked about.
14 But the second sub-bullet, do you see the one
15 where it states --

16 A One about the SAS?

17 Q -- it says, you have refused to sign on
18 to preapproved template decisions applying SAS?
19 Do you see that one?

20 A I do.

21 Q And then the next one says, you stated
22 that you see no need to follow the director's

1 guidance.

2 A I see the comment. That's not an
3 accurate statement.

4 Q Okay. So, what do those bullets refer
5 to?

6 A This is referring to four actually
7 procedurally identical cases. They're, in fact,
8 they're consecutively numbered. I forget their
9 docket numbers. But they were -- I worked -- I
10 was on the panel with two other judges. Thu Dang,
11 it's spelled, her first name is T-H-U, last name,
12 D-A-N-G, and Karl Easthom. And I think that's
13 Karl with a K. And right at the -- the reference
14 to SAS is yet another Supreme Court case. In SAS,
15 the Supreme Court held that it looked at the
16 institution statute for IPRs, which is 314. And
17 it said that institution is supposed to happen
18 upon -- you grant the entire petition if any claim
19 -- if the petitioner -- if there's a reasonable
20 likelihood that the petitioner will prevail on any
21 single claim that's challenged. So, if you get
22 the one, it's a one claim threshold. That's what

1 SAS came out and said.

2 And it said it right around the same
3 time that we were, that Judges Dang, and Easthom,
4 and I were deciding to institute in these four
5 cases. I believe, I mean, this was April of 2016
6 -- 2018. It was April of 2018, I believe. Yeah,
7 this was April of 2018. Excuse me. SAS comes out
8 and in the same month we're instituting.

9 And after SAS comes out, I told my
10 colleagues that I would like to follow the Supreme
11 Court opinion and only in the institution decision
12 I propose we just address one claim. And assuming
13 there's a reasonable likelihood of success for the
14 petitioner on that one claim, we grant the IPR.
15 We grant institution. We don't look at all the
16 other claims at that point. We wait until trial.
17 And what Weidenfeller, I guess, is pointing out
18 here is that I wanted to file a concurring opinion
19 stating this.

20 Q And do you agree that your concurrence
21 was inconsistent with director guidance?

22 A I disagree. It was clearly not. It was

1 clearly not inconsistent.

2 Q Okay. Could you turn to your binder tab
3 5? This is Appellant Exhibit B-c, record tab 6,
4 at 246 through 306.

5 A I'm there.

6 Q And what is this document?

7 A This is an email I sent on May 18th
8 addressed to Scott Weidenfeller but copying my
9 lead Judge Susan Mitchell and those two judges
10 that were on the panel in these four cases with
11 me, Karl Easthom and Thu Dang. And here we have
12 the numbers of the cases. So, it was IPR
13 2018-00129 and then the next case was the same
14 prefix -00130. The third case was -00131. And
15 the fourth case was -00132. Procedurally
16 identical cases. And so, this has a whole string.
17 So, this is my email on May 18th, but it starts --
18 I'm sorry, did you ask me about this particular
19 page? Or what were you asking me?

20 Q Why don't we walk through it? Why don't
21 you go to page -- let's go to page 249. The top
22 of page 249.

1 A Okay.

2 Q Do you see that there's an email from
3 Scott W?

4 A I do. That's Scott Weidenfeller.

5 Q And what is he saying here essentially?

6 A He's asking Karl to see if the panel,
7 i.e., Judge Easthom, Karl Easthom, Thu Dang, and
8 me would allow the institution decisions go out in
9 the name -- with just the majority opinion without
10 my concurring opinion.

11 Q Because he believed -- your
12 understanding was he believed it was not
13 consistent with guidance.

14 A That's what he stated. I don't know
15 whether he actually believed that or not.

16 Q Okay. And then if you go the bottom --

17 A I'm sorry. Can I correct myself here?
18 I don't know if at this point in time -- yeah, I
19 don't think he actually ever told me this at this
20 point in time. So, we submitted it to PTAB
21 management review and this is his response. He
22 ultimately would tell me that it was my concurring

1 opinion was inconsistent with guidance. But I
2 don't think he told me at this time.

3 Q Okay. So, if you look at the bottom of
4 page 248, after Judge Weidenfeller asked your
5 co-panelists if they were comfortable with just
6 submitting a two-judge decision, how did you
7 respond?

8 A I said I want to keep my opinion.

9 Q And then in response, if you look at the
10 top of page 248, Judge Weidenfeller said, please
11 mail the decision without the concurrence. Do you
12 see that?

13 A I do.

14 Q And were you on the panel at this point?

15 A Yes.

16 Q Was Judge Weidenfeller on the panel?

17 A No.

18 Q Are you aware of any authority that he
19 had to prevent your opinion from going out?

20 A I am not.

21 Q Are you aware of any authority that says
22 an institution decision that analyzes a single

1 claim is not permissible?

2 A I'm not aware of that and I'm aware of
3 evidence to the contrary.

4 JUDGE NIEDRICK: I'm sorry. Just a
5 quick question just for my benefit here. Does a
6 panel -- is there a requirement that a panel
7 consist of three judges or could you issue a
8 decision with just two judges on the panel?

9 THE WITNESS: So, with my -- without
10 looking at all the, you know -- you know, being
11 out of the game for four years, I'm going to do
12 the best to answer your question. Definitely for
13 some decisions, it's a absolute statutory
14 requirement because there's maybe it's 35 U.S.C. 6
15 that says at least three panel members. However,
16 institution decisions are, in the first instance,
17 given by Congress to the director. So, if you
18 look at the institution statute it talks about the
19 director instituting it. The director has
20 delegated that authority to us. And I think he
21 delegated that -- or it's she now, I'm sorry --
22 delegated that authority to us via a rule that's

1 in the CFR, in the Code of Federal Regulations.
2 And I don't know what that rule states. So, I
3 don't know if that -- if there's a minimum for
4 institution decisions.

5 JUDGE NIEDRICK: Okay, thank you.

6 BY MR. ABRAMIC:

7 Q If you look at page 246 of the same
8 exhibit we were looking at, and this is an email
9 from you to Judge Weidenfeller, and your panel
10 members, and Judge Mitchell. Do you see that?

11 A Yes.

12 Q And would you agree that in the first
13 part of the email, you were trying to explain to
14 Judge Weidenfeller why your concurrence is
15 consistent with guidance?

16 A Yes.

17 Q And then further on down in the second
18 to last paragraph of your email, there's a
19 statement that starts with additionally. It says,
20 additionally other panels have been permitted to
21 issue institution decisions assessing only one
22 claim as I proposed to do in my concurring

1 opinions. Do you see that?

2 A Yes.

3 Q Did you ever get an explanation from
4 Judge Weidenfeller as to the inconsistency you
5 were pointing out?

6 A I did not.

7 Q Okay. Let's go back to the notes of the
8 phone call.

9 A Can you give me that tab number?

10 Q Actually. That's okay. We don't need
11 the notes. You recall on the phone call you said
12 that Judge Weidenfeller was using this situation
13 as an example of your refusal to compromise with
14 your fellow judges?

15 A Yes, I remember that.

16 Q And were your fellow judges on the panel
17 frustrated that you wanted to write a concurrence
18 in this case?

19 A Not in the slightest. They welcomed my
20 concurring my opinion.

21 Q Okay. Can we go to tab 7 of your
22 binder? And this is Appellant Exhibit C-j, record

1 tab 7, at 77 through 80.

2 And looking at page 77, not at the top
3 but the second email in the chain looks to be an
4 email from you on Thursday, April 26th to your
5 panel members and you state, sorry to throw a
6 curveball but I am considering filing a concurring
7 opinion saying that I agree with our analysis on
8 one claim and that that is all that's required.
9 Do you see that?

10 A I do.

11 Q And then is that --

12 JUDGE NIEDRICK: Sorry, is that -- I'm
13 sorry, I just need to find this. It's 77, you
14 said? This is tab 6?

15 MR. ABRAMIC: It is tab 5. Sorry, tab
16 5.

17 JUDGE NIEDRICK: Oh.

18 MR. ABRAMIC: At 77 --

19 JUDGE NIEDRICK: Okay. Hang on one sec,
20 please.

21 MR. ABRAMIC: Yeah.

22 JUDGE NIEDRICK: Okay, thank you. I

1 have it.

2 BY MR. ABRAMIC:

3 Q Sure. And so, Judge Fitzpatrick, we
4 were reading your email, the second email in the
5 string where you are telling your co-panelists
6 that you're considering filing a concurring
7 opinion. Is this the opinion that we were just
8 talking about, the concurrence where you wanted to
9 analyze a single claim for institution?

10 A It is. And this is, you know, this is
11 on April 26th. SAS came out I think on April
12 24th. So, it was like right in the middle I was
13 trying to get these institution decisions going
14 out the door. SAS comes out and (inaudible).

15 Q And how does Judge Dang respond to your
16 idea about a concurrence?

17 A She welcomed it. As I said, she wrote,
18 I think a concurring opinion would be great. Let
19 me know.

20 Q Could you turn to your tab 8, which is
21 Appellant Exhibit C-i, record tab 5, at 76?

22 A Yes.

1 Q And at the top of this document, it's in
2 small print there, but who is the top email from?

3 A Karl Easthom.

4 Q And what does he say here?

5 A He's writing to me and Judge Dang. He
6 says, okay, thanks. And no worries. Concurrences
7 and descents make the record much more clear in my
8 view. So, please write that if you feel it.

9 Q And what was your understanding of the
10 opinion, proposed opinion that he was referring to
11 there?

12 A So, remember there's four cases that are
13 virtually identical. But there's some cross
14 emails going around. So, the header of this email
15 is talking about, I think, case ending 129 and
16 130. And maybe the other email, which I told the
17 Board -- or told my panelists I'm thinking about
18 writing a concurring opinion may have been another
19 email string dedicated to the related case. So,
20 but this is after both judges received my email
21 that I wanted to file a concurring -- that I may
22 want to file a concurring opinion in these cases.

1 And so, he's responding to that. That's how I
2 read it.

3 Q Going back to the call that you had with
4 Judge Weidenfeller and where your punishment was
5 announced, do you believe that the reasons that
6 Judge Weidenfeller gave you on the call were the
7 real reasons why you were punished?

8 A No.

9 Q Why not?

10 A Two kind of -- well, personally, I mean,
11 I had a good track record. I was a good judge. I
12 have all these written reviews telling me I'm a
13 good judge. And I had just received one of those
14 reviews in late April. And here we are just a
15 little over a month later and I get a irregular,
16 impromptu performance appraisal. I'm the only one
17 at the Board as far as I know who got a
18 performance appraisal on May 30th. It's not
19 provided to me in writing. And it's only in
20 regards to one of the four elements by which I'm
21 supposed to be appraised.

22 And it's, frankly, as we looked at those

1 things, it was a lot of -- based on false
2 accusations. And also, on that 12-day -- it was
3 based on things that other judges do and nothing
4 ever happens to them. Other judges circulate
5 decisions less than 12 days before statutory
6 deadlines and other judges wrote institution
7 decisions instituting based on a single claim.
8 So, the things that they criticized me for were
9 happening at the Board and there was no punishment
10 for others.

11 Q After you were removed from the Nike
12 panel, what's your understanding of what happened
13 to the panel?

14 A So, I was removed May 30th. In June,
15 management named a replacement for me, Scott
16 Daniels. So, to the expanded panel. So, and that
17 point in time, it was still expanded, five judges.
18 Scott Daniels replacing me. And then maybe like a
19 week later, management unexpanded the panel.
20 Removed David Ruschke and Scott Boalick. And then
21 told the parties to rule without further delay.
22 Oh, excuse me, told the panel, the three-judge

1 panel, to rule without further delay.

2 Q Can you turn to your binder tab 9. This
3 is Appellant Exhibit D-r, record tab 7, at 15
4 through 71.

5 A Yeah, I'm there.

6 Q What is this document?

7 A This is a disclosure that I made to the
8 Inspector General of the Department of Commerce on
9 July 19, 2018. It regards many of the issues that
10 we've talk about today and others.

11 Q And who wrote this document?

12 A I did.

13 Q And you believe that your statements in
14 the document are true and accurate?

15 A I do.

16 Q If you could turn to page 55 of the
17 document.

18 A Okay.

19 Q There is a paragraph numbered 171 there.
20 Do you see that paragraph?

21 A I do.

22 Q And this paragraph is stating that on

1 June 28th, Judge Boalick sent an email explaining
2 that the Nike panel was unexpanded to remove Judge
3 Boalick and Judge Ruschke.

4 A Correct.

5 Q How did you come across the information
6 in paragraph 171?

7 A Judge Daniels read the email to me so I
8 could copy it down verbatim. He read it slowly to
9 me.

10 Q So, you didn't get the email?

11 A No. This was sent -- Judge Daniels told
12 me this was sent to the three of them, the new
13 panel, Judge Arpin, Judge Cox, and Judge Daniels.

14 Q To your knowledge, did the PTAB ever
15 notify the public or the parties about the panel
16 expansion in the Nike case?

17 A No, they did not.

18 Q You mentioned that you didn't agree with
19 the reasons that were given to you for why you
20 were punished, or that you didn't believe that
21 those were the true reasons why you were punished.
22 Why do you believe you were punished?

1 A I believe I was punished because I had
2 made these disclosures about panel expansion that
3 it was improper and illegal, and but also
4 inconsistent with representations that the Patent
5 Office had made to the Supreme Court. So, this
6 was a way of retaliating against me for making
7 those disclosures. And by the same token,
8 silencing me with respect to those disclosures.

9 Q And as a result of what went on with
10 your removal and the un-expansion of the panel,
11 did your concurrence that disclosed the panel
12 expansion ever see the light of day?

13 A No.

14 Q After you were removed from AIA cases,
15 what did you do?

16 A A couple things. I prepared that
17 disclosure to the Inspector General but I also --
18 I filed an informal grievance. The Patent Office
19 has this administrative grievance procedure, which
20 is a process that you need to follow for certain
21 personnel actions that you want to challenge. So,
22 I filed this informal grievance.

1 JUDGE NIEDRICK: Mr. Abramic, before we
2 jump into that, can we -- let's take a short
3 break?

4 MR. ABRAMIC: Sure, sure.

5 JUDGE NIEDRICK: Does five minutes work
6 for everybody?

7 MR. ABRAMIC: Sure.

8 JUDGE NIEDRICK: Shake your head if
9 that's okay. Okay. So, let's take a five-minute
10 break. It's 11:42. We'll come back at 11:47.

11 (Recess)

12 JUDGE NIEDRICK: Okay. We're continuing
13 with Judge Fitzpatrick's testimony after a short
14 break. Judge Fitzpatrick, please remember you're
15 still under oath. Mr. Abramic.

16 BY MR. ABRAMIC:

17 Q Judge Fitzpatrick, if you could turn to
18 tab 11 of your binder, which is Appellant's
19 Hearing Exhibit A-s, record tab 6, at 68 through
20 74. Do you see this document?

21 A Yes. This is my informal grievance that
22 I submitted.

1 Q Who wrote it?

2 A I did.

3 Q And do you believe that your statements
4 in this document are true and accurate?

5 A I do.

6 Q Could you turn to your binder tab 12.
7 And this is Appellant Exhibit B-z, record tab 5,
8 at 54 through 59.

9 A I'm there.

10 Q And if we could turn to page 58 of the
11 document. The bottom of page 58 is an email from
12 Scott Boalick. Do you see that?

13 A I do.

14 Q And in that email he says I have
15 assigned your administrative grievance to the Vice
16 Chief Judge Gongola for decision. Do you see
17 that?

18 A I do.

19 Q And so, was it your understanding that
20 Vice Chief Judge Gongola, at least at this point,
21 was going to be deciding your informal grievance?

22 A It is my -- that was my understanding,

1 yes.

2 Q Do you know Judge Gongola?

3 A I do. Not very well but I do know her.

4 Q Have you ever served on a panel with
5 her?

6 A No.

7 Q What interaction have you had with her,
8 if any?

9 A Well, there's -- I think we traded
10 emails about the grievance. I was wondering when
11 she would rule on it. So, there's that. But she
12 also asked me -- she reached out and asked me to
13 serve on the All-Hands Committee. This was a
14 committee that was going to plan a meeting of all
15 of these judges on the PTAB. So, we're spread out
16 across the country. I'm in Illinois. And there's
17 more than 200 of them. And we were going to have
18 an all-hands meeting, bring everybody together in
19 Alexandria, Virginia, at headquarters. And she
20 asked me to serve on that. And, I'm sorry, I
21 should add, and I did serve on that. However,
22 that meeting never occurred because of the

1 pandemic.

2 Q If you could just quickly turn to tab
3 67. Your binder tab 67. This is Appellant
4 Exhibit A-h. And this is record tab 33, at 540
5 through 547.

6 A Yeah, I'm there.

7 Q And then do you recognize this document?

8 A I do.

9 Q And on page 540, the top of that --

10 JUDGE NIEDRICK: I'm sorry, Mr. Abramic,
11 can you hear me?

12 MR. ABRAMIC: Yes.

13 JUDGE NIEDRICK: I'm sorry, Mr. Abramic,
14 I just froze here. Everybody froze actually. I
15 think it was my line. Can you just repeat like
16 the last -- I lost about the last 20 seconds. We
17 just turned to some exhibit, but I didn't get the
18 exhibit number.

19 MR. ABRAMIC: Okay. So, the exhibit
20 that I turned to is Appellant Exhibit A-h, record
21 tab 33, at 540 through 547.

22 JUDGE NIEDRICK: Thank you.

1 BY MR. ABRAMIC:

2 Q And we had just turned to page 540. And
3 at the top of 540, Judge Fitzpatrick, do you see
4 that that's an email from Judge Gongola to you
5 dated Friday, September 21, 2018?

6 A Yes.

7 Q And do you see that in this email here,
8 she is asking you to join this All-Hands Planning
9 Team that you just mentioned?

10 A Yes.

11 MR. ABRAMIC: Your Honor, this is
12 actually one of the exhibits that is not yet in
13 the record. So, I'd like to move Appellant's
14 Exhibit A-h, which is record tab 33, pages 540 to
15 547, into evidence.

16 JUDGE NIEDRICK: Any objection, Mr.
17 Horrigan?

18 MR. HARRIGAN: No objection.

19 JUDGE NIEDRICK: Okay, thank you.
20 That's admitted.

21 BY MR. ABRAMIC:

22 Q Let's go back to the previous exhibit we

1 were looking at. Judge Fitzpatrick, it's tab 12
2 in your binder. It is record tab 5, at 54 through
3 59. On page 57, there's an email kind of
4 three-quarters of the way down when you're asking
5 when you can receive a response to the grievance.
6 You see that?

7 A I do.

8 Q Why were you asking?

9 A So, the court, according to the Agency's
10 own procedure, they're supposed to answer it
11 within 30 days, within 30 calendar days insofar as
12 is practicable. I submitted this on June 14th and
13 like two weeks -- I'm sorry. Let's see, yeah, I
14 submitted it on June 14th and two weeks goes by
15 before anyone even, you know -- then on June 28th
16 Judge Boalick says I'm assigning it to Vice Chief
17 Judge Gongola, okay? So, it's already kind of I'm
18 thinking, okay, that's two weeks wasted. I wonder
19 when they're going to rule. And so, I inquired
20 about it. I was anxious.

21 Q And then on that same page, page 57, do
22 you see a responsive email from Judge Gongola that

1 says, I appreciate your patience and don't expect
2 to take much longer. You see that?

3 A I do.

4 Q Okay.

5 A That was on August 8th.

6 Q And what happened after that?

7 A That's August 8, 2018. So, we're now
8 already well past 30 days. And then I didn't hear
9 anything. And so, for several more, maybe a
10 month. Yeah, for four more weeks, I still didn't
11 get a decision. And so, on September 5th, I
12 inquired again. And that's on that next page, on
13 the bottom of page 56.

14 Q Okay. And then on September 17th, and
15 this is on page 55, you get notice that Judge
16 Gongola has been replaced by Judge Fink for the
17 resolution. Do you recall that?

18 A Yes.

19 Q And then what was the ultimate
20 resolution of your informal grievance?

21 A Later that month, Judge Fink denied my
22 informal grievance.

1 Q And what did you do next?

2 A I filed a formal grievance. So, the
3 administrative grievance procedure that the USPTO
4 has it requires you to go through two levels of
5 in-house grievances. So, I did that. I filed a
6 formal grievance.

7 Q Could you go to tab 1 of your binder.
8 This is Appellant Exhibit B-x, record tab 5, at 24
9 through 52.

10 A I'm there.

11 Q What's this document?

12 A This is my formal grievance. I
13 submitted it on --

14 Q And who wrote it?

15 A I submitted it on October 9, 2018.

16 Q Who wrote it?

17 A I did.

18 Q And do you believe that your statements
19 in the document are true and accurate?

20 A I do.

21 Q Judge Fitzpatrick, you were punished by
22 the Agency on May 30, 2018. That's almost four

1 years ago, correct?

2 A Correct.

3 Q What impact has the Agency's actions had
4 on you?

5 A Quite a big impact. It's been very
6 negative and stressful experience trying to undo
7 what happened to me going through all the legal
8 portals that I've had to go through, the two
9 grievances that we just mentioned. After that I
10 had to go to the Office of Special Counsel. I
11 answered questions they had, but ultimately after
12 almost two years, they decided not to pursue it.

13 And then I was kind of left on my own.
14 And I filed the instant appeal. And it was only
15 after I filed the appeal that I had any counsel
16 representing me in this. So, that was -- a lot of
17 that was done on my own. It was hard work. It
18 was very demanding and it was stressful. And it
19 was in addition to my day job. I took leave at
20 times to be able to have the time to work on
21 stuff.

22 Q What impact has it had on you

1 professionally other than all of the everything
2 that went along with the appeal?

3 A Well, I understand. So, I don't -- so,
4 setting aside all of this process of the trying to
5 undo it, being assigned ex parte appeals is not
6 enjoyable for me. I don't get the kind of job
7 satisfaction or fulfillment that I used to get
8 when I worked on AIAs. I really miss working on
9 AIA trials. They're more intellectually
10 stimulating. They're more challenging. They're
11 more collaborative. I get to interact with my
12 colleagues more. I have, you know, a council of
13 the parties appearing before me. It's just a --
14 it's truly litigation and that was my background.
15 And I really miss working in that.

16 Q So, if that were the case, why didn't
17 you just remove the panel expansion stuff from
18 your opinion?

19 A Because as I explain in the concurring
20 opinion, I think what happened in Nike was
21 illegal. I think the parties' constitutional due
22 process rights were violated. I think the

1 parties' statutory due process rights under the
2 APA were violated. There's myriad problems with
3 it. And it was something that I couldn't stomach.
4 I wouldn't go along with it. It would be
5 inconsistent with the oath I took when I was
6 appointed.

7 MR. ABRAMIC: Your Honor, with that, I
8 will pass the witness. And if there's a good time
9 to talk timing, if now would be good, I'm happy to
10 do it off the record or we can wait until after
11 the cross.

12 JUDGE NIEDRICK: Sure. So, it's noon
13 right now. We can take a break and then, Mr.
14 Horrigan, you can do your cross. Or we could push
15 through now depending on how long it's going to
16 take. Mr. Horrigan, any idea how long you think
17 it'll take you to do cross?

18 MR. HARRIGAN: I don't imagine it'll
19 take more than half an hour. But I would like to
20 take a break to review my notes.

21 JUDGE NIEDRICK: All right.

22 MR. HARRIGAN: And to make some

1 communications with the witnesses.

2 JUDGE NIEDRICK: Okay. So, I would
3 imagine that even with redirect, we should be done
4 with Judge Fitzpatrick in another hour at the
5 most, an hour and a half, I would think. I don't
6 have a lot of questions either. So, why don't we
7 take a 45-minute lunch break now. So, we'll come
8 back at say 12:50. And then we can hear from
9 Judge -- after Judge Fitzpatrick finishes, we can
10 hear from Judge Kauffman and then go from there.
11 Does that work for everybody?

12 MR. ABRAMIC: Yeah, that sounds great.

13 JUDGE NIEDRICK: Okay. So, let's do
14 that. We'll come back on at 12:50. If you could
15 just let Judge Kauffman know that, you know, given
16 things, he'll probably be testifying around 2:00,
17 a little after 2:00. We can pick up with his
18 testimony, okay? All right. Anybody have any
19 questions before we break for lunch?

20 MR. HARRIGAN: When do we come back?
21 I'm sorry, I missed it.

22 JUDGE NIEDRICK: 12:50.

1 MR. HARRIGAN: Okay, thank you.

2 JUDGE NIEDRICK: About 45 minutes, okay?

3 All right. Thank you all very much. If we may go
4 off the record, Ms. Dawson?

5 (Recess)

6 JUDGE NIEDRICK: Okay. We're going to
7 continue on after a short lunch break with the
8 cross examination of Judge Fitzpatrick. Judge
9 Fitzpatrick, just please remember you're still
10 under oath. Mr. Harrigan, your witness.

11 MR. HARRIGAN: All right, actually, I
12 had one subject for you before we started in on
13 this, if you don't mind.

14 JUDGE NIEDRICK: Sure, go ahead.

15 MR. HARRIGAN: Okay. So, the name Janet
16 Gongola in the context of this allegation about
17 Mr. Yanku, this is -- today is the first time I
18 ever heard that name in that context. In fact,
19 Mr. Kauffman last week refused to give me that
20 name. She is standing by and she is ready to
21 testify. So, rather than get a hearsay witness,
22 we could just call Ms. Gongola.

1 JUDGE NIEDRICK: What are you talking
2 about? Are you talking about for later on, I
3 presume?

4 MR. HERRIGAN: Well, in lieu of Mr.
5 Kauffman, who is just a hearsay witness, we could
6 actually talk to the witness herself.

7 JUDGE NIEDRICK: Okay. Well, I'll make
8 that determination once we get to Judge Kauffman
9 because I don't know if that's the only reason
10 they're calling Judge Kauffman, so.

11 MR. HERRIGAN: Okay, fair enough.

12 JUDGE NIEDRICK: Good. So, go ahead.

13 CROSS-EXAMINATION

14 BY MR. HERRIGAN:

15 Q All right. So, Mr. Fitzpatrick, good to
16 see you again. You described your extensive IP
17 background and then you mentioned 121 decisional
18 units. Do you recall that?

19 A I do.

20 Q Okay. And so, how would you describe
21 the volume of work when you were doing AIA cases
22 in the 2018 time period?

1 A It was a lot of work.

2 Q And like how many different cases would
3 you be looking at at the same time would you say?

4 A It varied. It varied a lot. Because I
5 was working on AIA at the time and you might get
6 two decisions and they're always -- they tend to
7 be big. Two big decisions might go out in a month
8 and maybe you don't have any decision go out the
9 next month. So, you might get like 10 decisional
10 units in February and then none in March.

11 Q Okay. But you got --

12 A It's not as consistent.

13 Q I'm sorry, go ahead.

14 A It's not as consistent. I was going to
15 say it's not as consistent as in ex parte appeals.

16 Q Okay.

17 A Where you just do one unit.

18 Q And you had a docket, right?

19 A Yes.

20 Q How many matters would you say were on
21 your docket at any one time?

22 A In 2018?

1 Q Yes.

2 A Okay. So, when I'm working -- I was
3 working on AIA cases in 2018. I don't know is the
4 answer. I don't know how many cases I would have.
5 I'm sure it changed --

6 Q Well --

7 A -- as the year went on.

8 Q Would it be a handful or more like 30?

9 A I think it would be less than 30. I
10 think it would be -- because it would -- it would
11 -- I get assigned as soon as -- or as soon after a
12 petition's filed. So, it would include cases that
13 are pre-institution. It would include cases that
14 are post-institution. And it would include cases
15 in which I was the authoring judge and cases in
16 which one of the other two judges was the
17 authoring judge. It's hard to -- I don't -- I
18 don't recall what the --

19 Q Okay.

20 A -- number.

21 Q And the decisions that are produced,
22 would you say that they are legally exacting?

1 A I don't understand your question. I'm
2 not sure which decisions you're referring to.

3 Q Well, as a -- it could be a lead
4 decision. It could be a concurring opinion.
5 Aren't they fairly legally detailed?

6 A It depends on what -- I don't know what
7 decision you're asking me about.

8 Q Just generally. In your work, aren't
9 these very legalistic documents?

10 A Okay. So, I'm going to -- I'm going to
11 limit it to AIA cases. In AIA cases an
12 institution decision and a final decision I would
13 say those are pretty detailed.

14 Q Okay. And it's important to be clear in
15 your analysis, right?

16 A I would think so. I agree.

17 Q Yeah.

18 A (Inaudible).

19 Q And why is that? From your perspective,
20 why is that?

21 A I think it's self-evident. Why would --
22 you don't want to be -- you should explain the

1 basis for your ruling. This is my view. And so,
2 in order to explain it you would want to explain
3 it clearly so that it can be understood.

4 Q Okay. So, I'm going to ask you and I
5 don't know how your counsel is referring you to
6 documents. So, hopefully someone can help me.
7 But I would like to ask you to turn to what has
8 been marked as tab 5, page 22.

9 A Is that tab 5 referring to like the MS
10 -- like in the pleading, the fifth pleading?

11 Q Correct, yeah.

12 A I don't --

13 JUDGE NIEDRICK: That's the decision on
14 the formal grievance is what we're looking at?

15 MR. HARRIGAN: Yes, correct.

16 JUDGE NIEDRICK: Yeah.

17 MR. HARRIGAN: Yeah, uh-huh.

18 BY MR. HARRIGAN:

19 Q Is there a way I can be more clear to
20 you, Mr. Fitzpatrick?

21 A Yeah, I think Mr. Abramic if he's
22 allowed would tell me where it is in the binder

1 that I have for my direct.

2 Q Well, that's certainly fine with me.

3 A Yeah, that's fine with me too.

4 MR. ABRAMIC: I don't -- I'm not certain
5 that the decision on the formal grievance is in
6 his binder. Do you want to just pull it up and
7 share it?

8 MR. HERRIGAN: Administrative Judge,
9 I'll have to defer to you.

10 JUDGE NIEDRICK: Yeah, I'll go ahead and
11 give you permission to do that.

12 MR. HERRIGAN: Okay. I don't know how
13 to do that so I'll have to figure it out.

14 JUDGE NIEDRICK: Okay. You can go ahead
15 and share it, Mr. Herrigan.

16 MR. HERRIGAN: Okay.

17 JUDGE NIEDRICK: It looks like they all
18 froze.

19 MR. HERRIGAN: Yeah, I had you frozen
20 for a sec. Okay. So, I'm trying.

21 JUDGE NIEDRICK: Maybe it was just me.

22 MR. HERRIGAN: Okay. I'm going to drag

1 over the document hopefully. Do you all see this?

2 JUDGE NIEDRICK: Yes, that works.

3 THE WITNESS: I do.

4 BY MR. HERRIGAN:

5 Q Okay. And so, you'll see that this is
6 Mr. Boalick's decision on your formal grievance,
7 correct?

8 A This is the first page of it, yes.

9 Q Okay. And so, just for the record, we
10 can see we're in tab 5, it's page 22. And so, I'm
11 going to scroll down to page 23. Do you see that
12 paragraph there that starts, in addition?

13 A I do.

14 Q Now, have you reviewed that sentence --
15 or that paragraph prior to today?

16 A Not recently.

17 Q Would you like to take a look at it?
18 The question's going to be is there anything
19 inaccurate in there?

20 A Okay. In this paragraph?

21 Q Yeah.

22 A Or in the first sentence? Should I read

1 the whole paragraph?

2 Q The in addition paragraph.

3 A Okay. Okay. What's your question?

4 Q Is there anything inaccurate there?

5 A There's a lot that's inaccurate.

6 Q Why don't you tell us what that is.

7 A Okay. The first sentence he says, I
8 note that your difficulties seem to arise from a
9 misapprehension of the nature of your employment.

10 Q Yes.

11 A That's not accurate.

12 Q Okay. So, I think maybe the substance
13 of the paragraph that follows that would you -- do
14 you have an quarrels with anything else beyond
15 what's on the first paragraph -- or first
16 sentence?

17 A So, we'll go sentence by sentence I
18 guess. So, the next sentence -- excuse me --
19 says, your grievance arguments appear to be based
20 on the mistaken premise that you need not comply
21 with PTAB management's supervisory direction
22 because of some special status or authority

1 conferred upon you by your position as an
2 administrative patent judge. That's also
3 inaccurate.

4 Q Okay. And why is it inaccurate?

5 A My grievance arguments are based on the
6 punishments that were cited by management for
7 removing me from the AIA panels.

8 Q Okay.

9 A So, I don't even understand the
10 foundation for Boalick to say that they appear to
11 be based on a mistaken premise that -- and I won't
12 read the whole thing. I will also add that it
13 appears that he's imputing that premise to me that
14 I've made the mistaken premise that I have some
15 special status that I have -- I don't have any
16 mistaken premise.

17 Q All right. And the third sentence
18 begins, the administrative patent judges. Is that
19 an accurate statement?

20 A It says, well, this is a legal
21 conclusion here.

22 Q Is it accurate?

1 A It's accurate that I'm not -- oh, sorry.

2 JUDGE NIEDRICK: I'm sorry. There was
3 something that just popped up on the screen. I
4 think somebody was --

5 MR. HARRIGAN: Oh, I'm sorry. Sorry.
6 One of the witnesses I'm in communication with. I
7 don't --

8 JUDGE NIEDRICK: Oh, okay.

9 MR. HARRIGAN: -- even know how to drag
10 that way, sorry.

11 JUDGE NIEDRICK: That's okay. I just
12 want to make sure it's nothing that's
13 confidential.

14 MR. HARRIGAN: Nope.

15 JUDGE NIEDRICK: So, as long as you can
16 see it and you're okay with it. It's fine with
17 me.

18 MR. HARRIGAN: Yeah, I don't know how to
19 make it go over to the other screen.

20 BY MR. HARRIGAN:

21 Q Okay. So, we were at -- I was asking
22 you about the third sentence, administrative

1 patent judges and the question was is there
2 anything inaccurate there? And what was our
3 response?

4 A Yeah. Is there anything inaccurate?
5 Yeah, so, I certain -- I agree let me put it this
6 way that administrative patent judges are not
7 Article III judges. We're not appointed for life.
8 I am confused by the line that says that we --
9 that we are not subject to special provisions
10 under Title 5 of the U.S. Code. Because later in
11 the paragraph you say we are subject to evaluation
12 under Title 5 of the U.S. Code.

13 Q But you understand that administrative
14 patent judges are subject to Title 5, correct?

15 A I don't even know what you're saying
16 here. Because in this sentence, you're saying we
17 are not subject to Title 5. Or --

18 Q Right --

19 A -- excuse me, Boalick. And then later
20 on in the same paragraph he says we are.

21 Q Okay. So, from your understanding, are
22 administrative patent judges subject to Title 5?

1 A It's a difficult question to answer
2 because I don't know the scope of the entire Title
3 5. It's I imagine a very large set of laws. So,
4 I can't answer that. I don't know.

5 Q Okay. And are administrative patent
6 judges evaluated under a PAP like everybody else
7 at the USPTO?

8 A I don't know about everybody else, but
9 administrative judges are evaluated pursuant to a
10 performance appraisal plan that sometimes referred
11 to as a PAP.

12 Q And that final sentence is accurate too.
13 Is that right?

14 A I don't know what you want -- if you
15 could show me what 5 U.S.C. 75 says, maybe I could
16 answer that.

17 Q So, you're not familiar with that.

18 A I don't know. I don't know what --

19 Q You're not familiar --

20 A -- that -- I don't know what that
21 chapter says.

22 Q Okay. And so, looking down to the next

1 paragraph, which I hope they have moved up a
2 little bit. I guess we should take it one
3 sentence at a time. So, under that first
4 sentence, is that accurate or not accurate?

5 A Are you referring to the sentence that
6 starts, under your PAP?

7 Q Yes, I am. Thank you.

8 A Okay. What are the authorities above?
9 Do you know what -- I can't see the whole thing.
10 It says under your PAP any authorities above.

11 Q We just reviewed that didn't we?

12 A Is that what it's referring to? I mean,
13 that was -- you didn't start me at the beginning
14 of this document, so.

15 Q Let's assume for the sake of the
16 question --

17 A Are you representing authorities above?

18 Q Let's assume for the sake of the --

19 COURT REPORTER: Excuse me.

20 MR. HARRIGAN: -- question that that --

21 COURT REPORTER: This is the court

22 reporter. Can you please speak one at a time?

1 THE WITNESS: Yes, I'm sorry.

2 BY MR. HERRIGAN:

3 Q All right, Mr. Fitzpatrick. I think we
4 have your answer. Let's go then to the next
5 sentence, which is a reference to your PAP. Do
6 you see that? The CEG?

7 A The citation, right? Yep, I see the
8 citation.

9 Q Okay. Is that accurate?

10 A I don't know. I would need to look at
11 the PAP.

12 Q Okay.

13 A It doesn't sound --

14 Q And do you have any reason --

15 A I don't know that it's worded that way.
16 But I don't dispute that decisions should be
17 consistent with binding legal authority and
18 written guidance applicable to PTAB proceedings
19 issued by the director or the director's delegate
20 if the director, in fact, delegated it. I don't
21 know what the PAP actually says. But that sounds
22 reasonable to me.

1 Q Do you have any reason to dispute the
2 two quotations from 35 U.S.C. Section 3?

3 A No.

4 Q Okay. And then what is your position on
5 that final sentence in that paragraph?

6 A I think that's a vague sentence. So,
7 it's hard to form, you know, to have a very
8 succinct position. I mean, certainly my legal
9 views are independent of the director's legal
10 views. That's why I am named to preside over
11 panels.

12 Q All right. Let me change subjects and
13 talk about that May 30th meeting. I'm going to
14 stop sharing for now at least. All right. Is the
15 screen back like it should be?

16 JUDGE NIEDRICK: Yes. Yeah, you're
17 good.

18 BY MR. HARRIGAN:

19 Q Okay. Except I can't see you. So, let
20 me figure out why that is. Okay. There we go.
21 All right. In your informal complaint, you wrote
22 that Vice Chief Judge Weidenfeller's stated reason

1 for the hypothetical and irregularly timed
2 performance appraisals were based on alleged
3 timing and his problems on my decisions, as well
4 as an alleged failure to compromise with my fellow
5 judges. Is that what he told you?

6 A That was the best that I could recall at
7 that time. That was before I was provided what
8 appears to be a script that Weidenfeller used.
9 So, I was going by memory and I think it was --
10 you can compare those documents. I think it was
11 pretty accurate.

12 Q Okay. And in your formal grievance, you
13 wrote that Vice Chief Judge Weidenfeller asserted
14 that his May 30th performance appraisal was based
15 on negative views of me allegedly and exclusively
16 from Chris Paulraj, Zhenyu Yang, Karl Easthom, Thu
17 Dang, and unidentified AIA review ARC judges. Is
18 that right?

19 A Can I see the document? I'm not sure.

20 Q I don't know if you have it. It's your
21 -- it is your formal grievance. It's at tab 5,
22 page 24.

1 MR. ABRAMIC: This one we do have in his
2 binder. Judge Fitzpatrick, it's I believe your
3 binder, tab number 1.

4 THE WITNESS: Okay. And, Mr. Horrigan,
5 I'm sorry, can you tell me what page you're
6 reading from so I can just jump to that page?

7 MR. HERRIGAN: Twenty-four.

8 JUDGE NIEDRICK: And just for the
9 record, the informal grievance is at tab 6,
10 starting at page 68.

11 BY MR. HERRIGAN:

12 Q All right. Do you have page 24, Mr.
13 Fitzpatrick?

14 A I have page 24. And, Judge Niedrick, I
15 don't know, I assume you meant to say -- the
16 document I have in front of me is my formal
17 grievance. And it is --

18 Q Yeah, exactly.

19 JUDGE NIEDRICK: Oh, okay. We're
20 talking about the formal grievance or the informal
21 grievance. I'm sorry.

22 MR. HERRIGAN: We had been talking

1 previously about the informal. So, your citation
2 was correct. We are now currently on the formal.
3 And so --

4 JUDGE NIEDRICK: Okay.

5 MR. HARRIGAN: -- we're at tab 5, page
6 24.

7 JUDGE NIEDRICK: Got it, thank you.

8 BY MR. HARRIGAN:

9 Q Okay. So, you'll see the final
10 paragraph on that page. That's what I've quoted
11 from.

12 A Yeah.

13 Q Is that accurate?

14 A I think so.

15 Q Okay. And so, let me ask you to move
16 down to page then. It's still in tab 5.

17 A Okay.

18 Q And Mr. Weidenfeller -- you wrote that
19 -- you wrote an example. So, it says, for
20 example, in sustaining Vice Chief Judge
21 Weidenfeller's actions against me, the response --

22 A That was looking -- I'm sorry. Can you

1 tell me where you are? I don't see where you are.

2 Q Okay. I'm on page 30. Okay. And so,
3 it's under C, the second sentence. And that would
4 save me to having to read it. All right? Do you
5 see that the four examples section?

6 A Yep.

7 Q Okay. Is that also accurate?

8 A It's accurate that -- so, what happened
9 was I filed my informal grievance and it was based
10 on the reasons that I was given at the May 30th
11 performance appraisal. In denying my informal
12 grievance, Judge Fink injected new reasons, okay?
13 And these are two of them.

14 Q Is the statement accurate? Is your
15 statement accurate?

16 A This is -- my statement that Judge Fink
17 in sustaining Vice Chief Judge Weidenfeller's
18 action against me, he heavily relies on
19 allegations regarding these two cases.

20 Q Okay. And so, I was referring you to
21 four examples through the remainder in the
22 sentence. You wrote this, correct?

1 A I wrote everything that is in --
2 everything that's on page 30, I wrote. Put it
3 that way.

4 Q All right. So, you testified earlier
5 about three -- there was a question from the
6 Administrative Judge about three-judge panels,
7 two-judge panels. And you said that you were not
8 aware of -- well, why don't you say. Why don't
9 you repeat what you said.

10 A About what? I don't recall.

11 Q So, he had asked you if there were
12 occasions where two-judge panels -- I don't want
13 to mischaracterize his question. But something
14 along the lines of were there times when we use
15 two-judge panels?

16 A I don't think that's what he asked me.
17 But I'll tell you what -- I think he asked me if
18 it was allowed. Or he asked me about --

19 JUDGE NIEDRICK: That's what I asked
20 him. Yeah, whether it was permitted to have less
21 than three judges on a panel.

22 BY MR. HORRIGAN:

1 Q Okay.

2 A My answer is --

3 Q Do you call that then?

4 A Yeah, I remember, yes.

5 Q Yeah, why don't you give us what you
6 recall your answer to be.

7 A The answer was -- so, this was about
8 institution decisions. And --

9 Q Right.

10 A -- this was -- I didn't know -- okay.
11 So, I didn't know definitively.

12 Q Okay. And so, if I could ask you --

13 A I didn't know what --

14 Q -- to turn --

15 A I'll make an elaborative one as I did
16 with Judge Niedrick when he asked me that.

17 Q Well, why don't we just get -- move
18 forward and perhaps this will answer the question.
19 I'm at tab 6, page 71.

20 MR. ABRAMIC: I don't know if we have
21 that one.

22 MR. HARRIGAN: All right. Let me. Do I

1 still have permission?

2 JUDGE NIEDRICK: Yes. You can go ahead.

3 MR. HERRIGAN: All right. Do you see
4 this document?

5 JUDGE NIEDRICK: It hasn't popped up
6 yet, Mr. Herrigan.

7 MR. HERRIGAN: Oh, that's not good. I'm
8 having -- my Adobe does not like this. It keeps
9 freezing. Okay. Let me try again.

10 JUDGE NIEDRICK: I think I -- I can
11 share it but it -- okay, you got it?

12 MR. HERRIGAN: That might be the better
13 way to go. But, yeah, hopefully you see this?

14 JUDGE NIEDRICK: Yes, it's appearing.

15 BY MR. HERRIGAN:

16 Q All right. Mr. Fitzpatrick, can I take
17 you to the third sentence, which says, instead of
18 dissenting. Could you read that?

19 JUDGE NIEDRICK: And just for the
20 record, this is at tab 6, page 71 that they're
21 reviewing.

22 THE WITNESS: Yes.

1 BY MR. HARRIGAN:

2 Q Okay. Could you read that sentence?

3 A Instead of dissenting, I allowed
4 two-judge orders to be entered without an opinion
5 from me in order to avoid the evitable delay that
6 management would take in reviewing my dissenting
7 opinions.

8 Q Okay. And you're referring here to
9 institution decisions, right?

10 A No.

11 Q No, you're not. What are you referring
12 to?

13 A I'm referring to orders that went out in
14 cases that were already instituted.

15 Q Okay. So, this doesn't help you refresh
16 your recollection about whether two-judge orders
17 in institution decisions can go out?

18 A Well, it doesn't -- it doesn't inform my
19 opinion as whether it's legally -- whether it's
20 kosher, I would say. But this certainly happened.
21 And this was at management's request.

22 Q Okay. And so --

1 A So, it's not -- this is management
2 asking me to do it. In this instance, I allowed
3 it.

4 Q Well, is that what's happening in this
5 paragraph?

6 A Is what what's happening in this
7 paragraph?

8 Q I see it that says, I allowed two-judge
9 orders to be entered. Doesn't that say that?

10 A Right. He asked, right.

11 Q Okay.

12 A So, he asked me and allowed it. Or --

13 Q Okay.

14 A -- I don't even know who he was in this.
15 He asked me and I allowed it.

16 Q Okay. And so, your position now is that
17 this does not speak to institution decisions,
18 correct?

19 A I don't think so. But I would need to
20 see these orders for sure. I believe that this is
21 after institution in all of these cases. And this
22 is my memory without looking at the document. In

1 all these cases, we had partially instituted a
2 petition, okay? And then SAS came down. And SAS
3 said, hey, all you need is one claim. If you
4 establish a reasonable likelihood for prevailing
5 on one claim, the director, or his delegate, which
6 is us, needs to institute on everything, okay?
7 So, at this time when this case came down, SAS, we
8 had cases pending at the Board that had been
9 partially instituted. And so, we had to -- we had
10 to do something about it because it was something
11 that in retrospect the Supreme Court said was
12 erroneous to have done.

13 Q Okay. Then I'm going to move down to
14 page 72 and we're still in tab 6. And --

15 JUDGE NIEDRICK: Can I just ask some
16 questions? I just want to clarify I'm sure as to
17 what you were testifying to earlier, Judge
18 Fitzpatrick. When I asked you the question you
19 said that there are some decisions that by statute
20 require three panel members. But you said
21 institution decisions are different and in some
22 cases they may be allowed with less than three.

1 Is that accurate? Is that what you testified to?

2 THE WITNESS: It's not an accurate --
3 that's not -- that's not entirely accurate of my
4 view. My view is that it's extremely rare. In
5 fact, I don't know of any cases that ever went out
6 with two judges other than the ones that we talked
7 about today. I'm not aware of any that went out
8 with two judges other than the ones we've talked
9 about today.

10 JUDGE NIEDRICK: Okay. But --

11 THE WITNESS: And --

12 JUDGE NIEDRICK: -- but the question was
13 is it allowed?

14 THE WITNESS: And I don't know -- yes,
15 I'm sorry.

16 JUDGE NIEDRICK: Okay. So, that is
17 accurate with regard your testimony as to whether
18 it's allowed or not. You essentially said that it
19 may be allowed with less than three.

20 THE WITNESS: Well, I didn't -- so,
21 there's a statute that says that IPRs are to be
22 conducted and heard by a panel of at least three

1 judges or something to that effect. But before
2 you institute, there isn't an IPR that's being
3 conducted or heard. And also, there's a statute
4 that says the director is the one who's supposed
5 to -- who's responsible to institute. And the
6 director has delegated that authority to us. I
7 don't know. I think it's a somewhat gray area. I
8 would have to research. I don't know whether the
9 three-judge -- the at least three-judge
10 requirement applies to institution decisions. I
11 do know that it applies to conducting and hearing
12 instituted IPRs and in issuing final decisions. I
13 hope that is clear.

14 JUDGE NIEDRICK: Okay, thank you. All
15 right, thanks.

16 BY MR. HORRIGAN:

17 Q All right. I've scrolled us down to
18 page 72, of tab 6. And I'm going to ask you to
19 look at the sentence that begins, further and then
20 all the way through the question mark. Do you see
21 that?

22 A Further on May 12th?

1 Q Right, further on May 12.

2 A And then through the first question mark
3 I hit? Did you say there was a question mark?

4 Q Oh, sorry. Let me just read the -- let
5 me just read what I'm asking you to look at, all
6 right?

7 A Okay.

8 Q Here we go. Further, on May 12, 2018,
9 Vice Chief Judge Weidenfeller asked the panel if
10 it would be amenable to issuing two-judge DIs in
11 these cases, i.e., by Judges Easthom and Dang
12 only. He did not ask me to change the tone or
13 wording of my concurring opinions, nor did Vice
14 Chief Weidenfeller even broach the idea that there
15 was any problem with my tone or wording. Do you
16 see that?

17 A I do.

18 Q Okay. Now, first of all, just for the
19 record, what's DI?

20 A Decision to institute or institution
21 decision.

22 Q Okay. And so, this is on May 12th,

1 correct?

2 A This sentence is about something that
3 happened on May 12th. I didn't write this --

4 Q Well, you --

5 A -- on May 12th.

6 Q Right. But you're referring to
7 something that happened on May 12, correct? Is
8 that right?

9 A Yes.

10 Q Okay. And so, let's go to page 188 of
11 still in tab 6. Okay. Now, you see this is May
12 8th, right?

13 A Yes.

14 Q And this is a different case than what
15 we were just talking about, right?

16 A I hate to ask you to go back but I don't
17 know. I don't know what case I was just looking
18 at.

19 Q Okay. Well, you can see the Scott W.
20 here is Mr. Weidenfeller, right?

21 A Correct.

22 Q Okay. And do you see that Mr.

1 Weidenfeller's explaining to you that they're not
2 comfortable with the way you're handling SAS,
3 correct?

4 A Let me see. They're not comfortable
5 with the draft order that the three of us
6 unanimously decided to enter. This is --

7 Q Right.

8 A -- Judge Smith and Judge (inaudible),
9 yeah.

10 Q Well, he wrote to you that the draft
11 order selectively quotes Dicta and SAS, or SAS I
12 guess you guys refer to it, to imply that SAS
13 requires institution on all grounds in a petition
14 which is contrary to the interpretation of the
15 case that the director has instructed us to use.
16 Do you see that?

17 A I can see that, yes.

18 Q Okay. And so, not only had he mentioned
19 this to you on May 8th, but he says in a recent
20 email. So, he had already brought this to your
21 attention, right?

22 A No. This is, first of all, this is

1 addressed to me, but it's written to the entire
2 panel. And the reason I think it's addressed to
3 me is because there's an email below. I can't see
4 what it says. But there's an email below. I
5 probably or I may have been --

6 Q Well, I --

7 A -- referring to what's the last --

8 Q I'm sure your counsel can --

9 A -- so --

10 Q -- get to that if they want to. My
11 question though is it says, as I explained in a
12 recent email, doesn't that mean there was a
13 previous email?

14 A Yes.

15 Q Okay. So, you're going to want to see
16 this. I'm sorry, I'm going to refer you to tab 5,
17 page 36, which is the formal grievance. He does
18 have that, right?

19 MR. ABRAMIC: He does have his formal
20 grievance.

21 MR. HARRIGAN: Okay.

22 MR. ABRAMIC: That is in --

1 MR. HERRIGAN: Every time this happens,
2 by the way, I'm sorry, Judge. Every time this
3 happens, I have to close out Adobe because it
4 freezes.

5 JUDGE NIEDRICK: Okay.

6 MR. HERRIGAN: That's what I'm doing
7 right now.

8 JUDGE NIEDRICK: All right.

9 BY MR. HERRIGAN:

10 Q So, I was referring you to tab 5, page
11 36.

12 A Okay, I'm there.

13 Q Yeah, unfortunately I'm not quite.

14 JUDGE NIEDRICK: Do you have that in
15 front of you, Judge Fitzpatrick?

16 THE WITNESS: This document I do. This
17 is the --

18 JUDGE NIEDRICK: And this is the
19 institution decision template version two, is that
20 what you're looking at?

21 THE WITNESS: No, I'm looking at my
22 formal grievance.

1 JUDGE NIEDRICK: Okay. I'm sorry. I'm
2 on the wrong tab for mine. I think he's got this
3 one in front of him. So, I'm thinking he --

4 BY MR. HERRIGAN:

5 Q Great. So, I'm going to, yeah, good.
6 So, I'm on the middle of the page, right under B,
7 the response confirms. You see that? Do you see
8 that, Mr. Fitzpatrick?

9 A I do.

10 Q Okay, great. So, I'm actually getting
11 to the next sentence. Vice Chief Weidenfeller's
12 order was unlawful at least under 35 U.S.C. 6, and
13 it goes on. Do you see that?

14 A I don't. It says -- it doesn't say Vice
15 Chief (inaudible). It says Vice Chief Judge Fink.
16 I think it's referring --

17 Q Okay, I'm --

18 A -- to Fink in all of my --

19 Q Okay.

20 A -- informal grievance.

21 Q Maybe I put you in the wrong place.

22 We're at tab 5, page 36, under B, in the middle of

1 the page.

2 A Yes.

3 Q The paragraph starts, the response
4 confirms, correct?

5 A I apologize. Yes, confirms that Vice
6 Chief Judge Weidenfeller ordered the institution
7 decisions -- do you want me to keep reading or? I
8 see it.

9 Q No, no, no. I just want to make sure
10 you understand what I'm saying. Okay. And so --

11 A Okay.

12 Q -- I'm actually interested in the second
13 sentence. Do you see that?

14 A Yeah. And that's down -- okay, and
15 that's -- that was what tricked me up. So, the
16 next paragraph or are you talking about the
17 citation. Oh, I see --

18 Q That's --

19 A -- Vice Chief Judge Weidenfeller's order
20 was unlawful. That sentence.

21 Q Correct.

22 A I'm there.

1 Q Now, we talked --

2 A Okay.

3 Q -- about how important it was to be
4 clear in your legal writing. So, could you refer
5 us to the language in 35 U.S.C. 6, which was
6 violated by Mr. Weidenfeller here?

7 A Can I get a copy of the statute?

8 Q So, nothing is off the top of your head?

9 A I would need to see the statute.

10 Q Are you aware of any --

11 A Because the --

12 Q -- case which holds that?

13 A Which holds what? His order?

14 Q That that's illegal.

15 A I mean --

16 Q Right.

17 A -- no one really knows about his orders,
18 yeah.

19 Q Pardon me?

20 A No one knows about these -- no one knows
21 about Vice Chief Weidenfeller's orders. So, of
22 course, there wouldn't be a case talking about it.

1 Q Okay. Well, I think you must have been
2 referring to some previously existing law, right?
3 In order to accuse him of doing something illegal,
4 right?

5 A So, this is my formal grievance. I'm
6 not accusing him of anything. I'm defending
7 myself against unwarranted attacks. That's all
8 that's happening here. And I'm pointing out that
9 what he did there was unlawful.

10 Q Right, exactly. And so, I'm asking what
11 case would you point to to establish that fact?

12 A I pointed to a statute, actually
13 multiple statutes, and the Constitution.

14 Q Right, and I've asked you about -- I've
15 asked you about the first one, 35 U.S.C. 6.

16 A Yeah.

17 Q And I've asked you for the specific
18 language that was violated, correct?

19 A Yeah.

20 Q And you couldn't refer to that, right?

21 A I couldn't -- I would -- I'm sure I
22 could if you give me the statute. It's not that

1 long. If you let me look at the stature, I'm sure
2 I could answer the question.

3 Q And so, now, I'm asking you what case
4 comes to mind that would establish that what you
5 -- that the allegation --

6 A Okay.

7 Q -- that we just read, what case comes to
8 mind to establish that?

9 A So, you know, I look at -- there's
10 multiple cases. I think Arthrex, the holding that
11 came out by the Supreme Court, totally supports
12 this that management shouldn't be doing this.
13 That the director, I mean, Weidenfeller was acting
14 on behalf of the director here. It's the
15 director's power to name panels and so, him in
16 taking that opinion off and having to go out
17 effectively removing me, I guess, in a way from
18 the panel, that was the director's -- that was the
19 director's authority he was exerting there. And
20 in Arthex, the court held that the director cannot
21 -- doesn't have these kinds of -- these kinds of
22 supervisory authority over judges. Which his why

1 the Supreme Court gave the power to rehear our
2 decisions at the end. So, that's one case.

3 I have another case for you. It's
4 Nidec. I think you put something in there. It
5 was one of your exhibits. But during oral
6 argument in that, the Patent Office argued to the
7 Federal Circuit, it was in response to a direct
8 question from Judge Reyna, and Nate Kelley, on
9 behalf of the Patent Office, argued. He said, I
10 don't know if this will be a satisfactory response
11 to you -- to your question, Judge Reyna, but the
12 names of the judges that appear on decisions are
13 the names -- are the people that decided the case
14 without any influence by others. And when others
15 do influence cases, their names get on the -- get
16 on the decision. He said that in no unclear -- no
17 uncertain terms. So, that's to hopefully that
18 answered your question.

19 Q Your testimony then is the legal
20 authority for your allegation here taking away
21 your concurrence from these institution decisions,
22 Mr. Weidenfeller violated 35 U.S.C. 6 is to point

1 to the decisions in Nidec and in Arthrex. Is that
2 it?

3 A No. My view that it was unlawful is set
4 forth here. It's a violation of 35 U.S.C. 6, 316,
5 the APA, the Constitution. You asked me, I
6 believe, if I could name any cases that support my
7 position there and I just did that. And then I
8 think you just --

9 Q Oh, I'm sorry.

10 A -- yeah, okay.

11 Q Oh, I wasn't clear. I meant when you
12 wrote this. Did you have any legal authority for
13 that?

14 A Well, those two -- so, I don't know if
15 Nidec that case was already argued. And so, if
16 that quote had already happened. But when that
17 quote happened, I knew of it immediately because I
18 listened to that oral argument and I was shocked
19 to hear it. So, I don't know the time. If that
20 existed, I'm sure that was part of my thought
21 process. Arthrex definitely did not exist at this
22 point in time. So, it couldn't have been.

1 Q So, when you allege that Mr.
2 Weidenfeller violated U.S.C. 316, what language do
3 you point to?

4 A Again, I'd like to look at the statute.

5 Q What case would you point to?

6 A Those same two cases.

7 Q Then when you accuse him of violating
8 Administrative Procedures Act, what exactly in the
9 Administrative Procedures Act did he violate?

10 A So, it's a big act. But there is --
11 there are provisions that require government
12 officials when they are making determinations that
13 affect parties appearing before them, to explain
14 the reasons for those decisions and to be, I
15 think, transparent about it.

16 Q And could you cite the specific
17 language?

18 A No, not sitting here.

19 Q All right. And so, what case would you
20 refer to to say that Mr. Weidenfeller violated the
21 Administrative Procedures Act?

22 A Maybe those -- I mean, I think -- well,

1 there's cases that certainly support it. So,
2 there's this Alappat case that judge -- I forget
3 which judge at the Federal Circuit wrote a
4 concurring opinion in and said, hey, in this case
5 it was about expanded panels. So, it was a
6 different thing. Instead of removing someone, it
7 was about adding someone. But it was changing the
8 outcome of a decision.

9 And there, that judge wrote a concurring
10 opinion and said something along the lines of like
11 this is not to bless, even though we're not going
12 to reverse with the PTAB did here -- actually it
13 was the Board of Patent Appeals at the time --
14 even though we're not going to reverse it, this is
15 not to bless that this is -- this is not a
16 violation of the parties' due process. We're not
17 going to get into that though because the parties
18 -- neither party argued that their due process had
19 been violated. So, it was basically a suggestion
20 that they were very uncomfortable, or at least
21 this judge was very uncomfortable with what
22 happened there. And I would also add --

1 Q So, is it fair to say that --

2 A I would like to also add the Oil States
3 case. Chief Justice John Roberts is clearly
4 bothered by the idea of changing the panel while
5 decisions are being made. He doesn't -- it's --
6 and he specifically I think he asked, he
7 challenged the government to speak to the due
8 process concern that he had.

9 Q Sure. And Mr. -- I'm sorry -- the Chief
10 Judge's expression of concern was in oral
11 argument, correct?

12 A The one I just referred to, yes.

13 Q Yes. And it did not, in fact, make its
14 way into the holding of the court, did it?

15 A The transcript of the oral arguments did
16 not make it into the decision, correct.

17 Q Well, this point did not make it into a
18 holding of the Supreme Court, did it?

19 A Not, maybe not in that form. But I
20 think what happened there -- well, I know what
21 happened there. The Agency told a false story
22 about panel expansion, thereby putting the Chief

1 Justice at ease that this isn't an issue.

2 Q As an expert in the law and in legal
3 writing, would you agree that that sentence is
4 mere argument?

5 A What sentence?

6 Q The one we've just been looking at in
7 great detail.

8 A That Judge Weidenfeller's order was
9 unlawful? That one?

10 Q Yes.

11 A Is that argumentative?

12 Q That it's mere argument. What's your
13 answer?

14 A Well, I would -- no, I would disagree.
15 I'm citing law.

16 Q Okay, all right. Then let's --

17 A It may be conclusory -- it may be
18 conclusory, but it's not mere argument. It's I'm
19 citing authority.

20 Q Okay. And then I'm going to turn this
21 to page -- excuse me -- tab 7, page 559.

22 A What would that be?

1 MR. ABRAMIC: I don't know that we have
2 this one.

3 MR. HORRIGAN: All right. Hold on just
4 a second.

5 JUDGE NIEDRICK: All right. I believe
6 you do because you brought it up --

7 MR. ABRAMIC: Yeah.

8 JUDGE NIEDRICK: -- on your direct.

9 MR. ABRAMIC: Yeah.

10 JUDGE NIEDRICK: This is the April 19,
11 2018, email from Susan Mitchell? It's the one
12 that says I wanted to give you a call to discuss
13 what management identified as confidential
14 information in your concurring opinion. I don't
15 know where that is in there.

16 THE WITNESS: You're right it is in
17 here. I just don't know where it is yet.

18 MR. ABRAMIC: Yeah. It is, Judge
19 Fitzpatrick, it is tab 48, of your binder.

20 THE WITNESS: Okay. Thank you. Okay,
21 I'm there.

22 BY MR. HORRIGAN:

1 Q You have that? Okay, good. So, you see
2 that this is from Ms. Mitchell to you and she says
3 that she wants to talk about highlighted
4 information in yellow, right? Second sentence on
5 pages 6 to 9 of your concurring opinion.

6 A Yes.

7 Q Do you see that? Okay. And so, I'm
8 going to take you then to that which starts at
9 page 599 of tab 7.

10 A Okay.

11 Q All right. And so, you see the
12 highlighted information and can you see that on
13 your copy?

14 A I can.

15 Q All right. Is that, in fact, what Ms.
16 Mitchell brought to your attention?

17 A Yes.

18 Q Okay. And I'm going to scroll down all
19 the way to 602, just to make sure that we're all
20 in agreement. Okay? So, do you see that?

21 A Yes.

22 Q Through page 602?

1 A Some more highlighting.

2 Q All right. And so, that was what she
3 asked you, correct?

4 A The highlighted stuff on pages 601, 602,
5 and 599.

6 Q Right. And so, as I just I read from
7 her email that she was referring to pages 6
8 through 9 of your draft. Do you see that?

9 A Yes, and they correspond to the page 599
10 to --

11 Q Right. And so, right now, page 9 is
12 actually 602 of tab 7, correct?

13 A Correct.

14 Q Okay. And then we see after that part 4
15 of your concurrence, correct?

16 A Correct.

17 Q And that's where you begin your
18 discussion about your position on the legality of
19 expansion of the panel, right?

20 A That's where I get into detail. I may
21 -- I may -- I may introduce the concept above it.
22 I think I probably do.

1 Q Okay. But you agree that there's no --
2 no one asked you to make redactions in that
3 section, right?

4 A Section 4, no.

5 Q Okay. All right. Now, do you think
6 that it was illegal for Ms. Mitchell to ask you to
7 take this language out?

8 A No, because she didn't threaten me. She
9 asked me. And I willingly implemented the
10 request.

11 Q Okay. When you wrote about this in your
12 I believe it's your informal grievance, you said
13 that management's efforts in this regard violated
14 at least, and then a number of things. Does that
15 sound right?

16 A It sounds like something I wrote, but it
17 sounds like you're taking it out of context. So,
18 I don't know what efforts in this --

19 Q Well, let's --

20 A -- regard would be.

21 Q Then let's go back. So, tab 5, page 46.
22 Do you have that?

1 A I can't I'm sorry.

2 MR. ABRAMIC: We have it organized
3 according to tabs and exhibit numbers. What is
4 the document? The informal grievance or the
5 formal grievance?

6 MR. HERRIGAN: I'm sorry. Let me get to
7 it. It looks like the formal because it's very
8 long. Yes --

9 JUDGE NIEDRICK: Are we back to the
10 unlawful order under the statutes? Is that what
11 we're looking at, Mr. Herrigan?

12 MR. HERRIGAN: Correct.

13 JUDGE NIEDRICK: Again, what you wrote,
14 Judge Fitzpatrick, as you said, VCJ Weidenfeller's
15 order was unlawful under at least 35 U.S.C.
16 Section 6 and 316, the Administrative Procedures
17 Act, and then you provide citations to 5 U.S.C.
18 551 and through 559. And the due process clause
19 of the 5th Amendment.

20 BY MR. HERRIGAN:

21 Q Okay. I think I might have got the
22 wrong page here. So, why don't we just move on.

1 A Okay.

2 Q So, then you also claim that the panel
3 was secretly expanded, correct, the Nike panel?

4 A When you say then, where are we? I'm
5 sorry. I'm having trouble figuring out.

6 Q I'm not on any page at the moment. I'm
7 just asking a question. Are you claiming that the
8 Nike panel was secretly expanded, right? You've
9 said that, haven't you?

10 A Oh, we met -- yeah, I cite on the claim
11 that, yes.

12 Q And when you say secret, do you suggest
13 it was illegal?

14 A It was illegal when that by virtue only
15 of being secret. But, yes.

16 Q Okay.

17 A I (inaudible) of the term secret.

18 Q So, let's focus on secret. Is this what
19 you consider to be secret, illegal?

20 A I don't understand that question. A lot
21 of secret things that are --

22 Q Right, but we're talking about --

1 A -- I don't understand.

2 Q We're talking about your use of that
3 word with respect to the concurring opinion and it
4 was the expansion of the panel in Nike, correct?
5 Yes?

6 A I don't know, sir. What are you
7 referring to? I don't --

8 Q Let's back up then. Have you used the
9 word secret to describe the panel expansion in
10 Nike?

11 A Yes.

12 Q When you use that word, are you implying
13 that there was some sort of illegality taking
14 place?

15 A Yes, on the basis of at least due
16 process. Let me think here. It also brings up,
17 you know, I don't know if it's illegal to lie to
18 the Supreme Court. I imagine I know it's
19 unethical. But it brings that up.

20 Q So, if we could focus on my question,
21 which was about your use of the word secret.

22 A Yes.

1 Q Right? Do you consider that to be
2 tantamount to being illegal?

3 A I think the panel being secret was
4 illegal because it was in violation of due
5 process. And I think the government took steps to
6 maintain the secrecy that were also illegal. That
7 step including misrepresenting to the Supreme
8 Court and the Federal Circuit of what happens.

9 Q Specifically, what about due process was
10 violated when this secret expansion happened?

11 A So, many things. Well, you said when it
12 happened. It happened on maybe November 4, 2016.
13 I don't know if it was the biggest deal
14 immediately. You know, maybe if they got notified
15 the next day, everything would be fine. But
16 during this two years, a lot of things happened.
17 So, first of all, the parties were deprived of the
18 decision. Their panel had already reached a
19 decision. They could have gotten their decision
20 in the fall of 2018. And because of what happened
21 here, it was delayed for two years.

22 In addition, they briefed an issue that

1 was never going to affect the outcome of the case.
2 So, they wasted client resources, presuming the
3 clients paid for it, all because judges that were
4 on the panel secretly ordered us, the ones who
5 were publicly on the panel, to invite and
6 authorize briefing. So, they were not on the
7 panel and they affected the case by delaying it.
8 And they affected the case by having the parties
9 waste resources briefing Aqua Products.

10 Q And what specific aspect --

11 A At least --

12 Q -- of the due process clause do you
13 refer to when you say it was illegal?

14 COURT REPORTER: Mr. Fitzpatrick, could
15 you finish your last sentence before you answer
16 that question?

17 THE WITNESS: Thank you. I appreciate
18 it. I was just going to say that I'm sure there's
19 -- that's not my definitive response to the
20 parties' due process violations. I imagine the
21 parties would, if they knew what happened, they
22 could have advocated for themselves all these due

1 process violations that they suffered because of
2 this. But, of course, they don't know. This is
3 their -- these are their rights we're talking
4 about. But then to answer the next question, Mr.
5 Horrigan, you asked what provision of the due
6 process of the APA, is that what you asked?

7 Q No, I didn't.

8 A Okay. I'm sorry.

9 Q Okay. So, we're still on the secretly
10 expanded idea. But you were involved in the Idle
11 Free panel, correct?

12 A Correct.

13 Q And what happened there, right, there
14 was a three- judge panel who initiated on that
15 case?

16 A I believe so. I'm virtually certain of
17 that.

18 Q And then the panel was expanded, right,
19 to address an issue, correct?

20 A Not exactly. So --

21 Q And the first time --

22 A -- the panel was --

1 Q I'm sorry.

2 A No, I said not exactly. And I was going
3 to explain. So, what happened was parties -- we
4 instituted and then the parties we had this
5 initial conference call. And the patent owner
6 wanted to file a motion to amend. This would have
7 been maybe the first motion to amend in any AIA
8 case. This was early on. I think this was a 2012
9 docket number case. So, this was early on. We
10 had this order and we told them we would issue --
11 I'm sorry. We had this conference call and we
12 told the parties we would issue an order providing
13 guidance of what to put in the motion to amend.
14 What to argue, what they need to prove.

15 Judge Jameson Lee, I believe was the
16 authoring judge, and he wrote what he thought it
17 should be. And the panel was just all of a sudden
18 I was told that the panel was expanded. There
19 were six judges now on it. Three judges that I
20 believe were all management level judges.
21 Definitely senior judges. They joined the panel
22 and then the order went out. It was like all very

1 fast.

2 So, I had no -- this order went out,
3 this expanded panel order in Idle Free went out
4 probably the day I was told that it was expanded.
5 I never had a conference with all six of those --
6 with all five of those fellow judges. So, I had
7 no idea ahead of time that it was going to be an
8 expanded panel. But it went out. And then every
9 other decision and order in that case, I believe,
10 was a three-judge panel.

11 Q Well, a decision went out on the motion
12 to amend, correct? From the expanded panel,
13 right?

14 A Oh, no, an order providing guidance
15 about motions to amend. This is before --

16 Q Under the --

17 A -- the party even filed a motion to
18 amend.

19 Q Okay. But under all six judges,
20 correct?

21 A Yes.

22 Q And then the panel was de-expanded and a

1 final decision was rendered by three APJs, right?

2 A Not in that order. The case went
3 through trial. It was like a, you know, this --
4 the order that went out, the so-called Idle Free
5 order, I believe was very early on after
6 institution and there was like a year long period
7 where they were arguing. They're submitting
8 briefs and evidence. And then ultimately a
9 three-judge panel, including me, I think I was
10 still on, ruled in that case. Or maybe it was
11 even settled.

12 JUDGE NIEDRICK: Can I ask --

13 THE WITNESS: I don't know.

14 JUDGE NIEDRICK: Can I ask real quick?

15 So, when you're talking about the Idle Free order
16 that went out expanding the panel, the order
17 notified the parties that the panel was being
18 expanded? Is that what we're talking about when
19 we're talking about the Idle Free order?

20 THE WITNESS: Is that a question for me,
21 Your Honor?

22 JUDGE NIEDRICK: Yes.

1 THE WITNESS: So, the order -- so, I'm
2 referring to -- when I refer to the Idle Free
3 decision, I'm referring to this one order that has
4 six judges on it. The parties -- it's captioned
5 with six judges. So, that's how they know that
6 there was six judges that signed onto that case --
7 onto that order -- excuse me -- onto that order,
8 okay? Every other decision or order in that case
9 before and after, I believe, was a three-judge
10 panel.

11 JUDGE NIEDRICK: But what was the order?
12 What did the decision say? What was the purpose
13 of sending that out with the six judges on it?

14 THE WITNESS: So, my memory is that --
15 this is what I was told at the time. So, these
16 motions to amend were -- those were going to be
17 brand new. Nobody had ever -- nobody at the PTAB.
18 This is a whole new process. The IPRs, in
19 general, and the motions to amend aspect was also
20 new. And the PTAB management wanted, apparently
21 wanted to get out their preferred views for
22 motions to amend. And this was the vehicle that

1 they chose to use it. To use to do that. I think
2 because of chronologically it was there. It was
3 presented early on. So, we had a party. The
4 patent owner said, hey, I want to file a motion to
5 amend and then we said, okay, we're going to issue
6 an order providing guidance to the parties on
7 what, you know, what you should prove and,
8 petitioner, what you should do, you know, to
9 oppose the motion.

10 And then that order was drafted and it
11 -- I had -- I personally had no idea that it was
12 going to be a big deal. That is was going to have
13 six judges or that it was going to be some big
14 deal. And next thing I know, it was entered in
15 the case with all six of them on there -- with all
16 six of us on there. And then it became this
17 guiding decision for people to follow when they
18 wanted to file motions to amend and for the Board
19 to follow when they wanted to decide a motion to
20 amend.

21 JUDGE NIEDRICK: Right. So, but the
22 order itself wasn't some sort of decision on the

1 merits in the case. The order itself was just
2 simply guidance on how to handle this type of
3 motion.

4 THE WITNESS: Correct. And my
5 understanding it was guidance for that case and
6 that case only. It was for --

7 JUDGE NIEDRICK: And so, for purposes of
8 the parties in seeing that they knew who would be
9 -- or they at least thought, I guess, who would on
10 the panel because the notice of the six judges,
11 they were notified at that point before any
12 decision on the merits of the issues were
13 addressed by the panel. They knew who the panel
14 was because the panel issued the guidance saying
15 here's what we want. Is that correct?

16 THE WITNESS: Not exactly. I would have
17 to look at the docket. But I think after this
18 order went out with six judges, okay, once that
19 goes out, they knew that six judges signed onto
20 this, right? Then I think there were more orders
21 after that. You know, like any things that come
22 up. There definitely was at least one order that

1 set the hearing, right? And that order was only
2 had three judges on it. So, by the time like as
3 the case progresses, they then become under the
4 impression that it's back to the original three
5 judges that are presiding over their case. Did
6 that answer your question?

7 JUDGE NIEDRICK: Yeah, I think so. Mr.
8 Horrigan, you can go ahead and move forward.

9 BY MR. HERRIGAN:

10 Q Okay. And so, none of the parties in
11 the Idle Free complained about that, right?

12 A Not to my knowledge.

13 Q Okay. And you actually did not complain
14 about it either, right?

15 A I complained about the decision
16 internally early on after it went out.

17 Q Okay. All right. But you did not file
18 a concurrence with that decision, right?

19 A I did not. At the time that it went
20 out, I had -- I thought I was providing guidance
21 to the parties before me. I didn't know that this
22 was going to become the bible for the next decade

1 on motions to amend. And I was led to believe
2 that because the case was never -- PTAB has a
3 system to designate decisions and orders as
4 precedential and it chose not to. It didn't. But
5 it was being treated like that. And as the cases
6 evolved, I came to know that it was wrongly
7 decided. And I internally shared that with my
8 colleagues at meetings long before I wrote my
9 concurring opinion in Nike.

10 Q Well, it wasn't designated as
11 precedential, but it was designated as
12 informative, wasn't it?

13 A Correct, it was not designated as
14 precedential and it was designated as informative.

15 Q Okay. And then I think to the
16 Administrative Judge's point, I would refer you to
17 tab 32, page 253, if you have that.

18 A I'll let you know when I do, but I think
19 I a cue as to if it's in my binder or not.

20 JUDGE NIEDRICK: Mr. Horrigan, what page
21 was it? Tab 32, what?

22 MR. HARRIGAN: Two fifty-three.

1 JUDGE NIEDRICK: Thank you.

2 MR. HERRIGAN: Mr. Fitzpatrick --

3 JUDGE NIEDRICK: And Mr. Abramic, this
4 is -- it looks like the decision from Idle Free.

5 MR. ABRAMIC: I do not believe that's in
6 his binder.

7 BY MR. HERRIGAN:

8 Q All right. Well, I will show it to you
9 briefly but we don't need to spend much time on
10 it. So, this is what you've been referring to,
11 Mr. Fitzpatrick?

12 A This is what we -- this is the Idle Free
13 order that we've been talking about.

14 Q That says, Decision Motion to Amend
15 Claims.

16 A Correct.

17 Q Okay. That's all I have for that
18 document.

19 JUDGE NIEDRICK: Is that part of the
20 record already?

21 MR. HERRIGAN: It has not been moved
22 into evidence yet.

1 JUDGE NIEDRICK: Okay. Did you want to
2 or? It's totally up to you.

3 MR. HERRIGAN: I have a witness for it,
4 but if you'd like to it now, that's fine with me.

5 JUDGE NIEDRICK: Sure, any objection to
6 that coming in, Mr. Abramic?

7 MR. ABRAMIC: I guess I'd just like to
8 make sure that the Judge is able to see the whole
9 document and agree that that's the decision.
10 Unless -- if the --

11 JUDGE NIEDRICK: Okay.

12 MR. ABRAMIC: -- witness is comfortable
13 --

14 THE WITNESS: The first page looked --
15 the first page looked right, but I don't know
16 about the other pages, so.

17 MR. ABRAMIC: I highly doubt there would
18 be an objection, but all I saw was the first page
19 and I could try to track down the document here
20 somehow.

21 JUDGE NIEDRICK: Yeah, I don't know how
22 to give him time to actually sort of review it in

1 any meaningful way. It is let's see -- what's the
2 scope of that document, Mr. Horrigan?

3 MR. HERRIGAN: It goes from 265 to 293,
4 I believe.

5 JUDGE NIEDRICK: Yeah, I mean, I could
6 scroll through it for you really quick if you want
7 to look at, Judge Fitzpatrick, but.

8 THE WITNESS: That would be great, Your
9 Honor.

10 JUDGE NIEDRICK: Okay. Let me pull it
11 up.

12 THE WITNESS: Thank you. Actually,
13 given the page numbers you just said, it sounds
14 like it's too long from my memory.

15 JUDGE NIEDRICK: So, let me just get to
16 the beginning of it. This is where it started,
17 right, 253 is that correct?

18 THE WITNESS: Yeah.

19 JUDGE NIEDRICK: Mr. Horrigan?

20 THE WITNESS: That first page --

21 MR. HERRIGAN: I'm checking.

22 JUDGE NIEDRICK: I'm sorry. You gave it

1 to me and then I flipped onto something else.

2 MR. HERRIGAN: I believe so. It's paper
3 26. Yeah, that's -- yes, that's the one.

4 JUDGE NIEDRICK: Okay, this one. Yes,
5 okay. So, it goes from here to -- just tell me if
6 I'm scrolling too fast.

7 THE WITNESS: Thank you. This is a good
8 pace.

9 JUDGE NIEDRICK: Okay.

10 MR. ABRAMIC: I've got a hard copy here,
11 Your Honor, I can give it -- I can hand -- I can
12 walk towards the witness and hand it to him if you
13 want me to.

14 JUDGE NIEDRICK: Yeah, why don't you do
15 that. Then he'd feel comfortable --

16 THE WITNESS: Thank you.

17 JUDGE NIEDRICK: -- making sure.

18 THE WITNESS: Okay. So, it's 253 and
19 it's -- and it goes to 264. And it is what I was
20 talking about. Although I do want to make a
21 clarification. I can't -- I didn't remember this.
22 But I think what happened is the patent owner

1 filed the motion to amend like one that we thought
2 was maybe it was just completely out of whack and
3 it, you know, it was a nonstarter. And then we
4 held a conference call and said, hey, this is what
5 we want to see in your motion to amend. So, in
6 this order, we actually do deny a motion to amend.
7 However, we provide guidance for the patent owner
8 to file -- to file a renewed motion to amend
9 claims, yeah.

10 So, I misspoke earlier when I said it
11 did not decide a motion to amend. I think it
12 decided a motion to amend but not on the merits.
13 It denied it and then provided guidance and told
14 the patent owner they could refile.

15 JUDGE NIEDRICK: Okay. Mr. Horrigan, is
16 it 253 to 264? Is that what you wanted to admit?
17 Because I know there's --

18 MR. HARRIGAN: Yes.

19 JUDGE NIEDRICK: -- paper 14 follows
20 starting on page 265. Did you also want to
21 introduce that?

22 MR. HARRIGAN: Correct. I'd intended to

1 have Mr. Boalick walk through all that. But
2 whatever you prefer.

3 JUDGE NIEDRICK: Okay. It doesn't
4 matter to me. Why don't we just go ahead. Let's
5 admit it all just so we have it in the record
6 since we're going to be using it later anyways.
7 Do you have that in front of you, Judge
8 Fitzpatrick?

9 THE WITNESS: Well, I have the one we
10 just talked about. That's dated June 11, 2013,
11 paper 26.

12 JUDGE NIEDRICK: Yeah.

13 THE WITNESS: The next one was it paper
14 14?

15 JUDGE NIEDRICK: Yeah. No, the next
16 one's January 31st, and it's paper 14.

17 THE WITNESS: Yes, pages 265 to 293.
18 This is in this -- I have that in front of me.

19 JUDGE NIEDRICK: Correct.

20 THE WITNESS: I have it in front of me,
21 yes.

22 MR. ABRAMIC: What he has right now is a

1 binder --

2 JUDGE NIEDRICK: I'm sorry, I don't know
3 if you can hear me. Everybody froze on my screen.

4 COURT REPORTER: Yes, I can hear you.

5 MR. HERRIGAN: Yeah.

6 JUDGE NIEDRICK: I'm sorry. I don't
7 know if you can hear me. I'm getting a message
8 saying I have an unstable internet connection here
9 in the office. Okay. Looks like we're back. I'm
10 sorry. I just heard you say at the end that you
11 were looking at through 293, Judge Fitzpatrick,
12 and then it froze on me.

13 THE WITNESS: Yeah, I was asking if I'm
14 supposed to turn to pages 265 to 293. It wasn't
15 clear to me.

16 JUDGE NIEDRICK: If you can, yes,
17 please. Take a look.

18 THE WITNESS: I'm there.

19 JUDGE NIEDRICK: Okay. And does that
20 look like that's the decision that you were part
21 of?

22 THE WITNESS: I was part of this. This

1 looks like it's the institution decision in this
2 same IPR. And that it predates. It's dated
3 January 31, 2013. It predates, and this makes
4 perfect sense, it predates the what's called the
5 Idle Free decision that's dated June 11, 2013.

6 JUDGE NIEDRICK: Okay. Mr. Abramic, any
7 objection to those coming in?

8 MR. ABRAMIC: No.

9 JUDGE NIEDRICK: Okay. Those are
10 admitted without objection.

11 MR. HERRIGAN: Okay. And just to be
12 clear, what we've admitted is the document on 265
13 to 293. And the document at 253 to 264. Is that
14 correct?

15 JUDGE NIEDRICK: That's correct.

16 MR. HERRIGAN: Okay, great. Thank you.
17 All right. So, I'd like to switch subjects. I'd
18 like to go to tab 7, page 434.

19 JUDGE NIEDRICK: How much more time do
20 you think you're going to need, Mr. Herrigan?

21 MR. HERRIGAN: Well, I said I thought it
22 was only going to be half an hour to begin with.

1 At least half an hour.

2 JUDGE NIEDRICK: Okay. Do you want to
3 just give Judge Kauffman a call or text or
4 something just letting him know it's probably
5 going to be another hour, Mr. Abramic?

6 THE WITNESS: Your Honor, may I -- I've
7 been the one -- I texted him.

8 JUDGE NIEDRICK: Oh, sure. Yeah, if you
9 need to go ahead and text him and just let him
10 know it's probably going to be closer to 3:00.

11 THE WITNESS: Okay.

12 JUDGE NIEDRICK: Yeah, we'll just give
13 you a second to do that.

14 THE WITNESS: Okay. I'm sorry. I'm
15 trying to get my -- you said around 3:00, eastern
16 time, right?

17 JUDGE NIEDRICK: Yes, yes. That's
18 correct. So, in another hour. It'll probably be
19 another hour for him to wait.

20 THE WITNESS: Okay. I have sent that to
21 him.

22 JUDGE NIEDRICK: Great, thank you.

1 Okay, Mr. Horrigan, please continue.

2 BY MR. HERRIGAN:

3 Q Sure. I was referring us to tab 7, page
4 434.

5 A I don't presently have that in front of
6 me. Can you describe the document?

7 Q Sure. It's -- just a second. Sure,
8 this is your concurring opinion. We're at the
9 beginning of the argument of about panel
10 expansion.

11 JUDGE NIEDRICK: I can share it with the
12 group if that'll be faster, Mr. Horrigan. Is it
13 something you can just --

14 MR. HERRIGAN: That's fine with me.

15 JUDGE NIEDRICK: Okay.

16 THE WITNESS: Can I just get
17 clarification on the numbers? What is the first
18 number? The first like well, it's tab something
19 at something.

20 JUDGE NIEDRICK: So, it's tab 7, at 434.
21 That's on the Board's record. It's tab 7, page
22 434, out of 1,077.

1 THE WITNESS: Okay. All right, I am
2 there.

3 MR. ABRAMIC: Are we -- I think he has
4 this document.

5 THE WITNESS: I do and it's the middle.
6 It's like in the middle of the decision, right,
7 Mr. Abramic?

8 JUDGE NIEDRICK: Yeah, it's Roman
9 Numeral IV, yes.

10 THE WITNESS: Yes, okay.

11 MR. ABRAMIC: It's your binder tab 43, I
12 believe.

13 THE WITNESS: Thank you. I have it.
14 And I'm on that page now.

15 BY MR. HERRIGAN:

16 Q Okay. And this is the beginning of your
17 argument about the panel expansion being illegal,
18 correct?

19 A This may be the beginning of my detailed
20 argument. But I'm -- no. So, like on page 426,
21 you know, I introduce that the panel expansion is
22 contrary to law.

1 Q Okay. And so, what do you think we're
2 looking at page 434?

3 A Did I say -- I meant to say page 426.

4 Q Right. I'm on 434. What are we looking
5 at there?

6 A Oh, okay. Well, you told me that -- you
7 asked if that was the beginning of my argument.
8 And I'm saying I don't think so. I think I start
9 talking about it being contrary to law before this
10 page.

11 Q And so, then the question that follows
12 was what are we looking at here?

13 A Okay. So, this is a section entitled,
14 expansion of the panel was not authorized by the
15 director.

16 Q Okay. Now, you refer to MPEP. You see
17 that?

18 A Yes.

19 Q What is that?

20 A That's the Manual of Patent Examining
21 Procedure.

22 Q And what do you understand that to be?

1 A I mean, it's pretty descriptive to me.
2 It's something the Patent Office puts out.
3 Examiners, patent examiners who review in the
4 first instance, patent applications, this is like
5 the bible for their job. They refer to this all
6 the time.

7 Q Okay. And the director's authority to
8 designate panels has been delegated to the chief
9 judge. That's what we see here?

10 A Director's authority under the 35 U.S.C.
11 6, Section 6. Yes, is designated to the chief
12 judge.

13 Q Okay. And then you're quoting, or
14 you're -- yeah, you're quoting the section from
15 MPEP 1002.02f, paragraph 3. You see that?

16 A Yes.

17 Q Okay.

18 A But also part of it above too. Not just
19 paragraph 3.

20 Q Okay. But I'm referring you though to
21 paragraph 3, okay. And you see that it follows
22 into page 435, correct?

1 A Correct.

2 Q Okay. And you've highlighted initially
3 and on request for reconsideration, correct?

4 A I've italicized it, yes.

5 Q And in your argument, you're trying the
6 distinction between those two things, right?

7 A No. Or --

8 Q No.

9 A -- maybe I do. But the italics -- I'm
10 sorry. The italics are I'm trying to draw
11 attention to that whole phrase.

12 Q Well, isn't your argument here that the
13 director did not delegate authority to expand the
14 panel in Nike because, in your opinion, it wasn't
15 initially or on request for consideration. Isn't
16 that your argument?

17 A Right. Right, it was --

18 Q Okay.

19 A -- neither of those. That's one of --
20 one of my arguments.

21 Q Great. And so, what's the authority for
22 your position that there's only two categories of

1 cases that are referred to here?

2 A What I quote.

3 Q What do you quote?

4 A The MPEP, which --

5 Q Okay. So --

6 A -- also cites --

7 Q But the --

8 A -- 35 U.S.C. 6.

9 Q The logic of your position is there's
10 the third category that was not delegated to the
11 chief judge, right?

12 A What? I don't know what you're talking
13 about.

14 Q So, you're saying that Nike wasn't
15 initially and it wasn't on request for
16 consideration, therefore, the authority to expand
17 the panel was not delegated by the director to the
18 chief judge. Isn't that your argument?

19 A It's one of my arguments. But the --

20 Q Okay. And so --

21 A -- only thing that was -- the only
22 designation of panels authority, the only power

1 that came from the director to the chief judge was
2 limited to situations where it was initially and
3 on request for reconsideration.

4 Q Great.

5 A But I think if the logic of my argument
6 implies that there is some third category, I would
7 disagree with that.

8 Q Okay. So, in this particular case,
9 Adidas had filed an IPR against a patent held by
10 Nike, right?

11 A I think those are the right parties. I
12 think that Nike's the patent owner and Adidas is
13 the petitioner.

14 Q And back in 2014, a three-judge panel,
15 including you had issued a decision, correct?

16 A Correct.

17 Q The Federal Circuit reversed and
18 remanded that in 2016, right?

19 A Correct -- no.

20 Q And so, in --

21 JUDGE NIEDRICK: They vacated it,
22 correct?

1 THE WITNESS: Vacated.

2 BY MR. HERRIGAN:

3 Q Vacated, sorry. And so, in 2016, Adidas
4 did not have an answer to its complaint, right?

5 A I'm sorry. Can you ask that last
6 question again?

7 Q In 2016, when they got the decision from
8 the Federal Circuit, Adidas still had no answer to
9 their initial request, right?

10 A What's their initial request?

11 Q Their IPR.

12 A They had an answer to their petition.
13 We instituted years earlier.

14 Q But on the merits of their IPR, they
15 still don't have a decision, did they?

16 A They did not have a final decision that
17 was not appealable.

18 Q And they didn't get one until 2018,
19 right?

20 A I don't know.

21 Q Well, they didn't have one in March
22 2018, did they?

1 A They did not. When I left the panel,
2 they did not have a final decision.

3 Q Okay. So, wasn't it still an initial
4 action?

5 A No.

6 Q Okay. And so, what case would you point
7 to that says that?

8 A So, first of all, the premise of your
9 question is erroneous. You just said initial -- I
10 think you said initial request, okay. There's
11 nothing in this MPEP or 35 U.S.C. 6 that talks
12 about initial request. It says it talks about
13 designation of members of the PTAB and it lists
14 the various proceedings. And it says initially
15 and on request for reconsideration. So, I was
16 designated -- whenever I was designated to be on
17 the Nike case, and my colleagues, I would consider
18 that the initial designation. And that is what
19 initially is referring to.

20 Q And so, after remand, it's no longer
21 initially, in your opinion?

22 A Initially is an adverb that's describing

1 designation of panel members.

2 Q And so, my question was when it's on
3 remand, and you're still contemplating it, isn't
4 it still initially?

5 A Isn't what initially? Initially, you're
6 trying to use this word initially, I'm just
7 telling you I'm looking at the MPEP. That's where
8 that word comes from. Any significance that I put
9 to the word initially, and I did in this opinion,
10 is its use. It's in reference to its use as an
11 adverb to describe, to modify the adjective -- I'm
12 sorry -- to modify the verb, designation. Or I'm
13 sorry, the full verb phrase to be grammatically
14 correct is designation -- wait.

15 JUDGE NIEDRICK: I think we need to move
16 on from this line of questioning, Mr. Horrigan.
17 We're not getting anywhere with this.

18 BY MR. HARRIGAN:

19 Q Mr. Fitzpatrick what is your legal
20 authority for that argument? Point to something.

21 A Okay. MPEP 1002.02f and 35 U.S.C. 6.

22 Q That's it. Okay. So, let me ask you to

1 go down to --

2 A Also, that -- I'm sorry. I'd like to
3 add one more authority and that is -- and
4 unfortunately I can't give you a specific cite of
5 the provision, but there is a provision in the
6 CFR. I think it's part 42 that applies to inter
7 partes review and it's about requests for
8 rehearing. And so, I would -- I would without
9 being able to reference that particular provision
10 by number, I would say that is what -- that is
11 what the rehearing is referring to in request for
12 reconsideration.

13 Q Maybe I could put it this way. In
14 2018 -- or 2016, when Mr. Ruschke expanded the
15 panel, was there affirmative law that told him
16 that was illegal?

17 A There is not a statute that specifically
18 addressed that, okay? Because quite frankly, you
19 know, this is a common law jurisdiction as we all
20 know. But there are -- the Chief Justice of the
21 Supreme Court is clearly uncomfortable with it.

22 Q Okay. And so, when you -- in the second

1 part of your argument, you argue that the director
2 doesn't have authority to expand panels too,
3 correct?

4 A Correct.

5 Q Okay. And you argue that In re Alappat
6 doesn't give that authority, right?

7 A I do. That's on the rebuttal, I think,
8 to maybe the Patent Office position. I don't know
9 if they were telling me internally that Alappat
10 supports them. But, I mean, I -- Alappat is not
11 the most significant thing there. As you could
12 see, the first paragraph is about statutes. And
13 also, a Supreme Court holding that says an agency
14 is but a creature of statute. Any and all
15 authority pursuant to which an agency may act
16 ultimately must be grounded in an express grant
17 from Congress. So, to me it wasn't dispositive
18 that there's not an express prohibition from
19 Congress for Boalick -- I'm sorry -- for Ruschke
20 for an expanded panel. To me what was significant
21 is that there was no express grant from Congress
22 for him to do it. In addition to --

1 Q What --

2 A -- the fact that it was consistent with
3 several other statutes and also Alappat.

4 Q What affirmative --

5 A And the --

6 Q -- law between -- pardon me?

7 A And the MPEP. I added, I'm sorry.

8 Q What affirmative law would you point to
9 between 2016 when the panel was expanded and 2018
10 when you were taken off of it, what affirmative
11 law would you point to to establish that Mr.
12 Ruschke did not have authority to expand that
13 panel under the director's authority?

14 A I think all of --

15 JUDGE NIEDRICK: I think we've been over
16 this again and again and again. I don't think we
17 need to revisit this. He's explained what the
18 authority is that he's relying on five different
19 times.

20 MR. HARRIGAN: But I asked -- I am
21 asking with respect to his argument Alappat, what
22 affirmative law would he point to to support his

1 position?

2 JUDGE NIEDRICK: Go ahead and answer,
3 Judge.

4 THE WITNESS: So, I, I mean, are you
5 asking if there's a statute by Congress that
6 refers to Alappat? Because, of course, there's
7 not.

8 BY MR. HORRIGAN:

9 Q All right. Just a couple of follow-up
10 questions. How often did management review happen
11 on your cases?

12 A I don't know but every time I had a
13 concurring opinion or dissenting opinion.

14 Q How often would that be?

15 A I don't know the answer to it. And
16 there would be two answers. There would answers
17 like whether I wanted to have those and then there
18 would be answers did they actually was I allowed
19 to file a concurring opinion or dissenting. It
20 would be two different numbers and I don't know.
21 It was --

22 Q Okay.

1 A -- by far minority of my cases.

2 Q Okay, great. That answers my question.
3 Thank you. Nothing further.

4 JUDGE NIEDRICK: Okay. Judge
5 Fitzpatrick, I have a few questions I just want to
6 kind of clear up in my own mind before I turn you
7 over to Mr. Abramic. You'd referenced I think you
8 said it was a 2017 meeting or some get together
9 where you heard from management officials that
10 either you comply with their guidance or you face
11 termination. Can you just give me some more
12 detail on what exactly happened there? Like give
13 me some context for it. Was it for a agency-wide
14 meeting? Was it a APJ meeting? How did that
15 transpire?

16 THE WITNESS: There was a lot of, I
17 guess, maybe grumblings about the heavy handedness
18 of management. And there were many judges that
19 were uncomfortable with how we were being told to
20 rule and the mechanisms for it that we were told
21 to rule. You know, that we needed to follow
22 internal rules and we can't -- and that we cannot

1 cite it. I mean, we're being told to follow
2 purported rules that aren't published and that
3 we're not allowed to cite. And there were some
4 grumblings and there were, you know, it became a
5 big issue I would say.

6 And management's response to it or at
7 least one of the responses to it was to have a
8 meeting. And this was just for judges is my
9 memory. I don't know if there was high security
10 that court staff could have joined. But the
11 meeting was for judges. And during that meeting,
12 we were told what you just stated a moment ago.
13 We were told that you need to follow guidance in
14 whatever form it comes from and comes in or you
15 risk being punished up to and including
16 termination.

17 And several judges asked questions. And
18 the way you typically you ask questions at these
19 meetings you would send them to this chat box and
20 it was a Webex usually was how these meetings were
21 going. And you would ask questions and another
22 judge who was helping to facilitate the meeting

1 might collate the questions and kind of lump them
2 together and group them together and ask
3 questions. But a lot of us were asking questions
4 and I could see it. Because some people asked the
5 publicly and some privately. So, the public ones
6 are showing up on my screen and I'm asking
7 questions too.

8 And the questions are trying to figure
9 out what they mean by guidance. What is the outer
10 boundary of guidance? And what do we do if we are
11 being told we have to follow the guidance and rule
12 a certain way but we can't cite it. How on earth
13 do we write that? Those were the kinds of
14 questions that were being raised.

15 In response, we were being told in no
16 uncertain terms, you can't cite internal guidance.
17 What they would call sometimes internal guidance
18 or confidential guidance. You can't cite it. And
19 it includes in terms of the mechanisms through
20 which it can be relayed, it includes, for example,
21 that meeting and other meetings. It also includes
22 emails and phone calls or in-person orders from

1 any management level judge above you. And that
2 was -- that was it. It was pretty shocking to
3 hear. That was what happened at that meeting.

4 JUDGE NIEDRICK: Okay. And was anything
5 ever reduced to writing? Was there an email that
6 followed from management summarizing things? Was
7 there an email from an APJ to everybody saying I
8 just want to put into writing what I was just --
9 what we were just told? Any follow-up in writing?

10 THE WITNESS: It's possible that other
11 people memorialized it. I remember
12 contemporaneously at the time receiving emails
13 from, you know, receiving emails or phone calls
14 afterwards talking about it with other judges like
15 I can't believe what we just heard. Things like
16 that. But nobody, to my knowledge, memorialized
17 it in like, you know, published it within the PTAB
18 like so I'm aware -- I'm not aware. And I
19 testified today they had slides that they
20 presented to us but they were not distributed.

21 JUDGE NIEDRICK: Okay. You talked about
22 sort of you cited these different authorities in

1 response to Mr. Horrigan's questions about why
2 you believed it was a violation of law. And
3 ultimately, it seems as though one of your
4 responses suggested that it was a violation of law
5 because the director was essentially exceeding his
6 scope under the authorities that you were citing.

7 THE WITNESS: Yes.

8 JUDGE NIEDRICK: So, is your position
9 that unless the authorities explicitly provided to
10 the director if he exceeds the scope of that, that
11 that's a violation of the statutes that provide
12 him with the scope? Does that make sense?

13 THE WITNESS: Well, it's, I mean, I read
14 -- that was a holding from the Supreme Court case
15 that one sentence about the -- where agencies are
16 creatures of statute. And they need to find an
17 express grant of authority to do whatever they do.
18 Now, of course, there's deference to agencies, of
19 course. And so, then when it comes to sometimes
20 there's enabling statutes that kind of let the
21 agencies do stuff within a certain range, okay?

22 So, but that is -- so what we have here

1 is a statute that says that the director, I
2 believe, 35 U.S.C. 6 says the director shall
3 designate at least three members of a panel to
4 hear a case, you know, or to conduct a case. I
5 would need -- if I had the statute in front of me
6 I could be more exact. But it commands the
7 director to designate these judges. I think the
8 only reasonable interpretation of that is to
9 designate them in a way that the party knows that
10 they are the panel members.

11 So, it's not just that there's a lack of
12 express consent for the director to have panel
13 expansion after a decision's already been decided,
14 but before he lets it go out or panel expansion
15 that is never notified to the parties. It's not
16 merely that there's not an express grant of
17 authority in the statute to support it, but it's
18 inconsistent with those statutes. And I explained
19 it, I think, pretty well in that concurring
20 opinion my legal views.

21 Since that time, I've only been more
22 convicted in that in my thinking -- my conviction

1 has been strengthened, I guess, should say. And
2 that is because of what's happened in Arthrex
3 because of what they held in Arthrex. And also,
4 the Government Accountability Office, which is an
5 -- or a creature of Congress seems to be -- I put
6 it in the record. There was a letter from two
7 members of Congress asking about these types of
8 things and implying that they would be
9 inconsistent with the American Invents Act.

10 So, there's -- I'm all over maybe the
11 place, but there's a lot of reasons. But I think
12 I explained most -- all the ones that existed at
13 the time, I explained well in my concurring
14 opinion, and I would add to it what happened in
15 Arthrex, and what is going on with the GAO.

16 JUDGE NIEDRICK: You'd mentioned that
17 when you were removed from the Nike three-judge
18 panel and Judge Daniels took your place, that he
19 ultimately was the sort of third member of the
20 panel after it was unexpanded. Were the parties
21 ever notified that you were being taken off the
22 panel and he was being placed on the panel prior

1 to the issuance of the decision from that panel?

2 THE WITNESS: Yes. And actually, that
3 makes what happened worse because it implies --
4 there was an order. I believe it was in September
5 of 2018, very shortly before that new panel ruled
6 finally. And I think the order went out in
7 Boalick's name, just Boalick, who wasn't on the
8 panel at the time because he had already taken
9 himself off -- or Ruschke had already taken him
10 off -- excuse me. He issued a one-judge order and
11 it said that Judge Daniels replaces Judge
12 Fitzpatrick. And it makes -- it made no mention
13 of the other moves with the panel.

14 So, it was kind of an omission -- what's
15 the saying -- it was a misrepresentation by
16 omission. I forget the saying. But, you know, it
17 was only -- it purported to describe what happened
18 to the panel's makeup, but it was very incomplete
19 because it didn't mention Boalick and Ruschke
20 being on the panel for almost two years and then
21 being removed. And in addition, my memory is that
22 order also gave, in my view at least, a false

1 reason for the delay in ruling.

2 JUDGE NIEDRICK: And is that normal when
3 -- I'd imagine on occasion, judges are replaced on
4 panels either because they get sick or they retire
5 or something happens. Is it normal for the Agency
6 to issue an order if a decision hasn't already
7 been issued saying we're replacing a judge with
8 another judge and letting the parties know who
9 that new judge is?

10 THE WITNESS: I don't think it's normal.
11 I think for sure it's not normal that it would be
12 from the vice chief judge when he's not even on
13 the case.

14 JUDGE NIEDRICK: Okay. So, if I'm a
15 litigant -- if I'm a litigant and I have a case
16 before a panel and there's three judges and I know
17 who they are, would it be normal for a decision to
18 be issued in my case, an order to be issued in my
19 case, where all of a sudden there's different
20 judges on there without me having been previously
21 notified that there was a change in the panel?

22 THE WITNESS: If it's only one judge

1 that's changed, I don't think that would be too
2 unusual. I don't know -- I've been out of these
3 AIAs for four years -- I don't know if like if
4 it's typical for an order to go out to say that we
5 replaced one of the judges with another judge. I
6 mean, it definitely happens. People go on medical
7 leave. They go on -- when they have children,
8 they go on leave. They retire. So, this does
9 happen when there's just, you know, completely
10 innocent reasons and it's just we're swapping one
11 judge in for another. I just don't know the
12 mechanics of it.

13 JUDGE NIEDRICK: Okay. And, you know,
14 not being in this area, not practicing in this
15 area, this all seems very peculiar to me to not
16 know who the judges are on the panel. And I can
17 think of a lot of, you know, a lot of reasons
18 there might even be conflict issues. Some reason
19 as a litigant, a party in the case, that I don't
20 want a certain judge on there. And so, if I know
21 who's on the panel, then I could at least file
22 something saying, hey, I don't want this judge on

1 there. There's a conflict. There's an interest
2 issue here that that judge may not be disclosing
3 to the Agency, but that I'm aware of and I want to
4 disclose it so that I'm sure that I can get a fair
5 --

6 THE WITNESS: Yeah.

7 JUDGE NIEDRICK: -- shake in my case.
8 And I just wonder with the idea of this panel
9 expansion and un-expansion what the position is of
10 the APJs with this going on? I mean, you'd
11 mentioned earlier that there were some grumblings
12 about the guidance. But what is the -- what is
13 your position or your understanding of sort of the
14 group of judges that work for the Agency, what's
15 their position on that? Is that something that
16 was sort of okay? Or was there a problem with it?
17 Did they feel that their autonomy, their decisions
18 were being, you know, unfairly manipulated? It's
19 just strange to me this whole process. So, I
20 wanted to know what the position of your judge
21 community was on this issue.

22 THE WITNESS: It's very hard to gauge

1 everybody. There's -- people are afraid to talk
2 about certain things. They're afraid to be open
3 about it. Sometimes -- I mean, judges have told
4 me that they, even with this GAO thing, the
5 Government Accountability Office is trying to
6 gather information and I've told judges if you
7 have any information, I mean, you should talk to
8 them. I have people saying I'm not talking to
9 them. No way. I said, you know, why not?
10 They're just I keep my head down and do my work
11 and, you know, I got to put my kids through
12 school. There's that kind of mentality.

13 With respect to the conflicts, it's a
14 total can of worms because nobody even talks about
15 that. So, if you have in addition to people being
16 possibly on the panel but the parties don't know
17 it, there's also the reviewing committees, you
18 know, as helpful as they may be, at times, I don't
19 think there's any conflict checking that's going
20 on to make sure that those judges who aren't
21 actually on the case, but who are, you know,
22 providing some input, that there's not a conflict.

1 And there's no way for the parties, of course, to
2 protect any conflicts of interest that they might
3 have because they don't know.

4 JUDGE NIEDRICK: Is the private bar, are
5 they aware of this issue of expansion and
6 un-expansion that you know of?

7 THE WITNESS: They've seen some
8 expansions because they've been public. As I
9 testified earlier, sometimes they've expanded
10 after a decision's gone out, they've expanded and
11 had the effect of packing the panel but in a
12 public way. So, the public knows that the panel
13 is packed and then they reverse, you know, the
14 decision on rehearing.

15 But the bar has no idea what happened
16 that there are secret panel expansion and
17 un-expansion and that there's internal guidance
18 that judges need to follow and they can't even
19 cite it. I mean, they're being told two different
20 things. So, like for example, there's with the
21 SAS guidance, there was guidance that was
22 published and that was, you know, available to the

1 public. And my concurring opinions were perfectly
2 consistent with that. But then there was the
3 internal guidance in the form of, you know, Judge
4 Weidenfeller saying, hey, remove your concurring
5 opinion. The director doesn't want you to write
6 that. So, they're saying two different things.
7 And the bar has no idea about what's going on.

8 JUDGE NIEDRICK: When Judge Weidenfeller
9 reassigned you or told you to take out the
10 decision and then ultimately you were reassigned,
11 did you have any idea that that was a possibility
12 that you could be reassigned if you refused to
13 take out the problematic language from your
14 concurring opinion? Did they tell you that in
15 advance? In other words, did they give you the
16 ultimatum, either you take it out or we're taking
17 you off these cases?

18 THE WITNESS: Not in that case. I have
19 been given ultimatums before. And because of the
20 risk of suffering the punishment that is in that
21 ultimatum, I have capitulated. But not on that
22 case. On that case, he asked me in an email. He

1 asked if the panel was amenable. He actually
2 asked Karl. But he asked about the whole panel if
3 you're amenable and I said no. We had no further
4 conversation about it. He didn't say, hey, well,
5 I don't like the tone of your decision or,
6 Michael, I know I asked you originally, but now
7 I'm telling you. So, you need to take it off. He
8 didn't do that. He just told Karl to mail the
9 decision without my opinion.

10 JUDGE NIEDRICK: And so, when you were
11 reassigned and taken off the panel, was that a
12 surprise to you? Did you think that could happen
13 or was that a total surprise?

14 THE WITNESS: It was not a total
15 surprise because we had this meeting where we were
16 told -- or these threats were made explicit to us.
17 I mean, and I don't know when this -- I think by
18 the time of the incident we were just talking
19 about with taking my concurring opinion out, I
20 think it was after Judge Kauffman told me that the
21 director was interested in terminating me. And if
22 it was after that, you know, if I could think of

1 that, I could for sure contemplate being removed
2 from the case.

3 JUDGE NIEDRICK: Okay. I think that's
4 all I have. Mr. Abramic?

5 REDIRECT EXAMINATION

6 BY MR. ABRAMIC:

7 Q Just a couple of very quick things.
8 When Mr. Horrigan was questioning you about the
9 Nike case after it came back on remand, and you
10 had made a statement about how the original panel
11 was ready to go with a decision and you said the
12 parties could have had their decision in the fall
13 of 2018. Did you mean that date 2018?

14 A I misspoke. Fall of 2016. I think it
15 was September 30, 2016.

16 Q Okay. Thank you. And then the only
17 other question is, as Judge Niedrick was just
18 asking you about whether or not you were surprised
19 that you were punished after kind of the incident
20 with Judge Weidenfeller telling you to remove your
21 SAS opinion, ultimately, do you think you would
22 have been punished if the Nike thing wasn't going

1 on and you were not essentially threatening to
2 expose the secret panel expansion?

3 A No.

4 MR. ABRAMIC: That's all I have, Your
5 Honor.

6 JUDGE NIEDRICK: Okay. Mr. Horrigan,
7 any follow-up from Mr. Abramic or myself?

8 MR. HERRIGAN: No. No thanks.

9 JUDGE NIEDRICK: Okay, great. All
10 right. Thank you for your testimony, Judge
11 Fitzpatrick. You can just sort of hang on. We'll
12 move on to the next witness. And I know we maybe
13 put Mr. Kauffman in a tough spot. If you want to
14 reach out to him, Judge Fitzpatrick, and ask him
15 if he's available now?

16 THE WITNESS: Yes. It might be most
17 efficient if I call him. Is that okay if I mute
18 myself and give him a call?

19 JUDGE NIEDRICK: Yeah, go ahead and mute
20 yourself --

21 THE WITNESS: All right.

22 JUDGE NIEDRICK: -- and then why don't

1 we -- let's see if he's available and then what
2 we'll do is we'll tell him we'll start at 2:45
3 with his testimony if he is.

4 THE WITNESS: Okay.

5 JUDGE NIEDRICK: So, if you can call him
6 and just I think we'll probably be okay. So, what
7 we can do is take a break until 2:45. When we
8 come back, we'll hear from Judge Kaufmann.

9 THE WITNESS: Sounds good.

10 JUDGE NIEDRICK: Okay, great. Let's go
11 off the record.

12 (Recess)

13 JUDGE NIEDRICK: All right, Judge
14 Kauffman, this is Administrative Judge Andrew
15 Niedrick. Can you hear me?

16 THE WITNESS: I can hear you.

17 JUDGE NIEDRICK: Okay, fantastic. Thank
18 you for appearing today. Just to kind of give you
19 a little idea who's on the call here. We have Mr.
20 Kappers, Mr. Abramic, and Mr. Suarez. They're
21 representing Judge Fitzpatrick. And then William
22 Horrigan is representing the Agency. And then we

1 have our court reporter, Ms. Dawson, okay?

2 So, do you have any objection to
3 swearing an oath?

4 THE WITNESS: Your Honor, the sound is
5 coming through my laptop. I'm going to try to
6 switch it to my headset because I think that'll
7 give us better quality sound.

8 JUDGE NIEDRICK: Sounds good. Just let
9 me know when you've done that. I could test it
10 for you if you'd like.

11 THE WITNESS: I'm not as familiar with
12 Zoom as I'd like to be.

13 JUDGE NIEDRICK: It sounds like you're
14 on your headset. Certainly, the microphone sounds
15 like it's on the headset. The sound is coming out
16 of your computer?

17 THE WITNESS: Okay.

18 JUDGE NIEDRICK: Yes, does it --

19 THE WITNESS: Is it working now? You
20 can hear me well enough?

21 JUDGE NIEDRICK: Yes, we can hear you
22 fine.

1 THE WITNESS: Thanks, Judge.

2 COURT REPORTER: Put him on the mute
3 button. The mute button is on the Zoom. You see
4 that little, tiny arrow?

5 THE WITNESS: I do.

6 COURT REPORTER: Go ahead and press that
7 and it will give you options to switch the system.

8 THE WITNESS: How about now?

9 JUDGE NIEDRICK: I think you're good.

10 COURT REPORTER: Yes.

11 JUDGE NIEDRICK: Are you -- yeah.

12 COURT REPORTER: I can hear you clearly
13 enough --

14 THE WITNESS: I can hear you.

15 COURT REPORTER: -- but can you hear us
16 clearly enough as well?

17 THE WITNESS: I can, thank you.

18 COURT REPORTER: Okay.

19 JUDGE NIEDRICK: Okay, great. Do you
20 have any objection to swearing an oath?

21 THE WITNESS: No, I do not.

22 JUDGE NIEDRICK: Okay. Can you please

1 raise your right hand?

2 Whereupon,

3 PHILLIP KAUFFMAN

4 was called as a witness and, having been first
5 duly sworn, was examined and testified as follows:

6 JUDGE NIEDRICK: Great, thank you very
7 much. And if you can please state and spell your
8 first and last names for the record.

9 THE WITNESS: Yes, sir. My first name
10 is Phillip, P-H-I-L-L-I-P. My last name is
11 Kauffman, K-A-U-F-F-M-A-N.

12 JUDGE NIEDRICK: Great. And as we
13 proceed, if there's an objection during your
14 testimony, please stop. I'll rule on the
15 objection and then instruct you on how to proceed,
16 okay?

17 THE WITNESS: Yes, sir.

18 JUDGE NIEDRICK: Okay. And Mr. Kappers
19 is going to do the examination and then followed
20 by Mr. Horrigan with some cross, okay? Mr.
21 Kappers, your witness.

22 DIRECT EXAMINATION

1 BY MR. KAPPERS:

2 Q Thank you, Your Honor. Good afternoon,
3 Judge Kauffman. My name is Robert Kappers and I
4 represent the appellant in this appeal, Judge
5 Fitzpatrick. Thank you for joining us today. Why
6 don't you start by telling us what you do for a
7 living.

8 A I'm an administrative patent judge at
9 the Patent and Trademark Office. I've been here
10 with the Agency since 2006 and at the Board since
11 2008.

12 Q Okay. And what type of matters have you
13 worked on as an APJ?

14 A I began with appeals. Shortly after we
15 started having trials, I worked predominantly
16 trials. I currently have a mixed docket, and I
17 have run training for the Board I think it's
18 pretty close to 10 years now.

19 Q And when did you move from doing AIA
20 trials to having a mixed docket?

21 A We had a patent attorney who was
22 struggling and doing appeals and they asked me to

1 help with that. And I want to say that was two
2 and a half years ago.

3 Q Okay. And why did you switch over to a
4 mixed docket?

5 A We had a judge who had sort of been
6 demoted to being a patent attorney and they were
7 sensitive to who would be the judges working with
8 him. And they put together a special panel to try
9 to help get him production up to speed and so,
10 that's when I picked up appeals cases.

11 Q And how do you know Judge Fitzpatrick?

12 A I don't remember exactly when, but a
13 number of years ago, I started a group where we
14 would meet every week or every other week and we
15 would discuss cases. What had come out from the
16 circuit, how we were analyzing something we had
17 seen, that type of stuff. One of the folks at
18 that meeting said can we invite Mike Fitzpatrick
19 and we did. And that's how I came to know him.

20 Q Okay. And have you had any other
21 involvement with Judge Fitzpatrick other than this
22 discussion group?

1 A No. I mean, I think I should tell you I
2 was very impressed by his judicial philosophy, how
3 he thought through cases, how he resolved cases.
4 I thought that he was a good judge and that kind
5 of colored what we'll get to here in a little
6 while.

7 Q How about committees? Have you ever
8 served on a committee with Judge Fitzpatrick?

9 A Yes. I run the Training Committee and
10 he is a member of the Training Committee.

11 Q And describe your work with Judge
12 Fitzpatrick on the Training Committee.

13 A When I give a topic to Mike, he does a
14 really good job with it. I gave him the objective
15 indicia because it's a difficult topic and he did
16 a very nice job with that. So, I've been grateful
17 to have his help.

18 Q So, would it be fair to say overall you
19 have a positive impression of Judge Fitzpatrick?

20 A Yes.

21 Q Has your impression of Judge Fitzpatrick
22 changed since he's been removed from AIA trials?

1 A Maybe we're getting ahead here. But
2 when I heard about Mike and him maybe they were
3 talking about what consequences he would get for
4 being pulled off the case, that's when I asked him
5 if he would be on Training Committee because I
6 thought that this would improve the situation,
7 give him a chance to show that he's a good judge
8 and he's doing more than just cases. That this
9 was something extra for him to do to improve the
10 situation.

11 MR. KAPPERS: Okay. Your Honor, could I
12 show Judge Kauffman an exhibit?

13 JUDGE NIEDRICK: Sure.

14 MR. KAPPERS: Okay.

15 JUDGE NIEDRICK: Can you just tell us
16 for the record what exhibit?

17 BY MR. KAPPERS:

18 Q Sure. I'd like to show you what's
19 Appellant's Exhibit D-e, and it's tab 5, at page
20 333 of 340. Judge Kauffman, can you see the
21 document on your Zoom screen?

22 A I can see the document, exhibit. Looks

1 like ZZ-5.

2 Q Okay. And do you recognize this letter?

3 A I haven't seen it or thought about for a
4 long time, but, yes.

5 Q Okay. And what is it?

6 A It's a letter I wrote about Mike's
7 situation.

8 Q Okay. And why did you write it?

9 A You know, Mr. Kappers, I don't remember
10 if I was asked as part of this investigation or
11 why I wrote this letter. I don't remember what
12 initiated it.

13 Q Well, you made some positive statements
14 about Judge Fitzpatrick in this letter. Is that
15 fair?

16 A Yes.

17 Q Do you stand by what you wrote in this
18 letter?

19 A I do.

20 Q Okay. Judge Kauffman, I'd like to talk
21 to you about your time when you were presiding
22 over AIA trials exclusively. Does PTAB management

1 have oversight of the panels that are presiding
2 over IPRs?

3 A Yes, they do.

4 Q Can you describe that oversight for the
5 Board?

6 A I can give you a specific example that's
7 maybe what you're looking for. I was on a panel
8 where we were faced with a decision about joinder
9 and the decision of my panel was to not allow
10 joinder. At the time the agency was in litigation
11 over whether or not you may join a party to
12 themselves, and management's position was you may;
13 and the decision I wrote said you may not, you
14 can't join a party to themselves. Later in the
15 Windy City decision the Federal Circuit agreed
16 with that and said you cannot join a party to
17 itself; so, the decision the way it was written
18 ended up being the way the Federal Circuit came
19 out. Management called us in and said we just
20 can't have a decision go out the door written the
21 way this is when we've taken the opposite position
22 in litigation, and because one of the panel

1 members was willing to deny joinder on the merits,
2 as was I, we could not change the outcome but
3 change the reasoning, and management said they
4 would allow it to go out the door that way. In
5 retrospect I did not like doing that, but you have
6 to understand in March of 2018 Department of
7 Justice came in to give us training about the
8 Administrative Procedure Act and I set that up
9 because I run training. In that briefing they
10 told us their position about what the
11 Administrative Procedure Act requires and
12 afterwards an employment law attorney spoke, and
13 that attorney said "If the director's powers
14 include the powers to change the decision of a
15 panel, that is his prerogative as policy and if
16 you do not follow that policy you will be fired";
17 and I have to tell you I was a judge advocate in
18 the Air Force, I retired after 20 years, I
19 represented decision making authorities many
20 times, and I was very sensitive to the way that
21 was worded because I would never have allowed a
22 decision making authority, or the person speaking

1 on their behalf, to say something that indicated
2 they had pre-decided the case, right. I mean, he
3 didn't say "you might be fired", this employment
4 law attorney said "you will be fired if you don't
5 follow the director's policy"; and so, when we
6 were called in we felt like we didn't have any
7 choice but to change the reasoning of our case.

8 Q So, this meeting, you said it occurred
9 in 2018; is that right?

10 A That's right, that's when Department of
11 Justice spoke to us.

12 Q Okay, and who else attended the meeting?

13 A The judges were there -- to training, we
14 typically invite judges -- the patent attorneys
15 which are essentially the equivalent of clerks in
16 the district court system and other court systems,
17 and detailees. I think for this event -- and I'm
18 not positive -- but I think for this event we
19 only had judges. Sometimes the chief judge will
20 ask me just to invite them rather than including
21 patent attorneys. There's a variety of reasons
22 for that; our patent attorneys are Union members

1 for one thing and sometimes it's the intended
2 audience's judges. I think it was just judges.

3 Q And what was your reaction when it was
4 communicated to you that you would be fired if you
5 did not follow this guidance?

6 A This has been an important topic to me
7 for a long time. In 2013 the Federal Circuit
8 decided the Nidek case -- which I can give you the
9 cite to if you want that -- it's 863 F3d 1013 Fed
10 Circuit 2013. In that case it was a unanimous
11 decision, but two of the three circuit judges took
12 the time to write a separate concurrence where
13 they said that they had serious questions about
14 whether a panel member could be selected with an
15 outcome in mind; and this was all dicta, but they
16 made it a precedential decision which requires not
17 just the panel, it's the circuit as a whole has to
18 decide whether it's going to precedential. So, I
19 felt like the circuit saying to us they have
20 serious concerns about picking a panel member with
21 an outcome in mind was a huge warning to me that
22 that was behavior that should not be done and I

1 can't think of a legal distinction between picking
2 a panel member with an outcome in mind and telling
3 a panel member what to do; I just don't see a
4 difference between that. So, I've always thought
5 that management and their steering of cases and
6 outcomes is an Administrative Procedure Act
7 problem.

8 Q Other than yourself, do you know of any
9 other APJ's that shared your views from that
10 presentation where a threat was communicated?

11 A I do know plenty of APJ's that think
12 that it violates the APA to steer a panel, and I
13 haven't given you all the reasons for that, but
14 there are certainly more. Do I know of anyone
15 else that noticed that the labor attorney said
16 "you will be fired"? I haven't talked to anybody
17 about that because I've done that kind of work
18 before, I'm probably more sensitive to that than
19 most people, but I haven't talked to anyone about
20 that; other than I spoke to Jackie Bonilla about
21 it recently.

22 Q Can you describe that communication with

1 Judge Bonilla?

2 A I have told --

3 MR. HERRIGAN: Objection; relevance,
4 hearsay.

5 JUDGE NIEDRICK: What's the relevance of
6 that, Mr. Kappers?

7 MR. KAPPERS: I think it goes to the
8 knowledge of the PTAB management of other APJ's
9 reasonable belief that what was occurring was
10 illegal, that it violated the APA, it violated due
11 process.

12 JUDGE NIEDRICK: Remind me of Judge
13 Bonilla's position, was she a management official?

14 THE WITNESS: Yes, Judge Bonilla is the
15 number two in charge of the Board.

16 JUDGE NIEDRICK: Okay. I'm going to
17 overrule the objection. Please answer.

18 THE WITNESS: Just a couple of weeks ago
19 we were at a meeting and Judge Bonilla brought up
20 that what management tells people and management
21 review is a suggestion, and I said to Judge
22 Bonilla "How can we say that that was a suggestion

1 when we had a labor tele attorney tell people they
2 will be fired -- not might be -- will be fired if
3 they don't follow policy?"; and she said that was
4 a matter that they were considering. I have
5 spoken to her about that on previous occasions, I
6 have spoken to other members of management about
7 that on previous occasions.

8 BY MR. KAPPERS:

9 Q Were other members of management present
10 when you had that discussion with Judge Bonilla?

11 A It was Vice Chief Haapala's division
12 meeting, so Judge Haapala was there and the other
13 members of her division.

14 Q I want to go back just briefly to the
15 Nidek case. Do you recall the other party to that
16 appeal?

17 A No, I don't remember who the other party
18 was in that.

19 Q Does a party by the name of Zongshen
20 ring a bell?

21 A No, I'm sorry it doesn't.

22 Q And what was your recollection of the

1 arguments made to the Federal Circuit by Nidek in
2 that appeal?

3 MR. HERRIGAN: Objection, relevance.

4 JUDGE NIEDRICK: What's the basis for
5 the question -- relevance?

6 MR. KAPPERS: This goes to -- again --
7 the Judge Fitzpatrick's reasonable belief that the
8 expansion of panels at the PTAB was illegal.

9 JUDGE NIEDRICK: Okay, overruled.
10 Please answer the question, Judge Kauffman.

11 THE WITNESS: So, when we have a case --
12 a PTAB case -- that's appealed to the Federal
13 Circuit, the representation is done by the
14 Solicitor's Office and not our office, it's done
15 in conjunction with our management. In addition
16 to running training, I'm a section lead as a
17 fill-in; I'm doing that now, but that's typically
18 what we call executive committee; it's not section
19 lead judges, it's management at the second level;
20 and I was not involved in discussions about how
21 they were defending the Nidek case.

22 BY MR. KAPPERS:

1 Q Do you recall the arguments made by
2 Nidek itself?

3 MR. HERRIGAN: Objection, relevance.

4 JUDGE NIEDRICK: I'm going to sustain
5 the objection at this point.

6 BY MR. KAPPERS:

7 Q Judge Kauffman, you mentioned concerns
8 with the APA, are there at times concerns for the
9 due process rights of parties as a result of PTAB
10 management intervention?

11 A I think so. For me, Section 6 of Title
12 35 says that decisions are made by panels
13 appointed by the director, and that very strongly
14 implies for me that if you're not appointed to the
15 panel, you can't make that decision. That also,
16 for me, makes a lot of logical sense if we say
17 Smith, Brown and Jones decided this case, but
18 really they just did what management told them; I
19 don't see how that can be due process for the
20 parties. I think it's a problem under 35 USC 6
21 and it's a problem under the APA. I also think
22 that the Administrative Procedure Act requires

1 that the parties know the procedures being used to
2 decide their case. There was -- at the time -- to
3 my knowledge -- no written procedure for
4 management review, no criteria for which cases
5 would be reviewed. That to me is -- I can't
6 understand how that's not arbitrary, if you don't
7 have a set policy and in addition the parties are
8 supposed to know that policy. I want to write a
9 decision on my case that tells the story on
10 appeal; I have to tell that story or it's not a
11 meaningful appeal for the Federal Circuit. If
12 there's things happening that are reasons for
13 deciding a case that are not in that decision, I
14 think that that's a due process problem.

15 COURT REPORTER: Mr. Kauffman, is there
16 someone else in the room with you?

17 THE WITNESS: No, that noise is not
18 coming from here.

19 BY MR. KAPPERS:

20 Q Has management ever identified to you
21 what they believe is the legal authority for their
22 exercise of control?

1 A I heard many times that the director had
2 the power to do this under 35 USC 3 as a matter of
3 policy and the director's desire to have
4 consistent policy -- which of course you can't
5 argue with -- of course you'd love the agency to
6 be consistent -- but for me, there is a lot of
7 problems with that approach. First of all, if you
8 look at Arthrex, nothing in Arthrex says "Oh, the
9 director had the power under Title 35 Section 3 to
10 hear that"; they said "No, the director didn't
11 have that authority to review. In fact, we were
12 principal officers prior to that time and so it
13 should've been just the decision of the APJ's that
14 were appointed to the panel and no one else". So,
15 that didn't make sense to me that it would be part
16 of policy. I think it also has rule making
17 concerns. I don't know of another agency where
18 the head of an agency decides a case based on only
19 policy as his legal authority for doing that. I
20 think you'll find that other agencies -- there's a
21 specific statutory provision that says that the
22 head of that agency can make a decision. For me,

1 there's a case called Utica Packing versus Block
2 and it's not precedent -- it's from the 6th
3 Circuit, it's 781 F.2d 71 -- but in that case the
4 head of an agency picked a judge for their
5 judicial body with an outcome in mind, and the
6 court said "Director, you have the authority to
7 take your case, put your name on it and decide
8 whatever you want, but you cannot tell one of your
9 judges what to do"; and for me, I know that's not
10 precedent, but that's exactly the legal principle
11 that's involved here.

12 Q When PTAB management tells its judges
13 what to do, are APJ's allowed to cite that
14 instruction or guidance in their decisions?

15 A I have heard several times people were
16 told not to put what management considers inside
17 baseball discussions and decisions.

18 Q Has that ever happened to you?

19 A When they changed the reasoning in our
20 case they didn't specifically say to us "and you
21 may not say that the reasoning was changed by
22 management", but I believe that to be the case,

1 that I could not have said that.

2 Q Judge Kauffman, you're aware that Judge
3 Fitzpatrick was removed from AIA trials, is that
4 right?

5 A Right, yes I am.

6 Q Okay. And before he was removed from
7 AIA trials, did you communicate with Judge
8 Fitzpatrick about the risk of him being
9 terminated?

10 A I'm not sure this is directly responsive
11 to your question, but in a discussion with a
12 member of the executive management team I was told
13 that the director wanted to fire Mike, but that it
14 looked like PTAB management -- Board management --
15 was going to be able to talk him down from that
16 position; and I called Mike and I told him that --
17 my goal being -- I was hoping he would see --
18 "Hey, you're probably not going to be fired, hang
19 in there" and that's when I asked him if he would
20 be willing to be on training team. I was -- for
21 me -- it seemed like management was steering a
22 case when they shouldn't be and then removing a

1 judge for not following that policy, and I was
2 trying to make that situation better by getting
3 him to hang in there and then maybe over time he
4 could be put back on trials.

5 Q And who was the management official that
6 communicated that to you?

7 A I would really rather not say who that
8 was because that person -- it might be a costly
9 thing for them to have told me that.

10 Q Was it Janet Gongola?

11 A I'd really rather not answer that
12 question. For me, because that came shortly after
13 the employment law attorney at the DOJ training
14 saying "you will be fired", I completely believed
15 it and that's why I conveyed it to Mike.

16 Q Okay. Let's put a pin that. You
17 mentioned -- I think you mentioned -- Michael's
18 position, what were you referring to when you said
19 that?

20 A I'm not sure I remember what context
21 that was in.

22 Q I think you said something along the

1 lines of PTAB management wanted Michael to change
2 his position --

3 A Oh, that's probably --

4 Q -- What's your understanding --

5 A -- I'm sorry. That's probably poorly
6 worded. They were changing his docket from
7 working on trial cases to working on appeal cases.
8 Management has moved people from trials to appeals
9 in the past, it's kind of an informal firing at
10 times when they do that.

11 Q Okay. So, we won't name the official
12 now, but when was this communication with PTAB
13 management about Director Iancu wanting
14 Fitzpatrick terminated?

15 A So, I don't have an email, a phone
16 record, anything to give me an exact date and it's
17 like about four years ago; but it was a few months
18 after the March 2018 presentation from DOJ, maybe
19 May/June, somewhere around there of 2018.

20 Q Did this management official identify
21 any other members of management that were present
22 when Director Iancu suggested that he wanted to

1 terminate Judge Fitzpatrick?

2 A No, but I will say that the context it
3 was in seemed like it was an executive team
4 discussion -- I assumed that -- meaning the other
5 members of the executive team.

6 Q And at the time in May or June 2018, who
7 were those members?

8 A It would've been Mike Tierney, Scott
9 Weidenfeller, Scott Bullock, Jackie Bonilla, Janet
10 Gongola, Mike Tierney; I don't remember when Mike
11 Kim joined that group, but he may have been a
12 member as well already. Kal Deshpande was acting
13 and filling in a lot of the time and may have been
14 acting then, but he wasn't officially a member.

15 Q How about Chief Judge Ruschke?

16 A Yes, of course he was.

17 MR. KAPPERS: Your Honor, obviously
18 there's a very sensitive issue here in which we
19 want to be respectful. Could we have maybe five
20 minutes to caucus with our team?

21 JUDGE NIEDRICK: Yes, you can. We'll go
22 ahead and take a quick five minute break. It's

1 about 3:18, we'll come back at 3:23; so, I'm just
2 going to stay on. We can go off the record for
3 five minutes, Ms. Dawson please.

4 (Recess)

5 JUDGE NIEDRICK: We are going to
6 continue with Judge Kauffman's testimony. Mr.
7 Kappers, you may continue. Judge Kauffman, you're
8 still under oath.

9 THE WITNESS: Yes, sir.

10 MR. KAPPERS: Thank you, I have no
11 further questions at this time. I will pass the
12 witness.

13 JUDGE NIEDRICK: Okay. Mr. Horrigan,
14 your witness.

15 COURT REPORTER: Mr. Horrigan, we can't
16 hear you.

17 MR. HORRIGAN: Oh, my apologies, I'm
18 sorry.

19 JUDGE NIEDRICK: There you go.

20 CROSS-EXAMINATION

21 BY MR. HORRIGAN:

22 Q Mr. Kauffman, earlier today we were told

1 that you had identified Janet Gongola as the
2 person who told you this information, is that
3 correct?

4 A Yes, that is correct.

5 Q Okay. And so, you said you didn't know
6 precisely when this happened, but when roughly did
7 it happen?

8 A What I said before was it was a couple
9 months after the briefing from DOJ, probably in
10 May or June of 2018.

11 Q Okay; and this is clear in your mind,
12 this conversation with Ms. Gongola?

13 A The when is not clear, but the content
14 is clear.

15 Q Okay. And what precisely did she say?

16 A That the director wanted to fire Mike,
17 but it looked like PTAB management was going to be
18 able to steer him away from that.

19 Q Did she quote Mr. Iancu, or how did it
20 come about?

21 A She did not quote Mr. Iancu, she was
22 just conveying what he meant.

1 Q Okay. As closely as you can, tell us
2 what exactly she told you.

3 A I really can't add any more detail than
4 that. She said he -- I have a little bit of
5 detail -- she said he was very angry and that he
6 wanted to fire Mike Fitzpatrick, but it looked
7 like PTAB management was going to be able to steer
8 him away from that.

9 Q And did you understand what the context
10 for this statement was; who was there, why were
11 they there, that sort of thing?

12 A I assumed that it was the executive
13 management because that's who normally debates
14 issues for PTAB.

15 Q Okay. And you're sure it was -- like --
16 a direction rather than sort of a question; you
17 sure about that?

18 A She did not say that Director Iancu
19 asked if it was possible for him to fire him, she
20 indicated that that was his desire; which for me
21 is consistent with what was said back in March.

22 Q Okay. Now, I --

1 MR. ABRAMIC: We lost audio here.

2 JUDGE NIEDRICK: We can hear you. Can
3 you hear me, Mr. Abramic? Mr. Abramic, can you
4 hear me? Mr. Kappers, are you able to hear? It
5 looks like there may be some internet issues
6 because everybody's --

7 COURT REPORTER: Is Michael Fitzpatrick
8 frozen?

9 JUDGE NIEDRICK: It looks like they're
10 screen's freezing.

11 COURT REPORTER: They're all in the same
12 office, is that correct, Your Honor?

13 JUDGE NIEDRICK: Judge Fitzpatrick, can
14 you hear me? It doesn't look like they're on
15 here.

16 COURT REPORTER: Yeah, should we go off
17 the record?

18 JUDGE NIEDRICK: I can hear you, Mr.
19 Abramic. Can you hear me, this is Judge Niedrick?

20 MR. ABRAMIC: Yeah, something happened
21 with Mr. Kappers' computer, which is the only one
22 that we were getting audio from because we wanted

1 to not have feedback. So, we haven't heard the
2 last few minutes. So, he is going to step to my
3 computer because mine appears to be working.

4 JUDGE NIEDRICK: Okay, that sounds good.

5 MR. ABRAMIC: But we might have to go
6 back to a previous question.

7 JUDGE NIEDRICK: Okay, I'm not sure --
8 Mr. Kappers, if you could sort of tell us what the
9 last thing that you heard -- did you hear the
10 questions about the meeting and who was in it?

11 MR. KAPPERS: We heard that question and
12 the answer was to the extent that he remembered it
13 was the executive committee --

14 JUDGE NIEDRICK: Yes.

15 MR. KAPPERS: -- That was about where it
16 started to cutoff.

17 JUDGE NIEDRICK: Okay. Mr. Horrigan,
18 can you backtrack and add anything you want up to
19 that point -- past that point?

20 MR. HARRIGAN: So, as I recall, I just
21 asked the context -- what he understood the
22 context -- for the statement was. Why don't you

1 go ahead and answer that again, Mr. Kauffman?

2 THE WITNESS: I don't remember how Mike
3 came up in my discussion, but she said that the
4 director was very angry and that he wanted to fire
5 Mike, but it looked like PTAB management was going
6 to be able to steer him away from that -- to steer
7 the director away from that action.

8 BY MR. HERRIGAN:

9 Q Sure, and my question was the context in
10 which Ms. Gongola got that information. What is
11 your understanding of how she came across that
12 information?

13 A I assume -- she did not say -- I assume
14 that she was in those discussions at the PTAB
15 management level.

16 Q And do you have any idea why Mr.
17 Fitzpatrick's name would have come up?

18 A In my discussion with Ms. Gongola?

19 Q Correct.

20 A She was, at the time, my boss and it was
21 probably a weekly meeting where we were going over
22 the things that are in work and for whatever

1 reason Mike's name came up.

2 Q Did Ms. Gongola have any oversight of
3 Mr. Fitzpatrick?

4 A No, but common practice is -- from what
5 I hear secondhand -- that my executive committee
6 -- when there are personnel decisions like that --
7 they discuss that as a group, those kinds of
8 things. So, even if Mike was not in her direct
9 chain, it would probably be likely she'd be in on
10 discussions.

11 Q She was sharing personal information
12 about another employee with you?

13 A Yes.

14 Q Okay. Now, I mentioned to you that the
15 attorneys this morning told us about a
16 conversation between you and Mr. Fitzpatrick; is
17 that right?

18 A Yes.

19 Q And when did that happen?

20 A That was in probably May or June --
21 shortly after the conversation with Janet Gongola
22 -- of 2018.

1 Q Oh, I'm sorry; so, I meant recently.

2 A Oh, I have not had a discussion with
3 Janet recently. I had a discussion with Jackie
4 Bonilla recently about management review of cases,
5 not about Mike Fitzpatrick.

6 Q Yes, sir. What I'm trying to get an
7 understanding of is, do you agree that you had a
8 conversation with Mr. Fitzpatrick in which you
9 named Ms. Gongola?

10 A No. At the time I called Mike, my
11 intention was not to say who said that, I did not
12 tell Mike at that time that I heard it from Janet
13 Gongola; I just told him I heard this from
14 management. I was trying to balance here fixing
15 what I thought was an improper situation by giving
16 him a chance at maybe proving himself more on
17 training committee.

18 Q Sure, I understand that part, but I'm
19 trying to focus you on the last few days; have you
20 had a conversation with Mr. Fitzpatrick about
21 this?

22 A Yes.

1 Q In which you named Ms. Gongola as the
2 person who said this?

3 A Yes.

4 Q Okay. And do you recall speaking with
5 me early last week?

6 A I do.

7 Q And do you recall refusing to provide
8 that name to me?

9 A I did say I'd prefer not to answer that,
10 yes; I was not expecting this to come out here.

11 Q Now, do you have some reason to believe
12 that Ms. Gongola doesn't want you to identify
13 her?

14 A Yes.

15 Q And what's that?

16 A What you implied earlier, she was
17 talking about a personnel action; Mike didn't work
18 for me at the time, there wasn't really a -- you
19 know -- I think folks could be unhappy with her
20 for sharing that information with me.

21 Q Okay, and just to confirm; between May
22 of 2018 and now, you haven't discussed this with

1 Ms. Gongola again, right?

2 A And when you say "this", what do you
3 mean?

4 Q This allegation that she told you that
5 Mr. Iancu wanted to fire Mr. Fitzpatrick.

6 A No, I haven't. We've discussed Mike
7 because of his work on the training committee, but
8 we haven't discussed that specific issue, no.

9 MR. HARRIGAN: Okay. No further
10 questions.

11 JUDGE NIEDRICK: Okay. I have a couple
12 of questions. With regard to this training that
13 you setup with DOJ and this employment law
14 attorney that came over, do you know which section
15 within DOJ this attorney was working?

16 THE WITNESS: My best guess is that --
17 this was pre- pandemic and so some people were
18 in-person and someone else had setup the general
19 law attorney to come to the training in- person, I
20 didn't do that -- I think it was from the Patent
21 Office's Office of General Law and not an
22 employment attorney from DOJ; rather it was

1 somebody from the Patent Office, but I don't
2 remember who that person was.

3 JUDGE NIEDRICK: Okay, so it was an
4 agency attorney that came and spoke about that?

5 THE WITNESS: I think so; I'm not
6 positive, but it think so.

7 JUDGE NIEDRICK: And with regard to the
8 APA and sort of the discussion of the APA, was
9 that a DOJ attorney who provided that information?

10 THE WITNESS: It was; in fact, we still
11 have those set of slides from them and it was a
12 man and a woman -- I don't remember each of their
13 names -- who talked about the principles of the
14 APA.

15 JUDGE NIEDRICK: And so the attorney
16 that -- the employment law attorney for the
17 Commerce -- that came and spoke, your
18 understanding was that they were speaking on
19 behalf of management when they gave that sort of
20 threat that you could be fired and would be fired
21 if you didn't comply with the guidance?

22 THE WITNESS: So, the Patent Office has

1 a General Counsel's Office and within the General
2 Counsel's Office is the Office of General Law --
3 OGL -- and that's where the employment law
4 attorneys work; not directly for Commerce, but
5 within our agency that's within the Department of
6 Commerce; so, it was that person. I'm not sure I
7 answered your question though.

8 JUDGE NIEDRICK: No, I think that
9 answers it. So, I guess what you're -- my
10 question was, was it your understanding that they
11 were speaking on behalf of sort of management,
12 telling you what management's expectations were
13 with regard to the guidance?

14 THE WITNESS: Because this was all in
15 the context of the director's authority, I assumed
16 -- it was not stated by anybody -- but I assumed
17 that this was what the director wanted. My
18 experience with labor law attorneys is -- or
19 really with any attorney -- if you said something
20 on behalf of who you're working for and that's not
21 what they wanted, it would have been corrected.
22 They would've said "No, he had no authority to say

1 that" or "That's not what he meant", but that
2 never happened to my knowledge.

3 JUDGE NIEDRICK: And what they were
4 referring to specifically was guidance that PTAB
5 management provided to APJ's, is that correct?

6 THE WITNESS: Yes, Your Honor; guidance
7 in the form of steering outcomes of panels. They
8 were very specific that his policy authority under
9 Title 35 Section 3 included steering panels.

10 JUDGE NIEDRICK: And the word "guidance"
11 is the word that they used?

12 THE WITNESS: I think they just referred
13 to it as "his policy" and that we had to follow
14 his policy, I don't remember the term "guidance".

15 JUDGE NIEDRICK: Okay. With regard to
16 the meeting -- the call -- that you received from
17 the management official letting you know that the
18 director was very angry and wanted to fire Judge
19 Fitzpatrick, what was your understanding of the
20 reason that he wanted to fire Judge Fitzpatrick;
21 if you have an understanding of that?

22 THE WITNESS: I did. Mike was a member

1 of the case discussion group that I mentioned
2 earlier and he had told us some about how the case
3 had been held up for a very long time, the panel
4 had been expanded, he wasn't permitted to say that
5 the panel had been expanded, they weren't
6 permitted to explain why there was such a lengthy
7 delay.

8 JUDGE NIEDRICK: But, so what was your
9 understanding of the reason that Director Iancu
10 wanted to fire him?

11 THE WITNESS: So, my understanding from
12 Mike was -- and this is from him as I remember it
13 -- is that he wanted to tell the story, he wanted
14 to say the panel had been expanded, he wanted to
15 explain why there had been a delay, he wanted it
16 to come out a certain way in that case; and for
17 all of those reasons they removed him so that the
18 decision wouldn't be that way -- I think he was
19 replaced by Scott Daniels, another friend of mine
20 who helped broker a decision afterwards.

21 JUDGE NIEDRICK: I understand what Judge
22 Fitzpatrick believes the reason was, but my

1 question is, when you were talking on the phone
2 with the management official that told you about
3 what they had heard from Director Iancu, did you
4 get an understanding of what the reason was that
5 the director wanted to fire Judge Fitzpatrick?

6 THE WITNESS: Yes, Your Honor. My
7 understanding from that person was that it was
8 because of his failure to follow the guidance --
9 the policy -- to write the case up a certain way
10 -- to handle the case a certain way.

11 JUDGE NIEDRICK: Okay, thank you. I
12 don't think I have anything else. Any follow-up,
13 Mr. Kappers, Mr. Horrigan for my questions? Mr.
14 Kappers, any follow-up?

15 MR. KAPPERS: Nothing, Your Honor.

16 JUDGE NIEDRICK: Mr. Horrigan, anything?

17 MR. HERRIGAN: Yes.

18 REDIRECT EXAMINATION

19 BY MR. HERRIGAN:

20 Q So, you just told the administrative
21 judge what your impression was, what exactly did
22 Ms. Gongola say to you that gave you that

1 impression?

2 A You know, Mr. Horrigan I don't remember
3 exact words, it's been a long time, but I remember
4 the meaning conveyed to me was what I just said;
5 that because Mike was not following the direction
6 he was given, he was being removed from that trial
7 and from all trials.

8 Q Alright. So, let me try a question I
9 asked earlier again. Can you tell us exactly what
10 she said?

11 A No. I find that when something happened
12 quite some time ago, I remember the gist of what
13 happened, but I don't ordinarily remember people's
14 exact words.

15 MR. HARRIGAN: Okay. No further
16 questions.

17 JUDGE NIEDRICK: Great. Thank you very
18 much, Judge Kauffman; I really appreciate you
19 testifying here. If you have any questions about
20 your testimony, please contact Mr. Horrigan or
21 any of the attorneys for Judge Fitzpatrick, okay?
22 Please don't discuss your testimony with anyone.

1 Understand?

2 THE WITNESS: Yes, sir.

3 JUDGE NIEDRICK: Great. Thank you very
4 much and you can go ahead and leave the meeting
5 now. If you are unable to do it, I can go ahead
6 and remove you too.

7 THE WITNESS: I can leave, Your Honor;
8 thank you.

9 JUDGE NIEDRICK: Great, thank you.
10 Okay. It looks like we're going to hear from
11 Judge Weidenfeller now?

12 MR. HARRIGAN: I believe (audio cuts
13 out).

14 JUDGE NIEDRICK: I'm sorry?

15 MR. HARRIGAN: I understand Ms.
16 Mitchell's up next and I have a motion to add Ms.
17 Gongola to the witness list.

18 JUDGE NIEDRICK: Let's deal with one
19 thing at a time. So, Judge Mitchell is who you're
20 going to call now?

21 MR. HARRIGAN: I'm not calling -- my
22 understanding is they are calling Judge Mitchell

1 right now.

2 MR. KAPPERS: That's correct, Your
3 Honor.

4 JUDGE NIEDRICK: Okay. Alright, so
5 let's go ahead and hear from Judge Mitchell and I
6 don't know if we're going to need to hear from
7 Judge Gongola. We may be able to get that
8 information from the other people that are in the
9 meeting. I'll make a determination on that after
10 the fact.

11 MR. HERRIGAN: Well then I would
12 certainly like representation of what I expect her
13 to testify to on the record.

14 JUDGE NIEDRICK: Well, let's see what
15 the other folks have to testify to. If it's
16 consistent with what we just heard, then there's
17 no need to call her, right?

18 MR. HERRIGAN: Well, my proffer would be
19 that it's not.

20 JUDGE NIEDRICK: Okay. Well, I'll make
21 that determination later once we hear from them,
22 okay? So, let's go ahead and we'll hear from

1 Judge Mitchell. Is she available?

2 MR. KAPPERS: Your Honor, Judge
3 Fitzpatrick's going to reach out to her now --

4 JUDGE NIEDRICK: Okay.

5 MR. KAPPERS: -- And for Judge Mitchell,
6 my colleague Mr. Abramic is going to step out.

7 JUDGE NIEDRICK: Okay.

8 MR. KAPPERS: And, Your Honor, I think
9 it should be clear, but -- you know -- when and if
10 Mr. Horrigan makes that proffer, we would object
11 and we'll make our objection and provide our
12 arguments at that point.

13 JUDGE NIEDRICK: Okay, we'll talk about
14 that after I hear from all the witnesses.
15 Typically if there's going to be some sort of
16 rebuttal witness like this, I'll listen to that
17 after I hear everything and rule -- decide -- I'll
18 make a determination at that time and then I'll
19 give both of you an opportunity to clearly state
20 what the request is and then if there's any
21 objection; okay?

22 MR. KAPPERS: Great, thank you.

1 JUDGE NIEDRICK: Sure. It looks like
2 Susan Mitchell just signed on here, so let me go
3 ahead and admit her. Hi, Judge Mitchell. Hi, how
4 are you? If you can go ahead and just unmute
5 yourself? On the bottom left-hand corner you'll
6 see a little microphone and hover over --

7 THE WITNESS: Oh, I'm sorry.

8 JUDGE NIEDRICK: -- There you go.

9 THE WITNESS: Yeah, thank you.

10 JUDGE NIEDRICK: No problem. Great.

11 I'm Administrative Judge Andrew Niedrick and I'll
12 be conducting the hearing today --

13 THE WITNESS: Okay.

14 JUDGE NIEDRICK: -- Thank you for
15 appearing. Just to give you a little lay of the
16 land, Mr. Kappers and Mr. Suarez are Judge
17 Fitzpatrick's representatives in the case, and
18 William Horrigan is the representative for the
19 agency, and Ms. Dawson is our Court Reporter; and
20 then the other two -- sorry -- the one with the
21 telephone number and then the one that says
22 "Chandra Morrell", those are backups for Ms.

1 Dawson; okay?

2 THE WITNESS: Okay.

3 JUDGE NIEDRICK: Alright. Do you have
4 any objection to swearing an oath?

5 THE WITNESS: No.

6 JUDGE NIEDRICK: Can you please raise
7 your right hand?

8 Whereupon,

9 SUSAN MITCHELL

10 was called as a witness and, having been first
11 duly sworn, was examined and testified as follows:

12 JUDGE NIEDRICK: Great. Can you please
13 state and spell your first and last names for the
14 record?

15 THE WITNESS: Susan Mitchell, S-U-S-A-N
16 M-I-T-C-H-E- L-L.

17 JUDGE NIEDRICK: Thank you. If you hear
18 an objection while you're testifying or you hear
19 some commotion, please stop your answer; I'll rule
20 on the objection or figure out what's going on and
21 then we'll proceed. We're having a few little
22 issues with some audio and every now and then

1 things freeze, so just bear with us; and other
2 than that, I'm going to turn you over now to Mr.
3 Kappers, okay? Mr. Kappers, your witness.

4 MR. KAPPERS: Thank you, Your Honor.

5 DIRECT EXAMINATION

6 BY MR. KAPPERS:

7 Q Judge Mitchell, thanks for your time
8 today. You're a lead judge on the PTAB, is that
9 right?

10 A Yes, I am.

11 Q Okay, and as lead judge you are Judge
12 Fitzpatrick's direct supervisor or first in line
13 supervisor, is that right?

14 A Yes.

15 Q How long have you been his first in line
16 supervisor?

17 A Gosh, I should know this off the top of
18 my head. Probably at least five years. I've been
19 a lead for about seven and I'm trying to remember
20 because Judge Fitzpatrick wasn't with me at the
21 very beginning, he was with Judge Giannetti and
22 then got transferred into my section. So, I think

1 about five years, or maybe more.

2 Q Okay. So, you've worked quite a bit
3 with Judge Fitzpatrick over that time, is that
4 right?

5 A Yes. I mean -- not -- as his lead judge
6 certainly and on a few cases, not a lot, but on a
7 few cases, yes.

8 Q What are your impressions of him?

9 A You know -- I like working with Judge
10 Fitzpatrick. I think he -- my favorite thing
11 about him is that when we're on a panel together
12 he makes me kind of think about things in
13 different ways, which I think is very healthy for
14 the panel and sort of gets me out of my
15 assumptions sometimes. I don't always agree with
16 -- you know -- his conclusions, but I enjoy that
17 process of making me really think and make sure I
18 am on all fours with what my final decision would
19 be. So, I do enjoy working with him.

20 Q As part of PTAB management, should --
21 let me ask you this question -- should an APJ
22 follow guidance given to them from PTAB

1 management?

2 A In my view, yes. I mean -- I feel like
3 -- and this may or not totally match up I guess
4 with what is legally true -- but as I understand
5 it is I would follow it -- we're in the executive
6 branch, we're not in the judicial branch, so we
7 really are beholding to the political appointees
8 that come in to set policy for the agency. So, I
9 do believe that we need to follow -- when a
10 director comes in and sets policy that -- you know
11 -- we should follow the policy to the best of our
12 ability.

13 Q And what if the directive that
14 management gives an APJ is illegal; should an APJ
15 follow the directive then?

16 A I've never been in that situation where
17 I felt like I was told to do something that I felt
18 like was illegal. Honestly, I don't know. I
19 haven't thought enough to think because I haven't
20 been faced with that to -- you know -- think
21 through how I would respond if I felt like that
22 were the case. I would certainly raise it up the

1 chain and say I think is not appropriate under the
2 law, but I just haven't faced that situation.

3 Q Alright, Judge Mitchell, I'd like to
4 play a voicemail that you left Judge Fitzpatrick
5 --

6 A Okay.

7 MR. KAPPERS: And actually, Judge
8 Niedrick, if I could share my screen for a second?

9 JUDGE NIEDRICK: Was this part of the
10 record -- was this prehearing submission?

11 MR. KAPPERS: This is in the record,
12 yes, Your Honor.

13 JUDGE NIEDRICK: Where is it in the
14 record?

15 MR. KAPPERS: This is tab 5 at page 61
16 of 340.

17 JUDGE NIEDRICK: Is this an email? I'm
18 trying to figure out -- I don't remember any
19 audio.

20 MR. KAPPERS: So, this is an email, Your
21 Honor, and there is a wave file attached to the
22 email and that's embedded in the email, and it is

1 in the record.

2 JUDGE NIEDRICK: I can't access this I
3 don't think. I mean -- a lot of these hyperlinks
4 and stuff, they're not -- so I don't this is in
5 the record as -- all that's in the record is this
6 email. The wave file -- even though it says it's
7 attached -- unless it's been uploaded -- it's not
8 attached. So, I guess at this point -- any
9 objection, Mr. Horrigan to him playing the
10 voicemail?

11 MR. HARRIGAN: Yes, I do object. In
12 fact, the witness is right here, why don't you
13 just ask her?

14 MR. KAPPERS: Well, I'll find the
15 exhibit and we can move the voicemail into
16 evidence.

17 JUDGE NIEDRICK: Okay. Well, do you
18 want to ask her some questions about it -- I mean
19 -- you could short circuit -- you want to
20 summarize it and ask her if she left a voicemail
21 -- something to that effect -- that might help?

22 MR. KAPPERS: Okay, sure; I can try

1 that.

2 BY MR. KAPPERS:

3 Q Judge Mitchell, do you remember leaving
4 a voicemail with Judge Fitzpatrick on May 31,
5 2018?

6 A Not this specific date, but it think I
7 might know which voicemail you're talking about.
8 If you --

9 Q Okay --

10 A -- Start the summary and I think I know
11 which one you're talking about.

12 Q -- Alright, I'll try to do that. And
13 that voicemail on May 31st related to the meeting
14 that you had with Judge Weidenfeller and Judge
15 Fitzpatrick the day before, is that right?

16 A Was it that one or was it the one with
17 Judge Tierney -- BCJ Tierney? I mean --

18 Q Now, that one --

19 A -- Go ahead.

20 Q -- That one was in 2017. So, no, I'm
21 referring to the voicemail on May 31, 2018
22 regarding the meeting you had with Judge

1 Weidenfeller and Judge Fitzpatrick on May 30th.

2 A I don't remember that one offhand.

3 Q Okay.

4 JUDGE NIEDRICK: I'm lost here just a
5 little bit because I recognize that you all
6 thought this was accessible, so it kind of puts us
7 in a peculiar circumstance here; but again, I
8 can't access it. So, even though you thought it
9 was in the record, it's not. So, Mr. Horrigan,
10 what I propose is that Mr. Kappers plays the
11 voicemail message, she can authenticate and then
12 he can ask questions on it.

13 MR. HERRIGAN: Okay. My objection is in
14 the record.

15 JUDGE NIEDRICK: Okay. Mr. Kappers, go
16 ahead if you can and play the audio. I'm not sure
17 if it's going to work on your end, but give it a
18 shot.

19 MR. KAPPERS: Thank you, Your Honor.

20 (Voicemail audio is played)

21 VOICEMAIL AUDIO: Hey, Michael, it's
22 Susan again. I know you don't want to talk to me,

1 I would not want to talk to me after yesterday. I
2 do want to tell you that I wasn't there for the
3 meeting, I was there as your lead, I was not
4 involved at all in that decision to pull you off
5 AIA. I had heard stuff as they were getting
6 towards making that final call, which is why I
7 didn't respond to your email. When you sent me
8 the email I didn't know what was going on and then
9 I had heard, so I just mentally decided, I didn't
10 respond. So anyway, not that you want to hear it
11 and not that it matters whether I was involved or
12 not, I wanted you to know I was not involved in
13 this decision to pull you off AIA. I'm not sure
14 what the rationale is because I was certainly
15 involved in other stuff with you. I wish they had
16 called me about the concurrences before those got
17 pulled. (inaudible) yesterday and I'm sorry that
18 it's come to this. Anyway, I was looking at your
19 docket and I know there's not cases on your
20 docket, so just take admin for the day and don't
21 worry about it, and I will certainly signoff on
22 that. So anyway, if you want to -- anyway -- give

1 me a call if you get a chance. I can understand
2 if you don't want to talk to me. So anyway, I
3 will talk to you later. Bye.

4 BY MR. KAPPERS:

5 Q Judge Mitchell, was that you in that
6 audio recording?

7 A Yes, it was.

8 Q Okay. Now, do you remember leaving that
9 voicemail for Judge Fitzpatrick?

10 A Yes, I do, yes.

11 Q And that was after your meeting on May
12 30, 2018 with Judge Weidenfeller and Judge
13 Fitzpatrick, is that right?

14 A Yes.

15 Q Okay.

16 MR. KAPPERS: So, Your Honor, now I
17 would like to move that voicemail into evidence.
18 It's -- on our end -- admissible as a voice file
19 at tab 5, starting at page 61. It's also our
20 Exhibit V and we produced this wave file to the
21 agency during discovery and prior to this hearing,
22 so there's certainly on notice that this was on

1 our exhibit list. We'd be happy to provide the
2 wave file to the Board as well.

3 COURT REPORTER: Mr. Kappers --

4 JUDGE NIEDRICK: I mean -- we have it in
5 the record now. Let me -- I know there's some
6 issues with our system and how we manage wave
7 files and video files, so let me talk with our
8 folks. Again, we have the recording now as part
9 of the record --

10 MR. KAPPERS: Okay. I can then proceed,
11 if that's okay?

12 COURT REPORTER: Mr. Kappers, if you
13 could just repeat --

14 JUDGE NIEDRICK: It would be nice to
15 actually have the exhibit in order to make this
16 work, okay? I think he just -- it looks like he
17 just froze.

18 COURT REPORTER: Mr. Kappers, are you
19 able to hear me?

20 JUDGE NIEDRICK: Mr. Horrigan -- I'm
21 sorry -- everybody's -- okay -- there, we're back.
22 Everybody froze for a second on my end, so I think

1 my internet --

2 COURT REPORTER: Oh, I see. Are you
3 able to hear me now, Your Honor?

4 JUDGE NIEDRICK: Yes, I can hear you
5 now.

6 MR. SUAREZ: I'm going to concede my
7 computer to Mr. Kappers and see if this works
8 better.

9 JUDGE NIEDRICK: Okay. I find it funny
10 that I've never had an issue with internet
11 stability at home, but now during the day here at
12 work it's happening repeatedly, so --

13 COURT REPORTER: Yes, it's been unusual.
14 I just needed Mr. Kappers to repeat the file tab,
15 just to reconfirm it because he asked to move it
16 into evidence and he was cutoff.

17 MR. KAPPERS: Tab 5 at page 61 of 340.

18 COURT REPORTER: Wow, you're still
19 cutting off. If you could speak a little closer
20 into the microphone, try that.

21 MR. KAPPERS: Tab 5 at page 61 of 340.

22 JUDGE NIEDRICK: So, that's 61, 6-1 of

1 340?

2 MR. KAPPERS: 6-1.

3 COURT REPORTER: Yes, I got that. Okay,
4 thank you, sir. Thank you.

5 BY MR. KAPPERS:

6 Q Alright, Judge Mitchell, I hope we got
7 the kinks sort of worked out. So, in that
8 voicemail you told Judge Fitzpatrick "I was not
9 involved at all in that decision to pull you off
10 AIA", is that right?

11 A Yes.

12 Q Who was involved in making that decision
13 to pull him off of AIA trials?

14 MR. HARRIGAN: Objection. Lack of
15 foundation.

16 JUDGE NIEDRICK: Do you want to ask her
17 does she know who was involved?

18 MR. KAPPERS: Yeah, I'll rephrase.

19 BY MR. KAPPERS:

20 Q Do you know who was involved, Judge
21 Mitchell?

22 A Other than Vice Chief Weidenfeller, I'm

1 not sure. I mean -- I'm assuming -- you know --
2 that it was certainly management above me that was
3 involved in that decision. I was only pulled in
4 when we talked directly to Judge Fitzpatrick to
5 deliver that decision.

6 Q When was the first time that you heard
7 the decision was going to be made to remove Judge
8 Fitzpatrick from AIA trials?

9 A Oh goodness, it was probably a couple of
10 days before that because I know I'd gotten an
11 email -- as I had said -- I remember from Judge
12 Fitzpatrick and I was kind of in that awkward
13 position of knowing something was coming down that
14 was going to get delivered and so I didn't
15 respond, and so it just became sort of an awkward
16 moment to be -- you know -- being his lead, I
17 always want to be responsive, but wasn't able to;
18 so, it just sort of was an awkward situation until
19 he knew what was decided.

20 Q Yeah, I think in your voicemail you said
21 that you had heard some stuff. What did you hear
22 leading up to that May 30th call?

1 A Just -- I think -- about the Nike
2 decision -- if I remember right -- just that that
3 sort of -- and not even -- I don't think from
4 upper management or management above me, more from
5 just colleagues that I know -- the panel wanted
6 that decision to mail and just -- you know -- what
7 was going on -- I kind of heard third-hand, but I
8 wasn't involved and asked to -- you know -- deal
9 directly with it, but that's sort of what I
10 believe I was thinking about at the time.

11 Q The stuff that you had heard leading up
12 to the decision to remove Judge Fitzpatrick from
13 AIA trials related to the Nike decision, is that
14 right?

15 A Yeah -- I mean -- you know -- I don't --
16 not that that impacted the decision necessarily,
17 because I wasn't involved in that, but just -- you
18 know -- I knew Michael was unhappy about some
19 things and just had heard through the grapevine
20 different issues that he had with management, but
21 nothing that came directly to me at that point.

22 Q And who did you hear this from?

1 A Colleagues -- I think more colleagues.
2 I don't remember -- no -- nobody really in
3 management above me would've talked to me about
4 it, it was more just colleagues that knew -- you
5 know -- different events that were happening.

6 Q I think you told Judge Fitzpatrick "I
7 wanted you to know I was not involved in this
8 decision to pull you off AIA". Why did you want
9 him to know that you weren't involved?

10 A Just because I had that awkward moment,
11 I couldn't really talk to him until the decision
12 came down at that point, and I didn't -- I don't
13 know -- I didn't want Judge Fitzpatrick to feel
14 like I had sandbagged him by not saying anything
15 before that meeting with Vice Chief Judge
16 Weidenfeller. So, it was just kind of an awkward
17 circumstance and I wanted him to know that I was
18 there as sort of a witness to that meeting with
19 the Vice Chief and that I wasn't involved in the
20 decision to remove him from AIA.

21 Q The next thing that you told Judge
22 Fitzpatrick was "I'm not sure what the rationale

1 is because I was certainly involved in other stuff
2 with you", does that sound right?

3 A Yeah.

4 Q What did you mean by that?

5 A I think because my work -- you know --
6 with Judge Fitzpatrick -- I mean -- I've always --
7 I like having him on panels with me and I've
8 enjoyed our interactions -- and that's on AIA
9 panels -- so -- you know -- I felt like my
10 experience was definitely different than what was
11 said in the meeting by the Vice Chief as the
12 rationale for Judge Fitzpatrick to be -- you know
13 -- pulled off AIA cases. So, that was just -- not
14 that I discredit the judges that would've had
15 different experiences than me -- that was not my
16 experience with him; and so, as his lead, I wanted
17 to make sure -- you know -- I had no problems with
18 him from my end and my work with him.

19 Q So, the decision to remove him from AIA
20 trials was just inconsistent with your experience
21 that you had with him, is that right?

22 MR. HARRIGAN: Objection. Leading.

1 JUDGE NIEDRICK: Sustained.

2 BY MR. KAPPERS:

3 Q Alright. You also told him in the
4 voicemail, Judge Mitchell, "I wish they had called
5 me about the concurrences before those got
6 pulled". Do you remember hearing that?

7 A No, I'm sorry, I don't remember -- say
8 that again -- I mean -- in more of the context --
9 I'm sorry.

10 Q You told Judge Fitzpatrick "I wish they
11 had called me about the concurrences before those
12 got pulled".

13 A Oh-oh, because that -- we were talking
14 about the concurrence -- I believe that was the
15 case that Judge Fitzpatrick was sitting with
16 Judges Eastholm and -- was it Zhenyu Yang -- Judge
17 Yang on those and I know there was sort of email
18 traffic that went back and forth on whether or not
19 Judge Fitzpatrick's concurrence would go, and I
20 would've liked the opportunity to have just picked
21 up the phone and said "Look, we can't mail your
22 concurrence" -- I think that was when it had what

1 we would deem confidential information and we just
2 didn't want to waive any kind of deliberative
3 process privilege -- if I'm remembering the
4 concurrence -- and I would've chatted with him
5 instead of it sort of coming through email,
6 because I think that's just important as a first
7 line supervisor, to keep those lines of
8 communication open and I wouldn't have done that
9 through email.

10 MR. KAPPERS: Judge Niedrick, could I --
11 I'd like to share with Judge Mitchell Exhibit VI,
12 tab 6 at 11 of 462.

13 JUDGE NIEDRICK: Okay, go ahead. And
14 this is Exhibit O -- this is the confidential --
15 the summary that's labeled "Confidential" at the
16 top?

17 BY MR. KAPPERS: Correct.

18 JUDGE NIEDRICK: Okay. And that's
19 actually at page is where that starts.

20 THE WITNESS: I have it up, if that's --

21 MR. KAPPERS: Oh, you have it Exhibit O
22 up?

1 THE WITNESS: I do.

2 BY MR. KAPPERS:

3 Q Okay. And Judge Mitchell, what is this
4 document?

5 A So, the typewritten part, Vice Chief
6 Judge Weidenfeller wrote and prepared before the
7 phone call with Judge Fitzpatrick about his AIA
8 work; so I was brought in as -- you know -- his
9 first line supervisor and -- you know -- to be
10 there on the phone call, so I didn't see so I
11 started just -- you know -- jotting notes down
12 about what Judge Fitzpatrick was saying, just to
13 kind of keep in my mind what happened and what was
14 said during the meeting.

15 Q Okay. And so, those are your
16 handwritten notes?

17 A I'm sorry?

18 Q Those are your handwritten notes?

19 A Yes, those are my handwritten notes.

20 Q When did you receive a clean copy of
21 this document?

22 A It was probably the day that we talked

1 to Judge Fitzpatrick. I think it was right -- if
2 I remember right -- it was right before the phone
3 call.

4 Q And who provided you a copy of this
5 document?

6 A Vice Chief Judge Weidenfeller.

7 Q Do you know who else received a copy, if
8 anyone?

9 A I don't know if anyone else did.

10 Q Do you know who prepared the document?

11 A I believe Vice Chief Judge Weidenfeller
12 did to make sure -- you know -- he covered what he
13 wanted to cover in the phone call.

14 Q Do you know if anybody in management
15 approved or reviewed this document?

16 A No, I don't know one way or the other.

17 Q Do you see at the top of the page where
18 all the 452, there's a header that says "Three
19 Performance Summary"?

20 A Yes.

21 Q Were there other sections of this
22 document when you received it?

1 A I don't know, I don't believe so; and it
2 could've been that this was in-line with our
3 performance appraisal plan, that might be why it
4 says "Three".

5 Q Okay. And at the top in the first
6 sentence this document states "If I were to rate
7 performance today based on the information about
8 which I'm aware, I would rate you as marginal in
9 the element of internal-external shareholder
10 interaction". Do you see that?

11 A Yes, I do.

12 Q Did Judge Weidenfeller make that
13 statement to Judge Fitzpatrick during the May 30
14 call?

15 A Yes, I do remember him making that
16 statement.

17 Q And in this document -- Judge
18 Weidenfeller -- it looks like he lists
19 management's rationale for making the decision to
20 remove him from AIA trials, is that right?

21 A I'm sorry, could you repeat -- are you
22 talking about my handwritten notes?

1 Q Well, let me ask another question, Judge
2 Mitchell.

3 A Okay.

4 Q Do you see the first bullet and it says
5 "Problems with timeliness are too frequent and too
6 serious to ignore"? Do you see that?

7 A I'm so sorry, I don't. I know that's in
8 here, but I'm not seeing --

9 Q Well it --

10 A -- Oh, here it is -- I'm so sorry --
11 you're right at the top -- of course -- I see
12 that, yes.

13 Q Alright. Based on your interactions
14 with Judge Fitzpatrick, did you think he had
15 problems with timeliness that are too frequent and
16 too serious to ignore?

17 A In my direct experience on cases with
18 Judge Fitzpatrick, no; and I'll give a caveat here
19 because I'm a former litigator and I tend to push
20 deadlines, so I'm probably not the one to
21 necessarily assess other people because I live in
22 a glass house; but I always felt like -- in cases

1 where I worked with Judge Fitzpatrick -- I got
2 drafts of things actually earlier than I expected
3 generally. So, it was always nice to have time --
4 you know -- to fit in a review of one of his
5 decisions because I -- I mean -- I'm always
6 handing stuff two weeks before the deadline to my
7 panel members and he was definitely three to four
8 weeks out on cases when I worked with him; so, it
9 was a nice luxury that I unfortunately do not
10 often afford my colleagues, so I appreciated that
11 in working with Judge Fitzpatrick.

12 Q Is there a like an internal deadline for
13 which an APJ-1, is supposed to send a decision to
14 the other co- panelists for their review?

15 A Generally, I think in -- at this
16 timeframe -- I'm not sure if it was in our PAT
17 support document. Usually how we keyed off --
18 because there's some internal review processes and
19 so for those processes outside, the panel - there
20 were deadlines that we tried to meet so that that
21 process could get done in a timely manner and get
22 a case out the door and meet the statutory

1 deadline. I don't know if in this timeframe we
2 had the formal timeframe for that in the PAT
3 support document or not, I think we did later; but
4 yeah - I mean -- we all knew -- we're pushing
5 deadlines -- you want to get stuff out as soon as
6 you can so that if a panel member has a problem or
7 just disagrees and wants to file a concurrence or
8 a dissent, they get that opportunity.

9 Q Judge Mitchell, if you could look to the
10 first bullet and in the parenthetical, do you see
11 Judge Weidenfeller cites a --

12 A Oh, gotcha.

13 Q -- Twelve business days set forth in PAT
14 support document. Was that the internal goal for
15 an APJ-1 to send a decision to the other
16 co-panelists?

17 A So, at this time -- so, we have our
18 performance appraisal plan and we have a support
19 document that augments that plan, and in that --
20 so -- now I -- there is a deadline in there. So,
21 that's what the Vice Chief Judge Weidenfeller is
22 referring to. So, in this timeframe there was one

1 in the PAT support document of 12 business days.

2 Q And as an APJ-1, have you ever submitted
3 a draft decision to other APJ's with less than 12
4 days before the deadline?

5 A Yes, I have.

6 Q How many times do you think?

7 A I don't know -- I mean -- as I say --
8 I'm embarrassed to say as I sit here that I tend
9 to push deadlines with other work and things, so
10 certainly several times.

11 Q Have you ever received from other APJ's
12 a draft decision that's within this 12 business
13 day rule?

14 A Yes.

15 Q Okay. How many times?

16 A Oh goodness, probably every -- maybe --
17 third or fourth opinion I review. That's just an
18 estimate, but yeah, probably -- I mean -- every
19 four I would say.

20 Q Does the PTAB management track to
21 determine how frequently APJ's are missing this 12
22 business day goal?

1 A I think what -- no -- I doubt that
2 getting it to your panel is tracked; I don't think
3 anybody tracks that. I do think our review
4 committee -- so, after it clears the panel we have
5 a review committee that takes a look to see "Hey,
6 are there hot button issues that" -- you know --
7 "we want to make sure we're consistent on", so
8 that committee -- I think -- does keep track,
9 because unfortunately I've heard I'm quite the
10 scofflaw, so I'm one that's probably fairly late
11 getting stuff in to that review committee; so I
12 think they do -- or at least did at one point --
13 they have kept track of when stuff comes in.

14 Q Do you know how many times an APJ-1 that
15 submitted a decision past this 12 business day
16 rule has received an oral negative review like
17 Judge Fitzpatrick did on May 30th?

18 A I don't -- I would only know if it were
19 my direct reports and I don't have another direct
20 report where they got this type of review. So, I
21 wouldn't necessarily know if somebody else did
22 because most of us wouldn't talk about negative

1 things about our judges to each other just for --
2 you know -- we're all colleagues and so a lot of
3 this would be close-hold; so, I wouldn't
4 necessarily know if this were done with another
5 employee. I know from my direct reports, no.

6 Q Okay. Well, sticking with your direct
7 reports, have any of your direct reports been
8 removed from their entire docket of AIA trials for
9 missing the 12 business day rule?

10 A I know there -- I do know anecdotally --
11 there's maybe two or three other judges that have
12 been moved from AIA to an appellate docket. I
13 don't think -- anecdotally -- I don't think it was
14 for timeliness, it was other reasons.

15 Q And before the May 30, 2018 call with
16 Judge Weidenfeller did anyone in PTAB management
17 express to you a concern that they had with Judge
18 Fitzpatrick's timeliness?

19 A No, not that I recall.

20 Q As a lead judge and the direct
21 supervisor of Judge Fitzpatrick would you have
22 expected to have been consulted if others in PTAB

1 management had an issue with his timeliness?

2 A Not necessarily. I mean -- it's -- I
3 mean -- if it was something that they think I
4 should counsel them on, then yes. You know -- I
5 do like to be in the loop certainly with direct
6 reports and don't -- you know -- but I can
7 understand when a decision to remove a judge from
8 a particular jurisdiction that's -- you know --
9 sort of above my pay grade; so, it's nice to be in
10 the loop and know what's going on, but I wouldn't
11 necessarily expect upper management who are
12 thinking and making a decision like this to
13 necessarily include me in that decision.

14 Q Okay. Judge Mitchell, let's look at the
15 second major bullet that Judge Weidenfeller wrote.
16 He writes "The judge is expected to recognize the
17 need for discretion and judgment applies
18 appropriate". Do you see that?

19 A Yes.

20 Q And based on your other involvement with
21 Judge Fitzpatrick at this time, did you think he
22 exercised discretion?

1 A I think in general Judge Fitzpatrick
2 does, but there were the two instances -- and I
3 agreed with it -- where he talked about in his
4 opinions what we would deem to be confidential
5 information, part of our deliberative process in
6 the internal workings of the Board and I agreed
7 that that should not be put in a public opinion
8 that goes out. So, in those instances I felt like
9 -- you know -- from my view -- Judge Fitzpatrick
10 maybe did not exercise the discretion that he
11 should, and we had very lively discussions when I
12 talked to him about it, but he did remove that
13 information when I had asked him on at least the
14 first occasion.

15 Q And I would like to return to those two
16 instances that you reference; but just to be
17 clear, he did agree to remove that information
18 from his opinions; is that right?

19 A Yes, as I remember it, yes; after a
20 lively discussion, but yes.

21 Q Okay. Now, Judge Mitchell, I'd like to
22 point you to what is a sub-bullet and Judge

1 Weidenfeller says "You have refused to sign onto
2 preapproved template decisions, applying SAS which
3 has delayed issuance of those decisions while your
4 colleagues sought guidance from management". Did
5 I read that right?

6 A Yes.

7 Q Are you aware of the issue that Judge
8 Weidenfeller was referring to here?

9 A Yes.

10 Q Can you describe what he's referring to?

11 A So, I think Judge Fitzpatrick had
12 written separately saying under SAS -- his reading
13 of SAS -- we did not need to address all the
14 issues brought up in a petition or -- you know --
15 brought up by a patent owner in issuing our
16 decision on institution, but we had had guidance
17 from the director saying that we should address as
18 much as we can in the decision on institution to
19 really inform the parties going forward in the
20 trial about -- you know -- where the issues are
21 and sort of how we saw the case, to help move the
22 ball forward. So, I think that was the issue and

1 I think management said "Look, we don't want" --
2 you know -- "you to basically flout guidance from
3 the director in an opinion".

4 Q And if you recall your voicemail to
5 Judge Fitzpatrick -- I remember -- you said "I
6 wish they had called me about the concurrences
7 before they got pulled". Is that the same issue
8 that is in this sub-bullet?

9 A Yes, because I would have liked to have
10 talked directly; that's what I was saying. I
11 think it was done through email -- if I remember
12 right -- and I only saw that after the fact, but I
13 would've gotten on the phone with Judge
14 Fitzpatrick and talked it through, or would've
15 liked that opportunity to talk it through.

16 Q I'm pulling up another exhibit, okay?
17 I'd like to now -- just for the record -- show you
18 Appellate's Exhibit BC which is tab 6, starting
19 at page 246. And Judge Mitchell, on your screen
20 do you see an email from Judge Fitzpatrick dated
21 May 18, 2018, and you're CC'd here; is that right?

22 A Yes.

1 Q And this relates to the SAS issue that
2 we were --

3 (Audio cuts out)

4 JUDGE NIEDRICK: Yeah, sorry; Mr.
5 Kappers, you keep fading off. I don't know if
6 there's something in front of the microphone or
7 what, but it's just hard to hear you.

8 COURT REPORTER: Yeah, I was just about
9 to ask you to repeat your last sentence please?

10 BY MR. KAPPERS:

11 Q Okay. Does this relate to the SAS issue
12 that we were just discussing?

13 A Yes, I believe it does.

14 Q Okay. And in this email Judge
15 Fitzpatrick emails the group to explain why he
16 disagrees with Judge Weidenfeller's rationale for
17 removing his concurrence, is that right?

18 A Yes.

19 Q Alright. And he then copies the
20 concurrence in this email, do you see that?

21 A Yes.

22 Q Are you aware that other panels have

1 been permitted to issue institution decisions
2 assessing only one claim and one ground as Judge
3 Fitzpatrick wanted to do?

4 A I think -- yes -- there was a certain
5 group of judges that felt like that was the thing
6 to do, but I believe that was before the director
7 issued guidance to say (inaudible) really wanted
8 us to address -- you know -- at least what the
9 patent owner raised so that the parties would know
10 as much as they could going forward, but I believe
11 -- if I remember right -- I mean -- there were
12 certainly judges that did that, but that was -- I
13 believe -- before that further guidance came down.

14 Q You've mentioned the director's
15 guidance. What guidance are you specifically
16 referring to?

17 A You know -- I don't know if we received
18 in writing -- I mean -- certainly this would be
19 under Director Iancu and he was very good about
20 signing his name to things and telling us what he
21 wanted -- and I should know -- and I don't know if
22 it's in writing or if we were told in training

1 Tuesday "Look, we really" -- you know -- "when we
2 go forward on grounds" -- you know -- "or go
3 forward on a case" -- and we now know it's a
4 binary choice, you go forward on everything or
5 nothing, we couldn't pick what we thought were the
6 better grounds as we had done before SAS -- "that
7 if the patent owner really raised issues, try to
8 address them to let the patent owner know hey,
9 this is -- you know -- could be somewhat strong if
10 you go to trial or not, but just really try to
11 square up the issues for the parties so you get a
12 better trial going forward". That's really the
13 policy that we were told -- give the parties as
14 much information as you can in that decision on
15 institution, which is certainly a strategy -- you
16 know -- you always have to be careful because it's
17 a decision on institution and not a final
18 decision, so you don't want to lead the parties
19 the wrong way either, so; but that was the
20 thinking from the director.

21 Q Okay. So, you don't know one way or the
22 other whether the director signed this guidance?

1 A I should know and I apologize I do not.
2 I mean -- Director Iancu was very good about
3 putting things in writing and giving it to us, and
4 I apologize, I don't -- I should know that and I
5 don't -- if it were in a written directive or if
6 it were conveyed orally in our training Tuesdays,
7 I'm not sure. My inkling is it is in a written
8 directive, but I can't swear to that.

9 Q And when you mentioned that Director
10 Iancu gave "us" this guidance, who's the "us"
11 you're referring to?

12 A The judges at PTAB.

13 Q All of the judges?

14 A Yeah, he was -- yes. Usually at -- I
15 mean -- he was very good about coming in on
16 training Tuesdays -- he talked to us a lot
17 directly -- I can't remember if that was one of
18 the things he would've talked to us about in a
19 Town Hall -- that's terrible -- my memory is
20 terrible to remember all the things he talked
21 about -- but he would sometimes come and talk to
22 us directly or we would get the information

1 through the chief judge or the deputy or one of
2 the vice chiefs in a more open setting like a
3 training Tuesday where all the judges kind of come
4 together and we -- you know -- chat about the
5 important issues.

6 Q Did the guidance specifically say that
7 an APJ cannot institute on one claim, one ground
8 without analyzing the other things under the
9 grounds?

10 A I don't know if something was said in
11 the negative like that or if it was just really
12 the directive that "Look, if the patent owner
13 raises an issue, I want you to talk about it if
14 you can give the patent owner and the petitioner
15 some really idea where you're going". I mean -- I
16 think maybe the thinking is that "Look, the more
17 we say in our decision on institution, the
18 businesses may get together and settle" and a lot
19 of times we feel like that's a better resolution
20 than us going all the way to final because you get
21 a business agreement and it may be better for
22 industry; and I think that was probably Director

1 Iancu's view, is they give more information
2 upfront, it gives them more ability to kind of
3 assess the value of the case and maybe come to an
4 agreement, which could benefit both parties
5 instead of winner take all at the final written
6 decision.

7 MR. KAPPERS: Judge Niedrick, could we
8 take a short break?

9 JUDGE NIEDRICK: How much longer are you
10 going to need with Judge Mitchell?

11 MR. KAPPERS: I have quite some time,
12 maybe 20 minutes --

13 JUDGE NIEDRICK: You remember, you guys
14 weren't even going to call her; you sort of
15 withdraw initially, but now we're going to go for
16 hours? Give me an estimate of how much time you
17 think you're going to need?

18 MR. KAPPERS: Your Honor, I think it's
19 going to be or 30 minutes; but Your Honor, that
20 wasn't our position.

21 We were intending to cross examine Judge
22 Mitchell --

1 JUDGE NIEDRICK: Yeah, I understand
2 cross examine is limited to the scope of the
3 direct, correct? So, I don't understand how you
4 could assume that you were going to be able to
5 have a two hour discussion with her not knowing
6 what the direct of the scope would be -- the scope
7 of the direct would be. So, but -- needless to
8 say -- so, you're saying 20 or 30 minutes?

9 MR. KAPPERS: Yeah.

10 JUDGE NIEDRICK: Okay. Why don't we
11 take -- is five minutes long enough?

12 MR. KAPPERS: Yes, Your Honor.

13 JUDGE NIEDRICK: Okay. Let's take a
14 five minute break. It is 4:36 on my clock here;
15 we'll come back at 4:42. Alright, Ms. Dawson,
16 could we please go off the record?

17 (Recess)

18 JUDGE NIEDRICK: Okay, we are going to
19 continue with Judge Mitchell's testimony. Please
20 remember, Judge Mitchell, you're still under oath.

21 THE WITNESS: Thank you.

22 BY MR. KAPPERS:

1 Q Judge Mitchell, welcome back. If you
2 recall, Judge Weidenfeller cited a timeliness
3 issue in that May 30, 2018 call, right?

4 A Yes.

5 Q And I recall that you testified you had
6 submitted decisions past that 12 day goal, right?

7 A Yes.

8 Q Were you ever punished as a result of
9 that?

10 A No.

11 Q Don't you think it's unfair that Judge
12 Fitzpatrick was punished as a result of that?

13 MR. HARRIGAN: Objection. Relevance.

14 JUDGE NIEDRICK: Overruled. Please
15 answer.

16 THE WITNESS: In my experience, Judge
17 Fitzpatrick was usually very on time, in fact more
18 timely than most judges. I don't know what
19 happened in this particular circumstance because I
20 wasn't involved, but certainly I have been quite
21 untimely and have not -- you know -- suffered
22 being taken off AIA.

1 BY MR. KAPPERS:

2 Q Okay. And I had asked you about Judge
3 Fitzpatrick's discretion and judgment, I recall
4 you referencing some confidential information in
5 his opinions. Do you recall that?

6 A Yes.

7 Q That didn't come up during the May 30,
8 2018 call, did it?

9 A I don't believe so. I think Judge
10 Fitzpatrick talked about it, that "Look, I removed
11 stuff when you told me to", but I don't think it
12 was brought up as any kind of rationale for the
13 removal from AIA.

14 Q And Judge Weidenfeller didn't include it
15 on his written summary that was Exhibit O we were
16 looking at, right?

17 A No-no, I don't believe so.

18 Q Alright, Judge Mitchell, I would like to
19 show you an email --

20 JUDGE NIEDRICK: If you can give me a
21 citation, I can get --

22 MR. KAPPERS: I'm sorry. We were

1 looking at this document, I believe the tab is tab
2 5, starting at 221 of 340.

3 JUDGE NIEDRICK: You said 221? Is it in
4 -- it's an email April of 19' from Judge Mitchell?

5 MR. KAPPERS: I'm sorry.

6 JUDGE NIEDRICK: Okay. Do you want me
7 to share it and you can take a look?

8 MR. KAPPERS: One second, Your Honor.

9 JUDGE NIEDRICK: This is the one that
10 says "I wanted to give you a call to discuss what
11 management has identified as confidential
12 information in your concurring opinion"?

13 MR. KAPPERS: Yes. No, I'm sorry; I'm
14 looking at --

15 COURT REPORTER: Is -- where is that
16 banging coming from?

17 JUDGE NIEDRICK: So, this is also --
18 just so you know -- at tab 7, page 599.

19 MR. KAPPERS: I think I may have
20 misspoke, Your Honor.

21 JUDGE NIEDRICK: Okay.

22 MR. KAPPERS: So, I'm now going to pull

1 up what is Appellate Exhibit CR and that's tab 5,
2 starting at 221 of 340.

3 JUDGE NIEDRICK: Thank you.

4 BY MR. KAPPERS:

5 Q Judge Mitchell, do you see the email on
6 the screen?

7 A Yes, I do.

8 Q Can you describe what this email is?

9 A I was trying to remember which -- if
10 this is Nike -- but there was -- yeah -- there was
11 some confidential information -- or management
12 felt like it was confidential information -- in an
13 opinion that I wanted to chat with Judge
14 Fitzpatrick about to see if he would remove that
15 from the opinion.

16 Q And I'm going to scroll down.

17 COURT REPORTER: Can everyone mute their
18 mic -- can everyone hear me -- this is the Court
19 Reporter -- can everyone mute their microphones
20 who is not speaking?

21 JUDGE NIEDRICK: Okay, what are we doing
22 here? Mr. Kappers, are -- yeah -- there you go.

1 MR. KAPPERS: Yeah, I'm sorry everybody.
2 Mr. Suarez's computer now froze. So, I would
3 like to share a document I had previously shared
4 which is Exhibit -- it's tab 6 at 246.

5 BY MR. KAPPERS:

6 Q Judge Mitchell, can you see this?

7 A Yes, I can.

8 Q Okay. And -- you know -- we covered
9 this before, but you see that you received this
10 email on May 18, 2018?

11 A Yes.

12 Q And it looks like there's an attachment
13 to it, is that right?

14 A Yes.

15 Q Okay. Now I'd like to go down to the
16 attachment -- and this starts at page 252 of 462.
17 Judge Mitchell, is this the guidance regarding SAS
18 that you were referring to earlier?

19 A Yes, it is.

20 Q Was there any other guidance -- other
21 than this document -- that was communicated by the
22 director regarding institution decisions after

1 SAS?

2 A I do believe the director came and
3 talked to us personally because he did that
4 several times when we had big -- I mean -- this is
5 a pretty tectonic shift for us to have to address
6 all claims or none and it certainly shifted around
7 the workload for us a bit - and I want to say he
8 would've gone over some of this in-person -- if I
9 remember right - but I certainly remember the
10 guidance to -- you know -- address as much as you
11 can as to what the patent owner is questioning in
12 the -- you know -- proceeding.

13 Q Alright, just a few more questions,
14 Judge Mitchell. As Judge Fitzpatrick's lead judge
15 and first in line supervisor, did you sign -- do
16 you recall signing -- his written performance
17 appraisals?

18 A Yes, of course, yes.

19 Q Would you have signed those if you
20 thought them to be inaccurate or untrue?

21 A No.

22 MR. KAPPERS: Thank you. I'll pass the

1 witness at this time.

2 JUDGE NIEDRICK: Okay. Mr. Horrigan,
3 your witness.

4 MR. HERRIGAN: Thank you.

5 CROSS-EXAMINATION

6 BY MR. HERRIGAN:

7 Q Alright. Just a couple of background
8 questions. How long have you been a lead judge?

9 A I believe probably since 2014, somewhere
10 around there.

11 Q Okay. In your duties with respect to
12 supervision, are you more concerned with
13 administrative stuff or substantive legal matters?

14 A I consider myself more administrative
15 because I basically help the judges get their job
16 done and I'm not involved so much in the substance
17 of a case, but it's just -- you know -- when they
18 have a question, when they need something, they
19 need equipment, I'm the one they're going to call.

20 Q Okay. And you talked about your respect
21 -- I think is a fair word -- for Mr. Fitzpatrick,
22 right?

1 A Yes.

2 Q And he tends to do good work as a APJ?

3 A Yes.

4 Q He's a strong legal writer, would you
5 say?

6 A Yes --

7 Q Would you say --

8 A -- I mean -- I don't always agree, but I
9 feel like he's a strong writer, yes.

10 Q But do you think he typically covers the
11 issues well?

12 A Yes.

13 Q Okay. And why is that important -- if
14 it is -- to APJ's?

15 A We certainly -- you know -- part of what
16 I do with the performance appraisal ratings at the
17 end of the year is discuss quality -- that's one
18 of our core requirements of the job -- and to me,
19 quality and opinion is not whether I agree with
20 you -- certainly because reasonable minds can
21 differ on a lot of issues -- but how well do you
22 express -- you know -- the issue, how you get to

1 your decision, and the decision for that
2 particular issue. So, being able to write well is
3 paramount for our job and being able to
4 communicate our decisions and the why of our
5 decisions.

6 Q But explaining your position clearly
7 also affects stakeholders, correct?

8 A Yes-yes because they're certainly
9 looking at what we say about -- you know -- claims
10 and issues -- yes.

11 Q So, you agree it's important to be clear
12 about the legal reasoning?

13 A Yes.

14 Q And you would agree that Mr. Fitzpatrick
15 is very good at that?

16 A Yes.

17 Q Okay. We've covered this ground a
18 little bit, but I just need to get a little bit of
19 information from you. Tab 7, page 102. I'm
20 sorry; we haven't covered this subject yet. Tab
21 7, page 102.

22 A Okay. I've got it.

1 Q Okay. Do you recall -- I'm sorry --
2 thank you. Do you recall being involved in this
3 matter back in 2017?

4 A Yes.

5 Q Okay. And how did you get involved with
6 this?

7 A I'm trying to remember. I probably
8 would've been asked by Vice Chief Judge
9 Weidenfeller that "Hey, we think there's
10 confidential information in this opinion" and that
11 they wanted me to talk to Judge Fitzpatrick about
12 it; and would he --

13 Q Might that -- I'm sorry.

14 A -- Sorry.

15 Q -- Might that have been Mr. Tierney?

16 A It might have been Mr. Tierney at the
17 time, yes.

18 Q Okay. Well, why don't we just go to
19 page 96 of this same tab?

20 A Okay.

21 Q And do you recognize that?

22 A Yeah.

1 Q Alright. And I just want to make sure
2 that you agree that this is a decision in a
3 particular (inaudible) right?

4 A Yes-yes.

5 Q Okay. And so, then let's go to page 99
6 in that same document.

7 A Okay.

8 Q Alright. And do you see that line
9 through there?

10 A Yes, I do.

11 Q Okay. Now first of all, we've had a lot
12 of testimony about ARC, but who is on ARC?

13 A It's a rotation of judges, so I've been
14 on ARC in the past. Basically, judges rotate on
15 and off, so our colleagues make up ARC.

16 Q APJ's or lead judges -- what are you
17 referring to?

18 A Oh, APJ's, I'm sorry. What I would call
19 line judges.

20 Q Okay. And so, we see ARC made this line
21 through on Mr. Fitzpatrick's document?

22 A Yes.

1 Q Okay. And do you agree with their
2 decision -- or their -- whatever they were doing
3 -- requesting or asking -- do you agree with them
4 on this?

5 A Yes. Let me make sure I'm remembering
6 to make -- yes. So, this was a failed vote on the
7 decision that was put up for precedential status
8 that the judges voted no, and we consider this
9 confidential internal workings of the Board and
10 this would not -- should not -- be available for
11 public consumption.

12 Q Are you familiar with the phrase
13 "deliberative process"?

14 A Yes, I am.

15 Q Would that apply to this situation?

16 A Yes --

17 Q How?

18 A -- It certainly would. I feel my -- I
19 mean -- this is -- to me -- quintessential
20 deliberative process. You want the judges to vote
21 -- you know -- how they see fit on whether a case
22 should achieve precedential status for us, and

1 certainly that whole process of back and forth --
2 I mean -- we take comments, we talk about the
3 comments -- so all of that give and take of -- you
4 know -- that goes into that vote -- and the
5 decision really should be protected by the
6 deliberative process privilege.

7 Q Okay. And now I'm going to ask you to
8 go to tab 32, page 96.

9 A Okay. I'm there.

10 MR. HERRIGAN: Is everybody else okay?

11 Okay.

12 BY MR. HERRIGAN:

13 Q So, what do you understand this to be?

14 A These were the talking points that I
15 believe I wrote because I wanted to make sure I
16 understood what I was going to say as to why I was
17 telling Judge Fitzpatrick "This really can't be in
18 an opinion. This is really" -- you know --
19 "privileged information shouldn't be there".

20 Q So, you anticipated a conversation with
21 Mr. Fitzpatrick, is that it?

22 A Yes.

1 Q And these are notes for you to get
2 through that conversation, is that right?

3 A Right, to make sure I understood because
4 I know -- as I've said before -- the one thing I
5 appreciate about Judge Fitzpatrick is I better dot
6 my I's and cross my T's, and I wanted to make sure
7 I had thought through where we said that this is
8 deliberative process; and so I pulled SOP2 and
9 found what I needed, that look, we've said this
10 should be confidential.

11 Q What's SOP2?

12 A It's one our standard operating
13 procedures and I believe at the time it would've
14 talked about voting for precedential status of
15 opinions.

16 Q Okay. And so, why don't you just
17 explain to the Administrative Judge that second
18 bullet that we see?

19 A Yeah, so we had stated specifically in
20 our standard operating procedure -- we talked
21 about the vote -- "Look" -- you know -- "these
22 kinds of interactions we consider part of our

1 deliberative process" -- you know -- and like I've
2 said -- I'm a former litigator for DOJ and
3 would've -- you know -- I dealt with this in that
4 context too and certainly would agree in this
5 instance -- quintessentially you want judges to be
6 able to say what they want to say about an opinion
7 and not having it aired to the point where -- I
8 mean -- we've had -- you know -- comments that
9 "Look, there's a bunch of typos in this and we
10 don't want to make is precedential" -- you just
11 don't want that -- I mean -- and that's very minor
12 -- that's not going to substance -- but, those are
13 things you don't want aired to the public, that -
14 "Look" -- you know -- "these kinds of" -- you know
15 -- "interactions" -- and when you waive that
16 privilege about the vote -- you know -- that's a
17 slippery slope, it opens everything up. So, to me
18 this was very important that this not go out in
19 opinion, that we not be considered to have waived
20 our deliberative process anytime when we're
21 talking about a precedential opinion vote.

22 MR. HARRIGAN: Thank you. I'd like to

1 move Agency Exhibit 8 which is tab 32, pages 96 to
2 97 into evidence.

3 JUDGE NIEDRICK: Any objection?

4 MR. KAPPERS: No objection.

5 JUDGE NIEDRICK: Okay, that's moved into
6 evidence.

7 BY MR. HERRIGAN:

8 Q Alright, ma'am, can I refer you now to
9 tab 6, page 56?

10 A I'm there.

11 Q Alright. Why don't you explain what's
12 going on on September 01, 2017?

13 JUDGE NIEDRICK: I'm sorry, can you give
14 me the citation, Mr. Herrigan, I'm sorry.

15 MR. HERRIGAN: I'm sorry. Tab 6, page
16 56.

17 JUDGE NIEDRICK: Thank you.

18 THE WITNESS: So, this was a summary of
19 the call that I was on with Vice Chief Judge
20 Tierney where we talked about removing this
21 information on the precedential vote from Judge
22 Fitzpatrick's opinion.

1 BY MR. HERRIGAN:

2 Q And you were again on this call?

3 A Yes.

4 Q Okay. How did that conversation go --
5 was it well- received or not -- how would you
6 describe it?

7 A I think this was the second conversation
8 about it because I feel like with my first
9 conversation with Judge Fitzpatrick -- if I
10 remember right -- we had a very lively discussion
11 about -- you know -- if an opinion is voted to be
12 precedential, of course the public knows about
13 that vote; so, he felt like why wouldn't they know
14 if we voted and didn't -- the vote was not
15 successful. So, I think we was pushing more for
16 where is this -- you know -- can you really show
17 me it's confidential, I don't think it is. So, I
18 believe -- if I remember right -- that it was
19 elevated to Vice Chief Judge Tierney and --

20 Q Okay.

21 A -- You know -- and Judge Fitzpatrick is
22 always very cordial, but I'm not sure he -- you

1 know -- agreed with our assessment that "Hey, we
2 really can't have this in the opinion because" --
3 you know -- "you might have" -- "it might be
4 considered the waiver of deliberative process and
5 then people could ask for all kinds of things
6 about our votes on precedential opinion".

7 Q Okay. So, did I understand you to be
8 saying that you had a conversation with Mr.
9 Fitzpatrick before September 01, 2017?

10 A I believe so -- if I remember right --
11 and I apologize if I'm misremembering the
12 instances, but I know -- I believe -- this is the
13 one where he really wanted to know where we said
14 this is confidential and to understand why this
15 would be considered confidential. So, I believe I
16 talked to Judge Fitzpatrick before --

17 Q And then on -- I'm sorry, go ahead.

18 A -- No, that was it, I'm sorry.

19 Q Okay. On September 01, 2017 did Mr.
20 Tierney talk to Mr. Fitzpatrick about this?

21 A Yes.

22 Q Did he relate the points that we see

1 here on this page?

2 A Yes-yes.

3 Q Okay. And then, let me take you down to
4 the bottom final bullet. Do you see that, the
5 black bullet?

6 A Yes.

7 Q It's at the very bottom of page 56.

8 A Yes.

9 Q Okay. Did that happen as well -- did
10 that part of the conversation take place?

11 A Yes.

12 Q Okay. And if I could point you to the
13 second white bullet, you see "Adjusting your case
14 assignments"?

15 A Yes.

16 Q What do you understand that to mean?

17 A Moving Judge Fitzpatrick to another --
18 you know -- to ex parte appeals -- yeah -- we have
19 two sides of the house. We have the appellate
20 side, the ex parte appeals side and the AIA trial
21 side; and that's what I took that to mean, is
22 moving you to doing appeals and not AIA.

1 Q Okay. And then, let me refer you to tab
2 6, which we're in, page 59.

3 A I am there.

4 Q You're familiar with that email?

5 A Yes.

6 Q And for the Administrative Judge, who
7 are all the people who are copied on that?

8 A I'm sorry -- on the original -- from the
9 email from Judge Fitzpatrick?

10 Q Correct. And I've got to apologize as
11 well, I'm having computer problems; but I think
12 we're on tab 6, page 59.

13 A Mm-hmm, yes.

14 Q Okay. And so I just -- the question was
15 -- who is on the CC line here?

16 A Judge Yang, Judge Snedden, Deputy Chief
17 Judge Bonilla, Chief Judge Bullock, Judge Shiner,
18 me, Judge Margulies, Vice Chief Judge Tierney.

19 Q Okay. And who do you -- what do you --
20 understand the relationship between all those
21 people is?

22 A We're all colleagues on the Board and

1 some are in -- you know -- management positions
2 and some are administrative patent judges.

3 Q Okay. And then, real quick, if you
4 could go up to tab 6, page 62, the bottom, the
5 last paragraph there? Do you see that?

6 A On page 62?

7 Q Correct.

8 A Okay, yes.

9 Q I just want to confirm, does that
10 refresh your recollection about when you spoke
11 with Mr. Fitzpatrick?

12 A Yes.

13 Q Okay. And so, the date there is what?

14 A August 24, 2017.

15 Q Okay. Does that sound right to you?

16 A Yeah, yes.

17 Q Alright, thank you. Can we move to tab
18 7, page 559?

19 A Okay.

20 Q So, this document we've seen before, and
21 this looks familiar to you?

22 A Yes.

1 Q And then, I'm going to ask you to turn
2 down to page 599 and just confirm that that's the
3 information that you had highlighted?

4 A Yes -- I think actually, Vice Chief
5 Judge Weidenfeller highlighted this -- but yeah.

6 Q Okay. And so, down to 602.

7 A Okay.

8 Q And that's the information that was
9 highlighted to Mr. Fitzpatrick asking him to
10 remove it, correct?

11 A Yeah.

12 Q Okay. Anything else -- was he asked to
13 remove anything else?

14 A From this opinion, I don't believe so.

15 Q Okay. Just to clarify though, these
16 highlights were made by Mr. Weidenfeller and not
17 by you, correct?

18 A Yes, I believe so.

19 Q Okay. Do you agree that this is
20 confidential information?

21 COURT REPORTER: I'm sorry; could you
22 repeat that last answer, Ms. Mitchell?

1 THE WITNESS: Yes.

2 BY MR. HERRIGAN:

3 Q Okay. Let me ask you about -- first of
4 all -- SAS -- you talked about -- I just -- do you
5 know whether it's okay to have two judges issue an
6 institution decision?

7 A Yes; under our statute, only our final
8 written decisions require a three judge panel. We
9 actually at one point --

10 Q Okay. Were you --

11 A -- Oh, go ahead, sorry.

12 Q -- No, please, go ahead.

13 A At one point we talked about having a
14 pilot to just have single judge institutions when
15 we were so slammed with work, so we certainly knew
16 we could go down to even one judge, and we
17 certainly do that on some of our interlocutory
18 work; we'll send out -- you know -- an order as a
19 single judge too.

20 Q Was that the case in 2018?

21 A We certainly could -- yes -- do that.

22 We weren't as slammed in 2018 -- if -- I'm trying

1 to remember -- we had a good amount of work then,
2 but probably had a better handle on things.

3 Q And back in 2018, do you think that was
4 widely known among APJ's?

5 A That you could issue a decision on
6 institution with less than three judges?

7 Q Yes.

8 A Yes; that was known, yes.

9 Q Okay. Finally, I'm going to take you
10 back to that May 30th conversation you had with
11 Mr. Weidenfeller and Mr. Fitzpatrick, remember
12 that?

13 A Yes.

14 Q As a result of that, did anything go
15 into Mr. Fitzpatrick's record?

16 A No.

17 Q Now, you have been involved in
18 counseling sessions -- you mentioned that in your
19 testimony before -- remember that?

20 A Yes.

21 Q To your understanding, was this a
22 counseling session?

1 A Yes -- I mean --

2 Q Thank you. No further --

3 A -- I'm sorry.

4 Q -- That's okay.

5 A There was a consequence given to Judge
6 Fitzpatrick, but it was counseling, yes. We
7 didn't -- nothing from me went into the file.

8 Q Okay. Thank you very much, nothing
9 further.

10 A Okay.

11 JUDGE NIEDRICK: Okay. Judge Mitchell,
12 it was at the May 30th meeting that he was
13 reassigned, correct?

14 THE WITNESS: Yes.

15 JUDGE NIEDRICK: So, I would say that's
16 a little bit more than a counseling session,
17 wouldn't you?

18 THE WITNESS: Well certainly, that's --
19 yeah -- I mean -- in terms of -- yeah -- his
20 assignments changed, but certainly no -- there's
21 nothing in his file that would really discuss that
22 or -- you know --

1 JUDGE NIEDRICK: Do you consider the --
2 sort of -- removing him from the AIA cases a
3 punishment?

4 THE WITNESS: -- Yeah -- I mean -- that
5 would have been -- certainly in Judge
6 Fitzpatrick's mind it was --

7 JUDGE NIEDRICK: But, I'm talking about
8 in your mind.

9 THE WITNESS: -- Yeah -- I mean -- yes
10 -- if you want to do -- I mean -- to have the
11 availability to do the jurisdiction that you would
12 like -- you know -- permitting that we have the
13 work for you to do in that particular area -- is
14 something that judges would want, yes; and to be
15 told "No, you can't do a particular jurisdiction"
16 -- yeah -- would be -- could certainly be
17 considered -- you know -- not what you would want
18 to have happen.

19 JUDGE NIEDRICK: Is it commonplace at
20 the PTO for second and third level supervisors to
21 take a punishment against somebody or issue a
22 counseling against someone without the input of

1 the first level supervisor?

2 THE WITNESS: I don't -- I'm not sure if
3 that is common because I'm not as familiar with
4 other people -- you know -- so I don't know. I
5 mean -- it would -- you know -- like I said -- I
6 would like to be in the loop on things and this
7 decision was made and I wasn't, but I don't know.
8 I'm sorry, I don't have the answer to know because
9 I haven't been in other positions at the PTO to
10 kind of know "Hey, this is how it's done in the
11 court" or not.

12 JUDGE NIEDRICK: Has this ever happened
13 before or since? Have you ever had an APJ that
14 you were managing as a first line supervisor where
15 this sort of thing happened where upper management
16 took an action against them -- changing what they
17 were doing -- to the extent where you and the APJ
18 would consider a punishment without consulting
19 with you and getting your input prior to making
20 that decision? Has that happened before or has it
21 happened since?

22 THE WITNESS: No.

1 JUDGE NIEDRICK: Okay. Are you aware of
2 that happening with any other APJ's?

3 THE WITNESS: No, not that I'm aware of.

4 JUDGE NIEDRICK: Okay. In sort of
5 looking at the different documents that Mr.
6 Horrigan went over with you -- the target decision
7 -- sort of discussing -- I guess -- the
8 precedential or non-precedential effect of the
9 vote that occurred and discussing that in a
10 decision versus the issue in Nike relating to due
11 process -- do you see a difference between those
12 two issues with regard to your conclusion that
13 they involve deliberative process?

14 THE WITNESS: I think to the degree that
15 they do, yes; because I think -- you know --
16 understanding what deliberative process is for, it
17 seems to me that that vote on whether an opinion
18 should be precedential, that's just quintessential
19 deliberative process; where you want to protect
20 not the decision-maker but the people who are
21 giving information to that decision-maker -- you
22 want that to be a very-very fulsome discussion.

1 So, I would agree with you as far as applying
2 deliberative process -- so quintessential
3 deliberative -- what deliberative process is meant
4 to protect versus whether the panel is expanded or
5 not.

6 JUDGE NIEDRICK: Yeah, and I guess the
7 distinction -- for me looking at this -- and I'm
8 just trying to understand this and learn this
9 throughout -- this is not commonplace in the
10 practice that I've done -- where as a federal
11 prosecutor -- I haven't dealt with these types of
12 issues before. So, what I'm trying to understand
13 is, do you think that the deliberative process
14 privilege includes information that is a directive
15 to change your decision in a case, is that
16 protected under deliberative process? If I'm
17 being named administrative judge in this case and
18 someone who you don't -- as a party -- know is
19 involved in a case tells me to change my decision,
20 should that be protected under the deliberative
21 process?

22 THE WITNESS: The decision itself -- me

1 coming to you and saying "Hey, I need this taken
2 out" -- should that be protected? Is that what
3 you're asking?

4 JUDGE NIEDRICK: I'm going even further
5 than that in the example --

6 THE WITNESS: Okay.

7 JUDGE NIEDRICK: -- I'm changing my
8 decision in the case. I reach a conclusion, I'm
9 told by my supervisor "Change your conclusion" and
10 I'm supposed to issue a decision changing my
11 decision in a case without disclosing that I've
12 been told to do that. Is that --

13 THE WITNESS: You're talking about
14 changing your substantive decision?

15 JUDGE NIEDRICK: -- Yes.

16 THE WITNESS: Is that deliberative
17 process -- I mean -- I'm trying to think --
18 certainly the bread and butter of our decision --
19 we're dealing with patent ability. I have never
20 had anybody from upper management say "Hey, I
21 don't agree with your" -- you know -- "your
22 analysis under 102, change it". I mean -- that's

1 sort of -- as far -- in my view -- my independence
2 -- that's where it is at the core of that patent
3 ability decision. Some of what we kind of get
4 told by directives are really involving sort of
5 the penumbra -- sort of the procedural ways that
6 we handle things -- that to me -- I feel like the
7 political's really get that shot to say "This is
8 how we're going to go". I mean -- every time we
9 get a new director you get a little bit of
10 different emphasis and that's our process, that's
11 our executive branch of government -- you know --
12 I'm in this branch and not the judiciary which
13 would be a little -- certainly -- different and
14 more independent. So, that's my view. I don't
15 know -- I mean -- I think they have in some ways
16 the prerogative -- I would need a little bit more
17 on the hypothetical to know what I'm asked to
18 change -- but if we're talking about procedure --
19 which a lot of times we are on these directives --
20 I'm usually very fine to follow -- you know -- if
21 the director tells me "Hey, don't just do one
22 claim and one ground, I want you to address what

1 the patent owner says" because we get -- that
2 decision on institution is actually delegated to
3 us from the director. I'm fine if the director --
4 that's what the director feels like we should do
5 in decisions -- you know -- to move the ball
6 forward in a trial -- whether I agree or not --
7 because sometimes I might think "You know what, I
8 don't want to say too much because then they're
9 going to think I've decided one way or the other
10 and I don't necessarily want to push parties that
11 way". I can have a very different view, but I
12 respect the director gets to make that call --
13 that's how our system works on the executive
14 branch side. So, I'm not sure if that is helpful.

15 JUDGE NIEDRICK: Okay. Yeah, it's
16 helpful, but I guess in my sort of hypothetical --
17 this is kind of what I'm trying to understand is
18 -- by packing panels after you see what the
19 decision of the initial panel is, isn't that in
20 effect changing the decision without the parties
21 knowing it and having the ability to sort of
22 address it?

1 THE WITNESS: There is a decision -- and
2 I should've reviewed it -- it's in (inaudible)
3 where we actually -- I think the Federal Circuit
4 said you really can kind of pack the panels in a
5 sense and that's okay. I do think the management
6 that we have in place is very-very careful about
7 doing that, and certainly that has not happened
8 recently. You know -- it's such a fine line
9 between what can the director set as policy and --
10 you know -- how much independence the judges have
11 to sort of manage a case, and certainly for the
12 decision on institution -- because it's delegated
13 to us and can be removed -- I think the director
14 has a lot more say in what goes on there.

15 JUDGE NIEDRICK: Can I ask you if you're
16 familiar with the Arthrex decision that the
17 Federal Circuit issued?

18 THE WITNESS: Yes.

19 JUDGE NIEDRICK: My understanding from
20 what the Federal Circuit looked at was that you as
21 APJ's were principal officers, that's the
22 determination that they made; that in essence

1 there wasn't a political impact on your decisions
2 and that was one of the problems with Arthrex,
3 that for the Patent and Trademark Office you have
4 all these people who sort of weren't
5 presidentially appointed and senate confirmed
6 individuals making final decisions for the Agency;
7 and that's the way the Federal Circuit looked at
8 the APJ position. So, I guess -- and Arthrex came
9 out -- I'm not sure -- that was sort of after all
10 of this -- but clearly the court felt that you all
11 were the final decision-makers and so given that,
12 the idea that a political appointee at that time
13 -- and again I understand the landscape has
14 changed here -- but at that time it seems as
15 though it would've been a reasonable position to
16 say "My decision shouldn't be impacted in this
17 way, in packing the Board or changing the decision
18 after the panel had made a determination on a
19 case"; and I'm trying to understand the process
20 and whether that would be reasonable. You said
21 "it's a fine line between policy and sort of
22 decision making here" --

1 THE WITNESS: Mm-hmm, yes.

2 JUDGE NIEDRICK: -- And I'm wondering
3 whether you think that was a reasonable
4 conclusion? Was this a reasonable fight that
5 Judge Fitzpatrick was sort of making -- the stand
6 that he was making -- at that time?

7 THE WITNESS: I think when you look at
8 Arthrex -- I mean -- there's a difference between
9 -- I think -- our final written decisions on cases
10 and our decisions on appeals that are final --
11 agency decisions and the decisions on institution,
12 which would have involved the SAS issue because
13 that is delegated by the director; but certainly
14 on the final decision, it's a three judge panel.
15 I do think when we're talking about patent ability
16 -- substance -- although certainly Director Iancu
17 got very involved with 101, which is statutory
18 subject matter and how we would treat it because
19 frankly it's kind of a mess in the courts and he
20 was trying to make it as cohesive as we could from
21 a agency, trying to take a stab at doing that; so
22 he got into more substance that way in sort of

1 applying cases. But generally, when we're talking
2 about patent ability, nobody steps in to tell a
3 panel how to rule one way or the other; I haven't
4 seen that in my tenure at the Board. To me,
5 that's the heart of what we do. I feel like there
6 are other issues that -- procedure -- how we
7 handle some of the stuff that we do -- that I do
8 feel like it really is the political's purview to
9 direct the agency. I mean -- certainly the
10 political appointee is talking to Patents and
11 Patents can sometimes shift what they're doing to
12 address stakeholder interactions that the director
13 is having, and sort of making our agency more
14 responsive to people who are out there -- you know
15 -- on both sides of beat; whether you're a patent
16 owner or you're a petitioner -- you know --
17 somebody who's trying to break into an area or
18 somebody who's holding all the patents. Those are
19 kind of the political things that I feel like
20 that's the director's purview and that's what it
21 should be. I don't feel like director's do
22 interfere in those nitty-gritty patent ability

1 issues which are at the heart of what we do; even
2 though -- and that's where -- the courts are
3 talking about "you're a principal law officer".
4 We are -- I mean -- the director's not coming in
5 to tell me I got the 102 wrong. I mean -- there
6 can be director review of that where the director
7 disagrees and overturns me, fine; but does not
8 come in - I've never seen that happen where we get
9 in the substance of patent ability and somebody
10 said "Hey, you just got it wrong". I mean -
11 somebody may think we did and say "Hey, the panel
12 might want to think about X, Y and Z", but it's
13 still the panel's decision. That's how it is with
14 our ARC -- our AIA review committee -- they make
15 suggestions that you can take or leave and
16 certainly I value their input because I want to
17 make sure I'm not saying something in an opinion
18 that I'm so myopic on the opinion that I miss the
19 forest for the trees and I'm really saying
20 something that's the opposite of my colleagues,
21 and it makes the Board look like we're
22 inconsistent; and frankly, with the review

1 committee, we've stayed more consistent -- I would
2 say -- than the Federal Circuit, which we pride
3 ourselves -- you know -- that we have a lot of
4 judges and we stay very-very consistent. So, I
5 don't know if that fully answers your question?

6 JUDGE NIEDRICK: That helps. Again, I'm
7 just trying to understand it. Let me ask you
8 this. Specifically with the sort of issues that
9 we have in this case -- the issue of whether
10 parties -- litigants -- should be notified that
11 the panel is being expanded or changed or
12 unexpanded, do you see that as a sort of
13 procedural deliberative process issue that the
14 agency has no obligation whatsoever to disclose or
15 do you see that as a due process issue that the
16 litigants should at least know who's on the panel
17 -- who's been designated -- if it's expanded, they
18 should be told it's expanded -- I don't know if
19 you can answer that question, but I just want to
20 sort of generally understand what your view is on
21 that?

22 THE WITNESS: I can answer kind of

1 personally -- and I don't -- you know -- know what
2 the chief would say -- but I feel like until a
3 decision comes down, I'm not sure if the parties
4 really have a due process -- you know -- foot in
5 the door -- to say how -- "I want to know about
6 the internal workings". I feel like once a
7 decision comes down, it's going to show you there
8 is an expanded panel because you're going to have
9 a bunch more judges on the line that says this is
10 who decided. I feel like if it's expanded or not
11 expanded -- you know -- unexpanded -- and no
12 decision has gone out, I don't see why that would
13 necessarily be for public consumption because what
14 rights have really been impacted if we've made no
15 decision with that expanded panel if we just
16 decided "Hey, we expanded, but now we're not and
17 no decision was made", I don't -- I feel like
18 there's always -- I mean -- the old litigator in
19 me is always worried about waiving deliberative
20 process privilege and certainly as an agency we
21 get a lot of foyer requests from the media, from
22 individuals and you don't want to open that door

1 to have people with so much of a view of your
2 internal workings that we're bound up and we
3 really can't do what we need to do to take care of
4 cases and move cases; and I don't think the impact
5 and the intent of what we're doing is to hide the
6 ball from the public, it's just we need to be
7 nimble and maneuver and -- to me -- until a
8 decision is made, there's no impact on the
9 parties. So, that would be my answer; that you
10 don't want people sort of scrutinizing everything
11 that we do that we feel like we can't really
12 maneuver without worrying about "Wow, how is this
13 going to sell to this particular stakeholder group
14 or that one".

15 JUDGE NIEDRICK: Why identify judges at
16 all then in cases? Why not just say "Panel Z is
17 going to hear this"?

18 THE WITNESS: We have -- we can do that
19 with per curium -- I mean -- you know who the
20 panel is, but we don't really say who will write
21 it. If it's sort of one of those -- I mean -- we
22 have different reasons to write per curium -- but

1 we can certainly do that. I feel like though,
2 because we are those principal officers, we are
3 making those nitty-gritty patent ability decisions
4 -- you know -- you want people to put their names
5 on it -- you know -- you want people to stand
6 behind their work; and I feel like all judges --
7 you want your name on an opinion that you have
8 authored or that you agree with.

9 JUDGE NIEDRICK: I'm wondering -- it
10 seems as though a lot of the issues in this case
11 have arised from Judge Fitzpatrick not following
12 guidance, and that's been the concern and the
13 talking points from the May 30th summary, it seems
14 as though the issue was him not following
15 guidance; and I'm wondering why the agency calls
16 it guidance if it's directives? If the issue is
17 if you don't follow this guidance then you're
18 disobeying my directive and you will be punished,
19 it seems to me that in order for it to be clear,
20 the agency shouldn't refer to this information as
21 guidance; it should be directives. Why do they
22 call it guidance if you're required to do it?

1 THE WITNESS: I'm -- I don't have an
2 answer -- I mean -- I think that's probably
3 historic with the agency. I can tell you a few
4 asked and certainly we have judges that have --
5 what I call -- you know -- their in-house -- they
6 grew up in the Patent Office -- they come from the
7 Patent Corps. The would tell you "If I get
8 guidance from the director, I need to follow that
9 guidance" -- I mean -- that's understood in our
10 culture --

11 JUDGE NIEDRICK: Sure.

12 THE WITNESS: -- That when political put
13 that into guidance, that's something that you are
14 mandated to follow. So, that's maybe more
15 cultural to us and I know it's maybe somewhat hard
16 because a lot of our judges didn't grow up in the
17 corps of -- the examination corps -- you know --
18 when you come from the outside, the government's
19 always a little weird and different; so -- but I
20 feel like that's just our culture is it's called
21 guidance, but everybody knows when that director
22 puts pen to paper and says "This is what I want

1 the agency to do", that's what we do.

2 JUDGE NIEDRICK: Okay. I don't think I
3 have anything else. Any follow-up questions, Mr.
4 Kappers?

5 MR. KAPPERS: Just a few.

6 REDIRECT EXAMINATION

7 BY MR. KAPPERS:

8 Q Judge Mitchell, Mr. Horrigan had asked
9 you about the deliberative process and
10 confidentiality in two cases. It was the Target
11 cases and the Nike case; do you remember that?

12 A Yes.

13 Q And I just want to go through the
14 timing. So, in Target that was in September 2017,
15 is that right?

16 A I believe so.

17 Q And how many written reviews would Judge
18 Fitzpatrick have received after September 2017?

19 A Four, I believe; if I'm counting right.

20 Q Would it be the -- maybe it's two --
21 it's the October 2017 and then the -- the fiscal
22 year end review and then the April mid-year review

1 -- does that sound right?

2 A Yes. I'm sorry, I thought you were
3 talking til present -- oh, you mean --

4 Q No, I'm sorry --

5 A -- I'm sorry -- yeah.

6 Q -- In between September 2017 and the May
7 30, 2018 call -- okay. And the deliberative
8 process confidentiality issue -- that didn't make
9 it into his written reviews, right?

10 A No, it did not.

11 Q And was it discussed during the May 30,
12 2018 call with Judge Weidenfeller?

13 A I'm sorry -- what - no-no.

14 Q Alright. And now, in the Nike IPR, that
15 -- you had passed on some proposed changes in
16 April 2018, right?

17 A I believe so.

18 Q And there would have been one review
19 after that, the April mid-year review; does that
20 sound right?

21 A Yes.

22 Q And did the confidential deliberative

1 process issue -- with respect to the Nike IPR --
2 get discussed on the May 30, 2018 call with Judge
3 Weidenfeller?

4 A I don't believe so.

5 MR. KAPPERS: Okay. Thank you, that's
6 it for me.

7 JUDGE NIEDRICK: Okay. Mr. Horrigan?

8 MR. HARRIGAN: Yeah, just one question.

9 RE CROSS EXAMINATION

10 BY MR. HARRIGAN:

11 Q So, we talked about the end of year 17',
12 performance appraisal of the mid-year for 18', you
13 did not mention this in either of those; why is
14 that?

15 A It had already been dealt with, so I --

16 Q Thank you for that.

17 A Okay.

18 JUDGE NIEDRICK: Thank you very much,
19 Judge Mitchell, for your testimony. Please don't
20 discuss it with anyone. If you have any
21 questions, please contact Mr. Horrigan or Mr.
22 Kappers, okay.

1 THE WITNESS: Thank you.

2 JUDGE NIEDRICK: Thank you, and you can
3 go ahead and leave the meeting or I can go ahead
4 and remove you if you don't see the leave button.
5 There should be a little button on the --

6 THE WITNESS: I've got it.

7 JUDGE NIEDRICK: Okay. Alright, thank
8 you, have a good night.

9 THE WITNESS: Thanks, you too.

10 JUDGE NIEDRICK: Okay. So, I don't
11 think we're going to have time for our next
12 witness unless we go really late. Is it
13 Weidenfeller, is that who's going to be next, Mr.
14 Horrigan?

15 MR. HERRIGAN: That's correct.

16 JUDGE NIEDRICK: Okay. So, why don't we
17 pick up with him tomorrow morning at 8:30 and then
18 we'll go through the rest of these. Hopefully we
19 can finish tomorrow. Given the way we're moving,
20 I have a feeling it might be a little slower, we
21 might need an additional day; so we'll have to
22 talk about that, depending on how things go

1 tomorrow. I don't think I have anything else.
2 Any questions or concerns, comments before we go
3 off the record and adjourn for the day? Mr.
4 Horrigan?

5 MR. HERRIGAN: No.

6 JUDGE NIEDRICK: Okay. Mr. Suarez,
7 Kappers? Mr. Abramic, any questions, concerns,
8 comments? Okay.

9 MR. SUAREZ: No, Your Honor.

10 JUDGE NIEDRICK: Great. Ms. Dawson, do
11 you need anything before we go off.

12 COURT REPORTER: No, most of the
13 verifications that I have, I can actually look up
14 through the Patent -- they've mentioned people who
15 work there -- employees -- so, I don't need to
16 keep you for that.

17 JUDGE NIEDRICK: We'll see you all
18 tomorrow at 8:30 a.m. Thank you, have a good
19 night.

20 (Whereupon, at 5:39 p.m., the
21 HEARING was continued.)

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14 /s/Carleton J. Anderson, III

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ERRATA SHEET FOR THE DEPOSITION OF

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1 To the Witness:

2 Please note any errors and the
3 corrections thereof, on this errata sheet. Any
4 change or correction should have a reason. It may
5 be a general reason, such as "To correct
6 stenographic error," or "To clarify the record,"
7 or "To conform with the facts." Once you have
8 completed the sheet, signed and dated it, return
9 the sheet to your attorney, not to the court
10 reporting agency. Attorneys should exchange
11 errata sheets among the parties.

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UNITED STATES OF AMERICA
MERIT SYSTEMS PROTECTION BOARD
WASHINGTON REGIONAL OFFICE

MICHAEL FITZPATRICK v. U.S. DEPARTMENT OF COMMERCE

Case No. DC-1221-21-0423-W-1

HEARING (VOL. 2)

BEFORE:

ANDREW NIEDRICK
Administrative Law Judge

Alexandria, Virginia

Tuesday, May 12, 2022

1 PARTICIPANTS:

2 On behalf of Appellant:

3 JOHN L. ABRAMIC, ESQUIRE
4 ROBERT KAPPERS, ESQUIRE
5 Steptoe & Johnson LLP
6 227 West Monroe Street, Suite 4700
7 Chicago, Illinois 60606
8 (312) 577-1300

9 CHRISTOPHER A. SUAREZ, ESQUIRE
10 Steptoe & Johnson LLP
11 1330 Connecticut Avenue, NW.
12 Washington, D.C. 20036
13 (202) 429-8131

14 On behalf of Agency:

15 WILLIAM HARRIGAN, ESQUIRE
16 U.S. Patent and Trademark Office
17 U.S. Department of Commerce
18 600 Dulany Street
19 Alexandria, Virginia 22314
20 (571) 272-3000

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C O N T E N T S

WITNESS:	DIRECT	CROSS	REDIRECT	RECROSS
Scott Weidenfeller	7	112	168	170
Scott Boalick	178	257	370	375

* * * * *

P R O C E E D I N G S

(8:31 a.m.)

JUDGE NIEDRICK: Good morning, everyone.

We are back on the record in the appeal of Michael Fitzpatrick versus the Department of Commerce.

The MSPB Docket number for the case is

DC-1221-21-0423-W1-I1. I'm Administrative Judge

Andrew Niedrick. I've been assigned by the Board

to handle this appeal. We had a first date of

hearing yesterday. We went from about 8:45 till

almost 6:00 p.m. Eastern and we're continuing on

today. The agency's representative, William

Horrigan, is on the call this morning along with

the appellant's representatives of record, John

Abramic, Robert Kappers, and Christopher Suarez.

Our court reporter is also back with us, Shandra

Dawson, and of course, the Appellant Judge

Fitzpatrick is also on the call.

So, we're going to jump right in. It's

8:30 a.m. on May 12 and we're going to hear from

the appellant's witness this morning, Scott

Weidenfeller and I'll go ahead and admit Mr.

1 Weidenfeller into the hearing. Hi, Judge

2 Weidenfeller, this is Judge Niedrick. Can you

3 hear me?

4 THE WITNESS: Yes, I can. Thank you.

5 Can you hear me?

6 JUDGE NIEDRICK: Yes, I can.

7 THE WITNESS: Great.

8 JUDGE NIEDRICK: Perfect. Thank you for
9 coming today to testify. I appreciate your
10 participation. Do you have any objection to
11 swearing in oath?

12 THE WITNESS: No.

13 JUDGE NIEDRICK: Okay. Please raise
14 your right hand. Do you solemnly swear that the
15 testimony you're about to give is the truth, the
16 whole truth and nothing but the truth so help you
17 God?

18 THE WITNESS: I do.

19 Whereupon,

20 SCOTT WEIDENFELLER

21 was called as a witness and, having been first

22 duly sworn, was examined and testified as follows:

1 JUDGE NIEDRICK: Good, and can you
2 please give me your first and last names for the
3 record, spell them?

4 THE WITNESS: Scott, S-C-O-T-T,
5 Weidenfeller, W-E-I-D-E-N-F-E-L-L-E-R.

6 JUDGE NIEDRICK: Thank you. And, as you
7 can see we have a number of video windows on your
8 screen. Shandra Morell, that's Ms. Dawson. She's
9 our court reporter. Mr. Horrigan, I'm sure
10 you're familiar with him. He's the agency's
11 representative. And then we have John Abramic,
12 Robert Kappers and Christopher Suarez. They're
13 Judge Fitzpatrick's representatives. And then you
14 can see Judge Fitzpatrick as well. The little
15 phone icon that you see down there is a back up
16 for Ms. Dawson for reporting service. So, if
17 there's an objection while you're testifying
18 please hold your response, stop testifying. I'll
19 rule on the objection and then instruct you on how
20 to proceed. Okay?

21 THE WITNESS: Okay.

22 JUDGE NIEDRICK: Mr. Abramic, or excuse

1 me. We're going to go first with Mr. Horrigan,
2 your agency witness. Okay, Mr. Horrigan, your
3 witness.

4 MR. HARRIGAN: Thank you.

5 DIRECT EXAMINATION

6 BY MR. HARRIGAN:

7 Q Good morning, Mr. Weidenfeller. Thank
8 you for joining us.

9 A Good morning.

10 Q By whom are you employed?

11 A Covington and Burling, LLP.

12 Q And that's a law firm?

13 A Yes.

14 Q How long have you been with them?

15 A Since October.

16 Q And what do you do for them?

17 A I am a partner here. I do patent
18 litigation mostly.

19 Q Okay. And you previously worked at the
20 USPTO, is that right?

21 A That's right.

22 Q When did you begin working at the UPSTO?

1 A 2009.

2 Q And what position did you hold at that
3 time?

4 A I started out as an associate solicitor
5 in the solicitor's office.

6 Q Okay. What is the solicitor's office?

7 A The solicitor's office is part of the
8 office of the general counsel at the USPTO. It
9 handles mostly legal advice to the director and
10 defends agency decisions in the courts.

11 Q And in particular which court?

12 A Primarily in the federal circuit but
13 also in district courts and in the supreme court.

14 Q And so what were your duties as an
15 associate solicitor?

16 A I would write mostly red briefs so
17 briefs for the appellee and appeals from board
18 decisions. I also would advise the director on
19 issues of intellectual property and advise the
20 patents business unit as well.

21 Q And how long were you in that position?

22 A I was an associate solicitor for about

1 four years.

2 Q And what was your next position?

3 A I then became senior counsel for patent
4 law and litigation also within the solicitor's
5 office.

6 Q And were your duties different than you
7 have just described?

8 A There I spent a lot more time overseeing
9 the work of others and it was shortly after the
10 Leahy Smith America Invents Act or AIA was enacted
11 and put into place and we had the right to
12 intervene in appeals from board decisions in
13 trials under the America Invents Act and we did a
14 lot of -- a lot of my work was in deciding in
15 which cases to intervene and if we did intervene
16 handling those cases.

17 Q Okay. And how long were you in that
18 position?

19 A Also about four years.

20 Q All right. And then you became a vice
21 chief Judge?

22 A Yes.

1 Q How did that happen?

2 A I applied through USA Jobs. I had
3 talked to Scott Bolic, who at the time was the
4 deputy chief Judge, about the opportunity they
5 were creating new vice chief Judge positions to
6 oversee the APJs in the board and I thought it
7 sounded like a good opportunity to use my skills
8 in a different venue at the PTO.

9 Q And how many years were you a vice chief
10 Judge?

11 A About four and a half.

12 Q Okay. Did you come to the USPTO with
13 any other intellectual property experience that we
14 haven't mentioned yet?

15 A Yes. I was a law clerk for Judge Dike
16 on the federal circuit for a year and then I was
17 an associate here at Covington for about four and
18 a half years doing mostly patent infringement
19 litigation.

20 Q And so how many years of experience
21 would you say you have practicing in the field of
22 intellectual property?

1 A About 19.

2 Q The USPTO was organized into business
3 units, correct?

4 A Yes.

5 Q What is a business unit?

6 A A business unit is a component of the
7 USPTO that handles a particular area. One example
8 is the PTAB is a business unit. Another is the
9 Office of the General Counsel. There's the Chief
10 Financial Officer and other offices that handle
11 the day-to-day operations of the USPTO.

12 Q Okay, now we're going to go to our first
13 document. I believe you have those available to
14 you.

15 A Yes.

16 Q If we can open up Tab six.

17 A Okay.

18 Q And go to page 442.

19 A 442. Okay.

20 Q And are you familiar with that?

21 A Yes.

22 Q That's a org chart for the PTAB?

1 A Yes, it is.

2 Q And is it roughly accurate as to the
3 PTAB was in 2018?

4 A Roughly accurate. There were actually
5 five vice chief Judges, not two --

6 Q Okay.

7 A -- at the time.

8 Q So, overseeing the PTAB is the chief
9 Judge, correct?

10 A Yes.

11 Q And then underneath that person is
12 deputy chief Judge.

13 A Mm-hmm.

14 Q And then we see vice chief Judges,
15 correct?

16 A That's right.

17 Q Which you were.

18 A Yes.

19 Q And what are the duties of a vice chief
20 Judge?

21 A The vice chief Judges were the second
22 line supervisors for about a quarter of the

1 Board's Judges and also worked as an executive
2 team to set policy with the chief Judge.

3 Q Okay and if we could scroll down, we're
4 still in Tab six, to go to page 443 --

5 A Okay.

6 Q -- just the next page and you see,
7 again, more org chart, so the vice chief Judge sit
8 over lead Judges, is that right?

9 A Yes.

10 Q Okay. And what are the duties of a lead
11 Judge?

12 A The lead Judges are the first line
13 supervisors for APJs and they also tend to get
14 involved in various projects to support the
15 mission of the Board.

16 Q And when you were a vice chief Judge how
17 many lead Judges would you have at any one time
18 under you?

19 A Six.

20 Q And one of those was Susan Mitchell, is
21 that right?

22 A That's right.

1 Q How many APJs would a lead Judge
2 typically be supervising during that 2018 say
3 timeframe?

4 A It varied but it would generally be
5 between eight and 12 or maybe 13 at the most.

6 Q Okay, so in the 2018 time period, you
7 served as a second level supervisor for
8 approximately APJs?

9 A It would have been around 60, 65.

10 Q Okay. How are APJs hired?

11 A APJs are hired through the typical USA
12 Jobs process. They submit an application, there
13 are a series of interview and ultimately the chief
14 Judge will make a list of possible Judges to
15 select, recommend them to the director who then
16 makes recommendations to the Secretary of
17 Commerce.

18 Q Okay. Let's open up Tab 26, page 37.
19 Are you familiar with this document?

20 A Yes.

21 Q So, why don't you explain your
22 understanding of the legal authority to hire PTAB

1 Judges.

2 A So, it's there in Section 5d Public Law
3 110.313 and that is the legal authority that
4 permits the Secretary of Commerce to appoint APJs
5 on the recommendation of the director.

6 Q And are you aware that that public law
7 made changes to 35 USC6, correct?

8 A Yes.

9 Q Okay. Are you familiar with 35 USC3?

10 A Yes.

11 Q What does that concern?

12 A It generally concerns the authorities of
13 the USPTO.

14 Q Okay. Are you familiar with 35 USC3?

15 A Yes.

16 Q Okay, and so let me read that for the
17 record. 3C continued applicability of Title 5
18 officers and employees of the office shall be
19 subject to the provisions of Title 5 relating to
20 federal employees. What do you understand that
21 means?

22 A That APJs, like other employees of the

1 government, have the protections and
2 responsibilities under Title 5 of the US Code.

3 Q Does the US --

4 JUDGE NIEDRICK: Mr. Horrigan, can you
5 just give me the site again? What page you're ON?

6 MR. HARRIGAN: Of course. You're
7 talking the document?

8 JUDGE NIEDRICK: Yes, the document.

9 MR. HARRIGAN: Yes, Tab 26, page 37.

10 JUDGE NIEDRICK: Thank you.

11 MR. HARRIGAN: You're welcome.

12 BY MR. HARRIGAN:

13 Q Does the USPO publish human resources
14 policies?

15 A Yes.

16 Q Are those policies applicable to APJs?

17 A Yes.

18 Q Are employees of the USPTO expected to
19 comply with direction from their supervisors?

20 A Yes.

21 Q Are APJs any different in that regard?

22 A No.

1 Q Are supervisors expected to comply with
2 direction from their managers?

3 A Yes.

4 Q Are they all subject to the direction of
5 the Director of the USPTO?

6 A Yes, they are.

7 Q Is there anything about APJs that makes
8 them different in that regard?

9 A Not in that regard, no.

10 Q Okay. When you were there did the PTAB
11 employ people who were not APJs?

12 A Yes.

13 Q What sorts of non-APJs worked at PTAB?

14 A It was there were a lot of paralegals
15 who supported the Judges and other people in what
16 we called the Board Operations Division that
17 handled things like hearings and getting cases
18 paneled to -- Judges paneled to cases and matters
19 like that, the sort of day-to-day operations of a
20 board or a court.

21 Q From the perspective of a PTAB manager,
22 were APJs managed any differently than other USPTO

1 employees?

2 A No.

3 Q All right, so let me, I think we have
4 Tab 6 up and let me take you to page 423.

5 A Okay.

6 Q What do you understand that to be?

7 A This looks like the performance
8 appraisal plan or PAP for Judge Fitzpatrick.

9 Q And which year was this?

10 A This is FY17.

11 Q Why don't you explain to the
12 Administrative Judge what a PAP is.

13 A A PAP is the performance appraisal plan
14 that sets forth the requirements of the job and
15 how a Judge or other USPTO employee will be rated
16 at the end of the year based on the requirements
17 of the job.

18 Q Do all USPTO employees have a PAP?

19 A Yes.

20 Q I think we've already covered this, but
21 just to confirm, the signatures at the bottom, one
22 of them is yours, correct?

1 A Yes.

2 Q And what does it signify?

3 A It shows that I approved the performance
4 plan as the second line supervisor.

5 Q Okay, then we're still in Tab 6, if we
6 could go to page 440.

7 A Okay.

8 Q Does this show the elements of the APJ
9 PAP?

10 A Yes, it does.

11 Q Okay. So, to be clear, are APJs
12 appointed under Article 3 of the Constitution?

13 A No.

14 Q Are they nominated by the President?

15 A No.

16 Q Are they confirmed by the Senate?

17 A No.

18 Q Are they supervised like other USPTO
19 employees?

20 A Yes.

21 Q Are they disciplined like other USPTO
22 employees?

1 A Yes.

2 Q Under the same legal authority?

3 A Yes.

4 Q All right. So, with that context, what
5 does the phrase judicial independence mean to you?

6 A Judicial independence is in that context
7 would be the Judges are expected to follow the
8 limitations of the PAP, which tells them to follow
9 law and policy. Within that, applying fact --
10 applying law to fact has a lot of flexibility and
11 Judges are given the opportunity to apply their
12 independence in applying law to fact but they do
13 have to follow law, controlling law and governing
14 policy at the Agency.

15 Q Would you describe the intellectual
16 property field to be well settled and stable?

17 A No.

18 Q How would you describe it?

19 A It's a constantly changing field of law.
20 The Supreme Court has taken quite a few cases in
21 recent years. The federal circuit is issuing new
22 decisions all the time and there are frequently

1 changes in the governing law.

2 Q Are there legal interpretations to be
3 made in the course of the work at PTAB?

4 A Yes.

5 Q To what extent do novel fact patterns
6 and matters before the PTAB acquired creative
7 legal reasoning to resolve?

8 A To a great extent I would say.

9 Q How many presidentially appointed senate
10 confirmed officers are at the USPTO?

11 A One.

12 Q And who is that?

13 A The director and under Secretary of
14 Commerce for intellectual property.

15 Q What authority does the director have to
16 set USPTO policy?

17 A The director has authority by statute to
18 set the policy for the USPTO.

19 Q Are you familiar with 35 USC3a2a which
20 states the director shall be responsible for
21 providing policy direction and management
22 supervision for the office and for the issuance of

1 patents and the registration of trademarks?

2 A Yes.

3 Q What do you understand the scope of the
4 director's authority then under that statute?

5 A The director has plenary authority to
6 set policy for the agency obviously within the
7 legal boundaries set by law.

8 Q And to your understanding how does that
9 apply to patent law in particular?

10 A There are numerous areas that are the
11 law is unsettled or potentially unclear and the
12 director can set policy within those areas.

13 Q How does the director go about
14 exercising his authority?

15 A There are a number of ways. First
16 there's regulation the director can promulgate
17 rules. The director also can issue policy
18 memoranda and the director can advise internally
19 provide guidance on how policies and the law
20 should be interpreted through conversations with
21 the board executive team.

22 Q And during your time as a vice chief

1 Judge did the director, in fact, do that?

2 A Yes.

3 Q How would this information get down to
4 an individual APJ?

5 A If something is promulgated in writing
6 that will be provided to APJs at regular training.
7 There also if it's sort of less formal guidance on
8 an interpretation in a particular case, the board
9 executive team might convey that either by email
10 or by phone to the relevant panel.

11 Q What happens if an individual APJ does
12 not agree with the director on a particular IP
13 issue?

14 A They are expected to follow the
15 director's guidance.

16 Q Now referring now to the chief Judge of
17 the board, does the chief Judge set policy?

18 A Yes, the chief Judge has been delegated
19 the authority to set some policy by the director.

20 Q And what sorts of things might the chief
21 Judge set policy on?

22 A The handling of matters before the board

1 itself. For example, there are standard operating
2 procedures that are promulgated by the chief
3 Judge. They typically are approved by the
4 director. They are promulgated by the chief
5 Judge.

6 Q What were your expectations for how APJs
7 were to respond to policy director from the chief
8 Judge?

9 A They were expected to follow it.

10 Q All right. We have the appellant's PAP
11 up at Tab 6. I'd like to go back to page 424 in
12 Tab 6.

13 A Okay.

14 Q And what do you understand we're looking
15 at here?

16 A This is part of the PAP. It is one of
17 the elements, the quality element of the PAP.

18 Q All right, so I'm looking at Item 2 and
19 I see the paragraph that starts written decisions.
20 Do you see that?

21 A Yes.

22 Q Could you read the middle sentence of

1 that paragraph?

2 A Decisions are consistent with binding
3 legal authority and written guidance applicable to
4 PTAB proceedings issued by the director or the
5 director's delegate.

6 Q As a former manager at the PTAB, what
7 does that mean to you?

8 A That means as part of the performance of
9 their job, APJs are expected to issue decisions
10 that are consistent with binding legal authority
11 and written guidance by the director or her
12 delegate.

13 Q How long had you known the appellant?

14 A I'd first came to know him when I
15 started at the Board, which would have been in
16 2017.

17 Q And he was two levels below you while
18 you were vice chief Judge, is that right?

19 A Yes.

20 Q Okay. As the second level supervisor
21 how much contact did you have with the appellant?

22 A Not a lot. Typically the APJs would

1 raise issues with the lead Judge who might raise
2 them with me, but typically the interaction was
3 minor as far as supervisory direction directly
4 from me to an APJ.

5 Q Does that also apply to Mr. Fitzpatrick?

6 A Yes.

7 Q Now the matters that you would consult
8 with an APJ and, in particular, Mr. Fitzpatrick,
9 were they like interpretations of law or
10 administrative matters or how would you describe
11 it?

12 A Well as his second line supervisor it
13 would be administrative matters, you know, making
14 sure that his work environment was acceptable and
15 things like that. I did work on a program that we
16 called management review where substantive matters
17 would be raised by all the Judges, not just the
18 Judges in my division, but all the Judges for
19 substantive guidance on legal issues and I would
20 interact with the Judges in that capacity as well.

21 Q Okay. Do you recall interacting with
22 Mr. Fitzpatrick in that capacity?

1 A Yes.

2 Q Okay. Prior to May 2018, did you have
3 an opinion on the appellant's competence as an
4 APJ?

5 A Yes, I -- as we saw from the PAP that
6 I'd signed that he was given a commendable rating
7 so I thought he was a commendable Judge.

8 Q Okay. Were you aware at that time of
9 any concerns with respect to the appellant?

10 A I had heard some concerns and there had
11 been some back and forth with various panels about
12 separate opinions he was writing or his
13 interactions with his colleagues.

14 Q And how would that come to your
15 attention?

16 A Oftentimes we would -- something would
17 be -- if he was writing -- for example, if he was
18 writing a separate opinion that would be raised to
19 management review so we would notice that and
20 sometimes I would interact with the panel and hear
21 things about how they were receiving his separate
22 opinions.

1 MR. HERRIGAN: So, Administrative
2 Judge, I was going to go his Fiscal Year 17 PAP,
3 his performance appraisal and get that into
4 evidence but I think it's already in evidence in
5 one of the appellant's documents.

6 JUDGE NIEDRICK: I think it is, too.

7 MR. HERRIGAN: All right, so I'll just
8 skip over that.

9 BY MR. HERRIGAN:

10 Q Okay, so, in your four years as vice
11 chief Judge, did you have occasion to speak with
12 PTAB supervisors and managers?

13 A Yes, quite frequently.

14 Q Did these discussions sometimes concern
15 the appellant?

16 A Sometimes.

17 Q Based on those discussions did you
18 understand the appellant has a reputation among
19 PTAB supervisors and managers?

20 A I think that he had a reputation as
21 being perhaps a little more difficult than some
22 APJs as far as interactions with his colleagues.

1 Q And were you aware of this back in the
2 2018 timeframe?

3 A Yes.

4 Q And to what extent did your own opinion
5 align with that reputation?

6 A From what I'd heard from other -- from
7 his colleagues on other panels I shared that view.

8 Q Now one of the benefits of going to that
9 2017 performance appraisal would be to note that
10 it was a good performance appraisal, right?

11 A Yes, commendable performance.

12 Q And you approved of that.

13 A Yes, and I approved it.

14 Q So how do you square your understanding
15 of the reputation and other things that you've
16 just talked about with the performance appraisal
17 you approved in 2017?

18 A I think that in 2017 I had heard a few
19 concerns and so he was rated as commendable as
20 opposed to outstanding. I understood your
21 question to be as of the early 2018 and I'd been
22 hearing more concerns from his panels, colleagues

1 on his panels.

2 Q All right and so I was thinking back
3 down to 2018, do you remember what was on the
4 plate of PTAB when you were the vice chief Judge?

5 A I don't recall. There's quite a few
6 issues that we would handle in day-to-day
7 business. I don't remember any specific issues
8 that were at the forefront at the time.

9 Q And how would you spend a typical day
10 back then?

11 A We would meet as an executive team at
12 least once a day and discuss the matters that were
13 at issues of the day. We would meet with the
14 director at least once a week and discuss matters
15 of importance to the agency and we would have
16 other meetings throughout the day as well and I
17 would handle management review responsibilities
18 would take a large part of my day by reviewing
19 draft decisions and discussing things with panels
20 as necessary.

21 Q You testified that you supervised around
22 60-65 APJs. How many matters might each of them

1 be handling at any one time?

2 A I don't know the specific number. I
3 would say it would be probably on the order of 10
4 to 20 at a time.

5 Q In an average day back then how many
6 times would your attention be drawn to issues
7 raised in those types of matters?

8 A Frequently. I would say at least a
9 dozen on a typical day.

10 Q In an average day back then how much of
11 your time was devoted to the doings of Michael
12 Fitzpatrick?

13 A Not very much in the scheme of things.

14 Q And how much time were you devoting to
15 the remand decision in the Nike IPR?

16 A None.

17 Q How concerned were you with the
18 resolution of that IPR?

19 A I was aware of concerns about the length
20 it was taking to issue the decision, that another
21 APJ on the panel raised to me and to others and
22 that was that was my really my only involvement

1 was concern about the timing, not about the
2 substance.

3 Q And what responsibility did you have for
4 the timing?

5 A I had no responsibility other than I
6 understood that the federal circuit was displeased
7 at certain remand decisions taking a long time and
8 from my days in the solicitor's office that was a
9 concern to be, but I had no involvement in it.

10 Q Okay. Do you recall having a
11 conversation with Mr. Fitzpatrick on May 30,
12 2018?

13 A Yes.

14 Q Okay. We'll get into the details in
15 just a bit but how did Mr. Fitzpatrick get on your
16 radar at that time?

17 A At that time there had been a draft
18 decision that was submitted to management review
19 and it had a separate opinion by Mr. Fitzpatrick
20 and I had asked the panel whether it could issue a
21 decision without that separate opinion, just a two
22 Judge decision without the separate opinion and

1 Mr. Fitzpatrick had said that he wanted to mail it
2 with his decision and the other two panel members
3 said they would be willing to mail it with just
4 the two Judges and I instructed them to mail it
5 with just the two Judges and then there was some
6 back and forth by email.

7 Q Okay and this matter concerned the FAS
8 decision, is that right?

9 A Yes, it did.

10 Q Okay. Was it that one thing that caught
11 your attention at that point or was there anything
12 else in your mind?

13 A That was the primary thing at that point
14 although there had been some other draft decisions
15 that had come to management review that had come
16 to my attention and I had had discussions with the
17 panels in those cases as well.

18 Q Okay. How did the conversation on May
19 30th take place? Was it by phone, in person, how
20 did it go?

21 A By phone.

22 Q Okay. And who was on the call?

1 A Judge Fitzpatrick and Judge Mitchell.

2 Q And who initiated this discussion?

3 A I did --

4 Q Why?

5 A -- or perhaps, perhaps Susan Mitchell

6 did.

7 Q But why did you wish this to take place?

8 A I was concerned with what I had been
9 hearing from his colleagues and I wanted to
10 provide him a path forward. I was concerned about
11 his performance, I was concerned that I would at
12 the end of the fiscal year have to give him a
13 lower rating than he'd received and I thought I
14 had devised a solution that would prevent that
15 from happening and I wanted to discuss that with
16 him.

17 Q Okay. Have you had occasions to give
18 counseling before this May 30, 2018, conversation?

19 A No. This was really the only time I'd
20 counseled one of the Judges in my division.

21 Q What do you understand counseling to be?

22 A Counseling is when a supervisor has

1 identified a concern in the performance, you
2 counsel them so that they can perform better and
3 end up with a successful rating at the end of the
4 fiscal year.

5 Q And to what extent do you believe that
6 you were providing counseling on May 30, 2018?

7 A That was my goal was to provide
8 counseling to Mr. -- to Judge Fitzpatrick.

9 Q Okay. Mr. Fitzpatrick alleges that you
10 told him that were you to review him on May 30th,
11 you would rate him as marginal in the element of
12 internal stakeholder interaction. Did you tell
13 him that?

14 A Yes.

15 Q Why did you tell him that?

16 A I was trying to get him to understand
17 why I was counseling him and it was that I thought
18 that his performance was marginal in that element
19 and it's a critical element and so his overall
20 rating would also be marginal if I had to give the
21 rating at that time and so I was counseling him so
22 that he could achieve a successful rating by the

1 end of the fiscal year.

2 Q Did you provide any details to him about
3 what promoted the counseling?

4 A I did, yes.

5 Q Okay, so let's look at Tab 6, which I
6 think we're still in, and go to page 12.

7 A Okay.

8 Q Do you recognize that?

9 A Yes.

10 Q Okay, so the text we're looking at, who
11 wrote that?

12 A I wrote the typewritten text.

13 Q And who do you understand wrote the
14 handwritten notes?

15 A I believe that was Judge Mitchell.

16 Q And what does this page reflect that
17 we're looking at here, 12?

18 A This was my notes for counseling Judge
19 Fitzpatrick, my notes about my concerns so he
20 would understand why I was -- why I was going to
21 give him this counseling and my notes about just
22 so that I could provide the counseling and keep my

1 thoughts fresh.

2 Q These were notes that you prepared in
3 anticipation of the conversation, is that right?

4 A Yes.

5 Q Okay. And so I want to scroll down to
6 page 13 and why don't you explain to us what this
7 is.

8 A Page 13, it looks like excerpts from the
9 PAP for my reference during the discussion. So
10 the PAP is a rather lengthy document and I had
11 drawn out excerpts from the PAP that were relevant
12 to our discussion.

13 Q And what was the purpose of doing that?

14 A That was so that I didn't have to dig
15 through the PAP if he had a question about how the
16 element applied or something I had the language,
17 the relevant language directly in front of me.

18 Q Okay. If we could scroll back up to
19 page 12.

20 A Okay.

21 Q And let's look at the first black
22 bullet. Do you see that?

1 A Yes.

2 Q Okay, and then there's language that's
3 in quotation marks, correct?

4 A Yes.

5 Q What is that for?

6 A That is a quotation from the PAP about
7 it says problems with timeliness are too frequent
8 or too serious to ignore. That is from the PAP
9 indicating that that would be an issue for
10 internal stakeholder interaction.

11 Q So when you say that that's from the
12 PAP, what do you mean?

13 A That -- I believe that language is taken
14 directly from the element in the PAP itself. It
15 may have been taken from the PAP support document,
16 but I believe it was taken from the PAP element
17 itself.

18 Q Okay. And then you write for example,
19 correct?

20 A Yes.

21 Q And so then we see two bullets
22 underneath there.

1 A Yes.

2 Q So why don't you explain what you meant
3 by for example.

4 A Well the element is about timeliness and
5 frequency of issues and also seriousness of issues
6 with timeliness and I wanted to indicate that
7 there were -- I wanted to indicate a primary
8 example but it is an example because there were
9 multiple issues with timeliness that had concerned
10 me.

11 Q Okay. Why don't you explain to us what
12 the first white dot means?

13 A The first white dot talks about an issue
14 that had come to my attention in IPR 2018-00019
15 where it had come to my attention that there was a
16 footnote in a decision -- in a draft decision and
17 it ended up mailing with that footnote, which in
18 that footnote was a concern to me because it
19 indicated to me that the panel had received the
20 draft decision with insufficient time for them to
21 consider it and it had to mail for a statutory due
22 date and so it ended up mailing with a footnote

1 that concerned me.

2 Q Okay, so what is the statutory deadline?

3 A The America Invents Act sets forth
4 certain deadlines by which the Board must issue
5 decisions and the Board takes those statutory
6 deadlines very seriously. It has never missed a
7 statutory deadline and they are hard deadlines
8 because they're statutory.

9 Q And there are also internal deadlines,
10 correct?

11 A There are internal deadlines as well.
12 Those are less significant, but still significant.

13 Q And so in the context of this particular
14 item what was the internal deadline that you're
15 referring to?

16 A The internal deadline is the PAP support
17 document says that draft opinions should be
18 submitted with more than 12 business days before a
19 statutory deadline.

20 Q Okay. So you wrote neither of your
21 colleagues agreed with your approach but they
22 lacked sufficient time to draft a decision

1 instituting the IPR contrary to the draft they had
2 been sent. Do you see that?

3 A Yes, I see that.

4 Q And what do you mean by lacked
5 sufficient time?

6 A My understanding was because it had been
7 submitted to the panel only about one week under
8 the 12 business days in the internal deadline,
9 they wanted to have a decision going the other way
10 and they just did not have time to write a
11 decision instituting an IPR in that short period
12 of time. The decisions instituting tend to be
13 quite lengthy and they did not have time to draft
14 that from scratch.

15 Q Now how did this matter come to your
16 attention in the first place?

17 A It had been submitted to management
18 review because of a separate opinion with the
19 footnote that concerned me.

20 Q And the information that you just
21 discussed, where did you get that information?

22 A I discussed that with the panel and in

1 particular with Judge Paul Roush who was on the
2 panel and had written the separate decision.

3 Q All right, then let's look at the second
4 white bullet. What does that address?

5 A It talks about the submission to
6 management review and ARC review which is a
7 separate AIA review committee that was -- it was
8 submitted to management review and ARC review in
9 parallel. Typically it's supposed to go to ARC
10 review first and then to management review and it
11 was submitted in the afternoon two days before the
12 mailing deadline and the PAP support document
13 suggests that the -- or says that the timely
14 submission is six business days, not two business
15 days.

16 Q Now have other APJs missed deadlines?

17 A Internal deadlines, yes, not statutory
18 deadlines.

19 Q You identified one instance in which the
20 appellant failed to meet deadlines. Is missing
21 internal deadlines on one IPR significant?

22 A No, not on just one IPR.

1 Q Then why did you bring that up with the
2 appellant?

3 A This fell I think primarily into the
4 serious category where it says problems with
5 timeliness are too frequent and too serious to
6 ignore. I was indicating the seriousness of this
7 particular IPR although there were other
8 situations where Judge Fitzpatrick had been on
9 panels where decisions were submitted to the
10 management review process beyond the internal
11 deadline.

12 Q Okay. And so let's scroll down to the
13 second black bullet on page 12. Again, what is
14 that language in quotation marks?

15 A It says the Judge is expected to
16 recognize the need for discretion and judgment and
17 apply as appropriate. That is also from the PAP.

18 Q Okay. And so looking at the first white
19 bullet, why don't you explain to us what's going
20 on there.

21 A I indicate that Judge Fitzpatrick had
22 repeatedly showed a lack of discretion and

1 judgment as to when to compromise with his fellow
2 Judges and that includes compromise with the
3 director.

4 Q All right and then you make reference to
5 an unusual footnote in the first square dot thing,
6 right?

7 A Yes.

8 Q Okay. And we're still talking about the
9 same IPR, IPR2018-00019, correct?

10 A Yes, same IPR.

11 Q Okay and then why don't you describe the
12 footnote that you're talking about.

13 A As I recall the footnote it said that
14 the -- it invited rehearing of the institution
15 decision because the panel had not been afforded
16 sufficient time to consider the merits of the
17 petition.

18 Q Okay and this was a footnote to what?

19 A A separate opinion by Judge Paul Roush.

20 Q All right, so let me ask you to go to
21 Tab 32, page 83.

22 A Okay.

1 Q Do you recognize that?

2 A Yes.

3 Q Is that the IPR that we've been talking
4 about?

5 A Yes, it is.

6 Q And what do you understand this
7 particular document to be?

8 A This is the cover page with the opinion
9 so the first page of the opinion.

10 Q Okay and then let's go to page 93. What
11 is that?

12 A This is the beginning of Judge Paul
13 Roush's dissenting opinion.

14 Q And let's scroll down to page 94 and
15 we'll see a footnote one at the very bottom,
16 correct?

17 A Yes.

18 Q Is that the footnote that you had
19 referred to?

20 A It is, yes.

21 Q Okay. What is concerning to you about
22 this footnote?

1 A The final sentence says I would welcome
2 the opportunity for the panel to further consider
3 this issue in a request for rehearing.

4 Q Okay, is this what caught your attention
5 when you were reviewing this for management?

6 A Yes.

7 Q Why?

8 A It's very unusual and unprecedented in
9 my experience for a Judge to request rehearing in
10 his or her own case. Typically requests for
11 rehearing come in from the parties and I didn't
12 understand why a Judge would need to essentially
13 call for a rehearing of a decision.

14 Q Now you wrote in your notes for this
15 discussion that this was an embarrassment to the
16 Board. Do you recall that?

17 A I did.

18 Q How is this embarrassing to the Board?

19 A It indicates to me reading the footnote
20 it indicates that the panel did not fully consider
21 the issue before issuing a decision which is very,
22 very troubling to me.

1 Q Okay. And this footnote was, in fact,
2 published, correct?

3 A Yes.

4 MR. HERRIGAN: All right, Administrative
5 Judge, I'd like to move Agency Exhibit 7, which is
6 Tab 32 pages 83 to 95 into evidenced.

7 MR. ABRAMIC: No objection.

8 JUDGE NIEDRICK: Okay. That's admitted
9 without objection.

10 MR. HERRIGAN: Thank you.

11 BY MR. HERRIGAN:

12 Q All right, let's go now back to your
13 notes, Tab 6, page 12 and we're in the first,
14 excuse me, the second black bullet and the second
15 item. You refused to sign on to preapproved
16 templates. Why don't you explain that?

17 A So, okay, so preapproved templates
18 applying SAS. So, SAS was a decision by the
19 Supreme Court which held that the Board's practice
20 that we refer to as partial institution was
21 violated the America Invents Act. It said that
22 for some background, the America Invents Act sets

1 up a set of trials in front of the PTAB and
2 including IPRs and also PGRs and at the time
3 covered business method reviews and the way an IPR
4 is started, initiated, is a petitioner, a member
5 of the public files a petition requesting
6 interparties review at which after the patent
7 owner has an opportunity to file a preliminary
8 response the Board will decide whether or not to
9 institute the IPR and the issue in SAS was whether
10 the Board could -- if there were two grounds for
11 example, in an IPR petition whether the Board
12 could choose to go forward with only one of the
13 two grounds and not both grounds and SAS held that
14 we had to go forward on all or none of the grounds
15 in the petition. Once SAS was decided, that was a
16 change to the way the Board had been practicing so
17 the Agency promulgated guidance shortly after the
18 decision explaining how it would be implementing
19 that decision and it provided both internal and in
20 public guidance as to the implementation of SAS.

21 Q Okay, you mentioned PGRs. Why don't you
22 explain what that is?

1 A So PGR is similar to IPR although it can
2 have a broader scope. IPR is limited to prior art
3 and patent ability issues based on prior art
4 consisting of printed publications and patents.
5 PGR allows for challenges under other parts of the
6 US Code relating to patents, but it is limited in
7 time. It can only be filed within the first nine
8 months after a patent is issued.

9 Q And PGR means post grant review, is that
10 right?

11 A Yes. Post grant review, yes.

12 Q All right. So, what was the
13 significance of SAS to PTAB operations?

14 A It was a fairly significant shift
15 although once the Supreme Court had taken the case
16 I think Judges were doing less partial institution
17 than they had in the past but for a long time
18 Judges would partially institute trials and so
19 there were a number of trials pending at the Board
20 that had to be revisited and have issues added to
21 the trial during the pendency of the trial so it
22 was a pretty significant shift.

1 Q Okay. Now in your bullet you say
2 preapproved template decisions. What does that
3 mean?

4 A So my recollection is that we gave --
5 got public guidance indicating how the SAS
6 decision should be applied and we gave approved
7 language to the Board in internal training.

8 Q Approved by whom?

9 A Approved by the director.

10 Q Okay and what was the purpose of
11 providing these?

12 A The purpose was to provide guidance to
13 the Judges on how the director's policy
14 interpretation of SAS should be implemented.

15 Q Okay and so let me ask you to bring up
16 Tab 5, page 75.

17 A Okay.

18 Q All right, and what is this?

19 A This is the public guidance that we
20 issued on April 26, 2018 shortly after SAS was
21 decided, two days after SAS was decided.

22 Q And whose policy decisions does this

1 represent?

2 A This was the director's policy decision.

3 Q And to whom was this published?

4 A It was published on the USPTO web page
5 so it was published to the public and also
6 provided internally of course.

7 Q Are you aware of other direction from
8 the director concerning SAS?

9 A I'm aware of numerous discussions we had
10 with the director about how he thought we should
11 implement SAS. I don't recall any other written
12 guidance that was made public but I know there
13 were numerous discussions with the director about
14 how we should implement SAS and we conveyed that
15 information to the Judges both in individual
16 panels and in training sessions for the Judge
17 corps.

18 Q And to your understanding what was that
19 direction from the director?

20 A The -- a significant issue was whether
21 the decision to institute if it instituted had to
22 address all claims and all grounds in the petition

1 or whether because SAS held that if any claim met
2 the statutory requirement for institution or
3 threshold for institution whether the institution
4 decision could address only one claim in one
5 ground and the director's guidance was that it
6 should address more completely all claims and all
7 grounds challenged in the petition.

8 Q Did the director explain why?

9 A Yes. He thought it provided useful
10 guidance to the parties in how to proceed with the
11 IPR.

12 Q Okay. So, let's turn to Tab 6, page 15.
13 Do you recognize this email exchange?

14 A Yes.

15 Q Okay and now I'm going to take you back
16 to the beginning of this, which is at page 17 of
17 Tab 6.

18 A Okay.

19 Q All right, and so why don't you just
20 walk us through it. What's happening at the
21 bottom of the page?

22 A At the bottom of page 17 Carl Eastom who

1 would have been the what we called APJ1 and I'll
2 explain what that is. When we panel cases, we
3 assign APJs one, two and three roles and APJ1 is
4 the primary drafter of the decision and APJs two
5 and three are involved in the way the decision
6 comes out but APJ1 is the drafter of the decision,
7 so Judge Eastom here submitted to the AIA review
8 committee, also called ARC, two related decisions
9 for ARC review.

10 Q Okay and we see DIs. What does that
11 mean?

12 A DI is a decision on institution.

13 Q And what is that, a decision on
14 institution?

15 A It's based on the petition and a
16 preliminary response if one is filed the panel
17 decides whether the statutory threshold is met and
18 it will decide whether or not to institute an IPR.

19 Q Okay and if we could scroll up to the
20 bottom of page 16. What's happening there?

21 A This is an email to management review
22 from Judge Eastom again providing a gentle

1 reminder that we had -- that the statutory
2 deadline is coming up and that they needed
3 guidance from us.

4 Q Okay and then we see right above that
5 that you responded, correct?

6 A Yes.

7 Q And now why did you respond?

8 A I handled correspondence to and from the
9 PTAB management review box and so that's why I was
10 the one who responded.

11 Q Okay so why don't you explain that
12 second sentence? What does that mean?

13 A So I was asking because of a concern
14 that I had with the separate opinion by Judge
15 Fitzpatrick I was asking if the panel would be
16 willing to issue a two Judge DI, decision on
17 institution, written only by the two Judges
18 without the separate concurring opinion.

19 Q How many Judges are needed on an
20 institution decision?

21 A On an institution decision only one.

22 Q Okay. And was that the case back in

1 2018?

2 A Yes.

3 Q And why don't you explain the logic
4 there?

5 A So the statute says that we can panel
6 cases to three Judge panels and that final written
7 decisions and IPRs must be issues by a three-Judge
8 panel. An institution decision by statute is the
9 director's by rule that has been delegated to the
10 Board but it can be, the institution decision has
11 no requirement that it be done by a three-Judge
12 panel of the Board or by even by Judges on the
13 Board.

14 Q Okay. To your understanding how widely
15 known was that amongst APJs back in 2018?

16 A I think APJs understood that. We had
17 issued two- Judge institution decisions before.
18 It was not commonplace, but we had done it before
19 and I think Judges understood the way we were
20 interpreting the regulation, which did not require
21 three Judges.

22 Q Okay and so we saw in the very beginning

1 there were two DIs that we're talking about and
2 now we're talking about four. Just for the
3 record, how did we get from two to four if you
4 know?

5 A I don't know. My guess is that it was a
6 family of cases and they first submitted two and
7 then another two had similar issues so those also
8 went to ARC and by the time we were considering it
9 in management review all four were considered with
10 the same concurrence it looks like.

11 Q Okay. And do you recall these IPRs
12 concerned riot games?

13 A No, I don't recall that.

14 Q Okay. And what's the date on this
15 email?

16 A May 12, 2018.

17 Q And so we are in Tab 6. Let's go to
18 page 188. Do you have that?

19 A Yes.

20 Q And what are we looking at here?

21 A This is another exchange from PTAB
22 management review.

1 Q Okay so I'm looking sort of at the
2 middle here where there's an email from you,
3 correct?

4 A Yes.

5 Q Now is the same case as we were just
6 looking at?

7 A No.

8 Q And this is May 8th, correct?

9 A Yes.

10 Q So that would be four days before the
11 email that we were just looking at, right?

12 A Yes.

13 Q Okay and why don't you explain to us
14 what's going on in this paragraph you wrote to Mr.
15 Fitzpatrick?

16 A We had received a draft order that I
17 thought implied that the director's interpretation
18 of SAS was incorrect and I asked them to use a
19 template that we had provided as the starting
20 point.

21 Q Okay and then we see in the very
22 beginning you wrote as I explained in a recent

1 email on another matter. What does that refer to?

2 A I don't recall.

3 Q Okay. Let's scroll up. Pardon me?

4 A I don't recall.

5 Q Okay. No problem. Let's scroll up to
6 page 187. All right and at the bottom we see Mr.
7 Fitzpatrick's response to you, correct?

8 A Yes.

9 Q And what is your opinion of what he has
10 to say there?

11 A I'm not thrilled with this and I
12 respectfully disagree with it as well.

13 Q Okay. And then if we go up to the top
14 of page 187, what's going on here?

15 A So the -- it looks like Judge Smith was
16 APJ1 on this case and he sends an email asking
17 what the panel should do because he had seen the
18 back and forth between me and Judge Fitzpatrick
19 and nothing had been resolved and so he was asking
20 what they should do going forward and I provided a
21 response saying that they could use the template
22 that we had provided but they could not mail the

1 order as drafted.

2 Q Okay and Mr. Fitzpatrick was on this
3 email, correct?

4 A Yes.

5 Q All right, we're in Tab 6. Let's go to
6 page 16. Okay, do you recognize this?

7 A Yes.

8 Q Okay and so we see the email that we
9 just talked about where you wrote and so then if
10 we keep going up, just the next one, Mr.
11 Fitzpatrick responds to you, correct?

12 A Yes.

13 Q Okay and this is now six days after the
14 interactions that we just looked at, right?

15 A Yes.

16 Q Okay and so what did you understand him
17 to be saying here?

18 A That he wanted to keep his opinion and
19 not mail the decision as a two-Judge decision.

20 Q And what did you make of that?

21 A I understood that and I was primarily
22 interested in what Judge Eastom and Judge Dang

1 thought.

2 Q Okay. And then we go up and we see Mr.
3 Eastom's response, correct?

4 A Yes.

5 Q And what is that response?

6 A It's that they were fine mailing it with
7 or without the concurrence.

8 Q Okay. And then at the bottom of page 15
9 we see you, that's your direction, correct?

10 A Yes.

11 Q And what was that direction?

12 A To mail the decision without the
13 concurrence.

14 Q Okay. And then what do we see right
15 above that?

16 A Judge Fitzpatrick responded the next
17 morning saying do not mail the decision without my
18 concurrence.

19 Q And what did you make of that?

20 A I considered it insubordination.

21 Q And why don't you explain why?

22 A Because I had given an order to mail the

1 decision without the concurrence and he sent an
2 email saying do not do what I just ordered the
3 panel to do.

4 Q All right. And then we scroll up just a
5 little bit more and we see another email from Mr.
6 Fitzpatrick. What do you understand he's doing
7 here?

8 A He says that the decisions had to be
9 expunged and new decisions replace them because
10 they had mailed in accordance with my order.

11 Q And what did you think of that?

12 A I also considered that to be
13 insubordination.

14 Q Okay and let's note the time. That's
15 8:13 in the morning on May 15th, correct?

16 A Yes.

17 Q Okay. Let's turn briefly. We're in Tab
18 6. Let's turn briefly to page 20.

19 A Okay.

20 Q And what time do you see on this email?

21 A 8:35 a.m.

22 Q Okay, so just after, correct?

1 A Yes.

2 Q All right. And what's going on here?

3 A It looks like an email to a large number
4 of people including the Chief Judge, the Deputy
5 Chief Judge, a number of lead Judges, some board
6 support staff again saying that the decisions need
7 to be expunged and new decisions replace them.

8 Q What did you think of this email?

9 A I again considered it to be
10 insubordination and I recall receiving a telephone
11 call asking me what to do from a board support
12 staff member and I instructed them to follow my
13 original order.

14 Q Okay and so what did you make of the
15 fact that Mr. Fitzpatrick had shared this with
16 this group of people?

17 A I was upset and disappointed.

18 Q Okay. And so to what extent do you
19 think this piece of the exchange was
20 insubordinate?

21 A Again, since it was the same thing that
22 I considered insubordination when it was sent to

1 me, the fact that it was sent to a much broader
2 group of people including support staff who
3 typically follow instructions of APJs I considered
4 that to be insubordinate.

5 Q All right. And then let's go to page 15
6 still in Tab 6 and what are you saying to Mr.
7 Fitzpatrick here?

8 A I was explaining why he was removed from
9 the panels in those cases and explaining that I'd
10 informed the paralegals not to follow his
11 insubordinate instruction.

12 Q Okay. So, on May 15th, you had removed
13 him from those four cases we talked about?

14 A Yes. Yes.

15 Q Okay. And why did you do that?

16 A Because we -- because of his actions
17 after we had the decision, the two-Judge decision
18 mailed I thought that he had to be removed from
19 these cases because he obviously was not going to
20 follow instructions with respect to these cases.

21 Q Okay, now on May 15, 2018, had you
22 removed him from any other cases?

1 A No.

2 Q All right, so we see that this exchange
3 concludes at 10:06 on May 15th, correct?

4 A Yes.

5 Q And so let's go down to page 25 of this
6 same document.

7 A Okay.

8 Q Can you explain to the Administrative
9 Judge what this is?

10 A This looks like someone captured
11 questions that were asked in a meeting that we
12 had. It looks like it was likely an internal
13 meeting of PTAB Judges.

14 Q All right and the person who captured
15 this would be Lee Stapina, is that it?

16 A Yes.

17 Q All right and this was in the afternoon
18 of May 15th, is that what happened?

19 A Yes.

20 Q Okay. And so, let's scroll down to page
21 26 about in the middle. Do you see a comment from
22 Mr. Fitzpatrick?

1 A Yes.

2 Q And do we see that's to everyone?

3 A Yes.

4 Q Okay, and what do you understand Mr.
5 Fitzpatrick to be conveying to everyone?

6 A He's conveying that he was removed from
7 four panels earlier that day.

8 Q In your view was it appropriate for Mr.
9 Fitzpatrick to put this information out?

10 A No.

11 Q What do you understand the purpose of
12 this to have been?

13 A To complain in a public forum about my
14 instruction that he disagreed with.

15 Q And why, if you do, why do you consider
16 this to be significant?

17 A I didn't think that I was -- I was not
18 impressed with the email to all the lead Judges or
19 at least many of the lead Judges and board support
20 staff and I was also not impressed with a
21 complaint in a board wide training session.

22 Q To what extent did you consider

1 appellant's conduct here to be insubordinate?

2 A I also thought this was insubordinate.
3 Complaining publicly about an order is not
4 something I expect Judges to do.

5 Q All right. And if we could go back to
6 page 12 of this same tab, Tab 6. Okay, and we're
7 still working through the points that you raised
8 with Mr. Fitzpatrick. The fourth square bullet
9 concerns refused to compromise with your
10 colleagues. Okay, so what does that concern?

11 A So my concern here was that he was not
12 compromising with his colleagues and where we
13 would ask the panels to reevaluate whether they
14 could reach a compromise and mail a decision in a
15 timely fashion and he refused to compromise with
16 his colleagues in a number of cases writing
17 separate opinions on matters that I thought that
18 the panel should be able to reach a compromise.

19 Q Okay. All right. And so the final
20 bullet here, the white bullet.

21 A Yes.

22 Q And how did you come by this

1 information?

2 A So, we would oftentimes get an email
3 sent to the PTAB management review box that would
4 have a separate concurring or dissenting opinion
5 and typically those were of no real concern but on
6 occasion we would reach out to the panel to
7 understand why they were having this disagreement
8 and I can recall one situation where Judge
9 Fitzpatrick issued a separate opinion I believe it
10 was dissenting from the use of the term slip
11 opinion to refer to a board decision and when I
12 had reached out to the panel about why there had
13 to be a separate opinion about this they expressed
14 discontent with their inability to compromise on a
15 minor matter like that.

16 Q Okay so to help me understand, Mr.
17 Fitzpatrick wrote a dissent in this matter that
18 you're talking about?

19 A Yes.

20 Q And in this dissent was discussion about
21 slip opinions?

22 A Yes.

1 Q And what do you mean by that?

2 A So the majority decision had cited a
3 board decision using the term slip opinion which
4 was in accordance with the style guide, the PTAB
5 style guide at the time and he wrote a separate
6 opinion saying that board decisions are not slip
7 opinions and that term should not be used in a
8 citation.

9 Q Now in your view was that appropriate
10 thing to do?

11 A No. I thought if he had a concern with
12 the way the style guide was written he should talk
13 to the people who write the style guide and
14 suggest a change rather than write a dissent.

15 Q Thank you. So, we're looking at page 12
16 and you had discussed some other matters that were
17 on your mind at this time. Why did you not put
18 them on this list?

19 A This was just a list of the most
20 critical things. I think that I didn't want to
21 make an exhausted list of everything that was in
22 my mind. I just wanted to convey to him that I

1 had concerns generally about his refusal to
2 compromise with his colleagues. I didn't want to
3 go through, you know, a list of IPR numbers where
4 that had happened but it was just for me to know
5 that that was -- me to know and me to convey to
6 him in counseling him that that was a concern of
7 mine.

8 Q Okay. Now let me ask you to turn to Tab
9 6 still, page 56. And what do you understand was
10 taking place here?

11 A This looks like a discussion that my
12 Chief Judge Tierney had with Judge Fitzpatrick
13 along with Judge Mitchell about some confidential
14 information that he included in a concurring
15 opinion.

16 Q Okay. And so you see that that took
17 place on September 1, 2017, correct?

18 A Yes.

19 Q So were you aware of this on May 30,
20 2018?

21 A Yes.

22 Q Okay. And if I could ask you then to

1 turn to Tab 32, page 126. What do you understand
2 this to be?

3 A This is from Vice Chief Judge or I'm
4 sorry at the time Deputy Chief Judge Bolick
5 sending me a copy of an email that Judge
6 Fitzpatrick had sent to Chief Judge Rusche.

7 Q And when Mr. Bolick sent this to you did
8 you read it?

9 A Yes.

10 Q Okay. And were you aware of this fact
11 when you had your counseling session with him on
12 May 30, 2018?

13 A Yes.

14 Q And when you did read this email what
15 was your impression?

16 A I was not impressed. I had been -- I
17 was out of the office on this date so Mike Kenney
18 had handled this in my absence but a lengthy
19 complaint to the chief Judge about this counseling
20 seems unnecessary and inappropriate to me.

21 MR. HARRIGAN: Okay. So, I would like
22 to move Agency Exhibit 11, which is Tab 32, pages

1 126 to 131 into evidence.

2 JUDGE NIEDRICK: Any objection?

3 MR. ABRAMIC: No objection.

4 JUDGE NIEDRICK: Okay, that's admitted
5 without objection.

6 MR. HERRIGAN: Thank you.

7 BY MR. HERRIGAN:

8 Q From the totality of the information you
9 had concerning the appellant on May 30, 2018, what
10 conclusions had you drawn with respect to him?

11 A I had drawn the conclusion that he was
12 having a lot of difficulty compromising with his
13 colleagues and that was causing a lot of
14 frustration for his colleagues and I was concerned
15 by that and I decided that a lot of the concerns
16 and difficulties seemed to be driven by the
17 statutory deadlines that we had to meet in AIA
18 America Invents Act, trials and so that was why I
19 recommended that he -- or that's why I took him
20 off of those cases and reassigned him to what we
21 called ex parte cases, the appeals from examiner
22 decisions not to grant a patent because there are

1 no statutory deadlines in those cases.

2 Q In his formal grievance the appellant
3 stated that you removed him from AIA cases on
4 vague criticism of my alleged refusal to
5 compromise. Is that your recollection of the
6 discussion?

7 A That is not my recollection. I thought
8 I gave specific examples and sufficient examples
9 for him to understand my concerns.

10 Q All right. Just a second, please. So
11 I'd like to take you back one more time to page 12
12 of Tab 6.

13 A Okay.

14 Q All right and why don't you explain to
15 the Administrative Judge what that last paragraph
16 concerns?

17 A So this is what I was saying that I had
18 explained my concerns to him and then I was
19 telling him what I was doing to -- as part of
20 counseling him I was telling him what I was doing
21 to give him an opportunity to achieve a fully
22 successful rating at the end of the fiscal year

1 and that was to remove him from matters involving
2 statutory deadlines and my explanation that I
3 thought that the pressures of the statutory
4 deadlines were causing the lack of collegial
5 interactions with his colleagues.

6 Q Explain your view on whether removing
7 appellant from AIA cases was proportional to the
8 conduct you were addressing.

9 A My view is that it was completely
10 proportional to the conduct and perhaps generous
11 to him.

12 Q Was anybody else involved in the
13 decision to remove Mr. Fitzpatrick from AIA cases?

14 A I obviously discussed it with Lead Judge
15 Mitchell and I discussed it as well with the Chief
16 Judge and the Deputy Chief Judge.

17 Q Okay. Had you removed other APJs from
18 AIA cases?

19 A No.

20 Q Had you had other APJs working for you
21 involved in this sorts of behavior?

22 A No.

1 Q Okay. I think you might have touched on
2 this, but if an APJ does not work AIA cases what
3 do they do?

4 A So the PTAB is the Patent Trial and
5 Appeal Board, so the trial side is the AIA cases,
6 the American Invents Act cases. The appeals are
7 appeals from examiner decisions declining to grant
8 a patent so if they issue a second office action
9 saying that they will not grant a patent on
10 particular claim that is appealable to the PTAB.

11 Q Okay. How many APJs would you estimate
12 worked in PTAB in 2018?

13 A Around 260.

14 Q Of those, how many would you estimate
15 worked on AIA cases?

16 A I would say that roughly as I recall
17 roughly one third worked exclusively on AIA cases,
18 roughly one third worked on both AIA cases and
19 appeals and roughly one third worked solely on
20 appeals.

21 Q How does working on AIA cases impact an
22 APJs working conditions?

1 A It does not. There is no impact on the
2 working conditions.

3 Q Do APJs who work AIA cases get higher
4 performance appraisals than those who don't?

5 A No.

6 Q Are there bonuses available to those who
7 work on AIA cases but not the others?

8 A No.

9 Q Are there details or other opportunities
10 available to APJs who work on AIA cases but not to
11 the others?

12 A No.

13 Q All right. Let's look at Tab 32, page
14 10.

15 A Okay.

16 Q Okay, so this is that Fiscal Year 18
17 Performance Appraisal, correct?

18 A Yes.

19 Q Okay and let's scroll down to the last
20 page of that, which is at page 13 of the document.

21 A Okay.

22 Q All right and so Mr. Fitzpatrick

1 received a positive performance appraisal, would
2 you agree?

3 A Yes, he's rated as commendable which is
4 quite good.

5 Q Okay and you approved this, correct?

6 A I did, yes.

7 Q So in light of the fact that you had
8 this conversation on May 30, 2018, why did you
9 approve this?

10 A Because during the remainder of the
11 fiscal year I had received no complaints about his
12 conduct or interactions with his colleagues and in
13 the review process Judge Mitchell reached out to
14 his colleagues and received favorable comments
15 about his interactions so I thought that he had
16 ended up with commendable performance despite my
17 concerns at the beginning of the year or in the
18 middle of the year.

19 Q To what extent when you agreed to this
20 performance, to what extent did you think that
21 your counseling had been successful?

22 A That was my impression was that it had

1 been successful and that the removal of the AIA
2 docket and moving him to the appeals docket had
3 worked and that he was able to continue performing
4 at a commendable level as he had the previous
5 fiscal year.

6 Q Are you aware that the appellant
7 submitted a grievance concerning being removed
8 from AIA cases?

9 A Yes.

10 Q How did you become aware?

11 A I believe that at one point Vice Chief
12 Judge Fink asked me for information that I had
13 related to our interactions.

14 Q And did you, in fact, speak with Mr.
15 Fink about that?

16 A I provided him the information, yes.

17 Q Okay. Aside from providing that
18 information to Mr. Fink, what role did you play
19 in the disposition of the grievance?

20 A None.

21 Q Did you advise Mr. Fink on how to
22 respond to the grievance?

1 A No.

2 Q Appellant claims that you removed him
3 from AIA cases in response to two protected
4 disclosures. I'd like to address each. First,
5 we'll discuss appellant's claim that you acted in
6 response to his assertion that the expansion of
7 the panel in Adidas versus Nike IPR2013-00067 was
8 illegal. So, a little background, why don't you
9 give us your understanding what interparties
10 reviews is.

11 A Sure. An interparties review as I've
12 discussed is a proceeding in front of the PTAB set
13 up by the America Invents Act where a petition
14 will file a petition seeking to challenge one or
15 more claims of a patent on various grounds of
16 unpatentability. The board will decide whether to
17 institute it and then if they institute, conduct a
18 trial and issue a final written decision.

19 Q Okay and I believe you testified that
20 final written decisions have to be in three-Judge
21 panels, right?

22 A Yes, at least three.

1 Q Who decides who the APJs are for a
2 particular IPRR?

3 A The paneling of cases is officially
4 delegated to the Chief Judge but he's delegated
5 that authority to a paneling team that takes into
6 account the workloads of Judges and vacation
7 schedules, whether matters are related and things
8 like that.

9 Q Now I mentioned to the Nike case to you
10 before. Are you familiar with the Nike case?

11 A Yes, I am.

12 Q Now how did you first become aware of
13 it?

14 A I handled the appeal from the original
15 Nike decision when I was in the solicitor's
16 office.

17 Q And so you worked on the brief itself?

18 A Yes.

19 Q Okay and so to what extent do you think
20 you became familiar with the issues raised there?

21 A To a great extent.

22 Q And on May 30, 2018, when you removed

1 the appellant from AIA cases, were you aware that
2 he was on the panel for that case, the Nike case?

3 A I believe I was probably given a list of
4 all of his cases but I was not --I did not recall
5 at the time that he was on that case at all.

6 Q And were you aware that that case
7 concerned an expanded panel?

8 A Yes.

9 Q How did you become aware of that?

10 A I believe that a submission was sent to
11 management review with a draft decision by an
12 expanded panel.

13 Q All right, so, just a second, please.
14 All right, so let me take you to Tab 7, page 391.

15 A Okay.

16 Q Okay and do you understand what this is?

17 A This looks like a draft decision in the
18 Adidas v Nike case that we're discussing.

19 Q Okay. Now I will take you down to page
20 425 and what do you understand that to be?

21 A This is a concurring opinion by Judge
22 Fitzpatrick in that case.

1 Q Okay. Now do you recall an issue of
2 confidential information coming up in the context
3 of this?

4 A Yes.

5 Q And how did you become aware of that?

6 A When the decision was submitted to
7 management review I reviewed the concurring
8 opinion and noticed information that I deemed to
9 be confidential information of the Board.

10 Q Okay. So, on the question of panel
11 expansion are you familiar with that concept?

12 A Yes.

13 Q And what do you understand it to be?

14 A It is expansion of a panel from three
15 Judges to more than three Judges similar to, for
16 example, the federal circuit going on bog.

17 Q Are you familiar with In re Alappat, the
18 federal circuit decision of 1994?

19 A Yes, I am.

20 Q And how is it you're familiar with that
21 decision?

22 A I recall studying it in law school, but

1 I came to know it quite well working in the
2 solicitor's office on several matters including
3 Yisom versus Sony and Nidak versus I believe it
4 was Xong Chang Broad Ocean.

5 Q Okay, in Yisom, how did it come up?

6 A In Yisom, the issue was the propriety of
7 expansion of panels and whether Alippat permitted
8 the expansion of panels in PTAB cases.

9 Q Okay. And what role did you have in that
10 case?

11 A I was the lead attorney on the case and
12 I argued the case in the federal circuit.

13 Q And then you mentioned Nidak, is that
14 correct?

15 A Yes.

16 Q And that's a federal circuit decision
17 from 2017?

18 A Yes.

19 Q How did panel expansions figure into
20 that?

21 A It was the same issue as in Yisom. In
22 Yisom after a very lengthy oral argument they

1 issued a summary affirmance under Rule 36 and so
2 the issue was raised again in Nidak.

3 Q Okay. And you were on the USPTO as
4 brief in that case?

5 A Yes, I was.

6 Q All right. If I could ask you to turn
7 to Tab 32, page 132. What do you understand that
8 to be?

9 A This looks like the USPTO's brief on
10 intervention in the Nidak case.

11 Q Okay. And this is the one that you were
12 involved in, correct?

13 A Yes.

14 MR. HARRIGAN: All right and so I'd like
15 to move Agency Exhibit 12, Tab 32, pages 132 to
16 150 into evidence.

17 JUDGE NIEDRICK: Any objection?

18 MR. ABRAMIC: No objection.

19 JUDGE NIEDRICK: Okay. That's admitted
20 without objection.

21 BY MR. HARRIGAN:

22 Q All right, what is your understanding of

1 Alappat as it relates to the expansion of panels?

2 A So my understanding is that Alappat
3 permits the expansion of panels in order for the
4 director, then the commissioner for patents, to
5 achieve a desired policy outcome.

6 Q Based on your expertise, what was your
7 opinion on the authority of the director of the
8 USPTO to expand panels after Alappat?

9 A I believe that the director had such
10 authority after Alappat.

11 Q Now Alappat predated the AIA, correct?

12 A Yes.

13 Q All right. What is your opinion on the
14 application of Alappat to this panel expansion
15 issue after AIA?

16 A I thought that the AIA did not make any
17 change in the director's authority to expand
18 panels.

19 Q And what is the basis for your opinion?

20 A The relevant statute. I believe the
21 language of the statute did not change it. I
22 believe it was moved within US Code but the

1 relevant language did not change.

2 Q Are you aware of any case law from the
3 federal circuits, Supreme Court or anything other
4 binding case law that changed the application of
5 Alappat to the expansion of panels?

6 A No.

7 Q Okay, so then I want to ask you to turn
8 to Tab 7, page 434. I think we might even be up
9 there.

10 A Okay.

11 Q All right and do you see this is Mr.
12 Fitzpatrick's argument with respect to the
13 expansion of panels? Are you familiar with that?

14 A Yes.

15 Q Okay. In preparing for this hearing
16 have you had an opportunity to review appellant's
17 argument here on the legality of the expansion of
18 panels?

19 A Yes, I have.

20 Q Have you formed an opinion on the merits
21 of this argument?

22 A I disagree with the conclusion that

1 Judge Fitzpatrick reaches.

2 Q Okay, so here in Section 4, the
3 appellant argues that the director of the USPTO
4 did not have authority to expand the panel in Nike
5 and so looking at this first section at the bottom
6 of Tab 7, page 434 into 435, do you see that?

7 A Yes.

8 Q Do you see the appellant is attempting
9 to draw a distinction between initially and on
10 request for reconsideration in MPEP1002.0-2F,
11 correct?

12 A Yes, I see that.

13 Q What is the MPEP?

14 A The MPEP is the Manual of Patent
15 Examining Procedure. It is a manual published
16 under the director's authority to provide guidance
17 to examiners in examining patents in how they
18 should examine patents primarily. There are some
19 other things in there as well.

20 Q Under whose authority is it issued?

21 A It's issued under the director's
22 authority.

1 Q Okay and so let me ask you to turn to
2 Tab 32, page 150.

3 A Okay.

4 Q We are looking at the contents of
5 Chapter 1000 of the MPEP. Is that right?

6 A That's right.

7 Q And this Chapter concerns what?

8 A Matters decided by various US Patent and
9 Trademark Office officials so it is a compilation
10 of delegations of authority primarily from the
11 director to other agency employees.

12 Q And if we scroll down we'll see a
13 reference to Section 1002.02F, correct?

14 A Yes.

15 Q And so what does that subsection
16 concern?

17 A These are delegations of authority to
18 the Chief Administrative Patent Judge of the PTAB.

19 Q And if I could refer you to page 161 of
20 this same document. Do you see Section 1002.02F?

21 A Yes.

22 Q And specifically looking at paragraph

1 three, what does that concern?

2 A Paragraph three is the delegation of the
3 authority to designate members of the PTAB so to
4 panel cases in other words and to set the panels
5 for cases on appeals as well as AIA proceedings.

6 Q And as an expert in this area, what do
7 you understand paragraph three to be saying about
8 the authority of the Chief Judge to staff AIA
9 panels?

10 A I think that's the delegation from the
11 director to the Chief Judge of all of the
12 authority to empanel cases.

13 Q What constraints are there in that
14 paragraph on the authority of the Chief Judge to
15 staff AIA panels?

16 A I don't think there are constraints.

17 Q From your experience what is the
18 relationship between the powers given to the
19 director in 35USC6C and the powers delegated from
20 the director to the Chief Judge in this paragraph?

21 A I think there is no distinction.

22 Q Appellant's we just discussed sought a

1 distinction in his concurrence between initially
2 and on request for reconsideration so let's focus
3 on the last two clauses of paragraph three.

4 JUDGE NIEDRICK: Mr. Horrigan.

5 MR. HARRIGAN: Yes.

6 JUDGE NIEDRICK: I'm sorry. Can you
7 give me the specific page number you're on?

8 MR. HARRIGAN: Sure, 161 of Tab --

9 JUDGE NIEDRICK: I'm there. Got it.
10 Thank you.

11 MR. HARRIGAN: You're welcome.

12 BY MR. HARRIGAN:

13 Q All right, so I was drawing your
14 attention back to the distinction between
15 initially and on request for reconsideration. Do
16 you remember that?

17 A Yes.

18 Q Okay and so then we were focusing on
19 these last two clauses of paragraph three. Do you
20 see that?

21 A Yes.

22 Q All right. In the Nike IPR concerned an

1 interparties review within that paragraph, right?

2 A Yes, it did.

3 Q Okay. And then you talked about post
4 grant reviews already, correct?

5 A Yes, I have.

6 Q Okay and so when we look at this
7 sentence, what do you understand the initially and
8 on request for reconsideration to mean in this
9 context?

10 A I think it's an explanation of when the
11 panels are typically assigned so typically a case
12 will come in to the agency and it'll be assigned a
13 panel and if there's a request for reconsideration
14 the panel may be expanded at that point to achieve
15 the director's policy goals.

16 Q Is there any other category?

17 A I don't think so.

18 Q So to what extent did you understand the
19 phrase initially and on request for
20 reconsideration to be a constraint on the
21 authority to delegate it by the director to the
22 Chief Judge?

1 A I don't think it's a constraint. I
2 think it's just explanation of when paneling can
3 occur.

4 Q Based on your extensive experience in
5 this area, what is your opinion on appellant's
6 claim that the Chief Judge lacked the authority to
7 expand the panel in the Nike IPR because it was
8 not initially or upon request for reconsideration?

9 A I don't think that there is a limitation
10 in the MPEP that limits the Chief Judge's
11 authority to expand a panel at any particular time
12 in a case.

13 Q In your opinion could a reasonable
14 person with appellant's education, experience and
15 background believe that the state of the law in
16 2018 was that an expansion of the panel in the
17 Nike IPR was prohibited by law specifically
18 36USC6C?

19 A No.

20 MR. HARRIGAN: All right. I'd like move
21 Agency Exhibit 13, Tab 32, pages 150 to 169 into
22 evidence.

1 JUDGE NIEDRICK: Any objection?

2 MR. ABRAMIC: No objection.

3 JUDGE NIEDRICK: Thank you. That's
4 admitted without objection.

5 MR. HERRIGAN: Thank you.

6 BY MR. HERRIGAN:

7 Q All right and so we're on Tab 7, let's
8 go to page 435.

9 A Okay.

10 Q And you'll see Section 5 of Mr.
11 Fitzpatrick's argument.

12 A Yes.

13 Q And are you familiar with this argument?

14 A Yes, I am.

15 Q Okay and this is an argument that the
16 director did not have authority to expand the IPR
17 panel, correct?

18 A Yes.

19 Q Okay. And what is your opinion on
20 appellant's claim that 35USC6C does not grant the
21 director the authority to expand a previously
22 designated panel?

1 A I disagree with that.

2 Q Are you aware of any binding legal
3 precedent that supports the appellant's position?

4 A No.

5 Q What is your opinion on appellant's
6 claim that Alappat does not authorize the
7 expansion of the panel?

8 A I disagree with that.

9 Q Are you aware of any binding legal
10 precedent that supports appellant's assertion?

11 A No.

12 Q Based on your extensive experience, what
13 is your opinion on the appellant's claim that the
14 director lacked the authority to expand this
15 panel?

16 A I think it is incorrect.

17 Q In your opinion could a reasonable
18 person with the appellant's education, experience,
19 and background believe that the state of the law
20 in 2018 was that the expansion of this panel was
21 prohibited by law?

22 A No.

1 Q What does the phrase violation of any
2 law, rule or regulation mean to you?

3 A To me it means that there must be a
4 clear statutory or other legal statement that an
5 action flies in the face of or directly opposes.

6 Q When you read this argument back in 2018
7 did you believe the appellant had made an
8 allegation of the violation of law, rule or
9 regulation?

10 A No.

11 Q An abuse of authority occurs when there
12 is an arbitrary or capricious exercise of power by
13 a federal official or employee that adversely
14 affects the rights of any person or that results
15 in a personal gain or advantage to himself or to
16 preferred other persons. When you read that
17 argument in 2018 did you understand the appellant
18 was alleging an abuse of authority on the part of
19 a USPTO official?

20 A No, I did not.

21 Q Thank you. Let's turn to page 559 in
22 this same document.

1 A Okay.

2 Q Okay. We have all seen this a number of
3 times but you are familiar with this email?

4 A Yes, I am.

5 Q And what do you understand it to be?

6 A I understand that it's an email from
7 Lead Judge Mitchell to Judge Fitzpatrick about
8 what management has identified as confidential
9 information and the concurring opinion in the
10 Adidas v Nike case.

11 Q And Ms. Mitchell sent this on your
12 behalf, is that correct?

13 A Yes.

14 Q All right. And so we see that she
15 refers to highlighted information in yellow pages
16 six to nine, do you see that?

17 A Yes, I see that.

18 Q Okay and so let's go to 599 of this same
19 document and let's scroll down to 602 and you can
20 see the yellow highlighted information, correct?

21 A Yes.

22 Q And who made those highlights?

1 A I did.

2 Q Why?

3 A I was indicating the information that I
4 believed to be confidential to the Board and
5 trying to make very clear what that information so
6 there was no misunderstanding.

7 Q What does confidential mean to you?

8 A Confidential is information that should
9 not be released to the public. In this case I
10 think most relevant is the deliberative process of
11 the Board and we keep information confidential at
12 the Board in order to protect the deliberative
13 process.

14 Q And why don't you explain what you
15 understand deliberative process to mean in this
16 context?

17 A Deliberative process includes the
18 discussions among Judges and the relevant
19 discussions about how a case should come out and
20 should be resolved and I think that it's important
21 to keep those very private as we have
22 unfortunately seen with the Supreme Court

1 recently.

2 Q Who holds the privilege? Who can waive
3 them?

4 A The agency.

5 Q Okay. Is your APJ allowed to waive the
6 privilege?

7 A No.

8 Q Now do you consider this information
9 here to be privileged?

10 A Yes.

11 Q And can you explain why?

12 A Because it's discussing what had
13 happened with internally at the Board during a
14 period of time and I believe that discussing
15 internal timing and internal deliberations is
16 inappropriate.

17 Q Do you have an opinion on whether it was
18 known among APJs this type of information was not
19 to be published?

20 A I think it was generally understood that
21 discussions about internal deliberations were not
22 to be included in decisions.

1 Q What is the relationship between this
2 highlighted information and the appellant's
3 arguments about the legality of the expansion of
4 the panel?

5 A There is no relationship.

6 Q Did you suggest -- did you highlight any
7 information in this section where he discusses
8 legality of expansion of the panel?

9 A No.

10 Q All right. Before we leave this
11 subject, can we turn to Tab 6, page 52?

12 A Okay.

13 Q Okay. Are you familiar with this email?

14 A Yes.

15 Q Okay. What did you think of what the
16 appellant's saying here?

17 A I guess I was not thrilled that he was
18 disagreeing that with my decision that the
19 information was confidential but I guess I was
20 pleased that he was agreeable to making the ends.

21 Q What do you think of the section where
22 he underlined the language?

1 A I know that there were a lot of concerns
2 about the promptness of the mailing of the
3 decisions. I didn't think it was necessarily
4 appropriate to make a condition on his decision to
5 make the evidence removing confidential
6 information but I understood there were a lot of
7 concerns about promptness.

8 Q Well as a manager at the PTO is it
9 appropriate for an APJ to make a conditional
10 response to a requirement from the management?

11 A No. No, I don't think so.

12 Q Okay. And then let's turn to Tab 7,
13 page 656.

14 A Okay.

15 Q And are you familiar with this?

16 A I don't know if I've seen this before.

17 Q Okay. All right, fair enough. Are you
18 aware that Mr. Fitzpatrick unagreed to withdraw
19 that information?

20 A I see that here, yes.

21 Q But were you aware of that at the time?

22 A I was aware that the decision did not go

1 out promptly.

2 Q Okay. Okay. To what extent did the
3 appellant's argument about the legality of the
4 expansion of the panel, Sections 5 and 6 of his
5 concurrence, play a role in your decision to
6 remove the appellant from AIA cases?

7 A None.

8 Q Did you have any personal interest in
9 the appellant's argument concerning the legality
10 of expanding the panel?

11 A No.

12 Q Would that opinion, had it been
13 published, have impacted the operations of the
14 PTAB in any way?

15 A No.

16 Q Did you have some professional interest
17 in this?

18 A No. It was a matter that I'd worked on
19 but I didn't have a professional interest in it.

20 Q Okay. Do you recall that we were
21 discussing a footnote from Mr. Paul Roush earlier?

22 A Yes.

1 Q And you had written notes concerning
2 that for your discussion with Mr. Fitzpatrick,
3 correct?

4 A Correct.

5 Q And you said it was embarrassing, right?

6 A I did, yes.

7 Q And we talked about what you thought was
8 embarrassing about that, right?

9 A Yes.

10 Q To what extent do you think that the
11 argument that Mr. Fitzpatrick was making in that
12 draft concurrence would be an embarrassment to the
13 Board?

14 A I, not at all. I mean my concern with
15 the footnote was that it indicated that the Board
16 was not doing its job of fully considering the
17 issues before issuing a decision. This was a
18 legal interpretation that I strongly disagree with
19 but it's not an embarrassment to the Board that
20 someone has reached a decision that I disagree
21 with.

22 Q And under whose name was this draft

1 concurrence to be published?

2 A Under Judge Fitzpatrick's name.

3 Q Does that reflect the determination of
4 the Board?

5 A No.

6 Q On May 30, 2018, when you removed the
7 appellant from AIA cases, to what extent were you
8 motivated by this argument to remove him?

9 A None.

10 Q Why did you remove the appellant from
11 AIA cases?

12 A For the reasons I gave in the notes that
13 I had from the discussion.

14 Q But for appellant's behavior in the SAS
15 institution situation would you have removed the
16 appellant from AIA cases on May 30, 2018?

17 A No.

18 Q But for removing appellant from AIA
19 cases on that date, would you have taken any steps
20 to keep appellant's concurrence in IPR201300067
21 from being published?

22 A No.

1 Q To include the discussion on the
2 legality of the expansion of the panel is that
3 correct?

4 A That's correct.

5 Q All right, so let's turn now to the
6 second disclosure. If you could go to Tab 7, page
7 768. All right. Are you familiar with this email
8 chain?

9 A Yes.

10 Q Okay. Were you involved in this email
11 chain?

12 A No, I was not involved in the email
13 chain itself although I was involved in the
14 underlying issues.

15 Q Okay. Were you personally involved with
16 the Oil States case?

17 A Yes.

18 Q What was your role?

19 A I had handled the legal arguments in Oil
20 States when I was in the solicitor's office and I
21 remained involved in the case when I moved to the
22 PTAB.

1 Q Did you have some involvement in moot
2 courts for this?

3 A I did. I attended I believe two moot
4 courts at the solicitor general's office.

5 Q And why don't you explain for the record
6 what these moot courts were.

7 A So typically the solicitor general's
8 office will hold two moot courts before a Supreme
9 Court argument where the relevant agencies can
10 attend and assistants to the SG who are not on the
11 case will play the role of the Supreme Court
12 Justices asking questions and inform the, in this
13 case it was the, inform whoever's arguing the
14 case. In this case it was Deputy Solicitor
15 General Malcolm Stuart and to inform him on
16 questions he may have, questions that may arise,
17 give him the best answers to get to the Supreme
18 Court.

19 Q And you say you were at one of these
20 moot courts?

21 A Yes.

22 Q Okay. Did you become aware that the

1 Deputy Solicitor General was inquiring about the
2 number of panel expansions?

3 A Yes.

4 Q How did you become aware of that?

5 A He asked the people from the USPTO who
6 were present at the moot, so people from the
7 solicitor's office at the USPTO and me, how many
8 panel expansions had occurred.

9 Q And how did you all go about responding
10 to that question?

11 A We came back and looked at our records
12 and provided him an answer.

13 Q And who's we in that context?

14 A I worked with individuals in the
15 solicitor's office. I don't remember specifically
16 at this point who they were.

17 Q And do you recall who passed the
18 information back to the Deputy Solicitor General?

19 A I provided the information to the
20 solicitor's office and they passed it on to the
21 Deputy Solicitor General.

22 Q Okay. In your opinion, was the

1 information that was provided to the Deputy
2 Solicitor General accurate?

3 A Yes.

4 Q Okay. And so let's scroll down so we
5 see Mr. Fitzpatrick is complaining on 768 to 769
6 about a sentence from Mr. Stuart, correct?

7 A Yes.

8 Q Okay. What is your opinion on whether
9 that's an accurate statement?

10 A I think that is accurate. We had looked
11 into it and give them the answer that it's been
12 three at the institution stage.

13 Q Okay and then Mr. Fitzpatrick highlights
14 right below that a section that says "has not been
15 done at the merit stage if you will." Do you see
16 that?

17 A Yes.

18 Q And what do you understand that to mean?

19 A That panel expansion had not occurred at
20 the time of a final written decision to change the
21 outcome of a patentability determination. Instead
22 it was done at the institution stage to effect the

1 director's policy regarding whether or not a case
2 should be instituted.

3 Q And that would be for instance idle
4 free, correct?

5 A Correct.

6 Q Okay. You see Mr. Fitzpatrick's
7 argument here is that Nike should have been
8 factored into this answer from the solicitor
9 general, correct?

10 A Yes, I see that.

11 Q And what is your opinion on that?

12 A I don't think that is correct because no
13 decision had been issued at the time in the Nike
14 case by an expanded panel.

15 Q Now after you became aware that Mr.
16 Fitzpatrick has raised this allegation, was there
17 any further action within your office?

18 A Yes. We went and rechecked our numbers
19 and confirmed them.

20 Q And as a result of rechecking your
21 numbers did you confirm that these two statements
22 were accurate?

1 A Yes.

2 Q Okay. What was the relationship between
3 Mr. Fitzpatrick's allegations here and your
4 decision to remove him from AIA cases?

5 A No relation between the allegations here
6 and the decision to remove him from AIA cases.

7 Q Did you understand that Mr. Fitzpatrick
8 was accusing you of doing something here?

9 A No. I think he misunderstood what Mr.
10 Stuart had argued but I didn't think he was making
11 an allegation against me.

12 Q Were you in any way professionally
13 embarrassed by this?

14 A No.

15 Q Did you understand that appellant's
16 allegations here to be an embarrassment to the
17 USPTO?

18 A No.

19 Q Okay. And ultimately did we go back and
20 correct the record with the Deputy Solicitor
21 General?

22 A No, we did not because there was no need

1 to correct it.

2 Q Okay. Appellant claims that in May
3 2018, Director Eyonku voiced a desire to USPTO
4 management to terminate him and threat was
5 conveyed to him through intermediaries. Why don't
6 you explain how the executive -- the management of
7 PTAB interacts with the director.

8 A So we would meet, we would have weekly
9 standing meetings and we would meet on occasion as
10 necessary at other times. The PTAB executive
11 team, so the Vice Chief Judges, the Deputy Chief
12 Judge and the Chief Judge would meet with the
13 director regularly.

14 Q Okay. Is there a name for this meeting?

15 A Not that I can recall. I mean we would
16 call it the director meeting but.

17 Q Okay. So, the director meeting with
18 which group, maybe that's what I'm asking? With
19 the counsel or how would you say?

20 A With the PTAB executive team is what we
21 would call it.

22 Q Executive team. Okay, great. And was

1 Janet Gongola on this executive team?

2 A Yes.

3 Q And you said you have these meetings
4 weekly?

5 A Yes.

6 Q Were these meetings that you would have
7 participated in?

8 A Yes.

9 Q Okay. Did you ever hear Mr. Eyonku say
10 anything approaching what I read to you?

11 A No.

12 Q Did anybody else make you aware that
13 Director Eyonku had said anything along those
14 lines?

15 A No.

16 Q Would these meetings have been a forum
17 in which Mr. Eyonku would have raised such a
18 statement?

19 A It's possible, yes, I think if there
20 were a concern with the PTAB he would raise it in
21 that venue.

22 Q Well did you discuss personnel matters

1 at these meetings?

2 A We did not discuss personnel matters but
3 if he were so concerned with a Judge that he
4 wanted that Judge removed I think we would have
5 discussed that personnel matter.

6 Q Did you?

7 A No.

8 Q Now did, in fact, you take any action at
9 any time to remove the appellant?

10 A No.

11 Q Did you understand at any point that you
12 were being asked to remove him?

13 A No.

14 Q Okay. So, are you aware of, I think we
15 talked about taking AIA cases, other people who
16 were removed from AIA cases and I believe you said
17 that you were not aware of it, correct?

18 A That's correct.

19 Q Okay. All right, I think I can leave it
20 there. That's all my questions. Thank you.

21 JUDGE NIEDRICK: Thank you, Judge

22 Weidenfeller. It's about 10:30. Are you all good

1 to go? Mr. Abramic, prepared for cross now or do
2 you want to take a short break?

3 MR. ABRAMIC: Why don't we do five
4 minutes, Your Honor?

5 JUDGE NIEDRICK: Okay. That works for
6 me. Let's come back at, let's say 10, let's come
7 back at 10:30 everyone so about seven minutes from
8 now. Please go off the record, Ms. Dawson.

9 (Recess)

10 JUDGE NIEDRICK: Okay, we're going to
11 just continue with Scott Weidenfeller's testimony.
12 Please continue. I guess we're going to go with
13 cross examination now and, Mr. Abramic, are you
14 going to be the one doing it?

15 MR. ABRAMIC: Yes, Your Honor.

16 JUDGE NIEDRICK: Great. Please proceed.

17 CROSS-EXAMINATION

18 BY MR. ABRAMIC:

19 Q Good morning, sir. Thank you for being
20 here today. My name is John. I'm going to ask
21 you a few questions. I will try to be as
22 efficient and as brief as possible and avoid

1 relying on documents to the extent that I can.

2 So, I believe you said in your testimony that

3 Judge Fitzpatrick got a positive review, year-end

4 review in October of 2017, right?

5 A That's right.

6 Q And then also got a positive mid-year

7 review in April of 2018, right?

8 A I believe that is correct, yes.

9 Q Okay. Thank you. And you were aware of
10 those reviews at the time you had your May 30th
11 phone call?

12 A Yes.

13 Q Okay. And that May 30th, would it be
14 fair to say that that call would be an irregular
15 performance appraisal?

16 A I don't believe it was a performance
17 appraisal. I believe it was a counseling session.

18 Q So, you want to call it a counseling
19 session but you informed him that he failed on one
20 of the metrics that are in the performance
21 appraisals, right?

22 A I told him that if I were to review him

1 as of that date he would have been rated as
2 marginal.

3 Q Right, rated, and that's a performance
4 review, right?

5 A I said if I were to give a performance
6 review today this is what it would be, so I don't
7 believe it was a performance review.

8 Q So you said if you were to give him a
9 review this is what the review would be?

10 A Yes.

11 Q Oh, okay and for that reason you didn't
12 call it a performance appraisal. You want to call
13 it an oral counseling session?

14 A Yes.

15 Q Okay. So in that oral counseling
16 session would you agree that you told him that he
17 had problems with timeliness that are too frequent
18 and too serious to ignore?

19 A Yes.

20 Q I want to focus on the frequent language
21 just for a minute here. When did you become aware
22 that Judge Fitzpatrick had frequent timeliness

1 problems?

2 A I don't recall specifically. I recall
3 there being a series of draft decisions that came
4 in late in the management review process including
5 the ones that we discussed in my direct testimony.

6 Q What's the timeframe on that?

7 A I don't know the specific timeframe.

8 Q Can you point to any late, late opinion
9 that he sent that would have occurred prior to his
10 April mid-year review?

11 A I can't point to any, no.

12 Q Okay. So, the example that you gave him
13 during his oral counseling session for his
14 timeliness problem, do you remember that there was
15 a bullet that explained that he missed the 12 day
16 internal deadline for getting an institution
17 decision to his fellow Judges?

18 A Yes.

19 Q Okay. And so you were an APJ at the
20 time, right?

21 A Yes.

22 Q Were you on panels at the time?

1 A I don't recall at the time. I was not
2 on a lot of panels in my tenure as a Vice Chief
3 Judge but I was on panels.

4 Q Okay, so you were on panels. Did you
5 ever miss that day internal deadline?

6 A Probably yes.

7 Q How many times?

8 A I don't recall.

9 Q Were you given oral counseling for that?

10 A No.

11 Q Have you ever received a draft decision
12 from another APJ with less than 12 days' time
13 before the deadline?

14 A Yes. I'm sorry.

15 Q Did you give those APJs oral counseling?

16 A No.

17 Q In what percentage of IPRs does an APJ
18 submit a draft decision to the other APJs that
19 doesn't meet that internal 12 day deadline?

20 A I don't know a particular percentage.

21 Q Do you know if the PTO tracks that
22 information?

1 A I believe I have seen that information
2 compiled in a report, yes.

3 Q Okay, so if the PTO wanted to show it
4 they'd be able to show it.

5 A Yes.

6 Q Okay. In connection with this case have
7 they shown you that data at all?

8 A No.

9 Q Did you take a look at it when you
10 decided to give Judge Fitzpatrick oral counseling?

11 A Not that I recall.

12 Q Would it surprise you if that number was
13 maybe as high as 25 percent of the time that
14 Judges miss that 12 day deadline?

15 A That would not surprise me, no.

16 Q Are you aware of any other APJ at the
17 PTO the entire time that you were in management
18 that received oral counseling or any punishment as
19 a result of missing that 12 day internal deadline?

20 A I am not aware of that.

21 Q At the time of the performance
22 appraisal, or I'm sorry, the oral counseling, were

1 you aware of how many times Judge Fitzpatrick
2 authored an institution decision in his career?

3 A No.

4 Q Were you aware of how many times Judge
5 Fitzpatrick in his career missed the 12 day
6 deadline?

7 A No.

8 Q Did you go back and try to figure that
9 out before you gave him the oral counseling on the
10 one time he missed that 12 day deadline?

11 A No, I did not.

12 Q Did you ask anyone to?

13 A No.

14 Q So, I'm trying to figure out how you
15 first came to decide that he had a frequent
16 timeliness problem from the time he got a good
17 review in April to the time that you gave him his
18 oral counseling. Did you have discussions with
19 other Judges? You mentioned you had discussions
20 with Judge Paul Roush. When in that timeframe did
21 the subject of timeliness come up?

22 A I recall it coming up in connection with

1 Judge Paul Roush's case and in connection with the
2 SAS related institution decisions that we
3 discussed earlier with Judge Eastom.

4 Q Okay. So, let's talk about the Judge
5 Paul Roush case first. Did he approach you about
6 it first or did you approach him?

7 A So, the decision was submitted to PTAB
8 management review by I don't recall who submitted
9 it, whether it was Judge Fitzpatrick or Judge Paul
10 Roush, and it concerned me and then I believe I
11 contacted Judge Paul Roush.

12 Q Okay, so to be clear it was you who
13 contacted Judge Paul Roush first. Not the other
14 way around.

15 A I think that is true, yes, with the
16 caveat that it was sent to management review and,
17 therefore, brought to my attention, but.

18 Q Okay, understood. Now so after this
19 occurred you saw the footnote, you reached out to
20 Judge Paul Roush, you discussed what happened in
21 that case. Do you remember the title of the case?
22 I can pull it up if I need to.

1 A I don't recall the title of the case. I
2 have the IDR number in front of me, but.

3 Q Sure, yeah, what's the IPR number?

4 A 2018-00019.

5 Q Okay, so you reached out to Judge Paul
6 Roush to have a conversation about what happened
7 in that case because there was this concerning
8 footnote. Is that right?

9 A That's right.

10 Q And then he gave you his side of the
11 story, right?

12 A Right.

13 Q And did you talk to the other Judge?
14 Was it Judge Yang who was on the panel?

15 A I don't recall talking to the other
16 Judges on the panel.

17 Q Okay, so it was just Judge Paul Roush
18 that you talked to, right?

19 A I think that's correct.

20 Q Okay. Did you reach out to Judge
21 Fitzpatrick to get his side of the story before
22 you gave him oral counseling?

1 A No.

2 Q Did you reach out to Judge Mitchell to
3 see if she could get his side of the story before
4 the oral counseling?

5 A I don't recall doing that.

6 Q So you got Judge Paul Roush's version of
7 the story, accepted it, and gave Judge Fitzpatrick
8 oral counseling. Is that right?

9 A Yes.

10 Q Do you think that comports with due
11 process?

12 A I don't believe that Mr. Fitzpatrick had
13 a due process right in an oral counseling session.

14 Q What about just as an organization where
15 you're a supervisor and you supervise a bunch of
16 employees and you reach out to one employee to get
17 one person's side of the story and then you go
18 punish another employee. Does that seem like a
19 good practice for a manager?

20 A I don't believe I was punishing Judge
21 Fitzpatrick.

22 Q Does it seem like a good practice for a

1 manager to give oral counseling in that situation
2 without getting his side of the story?

3 A I think it's appropriate to give oral
4 counseling to an employee based on the totality of
5 the circumstances of which I was aware which
6 included discussions with individual Judges and
7 included what I'd experienced with the management
8 review box.

9 Q And that totality of circumstances did
10 not include a conversation with Judge Fitzpatrick
11 just to be clear?

12 A Not on these specific matters, no.

13 Q Okay. I want to switch gears and talk
14 about the SAS issue. You were talking in your
15 direct about the SAS decision coming down and what
16 SAS said was that you only have to find that
17 there's a reasonable probability or a reasonable
18 likelihood of unpatentability with respect to one
19 claim even if there's a whole bunch of other
20 claims that are challenged in the petition. If
21 you find one then you can institute. That's kind
22 of what SAS said generally speaking?

1 A Generally speaking, yes.

2 Q Okay. But even though I think what I
3 heard you say is that even though SAS said that it
4 was your understanding that the director wanted
5 institution decisions to analyze all the
6 challenged claims as opposed to analyzing just one
7 claim, right?

8 A That's right.

9 Q Okay. So, if you could pull up Tab 6 at
10 246.

11 A Okay.

12 Q Do you see this document?

13 A I see it, yes.

14 JUDGE NIEDRICK: I'm sorry. Could you
15 give me the site, Mr. Abramic, again?

16 MR. ABRAMIC: Sorry. Tab 6 at 246.

17 JUDGE NIEDRICK: Thank you.

18 BY MR. ABRAMIC:

19 Q So, sir, if you go to page 247 I think
20 you'll see that this is an email string that you
21 were discussing in your direct testimony. Do you
22 see that?

1 A Yes.

2 Q Okay and then if you go back to 246 I
3 think this is just a different exhibit that has an
4 additional email. On page 246 do you see an email
5 from Judge Fitzpatrick to you about these SAS
6 decisions?

7 A Yes.

8 Q Okay. And so if you look at the email
9 that Judge Fitzpatrick sent to you do you see that
10 he has his proposed concurrence sitting there in
11 the middle of the email?

12 A Yes.

13 Q And at the start of the email he's
14 referring to the guidance which he says is
15 attached. Do you see that?

16 A Yes.

17 Q Okay. And then in his proposed
18 concurrence it's essentially saying wouldn't you
19 agree with me that he's saying because there's a
20 reasonable likelihood that petitioner would
21 prevail with respect to at least one claim, I
22 would institute. So what Judge Fitzpatrick wanted

1 to say in his concurring opinion is don't have to
2 analyze all the challenge claims because there's a
3 reasonable likelihood that the petitioner would
4 prevail with respect to at least one claim, I can
5 institute. Is that a fair kind of recitation of
6 what he wanted to do?

7 A I think that's fair.

8 Q Okay. And you thought at the time that
9 that his proposed approach was inconsistent with
10 the director's guidance, right?

11 A Yes.

12 Q Okay. And so if you go back up to the
13 top of the email where he says I believe the only
14 part of the guidance attached, right, and so is it
15 your understanding that Judge Fitzpatrick is
16 trying to explain why his concurrence is
17 consistent with the director's guidance?

18 A Yes.

19 Q But Judge Fitzpatrick is referring to
20 attached guidance, which I'm assuming you
21 understand that to be the official published
22 guidance of the director. Right?

1 A That's correct. If there is an
2 attachment it was the published guidance.

3 Q Okay but just to be clear, the guidance
4 that you are saying Judge Fitzpatrick was not in
5 conformance with was not the written guidance he's
6 referring to here. It's what you termed I think
7 in your direct testimony informal guidance, right?

8 A Yes.

9 Q Okay. And could you tell me explicitly
10 where I can find this informal guidance other than
11 through your emails here where you're saying that
12 that's what the guidance is?

13 A I don't recall if exactly how we
14 conveyed the director's guidance to the Board. My
15 guess is that we had a session, a training session
16 with all the Board Judges and explained it there.
17 I don't recall if there was documentation
18 associated with it or not. I saw some reference
19 to some templates in one of the emails that we
20 discussed in my direct testimony and I don't
21 recall how those were conveyed to the Judges.

22 Q Okay. So is it your testimony that at

1 this meeting to the best of your recollection it
2 was conveyed to all of the APJs that the director
3 wanted institution decisions to analyze all the
4 challenged claims?

5 A Yes.

6 Q Okay. Bear with me here. I'm trying to
7 pull up a document.

8 MR. ABRAMIC: Your Honor, may I share my
9 screen?

10 JUDGE NIEDRICK: Yes. Let me go ahead
11 and give you permission. It's always dangerous
12 giving this to me. Okay. You should be good to
13 go.

14 BY MR. ABRAMIC:

15 Q All right. All right, are we seeing a
16 document here?

17 A Yes, I see a document. It says
18 Caterpillar, Inc. Versus --

19 Q Perfect.

20 MR. ABRAMIC: Could I ask that this be
21 identified for the record, please?

22 MR. HARRIGAN: Absolutely. We're going

1 to do that.

2 MR. ABRAMIC: No, this is not a document
3 that's in the record. This is --

4 MR. HERRIGAN: Then I object.

5 MR. ABRAMIC: Your Honor, this is a
6 public document, an agency document.

7 JUDGE NIEDRICK: Okay and what's the
8 purpose? What are we doing this for?

9 MR. ABRAMIC: We're going to see some
10 institution decisions that violate the director's
11 informal guidance.

12 JUDGE NIEDRICK: Okay, Mr. Herrigan?

13 MR. HERRIGAN: I'll put my objection on
14 the record then. There was a deadline for
15 submitting documents. This did not meet that
16 deadline and we object.

17 JUDGE NIEDRICK: Okay. Understood and I
18 understand it to be introduced for rebuttal. Is
19 that why you're introducing this document?

20 MR. ABRAMIC: Yeah.

21 JUDGE NIEDRICK: Okay. Please proceed.

22 MR. ABRAMIC: Thank you, Your Honor.

1 BY MR. ABRAMIC:

2 Q Do you see on the first page of this
3 document it refers to Case IPR 2017-02186?

4 A Yes, I see that.

5 Q And that's Caterpillar versus Working
6 America, right?

7 A Yes.

8 Q All right, and we see that this is dated
9 May 3, 2018, right?

10 A Yes.

11 Q Okay. And that is just for the record
12 paper number seven, do you see that?

13 A I see that, yes.

14 Q Do you see that it's an institution
15 decision?

16 A Yes.

17 Q Okay. Now I'm going to go to the next
18 page at the very introduction. Do you see that it
19 states that Caterpillar filed a petition to
20 institute interparties review of a number of
21 claims? Do you see that there?

22 A I see that, yes.

1 Q Okay. Now I'm going to jump down. Do
2 you see the summary?

3 A I see the summary, yes.

4 Q Do you see where it states for the
5 reasons expressed above we determine that
6 petitioner has demonstrated a reasonable
7 likelihood of showing that at least claim one
8 among the challenged claims is unpatentable and so
9 then they institute, do you see that?

10 A I see that, yes.

11 Q Is that consistent with the director's
12 informal guidance?

13 A I haven't seen this decision possibly
14 ever, certainly not recently enough to recall
15 whether there was a discussion of other claims in
16 the body of this 24 page document.

17 Q Okay. Assuming they didn't analyze the
18 other claims, would it be consistent with the
19 director's guidance?

20 A No. The director's guidance was to
21 analyze the claims at least to some extent.

22 Q And now you're saying to some extent.

1 What extent?

2 A It varies on the facts of a particular
3 case. Sometimes the panel could simply say that
4 the parties argued only claim one and so we're
5 addressing only claim one in this decision or
6 something like that. There are a lot of different
7 factual scenarios that the director's guidance was
8 to address all claims and all grounds to the
9 extent warranted in the particular case.

10 Q That was the director's guidance, to the
11 extent warranted in the particular case? Was it
12 anything more specific than that?

13 A I believe the guidance was to address
14 all claims and all grounds and there was a
15 recognition that in the facts of a particular case
16 the extent to which something needs to be
17 addressed can vary. I don't think that was part
18 of the guidance. I think that was part of the
19 understanding that we conveyed to Judges.

20 Q Okay, so it seems like these Judges
21 didn't have that understanding, right?

22 A I, again, I haven't had a chance to read

1 the decision to see whether they addressed
2 anything other than claim one. I just have this
3 one sentence in front of me.

4 Q Sure. Do you see that they say in
5 accordance with SAS and the director's guidance?
6 Do you see that?

7 A Yes.

8 Q So assuming that they only analyzed the
9 one claim, do you think that they're just citing
10 the director's public guidance on this and not the
11 informal guidance?

12 A I don't know what they mean by
13 director's guidance, whether they in their minds
14 believed it to be limited to the publicly issued
15 guidance or not.

16 Q Okay. And let's see. So, I went back
17 up to the top again in this decision and you can
18 see that the panel in this case was Scott Daniels,
19 Barry Grossman and Kevin Cherry. Do you see that?

20 A Yes.

21 Q Do you know those Judges?

22 A Yes.

1 Q Are they good Judges?

2 A Yes.

3 Q Do you know if they were ever given oral
4 counseling for this decision?

5 A Not to my knowledge.

6 Q And just to make this faster for the
7 other decisions that we'll walk through, are you
8 aware of any administrative patent Judge would was
9 ever, other than Mr. Fitzpatrick, who was ever
10 given oral counseling for issuing an institution
11 decision that only analyzed one claim?

12 A No.

13 Q I'll try to be quick here. Pulled up
14 another document here. Do you see that this
15 refers to Case IPR 2018- 00106?

16 MR. HERRIGAN: The Agency makes the same
17 objection.

18 JUDGE NIEDRICK: Objection noted and
19 overruled.

20 BY MR. ABRAMIC:

21 A Yes, I see that.

22 Q Do you see that it's Paper 15 May 3,

1 2018?

2 A Yes.

3 Q And you see it's an institution
4 decision?

5 A Yes.

6 Q And you see that the Judges on the panel
7 were Judge Scanlin, Weatherly and Judge Worth? Do
8 you see that?

9 A I see that, yes.

10 Q Are they good Judges?

11 A Yes.

12 Q Okay, you see at the start here in the
13 introduction it refers to a petition that
14 challenges multiple claims in the patent. You see
15 that?

16 A I see that, yes.

17 Q All right, I'm on page 22 of the
18 document. Do you see where it says conclusion?

19 A Yes.

20 Q Do you see that it states for the
21 foregoing reasons we determine that the
22 information presented in the petition establishes

1 that there is a reasonable likelihood that
2 petitioner would prevail with respect to claim one
3 of the 782 patent? Do you see that?

4 A Yes.

5 Q And then they decide to institute for
6 that reason, right?

7 A Yes.

8 Q Assuming they only analyzed that one
9 claim in this decision would you agree that this
10 was against the director's guidance?

11 A Again, I would have to know more about
12 the facts of this case and whether there was a
13 reason why they were limited to discussing just
14 the one claim if, in fact, they did that, which
15 you asked me to assume.

16 Q What are the possible reasons that can
17 exist for only analyzing one claim such that it
18 would not be inconsistent with the director's
19 guidance?

20 A One example is if the preliminary
21 response focused entirely on claim one, the panel
22 would have very little to address in its

1 institution decision regarding the other claims.

2 Q Any other examples?

3 A Not that I can think of right now.

4 Q Okay. Just pulled up another document
5 and it's from IPR 2018-00070. Do you see that?

6 A I see that, yes.

7 Q And it's Paper 14 dated May 10, 2018.
8 Do you see that?

9 A Yes.

10 MR. HERRIGAN: The Agency objects. Same
11 objection.

12 JUDGE NIEDRICK: Objection noted and
13 overruled.

14 BY MR. ABRAMIC:

15 Q Do you see that this is an institution
16 of interparties review decision?

17 A Yes.

18 Q Do you see that the panel in this IPR is
19 Jamison Lee, Grama Elroo and John Kenney? Do you
20 see that?

21 A Yes.

22 Q Do you know those Judges?

1 A Yes.

2 Q Are they good Judges?

3 A Yes.

4 Q Okay. Do you see in the introduction
5 that there was a petition filed requesting
6 interparties review in a number of claims?

7 A I see that, yes.

8 Q Do you see on this same page it states
9 having considered the arguments and evidence
10 presented in and with petition in preliminary
11 response we determine that petitioner has
12 established reasonable likelihood that it would
13 prevail in showing unpatentability of claim 14 of
14 the 898 patent and then they institute based on
15 that statement? Do you see that?

16 A I see that, yes.

17 Q Assuming they didn't analyze the other
18 challenged claims, would you say that this
19 decision is inconsistent with the director's
20 informal guidance?

21 A Again, I would like to have a chance to
22 review the document, a 40-page document, review it

1 more completely, but from what you've shown me it,
2 assuming that this is the only thing they
3 addressed, there might be some other reason why
4 they addressed only the one claim. I don't know
5 what it is, but the guidance was that they should
6 address all the claims when instituted.

7 Q Do you know if anybody reached out to
8 them to talk to them to ask them why they were
9 only analyzing one claim assuming they did?

10 A I don't recall in this particular case.
11 I do recall reaching out to some panels to discuss
12 their treatment of SAS in a number of cases.

13 Q After looking at all these decisions,
14 would you agree at least that there might have
15 been some confusion among the Judges about what
16 the informal guidance really meant?

17 A I don't know that there was confusion.
18 I will say that it was, you know, a period of
19 implementing SAS over time where people, you know,
20 came to understand what the director's guidance
21 was. They may not have had understanding
22 immediately and we were implementing it, you know,

1 on the fly and so it's possible that they didn't
2 raise it to management review or that management
3 review discussed it with them. I don't know
4 specifically in this case.

5 Q You're saying earlier on it's more
6 understandable if there would be confusion?

7 A Yes.

8 Q And that would be in the May timeframe?

9 A Yes.

10 Q Okay. And this is right around the time
11 that Judge Fitzpatrick was being counseled, right?

12 A I believe he was counseled at the end of
13 the month.

14 Q Oh, okay.

15 JUDGE NIEDRICK: And can I just ask you
16 one quick question, Mr. Weidenfeller, on this
17 issue? The counseling session and sort of the
18 discussion of the guidance as it related to SAS,
19 was your determination that Judge Fitzpatrick
20 violated the published guidance or is it just
21 based on this informal guidance that was
22 communicated somehow to the ABJ corps?

1 THE WITNESS: It was the informal
2 guidance communicated to the ABJS, not the
3 published guidance and --

4 JUDGE NIEDRICK: Thank you.

5 BY MR. ABRAMIC:

6 Q Okay, I'm just going to do one more.
7 This is in Case IPR 2018-00299. Do you see that,
8 sir?

9 A Yes, I see it.

10 Q And this is Paper 21, do you see that?

11 A Yes.

12 MR. HERRIGAN: Same objection.

13 JUDGE NIEDRICK: Objection noted and
14 overruled.

15 BY MR. ABRAMIC:

16 Q This is dated June 18, 2018, do you see
17 that?

18 A Yes.

19 Q And you would agree that that's after
20 Judge Fitzpatrick's oral counseling, right?

21 A Yes.

22 Q All right, and the Judges on this panel

1 were Judges Zecker, Orbath and Galligan. Do you
2 see that?

3 A Yes.

4 Q Do you know those Judges?

5 A Yes.

6 Q Were they good Judges?

7 A Yes.

8 Q Okay. And moving to the second page
9 under the introduction, you see that it refers to
10 a petition challenging 34 claims. Do you see
11 that?

12 A I see that, yes.

13 Q Do you see, I'm on page, let's see, page
14 22 of the document and you see there's a
15 subsection E there at the top of the page?

16 A Yes, I see that.

17 Q And it states based on this preliminary
18 record petitioner has demonstrated a reasonable
19 likelihood that it would prevail in showing that
20 Tanner anticipated claim one. Do you see that?

21 A I see that, yes.

22 Q And then just a little bit further down

1 on the same page in the conclusion it states there
2 is a reasonable likelihood that petitioner would
3 prevail on challenging at least one of claims one
4 through 34 of the 232 patent so they institute for
5 that reason. Do you see that?

6 A I see that, yes.

7 Q And assuming they only analyzed the one
8 claim, you would agree that this would be
9 inconsistent with the director's internal
10 guidance, right?

11 A Yes, absent some other reason why they
12 didn't see the need to address further.

13 Q Okay. Thank you. Okay, I believe I
14 stopped sharing.

15 A Yes.

16 Q Thank you. So, getting back to your May
17 30th oral counsel session I think I want to talk
18 about who was involved in the decision to give him
19 that oral counseling. Was it just you?

20 A It was my decision but I certainly
21 discussed it with others at the Board.

22 Q Who?

1 A I certainly would have discussed it with
2 Susan Mitchell since she was at the meeting and I
3 am sure I discussed it with the Chief Judge and
4 the Deputy Chief Judge and possibly the rest of
5 the executive team.

6 Q Who's on the executive team?

7 A The Chief Judge, the Deputy Chief Judge,
8 the Vice Chief Judges and the Board executive.

9 Q Who's the Board executive?

10 A The Board executive is the head of the
11 Board Operations Division, which is the head of
12 paneling and hearings and things like that so the
13 non, the head of the division that does not
14 include Judges at the PTAB.

15 Q And who was the Board executive at this
16 time?

17 A I don't recall.

18 Q Okay. You mentioned that you would have
19 talked to Judge Mitchell about it. When?

20 A I'm sure I would have discussed it with
21 her before the meeting and I must have given her a
22 copy of the document that I prepared because we

1 saw earlier that her notes were on the copy of the
2 document.

3 Q But you don't have a specific
4 recollection of when you first talked to her about
5 this oral counseling session?

6 A No.

7 Q Okay. Do you have a specific
8 recollection of when you may have talked to other
9 folks about it?

10 A No.

11 Q Would there have been meeting notes?

12 A People may have made notes. I don't
13 recall making any notes.

14 Q What about communications, emails?

15 A We probably would have discussed it in
16 meetings, not by email.

17 Q You're not aware of any emails that
18 exist discussing these issues about Joseph
19 Fitzpatrick?

20 A Not beyond the ones that we've seen
21 today.

22 Q To your recollection, what was Judge

1 Ruschke's involvement in the oral counseling?

2 A I believe I would have discussed my
3 approach with him, but I don't recall any role
4 beyond that. I would have --

5 Q What about for -- sure, go ahead.

6 A I would have wanted him to know the
7 decision I was making and give him a chance at
8 least to object if he did.

9 Q You have no other recollection about it?

10 A No.

11 Q Is it the same answer with respect to
12 Judge Boalick?

13 A Same answer, yes.

14 Q So, you were asked a little bit about
15 the Nike IPR, you recall?

16 A Yes.

17 Q And Judge Fitzpatrick, in that case,
18 wanted to draft a concurrence discussing panel
19 expansion. You recall that?

20 A Yes.

21 Q Okay. And let me see if I can establish
22 agreement on kind of the basic facts of the panel

1 expansion that occurred in that case. Judge
2 Fitzpatrick was on the original three-member
3 panel. After remand from the Federal Circuit, the
4 panel was expanded to include Judges Ruschke and
5 Boalick. The parties and the public were not
6 notified of the expansion.

7 Judges Ruschke and Boalick were on the
8 panel for many months, then Judge Fitzpatrick was
9 replaced by Judge Daniels. The panel was
10 unexpanded, Judges Ruschke and Boalick were
11 removed, and the parties and the public were never
12 notified of the expansion. Does that comport with
13 your recollection of the case at least with
14 respect to the procedural expansion?

15 A Yes.

16 Q Okay. Is it reasonable for a judge to
17 question the propriety of PTAB panel expansion
18 practices?

19 A Yes, I think it's reasonable for a judge
20 to question it. Yes.

21 Q Okay. Because you're aware that the
22 Federal Circuit has explicitly questioned it,

1 right?

2 A Yes.

3 Q And that would be in the Nidec case
4 where you were involved, right?

5 A Yes.

6 Q That's at least one example, right?

7 A Yes.

8 Q Okay. And so, you were intimately
9 familiar with the Nidec case. I'm just going to
10 cite the Federal Circuit opinion. This is the one
11 -- you're familiar with the -- I'll try to do this
12 without bringing up the document. But you're
13 familiar with the concurrence written by Judges
14 Dyk and Judge Wallach in the Nidec case?

15 A Yes.

16 Q Okay. And the citation for that
17 decision is 868 Federal third 1013. And I'm just
18 going to read from that concurring opinion and see
19 if you recall.

20 The opinion states, "Second, we are also
21 concerned about the PTO's practice of expanding
22 administrative panels to decide requests for

1 rehearing in order to, "secure and maintain
2 uniformity of the Board's decisions."

3 Here, after a three-member panel of
4 administrative judges denied petitioner Broad
5 Ocean's request for joinder, Broad Ocean requested
6 rehearing, and requested that the rehearing be
7 decided by an expanded panel. Subsequently, the
8 acting chief judge, acting on behalf of the
9 director, expanded the panel from three to five
10 members, and the reconstituted panel set aside the
11 earlier decision." See that? Or I'm sorry, you
12 don't see that.

13 A I don't see it.

14 Q Do you think I read that correctly?

15 A It comports with my understanding. I
16 have not read the decision in some time.

17 Q Thank you. No, I appreciate that you're
18 helping me do this quickly.

19 A Okay.

20 Q And then later on, there's a quote that
21 says, "While we recognize the importance of
22 achieving uniformity in PTO decisions, we question

1 whether the practice of expanding panels where the
2 PTO is dissatisfied with the panel's earlier
3 decision is the appropriate mechanism of achieving
4 the desired uniformity." Do you remember that
5 statement?

6 A Yes.

7 Q Okay. And so, at least, Judges Dyk and
8 Wallach were questioning the propriety of panel
9 expansion, right?

10 A Yes.

11 Q Were you at the oral argument in the
12 Nidec case?

13 A I don't recall. I think not.

14 Q Okay. Would you -- to your
15 recollection, was it your colleague, Mr. Kelley,
16 who handled the oral argument in that case?

17 A Yes.

18 Q Okay. Can you go to Tab 7 at 17?

19 A 17?

20 Q Correct.

21 A Okay.

22 Q Did you ever listen to the oral argument

1 in the Nidec case?

2 A Yes.

3 Q Okay. And so, this document, this was
4 written by Judge Fitzpatrick. And you see in the
5 -- in paragraph 9, he's referring to the Nidec
6 case. Do you see that?

7 A Yes.

8 Q And at the bottom of the paragraph, he's
9 referring to the Federal Circuit's website that
10 has all Federal Circuit oral arguments. Do you
11 see that?

12 A I see that, yes.

13 Q And is it your understanding that
14 Federal Circuit oral arguments are available at
15 the Federal Circuit Court website?

16 A Yes.

17 Q Okay. And so, I'll just try -- I'll try
18 to do this quickly. So, Judge Fitzpatrick has a
19 quote here. He's quoting a statement from Mr.
20 Kelley. I'll let you read that.

21 A Okay.

22 Q Do you recall hearing that in the oral

1 argument?

2 A Yes.

3 Q Okay. And you would agree that that was
4 something that Mr. Kelley said?

5 A Yes.

6 Q And do you recall that he was saying
7 this in response to a question from Judge Reyna
8 raising a due process concern about panel
9 expansion?

10 A I don't recall that, but it seems to
11 comport with what Mr. Kelley said.

12 Q Okay. And so, in the first part of the
13 statement here, he says in response to that
14 concern, "I don't know that this will be
15 satisfying to you. But the people, the judges
16 listed on the Board's opinion, are the judges who
17 made that decision without any influence." Do you
18 see that?

19 A Yes.

20 Q So, does it seem to you that Mr. Kelley
21 said that to try to sue Judge Reyna's concerns
22 about due process?

1 A Yes, I think he was -- I think that was
2 his intent.

3 Q And in doing so, he was trying to assure
4 the judge that the judges listed on the opinion
5 are the judges who made the decision without any
6 influence, right?

7 A Right.

8 Q Why do you think it would be important
9 for people to know that judges who are listed on
10 the decision are the judges who made the decision
11 without any influence?

12 A I think it would be important for the
13 public to know who is making the decision in their
14 case.

15 Q Why?

16 A I believe it comports with due process.

17 Q Do you see later on in the statement it
18 says, "And I can also tell you that when judges
19 are added to panels where they do exert influence,
20 their names are on the panel." Do you see that?

21 A Yes.

22 Q Would you agree that's another statement

1 by Mr. Kelley seeking to soothe Judge Reyna's
2 concerns about due process?

3 A Yes.

4 Q Why do you think it would be important
5 with respect to due process to name the judges who
6 are on the panel?

7 A The same reasons as I gave for the
8 previous sentence.

9 Q Okay. So, if you were in Mr. Kelley's
10 shoes at the time, would you have provided the
11 same answer, do you think?

12 A We skipped over the sentence that says
13 "I can say that because I know that." And Mr.
14 Kelley was uniquely suited, because he had been
15 the acting chief judge of the PTAB at the time of
16 the expansion. And then he returned to his role
17 as the solicitor, and had particular understanding
18 of the facts in the case. And I would not have
19 been able to -- I do not have the same
20 understanding that that Mr. Kelley had.

21 Q Well, I took it in your -- in your
22 direct testimony, I took your testimony to

1 essentially be saying that the director has
2 unfettered power to expand the panel whenever he
3 or she wants. Is that what you were saying in
4 your direct testimony?

5 A Yes.

6 Q Why didn't Mr. Kelley just say that in
7 response to Judge Reyna's concerns here?

8 A Because he was responding to a concern.
9 I'm supposing that what Mr. Kelley was thinking --
10 I think that there's a difference between the
11 power to do something and concerns about when that
12 power is exercised.

13 Q Okay. So, you think it was a reasonable
14 concern on Judge Reyna's behalf?

15 A Yes.

16 MR. ABRAMIC: I have no further
17 questions.

18 JUDGE NIEDRICK: Okay, thank you. I
19 just had a few questions. You had mentioned,
20 Judge Weidenfeller, that you talked with Judge
21 Mitchell prior to the March 30th counseling
22 session. And what specifically did you discuss?

1 I know you can't really recall sort of when the
2 discussion took place, perhaps. But what
3 specifically did you discuss with her?

4 THE WITNESS: Before I answer that, if I
5 could make one clarification. I believe you said
6 March 30th, and I believe the conversation
7 occurred May 30th.

8 JUDGE NIEDRICK: Oh, it's May. You're
9 correct. I'm sorry.

10 THE WITNESS: Just to clarify the
11 record. But I believe I would have discussed it
12 with her. She was his first-line supervisor, and
13 we would have, you know, discussed the appropriate
14 approach to take in order to improve his
15 performance for the rest of the fiscal year.

16 JUDGE NIEDRICK: Do you recall, though,
17 if you specifically discussed the issues that you
18 had outlined in your summary -- you know, the
19 specific bullet points -- and got her take on,
20 say, for instance, the timeliness issue and
21 whether it was frequent or whether it was serious,
22 what her experiences with him had been in the past

1 with regard to timeliness? Did you discuss those
2 types of details with her before?

3 THE WITNESS: I believe I circulated the
4 document to her before the meeting, and we
5 probably discussed it. I don't know -- I don't
6 recall the extent to which we discussed it. And I
7 don't recall -- I mean, it was kind of my thoughts
8 about why I was doing what I was doing, and I
9 wanted to get her input. But I think it was -- I
10 don't think I discussed with her, you know, do you
11 think this is serious, because it didn't matter
12 whether I thought it was serious to me.

13 JUDGE NIEDRICK: So, you -- when you
14 received her input, what was her input? Was she
15 in agreement that these were serious issues and
16 that your approach was the appropriate approach to
17 take?

18 THE WITNESS: I believe she agreed with
19 the decision, yes. It can be hard as a supervisor
20 to weigh if whether someone fully agrees with you
21 or is just going along with you, but I believe
22 that she agreed with me. I certainly would have

1 valued her input if she disagreed with me. And I
2 believe she knew that.

3 JUDGE NIEDRICK: Okay. And as far as
4 the approach here of reassigning him from the AIA
5 cases, do you think that judges who are doing AIA
6 cases would see that -- the sort of reassignment
7 of those cases as being a punishment?

8 THE WITNESS: I think it depends. There
9 are some judges who get fed up with working on AIA
10 cases and ask to have their dockets taken away.
11 And obviously, they wouldn't believe that's a
12 punishment. But I do think that there are some
13 judges who really enjoy doing the AIA cases, and
14 they would feel disappointed to have their docket
15 changed without asking for it.

16 JUDGE NIEDRICK: Do you know what Judge
17 Fitzpatrick's position on that was? Was he happy
18 doing the AIA cases, or was he -- did he want to
19 voluntarily take a different type of caseload?

20 THE WITNESS: I think it was made clear
21 that he was happy doing AIA cases and would prefer
22 to have continued doing AIA cases.

1 JUDGE NIEDRICK: Okay. Sort of
2 listening to things and the idea that, you know,
3 the director has unfettered authority to expand
4 and sort of manipulate -- I think it's -- I think
5 that would be fair based on what I've heard --
6 manipulate a panel in order to come to an outcome
7 that the director believes is appropriate in one
8 of these cases. Why are there dissenting opinions
9 in these decisions?

10 THE WITNESS: Because the director will
11 -- or the chief judge will expand the panel to get
12 the outcome that they want, but they believe that
13 judges should be allowed to express their own view
14 of how they would come out. So, they're perfectly
15 allowed to write a dissent, but they can't make a
16 decision of the Board.

17 JUDGE NIEDRICK: So, if there's a -- say
18 there's a disagreement with guidance. And I've
19 come to learn that it sounds like the director's
20 guidance is not guidance. It's a direction. So,
21 that if -- and correct me if I'm wrong, but my
22 understanding based on the testimony I've heard so

1 far is that when there's informal or formal
2 guidance issued by the director, that guidance is
3 a directive. And if you don't do it, you can be
4 terminated. Is that a correct understanding of
5 the policies at PTO?

6 THE WITNESS: I don't believe any judge
7 has ever been terminated for not following
8 guidance. But I think that -- and the reason we
9 call it guidance is because it gets very kind of
10 mushy in particular cases. So, saying it's to
11 address all claims, because that's good for the
12 parties to understand what you think about all
13 claims, there may be reasons why you don't.

14 And so, someone arguably going against
15 the guidance to address all claims would not be
16 disciplined in any way because it was appropriate
17 in a particular case. Or even if the director
18 didn't think it was appropriate in a particular
19 case, it would have to be an egregious violation
20 for someone to be disciplined in any way. I don't
21 --

22 JUDGE NIEDRICK: Okay. So, if there was

1 a dissenting opinion or even a concurring opinion
2 where, say, for instance, a judge discussed
3 guidance and stated, you know, essentially, hey,
4 here's our public guidance. Everybody can see
5 this. I disagree with it on these legal grounds,
6 because I don't think it's appropriate. But
7 nevertheless, I'm following it. Would that be
8 appropriate to have in an opinion?

9 THE WITNESS: We definitely have
10 permitted opinions to go out -- separate opinions
11 to go out saying that. I will say that at least
12 some directors have not appreciated that practice.

13 JUDGE NIEDRICK: Right. You testified
14 earlier too that -- you said, I think it's
15 important for the public to know who is making the
16 decisions in their cases, because it comports with
17 due process. If the director has unfettered
18 authority to issue the decision, essentially, why
19 does it even matter who's on a panel? Why does it
20 matter that the litigants are given that
21 information? I want to understand how that piece,
22 in your mind, comports with due process.

1 THE WITNESS: So, I think it's important
2 for judges to be able to issue decisions that they
3 believe in on the record in front of them. And I
4 think that the director can provide guidance as to
5 how they should -- for uncertain policies they
6 should follow.

7 And I think that one thing that we did
8 at the Board was to make the process of director
9 involvement in a case much more transparent. And
10 it's become even more transparent after another
11 recent Supreme Court decision where there's a
12 director review process where the case actually
13 goes to the director herself for review.

14 And so, I think there are legitimate
15 concerns about the director's influence. And so,
16 we've tried to make that process much more
17 transparent, because I believe that's appropriate
18 and it comports with due process.

19 But I do think it's important for the
20 individual judges who sign an opinion to agree
21 with it. And I think we made that clear
22 throughout my time with the Board that they

1 shouldn't sign something they disagree with, but
2 they can say I'm following orders by following
3 this guidance.

4 JUDGE NIEDRICK: I see. And again, I'm
5 just trying to wrap my head around -- I think, you
6 know, Mr. Horrigan provided a good discussion of
7 what the disclosures are here. And you testified
8 that you don't think that a reasonable person in
9 Judge Fitzpatrick's position would have thought
10 that there was a due process problem with
11 expanding panels, and that's accurate. Isn't that
12 what you testified to?

13 THE WITNESS: My understanding of the
14 question was would a reasonable person have
15 thought that expansion of panels violated the law.
16 Whether there are due process concerns with it, I
17 believe, is a much fuzzier area.

18 But whether -- my understanding of the
19 question was whether it was a violation of -- he
20 was alleging a violation of the law as opposed to
21 whether he was saying I disagree with this because
22 I think it's -- it doesn't comport with due

1 process. I see a distinction there. And I'm not
2 sure I'm conveying it to Your Honor, but --

3 JUDGE NIEDRICK: No, and I'm struggling
4 with some of the same things. So, do you think
5 that if somebody violates due process, the
6 litigant's due process, that they're violating a
7 law?

8 THE WITNESS: Yes. I think if they're
9 making a clear due process violation, that is a
10 violation of the law.

11 JUDGE NIEDRICK: Okay. In my
12 understanding, from hearing the testimony and
13 reading what I've read in the case, is that
14 there's no question that the director has the
15 authority to expand panels. That's not an issue.
16 It doesn't seem like anybody, including Judge
17 Fitzpatrick has a problem with that. The issue
18 comes when the expansion occurs after an initial
19 panel has been designated, and then the litigants
20 are not informed that the panel has been expanded.
21 And so, I want to know whether you think
22 that the authority that you discussed with Mr.

1 Horrigan earlier that talked about that authority
2 of the director, whether you think that that
3 authority -- that the authority that you cited
4 allows and permits the director to expand a panel
5 at any time during the preceding even after a
6 decision has been rendered by the initial
7 designated panel.

8 And I know in your process, that isn't
9 the end of the story. They say, here's our final
10 decision, and then depending on the type of
11 decision, whether it has concurrence or dissent or
12 some other issue that might be a hot topic, it
13 goes to this management review panel. And then it
14 also goes to the ARC. And so, there's this
15 different sort of review.

16 But question that I'm struggling with
17 is, is your position that that authority that you
18 cited allows the director to expand at any time
19 without letting the parties know? Even in
20 circumstances like this where there's been a
21 decision issued -- or drafted, at least, by the
22 panel, the originally designated panel -- and is

1 prepared to go out, it just needs the review
2 process. Is your position that he -- that the
3 director -- he or she -- can expand it at that
4 point?

5 THE WITNESS: I think that the -- yes,
6 the director can expand the panel at any point
7 during the proceeding. It typically occurs
8 initially or on a request for reconsideration. In
9 this case, as I understand it, it occurred and
10 then un-occurred, for lack of a better word, on
11 remand.

12 So, there was kind of another chance to
13 decide who the panel should be, because it was
14 remanded back to the Agency. And so, I think that
15 that's an appropriate time to consider the
16 paneling again. Whether it be expansion, or
17 sometimes, Federal Circuit appeals take a long
18 time and the judge is no longer available for one
19 reason or another, and so, the case may be
20 repaneled at that point.

21 JUDGE NIEDRICK: Okay. But you do think
22 that the authority that you cited allows for

1 expansion in a case after the initially designated
2 panel renders their draft decision?

3 THE WITNESS: Yes.

4 JUDGE NIEDRICK: And there's no
5 requirement to notify the parties that the panel
6 has been expanded at that point?

7 THE WITNESS: To clarify something, our
8 current standard operating procedures do require a
9 panel change -- the parties to be notified of a
10 panel change. And I believe that would have
11 happened when Judge Fitzpatrick came off the case
12 and Judge Daniels was added. I believe there was
13 a panel change order in that situation.

14 And because the panel was never -- the
15 panel was expanded, and then unexpanded. I don't
16 know that there is a requirement under the SOP to
17 notify the parties of that -- the panel wasn't
18 paneled briefly during the tenure, and when,
19 ultimately, the judges deciding the case are
20 listed on the decision.

21 JUDGE NIEDRICK: But why in that case
22 did they issue an order notifying that there was a

1 change in the composition of the panel? What was
2 the purpose of that?

3 THE WITNESS: The purpose is to let the
4 parties know when there is a change to the panel,
5 and that would occur, you know, sometimes only a
6 short time before the decision issues. But the
7 idea is that they understand the composition of
8 the panel that is going to be issuing a decision
9 in the case. And so --

10 JUDGE NIEDRICK: And that goes back to
11 your statement about that that comports with due
12 process?

13 THE WITNESS: Yes.

14 JUDGE NIEDRICK: Okay. I think that's
15 all I have. So, let me ask you this. If you were
16 on the management review panel, or the ARC -- I
17 guess you wouldn't be on the ARC. You were on the
18 management review panel.

19 If you were reviewing a decision, and
20 you looked at the decision and there was an
21 analysis in a concurring or dissenting or even the
22 decision that you felt was sort of unreasonable

1 based on the shortsighted and controlling law that
2 an APJ had written, what would you do under those
3 circumstances?

4 THE WITNESS: I might contact either the
5 full panel or the judge writing separately and
6 say, you know, I'm not sure this makes a lot of
7 sense, and talk through with them and just sort of
8 get their understanding. But then they would be
9 allowed to issue that decision as written.

10 JUDGE NIEDRICK: Okay. I think that's
11 all I have. Mr. Horrigan, are you prepared to do
12 your redirect, or would you like to take a quick
13 break? It's up to you.

14 MR. HARRIGAN: I just have one question.

15 JUDGE NIEDRICK: Okay, great. Go ahead.

16 REDIRECT EXAMINATION

17 BY MR. HARRIGAN:

18 Q So, Mr. Weidenfeller?

19 A Yes.

20 Q You were presented with those four
21 cases, those four IPR decisions?

22 A Yes.

1 Q Had you ever seen those before?

2 A Not to my recollection.

3 Q Were there any concurrences in any of
4 those?

5 A Not that I saw, with what I was shown.

6 Q Were there any dissents in any of those?

7 A Not that I saw from what I was shown.

8 Q Do you have any reason to believe they
9 were submitted for management review?

10 A I don't recall whether they were. Many
11 cases involving SAS were submitted for management
12 review, but I don't know whether all of the cases
13 were.

14 Q But the counsel did not show you any
15 evidence that those were, right?

16 A Right.

17 Q Okay.

18 MR. HERRIGAN: Thank you. Nothing
19 further.

20 JUDGE NIEDRICK: Mr. Abramic, any
21 follow-up?

22 MR. ABRAMIC: Sure.

1 REXCROSS EXAMINATION

2 BY MR. ABRAMIC:

3 Q You're no longer with the PTO, sir,
4 right?

5 A That's right.

6 Q Okay. And so, what Mr. Horrigan seem to
7 be driving at is that maybe people in management
8 weren't aware that these opinions were going out
9 analyzing single claims. Now that they are, do
10 you think that those judges that you saw are going
11 to be punished?

12 A I think it's very unlikely.

13 MR. ABRAMIC: Thank you.

14 JUDGE NIEDRICK: Okay. Thank you very
15 much for your testimony today. I really
16 appreciate it. Please don't discuss your
17 testimony with anyone. If you have any questions,
18 please contact Mr. Horrigan, okay?

19 THE WITNESS: Okay. Thank you, Your
20 Honor.

21 JUDGE NIEDRICK: Thank you. And if you
22 could just hit the leave button on your screen

1 there, that'll take you out.

2 THE WITNESS: Yes, sir. Thank you.

3 JUDGE NIEDRICK: Thank you. Okay. That
4 took a little longer than at least I expected.
5 So, we're at 11:40, and we're going to hear from
6 Boalick next time. I imagine he's going to
7 probably be close to the same length. Is that a
8 good assumption, Mr. Horrigan?

9 MR. HERRIGAN: On direct, he will be --
10 he will take less time. Probably half hour less.

11 JUDGE NIEDRICK: Okay. Did you want to
12 do the direct now and then take a lunch break?

13 MR. HERRIGAN: That's fine. I need to
14 email him to --

15 JUDGE NIEDRICK: Okay.

16 MR. HERRIGAN: -- let him know that it's
17 time.

18 JUDGE NIEDRICK: Does that work for
19 everybody? So, we'll do the direct with Judge
20 Boalick, and then come back for the cross after
21 lunch.

22 MR. ABRAMIC: Yep, that's fine.

1 MR. HARRIGAN: Before we go off the --

2 JUDGE NIEDRICK: I'm sorry, go on.

3 MR. HARRIGAN: I'm sorry. Before we go
4 off the record, I would like to ask that those
5 four documents be appended to the record.

6 JUDGE NIEDRICK: Can you submit those,
7 Mr. Abramic?

8 MR. ABRAMIC: Absolutely. What, just
9 email, or --

10 JUDGE NIEDRICK: You can just upload
11 them as hearing exhibits.

12 MR. ABRAMIC: Okay. All right.

13 JUDGE NIEDRICK: In a new Tab. So,
14 they'll pop up in a new Tab, and then I'll just
15 get a note that in my decision, I'll have that.

16 MR. ABRAMIC: The only reason I'm going
17 to ask a question is because I skipped through a
18 couple just to save time. So, I'm going to need
19 to figure -- make sure I put the right ones --
20 will we have -- can I do it after I have access to
21 a transcript?

22 JUDGE NIEDRICK: I can tell you which

1 ones you had right now, if that helps. Or if you
2 want to just upload them all, they're all the same
3 types of issues --

4 MR. ABRAMIC: Yeah, I'll do that then.
5 Sure, yeah.

6 JUDGE NIEDRICK: Okay. Yeah. And then
7 --

8 MR. HARRIGAN: Unfortunately, that
9 creates the same problem I'm trying to avoid. It
10 makes the record unclear. So, I would like those
11 four documents appended to the record, and none
12 others.

13 MR. ABRAMIC: I sent you the --

14 JUDGE NIEDRICK: Okay. Do you want --
15 let me ask you this. Do you want to introduce the
16 other ones, or are you fine with just the four, I
17 think, that you discussed?

18 MR. ABRAMIC: Well, I guess the --
19 here's the question, Your Honor. And maybe you
20 don't know the answer to this. Do you suspect
21 that we will have a briefing at the end of the
22 case?

1 JUDGE NIEDRICK: Yes.

2 MR. ABRAMIC: Okay. So, I mean, I can
3 -- you know, if there's some decision that I want
4 -- a public decision that I want to cite, I can
5 just cite it. So, I'll just upload the four.

6 JUDGE NIEDRICK: Okay. So, Caterpillar
7 was the one -- it's paper 7, May 3, 2018.

8 MR. ABRAMIC: Okay.

9 JUDGE NIEDRICK: The next one was St.
10 Jude Medical, LLC, May 3, 2018.

11 MR. ABRAMIC: Okay.

12 JUDGE NIEDRICK: That's paper 15. The
13 next one was Alcatel-Lucent USA, Inc.

14 MR. ABRAMIC: Yep.

15 JUDGE NIEDRICK: That was paper 14, May
16 10. And then you had Aligent -- I think I spelled
17 that right. Aligent (sic) Technologies, Inc.

18 MR. ABRAMIC: Okay.

19 JUDGE NIEDRICK: That one was June 18th,
20 and that's paper. 21. And those are the four
21 that I had in my notes here.

22 MR. ABRAMIC: Perfect. Thank you.

1 JUDGE NIEDRICK: Okay. Mr. Horrigan,
2 any word from him yet?

3 MR. HERRIGAN: Oh, I'm sorry. I thought
4 we were going to take a break.

5 JUDGE NIEDRICK: Okay. Do you want to
6 take a quick break and then -- we're going to take
7 a lunch break after --

8 MR. HERRIGAN: I misunderstood. I'm
9 sorry. I have not emailed him. I might do that
10 right this second.

11 JUDGE NIEDRICK: Okay. Why don't we
12 take a quick 5- minute break while he does that,
13 and then we'll come back and pick up with Scott
14 Boalick. Right. If we can go off the record, Ms.
15 Dawson (phonetic).

16 COURT REPORTER: We are off the record
17 at 11:40 a.m.

18 (Recess)

19 COURT REPORTER: We are back on the
20 record at 11:48 a.m.

21 JUDGE NIEDRICK: Thank you. I'm going
22 to hear from the Agency's next witness, Scott

1 Boalick. I'm going to go ahead and admit him into
2 the review hearing. Hi, Judge Boalick. This is
3 Administrative Judge Andrew Niedrick. Can you
4 hear and see me?

5 THE WITNESS: Yes, Your Honor. Can you
6 see me? I --

7 JUDGE NIEDRICK: I can't see you right
8 now. There you go.

9 THE WITNESS: Okay.

10 JUDGE NIEDRICK: Now I can, and we can
11 hear you fine, too. So, thank you very much for
12 appearing today. And we're going to jump right
13 into it. Mr. Horrigan's going to be asking you
14 some questions first. You see him in one of your
15 windows there. You probably know him. And then
16 --

17 THE WITNESS: Yes.

18 JUDGE NIEDRICK: -- Mr. Suarez, Mr.
19 Kappers, and Mr. Abramic, they're Judge
20 Fitzpatrick's representatives. You see Judge
21 Fitzpatrick there. And then Ms. Dawson, she's our
22 court reporter. And the other two sort of lines

1 or windows that you see are her backup, okay?

2 THE WITNESS: Okay.

3 JUDGE NIEDRICK: So, do you have any
4 objection to swearing an oath?

5 THE WITNESS: No.

6 JUDGE NIEDRICK: Can you please raise
7 your right hand?

8 Whereupon,

9 SCOTT BOALICK

10 was called as a witness and, having been first
11 duly sworn, was examined and testified as follows:

12 JUDGE NIEDRICK: Great. Thank you. You
13 can put your hand down. And please state and
14 spell your first and last names for the record.

15 THE WITNESS: Scott Boalick, S-C-O-T-T,
16 B-O-A-L-I-C- K.

17 JUDGE NIEDRICK: Okay. Thank you very
18 much. If there's an objection or you hear some
19 sort of commotion, please stop testifying. If
20 you're testifying, I'll rule on that objection if
21 that's what it is, and then instruct you on how to
22 proceed, okay?

1 THE WITNESS: All right.

2 JUDGE NIEDRICK: Great. Mr. Horrigan,
3 your witness.

4 MR. HERRIGAN: Thank you.

5 DIRECT EXAMINATION

6 BY MR. HERRIGAN:

7 Q Mr. Boalick, what is your current
8 position?

9 A I'm the chief judge of the Patent Trial
10 and Appeal Board of the U.S. Patent and Trademark
11 Office.

12 Q And how long have you been in that
13 position?

14 A I've been in that position about just
15 over 3 years.

16 Q And what are the duties of the chief
17 judge?

18 A So, the chief judge is basically the one
19 who oversees the operations of the Patent Trial
20 and Appeal Board, including all of the traditional
21 operations and the support operations. We're also
22 responsible for interfacing with the director for

1 Agency policy, and, you know, making sure the
2 judges are trained. And I also am responsible for
3 the hiring of judges and other staff at the Board.

4 Q How long have you been with the USPTO?

5 A I've been with the USPTO since 2007.

6 Q And so, what other positions have you
7 held?

8 A So, I joined as an administrative patent
9 judge, where I've served as an APJ for about 4
10 years. I became one of our first-line
11 supervisors. We call that a lead judge. I was in
12 that position for about 3 years. Then I became
13 part of our executive management team as a vice
14 chief judge, served about 2 years as a vice chief.
15 I then became a deputy chief judge, and I held
16 that position for about 6 years until about 3
17 years ago when I became chief judge.

18 Q And you're a practicing attorney,
19 correct?

20 A I am. Yes. And I got sit on the --

21 Q Did you --

22 A Oh, sorry.

1 Q Go ahead.

2 A No, I was going to say -- so, yes, I am
3 a licensed attorney. And I do -- as part of the
4 duties, we do occasionally sit on some cases as
5 well. But my duties are far more administrative
6 than case-specific.

7 Q Okay. Prior to coming to the USPTO, had
8 you had any experience in intellectual property?

9 A Yes. So, you know, I had a number of
10 years of experience on both -- right out of law
11 school, I clerked for a year for a judge on the
12 Federal Circuit. Then after that, I joined an
13 intellectual property law firm in Washington,
14 D.C., where I practiced as a patent attorney for
15 about 4 years.

16 Then I joined the Navy Department's
17 Office of General Counsel as a patent attorney
18 where I was effectively in-house counsel for two
19 different Navy laboratories, and practiced patents
20 and other IP law until I joined the USPTO as an
21 administrative patent judge. So, my experience in
22 the law has been entirely in the field of

1 intellectual property.

2 Q And how many years of experience is
3 that?

4 A So, I graduated in '99. So, yes, it's
5 over, you know, 23 years I guess I'm coming up on.

6 Q Okay. And in 2018, what position did
7 you hold?

8 A 2018, I was the deputy chief judge.

9 Q And what are the duties of the deputy
10 chief judge?

11 A So, deputy chief judge assists the chief
12 judge in carrying out his or her duties, and is
13 essentially the first-line supervisor of all of
14 our vice chief judges and the second-line
15 supervisor of our lead judges, and -- yes. So,
16 that was the -- right, the deputy chief judge.

17 And there were -- I believe, in 2018, we
18 had four vice chief judges. We also have a
19 position called the Board executive, another SES
20 position. And the Board executive is responsible
21 for all of the administrative functionings of the
22 Board, including our paralegal operations, our IT

1 operations, personnel, you know, all of the
2 various things that helped the Board function.

3 There's about a hundred personnel within
4 the Board Operations Division in addition to about
5 over 250 judges spread out among those vice chief
6 judges.

7 Q Okay. How much interaction would you
8 have with a typical one of these 250 APJs?

9 A Very little. At least very little
10 one-on-one.

11 Q Okay. What --

12 A I think we -- yeah.

13 Q No, go ahead.

14 A Yeah, I was going to say -- so,
15 typically, it's very little. Most of my
16 interaction is with members of the senior
17 management team and also with the Office of the
18 Undersecretary.

19 Q What involvement does a vice chief judge
20 have in that in the matters that come before the
21 PTAB?

22 A So, the vice chief judges are a little

1 -- are more engaged, you know, in the actual
2 cases. So, they are -- first-line supervisor is
3 the lead judge, and second-line supervisors of all
4 the judges. And so, they are more involved in
5 cases. They sit on cases, although they don't
6 have a regular docket of cases. But they're
7 involved in assisting the chief and deputy chief
8 in setting policy, helping to make sure the judges
9 are trained, helping, you know, to facilitate all
10 the operations of the Board.

11 Q And as the vice chief judge, what
12 involvement would you normally have with an
13 individual IPR?

14 A So, as the vice chief judge, you don't
15 have much interaction. As I said, sometimes, vice
16 chief judges are paneled on individual IPRs more
17 so than the chief or deputy chief, and they also
18 oversee some of our policies.

19 So, they might have a case brought to
20 their attention that's significant because of
21 either its holding or some of the legal reasoning
22 in the case. So, cases are brought to their

1 attention. And we had various mechanisms to alert
2 the vice chiefs and the management team about
3 significant cases that are coming down.

4 Q Okay. In the context of AIA cases, APJs
5 work in panels, right?

6 A That's right.

7 Q And panels issues decisions, correct?

8 A That's right.

9 Q And are these final decisions considered
10 final Agency actions?

11 A So, they are now subject -- as we know
12 from a recent Supreme Court case, subject to
13 review by the director of the USPTO. So, it's
14 final, but the director has the freedom to get
15 involved in any final written decision.

16 Q Okay. But APJs are not Article III
17 judges, correct?

18 A They're not. They are not.

19 Q And they are federal employees?

20 A They are federal employees.

21 Q And to your understanding, are they
22 subject to civil service laws?

1 A Yes. So, they are subject to the
2 protections of Title 5.

3 Q And why don't you explain to the
4 administrators your understanding of the
5 responsibility of an APJ to comply with direction
6 from the chief judge from the director?

7 A Yes. So, my understanding is the way
8 the statute's set out is the director of the
9 Agency sets policy for the Agency, and that
10 judges, as Agency employees, must follow the
11 policy guidance of the Agency justice. We must
12 follow binding case law from our reviewing courts.
13 And also, you know, we're bound by the statutes as
14 well.

15 Q Okay. Given that, what does the phrase
16 judicial independence mean to you in the context
17 of an APJ?

18 A So, the way I understand judicial
19 independence is, within the context of a given
20 case, applying the laws and policy that exist, the
21 judges are free to apply that law and policy to
22 the facts of a case based on the arguments and the

1 evidence presented in each case before the panel.
2 And each panel member independently decides how
3 the case should come out, although panels do
4 conference and confer on the cases.

5 Q Does an APJ have to follow the Supreme
6 Court precedent?

7 A Yes.

8 Q How about Federal Circuit precedent?

9 A Yes.

10 Q How about direction from the director of
11 the USPTO?

12 A Yes.

13 Q And how about from the chief
14 administrative patent judge?

15 A Yes.

16 Q Okay. So, then to your understanding,
17 what's the relationship or the line perhaps
18 between judicial independence and an APJ's
19 obligations to follow the direction of management?

20 A So, I mean, the -- again, the
21 independence is to take the policy guidance and
22 apply that to the case that they -- so, the

1 independence is -- you know, sometimes reasonable
2 minds can differ in a given case as to whether,
3 you know, the outcome should be one way or
4 another. In most of our cases, we deal with
5 whether a claim is patentable or not.

6 And so, given the guidance and the
7 policy at hand, one could decide a claim is
8 patentable or not patentable. And there are cases
9 that are very much on the edge sometimes. So,
10 that's what my understanding is. That's where
11 reasonable minds can differ, and a judge is free
12 to vote the way they see the outcome going.

13 Q Okay. I'd like to turn you to one of
14 their tabs, Tab 7, page --

15 A Okay.

16 Q Page 158.

17 A 158, just a moment. Okay.

18 Q Do you recognize that?

19 A Yes, I recognize that email.

20 Q Okay. And so, what's your understanding
21 of the reason why you expanded the panel or you
22 gave notification of the expansion of the panel in

1 this case?

2 A Yes. So, to back up maybe a little bit,
3 the panels are usually set in panels of three
4 judges. Although, the way the statute's written,
5 it can be at least three judges on a panel. It
6 was our practice back when this panel was expanded
7 to -- for certain types of cases, to expand them,
8 there were a number of reasons. We had a standard
9 operating procedure that laid out these reasons.

10 And among them were if it's a case that
11 deals with an important issue, or there's a split
12 at the Board, you know, over a particular point of
13 law and there's a need to resolve that split. So,
14 in this case was a case on remand from the Federal
15 Circuit, and there was a need to clarify. There
16 was an important issue having to do with
17 amendments of claims at the time.

18 Q Okay. Did you have a -- I'm sorry.

19 A I'm sorry. I was only going to say that
20 -- so, the chief judge is the one who decides to
21 expand the panel, and I was merely -- I was
22 conveying the decision of the chief judge to

1 expand the panel.

2 Q Okay. So, you had discussions with Mr.
3 Ruschke about this?

4 A Yes.

5 Q And so, this decision was his?

6 A So, the decision to expand was his.
7 Yes.

8 Q What role did Scott Weidenfeller play in
9 the decision to expand the panel?

10 A He didn't really play a role in the
11 decision to expand, other than -- I believe he may
12 have been the one that brought the issue to our
13 attention.

14 Q And how would that have happened?

15 A So, we had a committee -- we still do,
16 it's called the AIA review committee. It's
17 modeled after a very similar process at the
18 Federal Circuit, although the Federal Circuit has
19 since modified this process where there was a
20 group that looks at outgoing decisions and points
21 out conflicts among precedent or, you know, cases
22 where there's arguable areas of unclarity.

1 So, there's -- the AIA review committee
2 looked at all final AIA decisions and decisions on
3 remand from the Federal Circuit, and would flag
4 areas where there seemed to be some disagreement
5 or need for clarity or important issues. And this
6 was one of those cases that was at least brought
7 to my attention by the AIA review committee.
8 Scott Weidenfeller was a primary interface to the
9 AIA review committee.

10 Q Okay. So, now, on November 4, 2016,
11 when this decision was rendered, was the public
12 notified of this?

13 A No.

14 Q Why not?

15 A This was something we considered to be
16 internal operations of the Board and deliberative
17 process type information -- these kinds of
18 decisions, whether to expand, to unexpand --
19 because we didn't consider a case truly expanded
20 until it had issued with the expanded panel.

21 It could be unexpanded at any time by
22 the chief judge, as actually happened in this

1 case. But there were others where cases were
2 expanded and unexpanded. So, it was not something
3 that -- you know, we felt it is a deliberative
4 process information of the Agency.

5 Q Okay. So, do you think it's important
6 for the Board to let the public know or the
7 parties know who the judges were that made the
8 final decision?

9 A Yes, and we do that when a decision
10 issues; it has the names of the judges who, you
11 know, are actually on the panel at the time making
12 that decision. So, for example, if this had
13 issued as an expanded panel, it would have had the
14 names of all of the expanded panel judges on it.

15 And the same process was used even if a
16 judge had to drop off a case, say, due to a
17 conflict of interest that arose or some other
18 issue where they weren't able to continue
19 participating. When the decision issued, at least
20 at this point in time in the Board's history, what
21 would happen is the decision would issue with the
22 new judges' name on the opinion. But it would not

1 have been apparent until that decision issue that
2 the change had been made. So, that was our
3 practice at the time.

4 Q At that time, did you agree with that
5 practice?

6 A At that time, I didn't have a problem
7 with that practice. Although, you know, in
8 general, I'm in favor of, you know, being
9 transparent to what's happening. And in fact, at
10 a later point in time, Director Iancu, when he
11 came on Board, wanted to be more transparent, and
12 we changed our operating procedure to, you know,
13 notify the public when panel changes were made.

14 So, that's something that -- you know,
15 in our evolution, we came to a point where when
16 panel changes were made, we would announce them.
17 But that was several years -- that was, you know,
18 down the road. That was -- I don't recall exactly
19 when, but it was after -- long after this change
20 had happened for the panel expansion.

21 Q Okay. And so, can we get your views on
22 how this process of notification of the parties

1 and the public of the panel members comports with
2 due process?

3 A So, again, I think parties are entitled
4 to know who made the decision. And our process of
5 putting the names of the judges on the decision
6 when it issues told the parties who had made their
7 decision.

8 Q Okay. What is your understanding of the
9 authority of the director of the USPTO when it
10 comes to staffing panels?

11 A My understanding is the director has
12 complete control to staff panels.

13 Q Is it correct that the source of this
14 authority is U.S.C. 6(c) (sic)?

15 A That's my understanding. Yes.

16 Q What do you understand the constraints
17 placed on the director in 36 U.S.C. 6(c) to staff
18 panels?

19 A I mean, it's very broad. I think there
20 may be, of course, some theoretical limits. I
21 don't believe the director could staff panels in a
22 way that was discriminatory, for example. You

1 know, all-male panels, and forbid female judges
2 from being paneled, I think that would be beyond
3 the limits. But otherwise, the authority is quite
4 broad.

5 Q Have you had occasion to research the
6 director's authorities to staff panels under 35
7 U.S.C. 6(c)?

8 A I've done some. I've not extensively
9 researched it. However, our legal team and the
10 Department of Justice had weighed in on the
11 legality of this. I know they do extensive
12 research on this.

13 Q Are you familiar with In re Alappat from
14 the Federal Circuit in 1994?

15 A I'm familiar with the case.

16 Q How is it that you're familiar?

17 A Well, so, I've read it. Although, it's
18 been a while since I've read the case. But it is
19 a case that was -- I'm trying to remember exactly
20 when, I believe late '90s -- dealt with panel
21 expansion, where the director of the office had
22 expanded a panel with management judges who the

1 director was fairly confident would vote on a case
2 the way that the director wanted the case to come
3 out. That case went up to the Federal Circuit and
4 was affirmed.

5 Q And so, what is your understanding of
6 the holding with respect to panel expansion?

7 A So, my understanding of the holding is
8 that, you know, panel expansion is a mechanism or
9 tool at the disposal of the director.

10 Q The Alappat case predates the American
11 Invents Act, correct?

12 A It does, yes.

13 Q What is your understanding of the
14 continued application of Alappat to AIA cases?

15 A I believe the -- that it continues.
16 There was not a change in the America Invents Act
17 that I am aware of that would impact that
18 authority the director to set panel. The wording
19 in the statute is either very close or nearly
20 identical. So, I'm not aware of anything that
21 would have changed and made Alappat anything other
22 than good law.

1 Q Okay. So, what is your understanding of
2 the constraints that the courts have placed on the
3 director's authority under 35 U.S.C. 6(c)?

4 A I'm not aware of any case that has
5 ruled, you know, on that authority to set panels.
6 And they've not, to my knowledge, set any
7 boundaries in a court decision.

8 Q All right, I'm going to refer you now to
9 Tab 32, page 161.

10 A Okay.

11 Q Do you recognize that as MPEP
12 1002.02(f)?

13 A Yes, I do.

14 Q Under whose authority do you understand
15 the MPEP is issued?

16 A I understand it to be issued under the
17 authority of the director.

18 Q And what do you understand section
19 1002.02(f) to be doing?

20 A Well, it's doing a couple of things.
21 But one of the things that it does is it does talk
22 about in -- I believe it's number three here, that

1 it gives the authority to designate members of the
2 Board, either on appeal or in our AIA trials, you
3 know, to be paneled by the chief judge, or further
4 delegated by the chief judge to others.

5 In fact, what we have at the Board,
6 we've had for pretty much as long as I can think
7 going back, because we do have administrative
8 staff who do the day-to-day handling of the cases.
9 And they had been delegated that authority to
10 assign members of the Board to the cases.

11 Q Okay. To your understanding, what is
12 the relationship between the director's authority
13 under 35 U.S.C. 6(c) and the delegation we see at
14 paragraph three of MPEP 1002.02(f)?

15 A I believe it's the same authority, just
16 delegated non-exclusively to the chief judge. And
17 it may be further delegated by the chief to
18 others, including administrative staff.

19 Q What constraints do you understand the
20 director placed on the delegation of authority you
21 see here?

22 A No constraints.

1 Q Okay. All right. So, we're focused on
2 the final two clauses of paragraph 3. And let's
3 look at the language, "Conduct inter partes
4 reviews and post-grant reviews initially and on
5 request for reconsideration." We've had a lot of
6 evidence about what a post-grant review is, so
7 let's just skip to initially and on
8 reconsideration.

9 A Okay.

10 Q What do you understand that to mean?

11 A So, I understand that to mean both at,
12 you know, the outset of an opinion and once an
13 opinion has been issued, there's a reconsideration
14 period. And so, this happens both when a
15 decision, let's say -- so, you've gone through the
16 different stages. So, I'll just say -- so, you
17 have at the institution phase, you have an
18 institution decision. You panel -- you can panel
19 the judges initially. The institution decision
20 issues, there's an opportunity to request
21 rehearing.

22 Then if a trial was instituted, you can

1 initially panel the judges on the actual trial,
2 which could be different than the institution
3 panel. And then the final decision after the
4 trial issues, there's a period of requests for
5 rehearing.

6 Likewise, on remand from the Federal
7 Circuit, when it comes back from the Federal
8 Circuit, there's also an initial decision on
9 remand that's made. And then when the decision on
10 remand is issued, parties can request
11 reconsideration. And so, those are places under
12 the MPEP here that -- where panel members can be
13 designated.

14 Q Now, in this particular case, there was
15 a remand from the Federal Circuit, correct?

16 A That's right.

17 Q Now, did the IPR number change at all
18 after that remand?

19 A No, it's the same IPR number.

20 Q And why is that?

21 A Well, it's -- we consider it part of a,
22 you know, continuing matter. Just as, you know,

1 the final written decision gets appealed, the
2 Federal circuit can do a number of things with it,
3 you know, including affirm it. They can reverse
4 it. They can, you know, remand it to us, which is
5 what happened here. We just keep the same number
6 for ease of reference. I mean, I suppose one
7 could change it, but there's really no reason to.

8 Q Now, do you, as an expert, see anything
9 in paragraph here that would constrain the ability
10 of the chief judge to expand the panel in the Nike
11 IPR after remand?

12 A No, because we -- the way I see this is,
13 coming back on remand, there's -- before, you
14 know, the decision is issued, you can initially
15 panel that panel, including expand it. And it
16 could have been, although it wasn't, you know,
17 repaneled if a request for reconsideration were to
18 issue.

19 Q In fact, what's your understanding of
20 the director's authority on the remand to put in a
21 whole different panel?

22 A Well, they could do that and put an

1 entirely different panel in.

2 Q All right. Let me ask you to turn to
3 Tab 26, page 45.

4 A All right.

5 Q Do you have that?

6 A Okay. I do. I do, yes.

7 Q What do you understand that to be?

8 A So, that's our standard operating
9 procedure number 1. This looks like an older
10 version of that. And this is a public document
11 that explains how we assign judges to panels.

12 Q Okay. Does it look like this is the
13 version that was in effect in 2018?

14 A I believe it is.

15 Q Okay. And so, how does SOP 1 relate to
16 the expansion of the panel in the Nike case?

17 A So, SOP 1 talks about expanded panels
18 and the criteria for expanding a panel. And as I
19 believe I mentioned earlier, those criteria were
20 met by the Nike case, and the chief judge decided
21 to expand. It's not something that was done
22 often, in fact. And the SOP says that it's

1 something that should not be used often, and it
2 wasn't. But in the right case, that was a
3 mechanism that had been used, especially where
4 there were important issues or potential splits of
5 thinking at the Board.

6 Q Okay. And let me ask you to scroll down
7 to page 47 of this same document.

8 A Okay. All right.

9 Q And what do you understand that to be?

10 A So, that's the guidance that I was
11 referring to. It's saying that expanded panels
12 are not favored and won't be used in the ordinary
13 course. But there are some criteria setting out
14 for -- yeah, for criteria that are exemplary.
15 They're not exclusive, but they are examples of
16 when it might be appropriate.

17 And so, the first one involves issues of
18 exceptional importance -- that's one of the things
19 that was an issue in the Nike case -- as well as
20 perhaps uniformity of decisions where there might
21 be conflicting decisions on interpreting the
22 statute or rules. So, those were reasons that a

1 panel would be expanded.

2 Q And to what extent do you understand
3 that the expansion of the panel in the Nike case
4 was consistent with the guidance we see here in
5 paragraph 3 -- or section 3?

6 A So, I understand it to be consistent
7 with, you know, the SOP 1 in part 3.

8 Q When the decision was made to expand the
9 Nike IPR panel, what doubts did you have about the
10 authority of the director or of the chief judge to
11 expand that panel?

12 A Oh, I didn't have any doubts about the
13 authority.

14 Q All right. So, let's go back to early
15 2018. Just describe the sort of work that you did
16 as a vice chief judge. Oh, excuse me, as deputy
17 chief judge.

18 A Okay. So, as deputy chief judge, as I
19 mentioned, I was involved in helping the chief
20 judge operate the Board. At the time, we had over
21 250 judges in four different judge divisions. We
22 had about a hundred other staff, including --

1 there were IT development efforts that I was
2 helping with, policy efforts, rulemakings that
3 were going on where we were trying to make some
4 changes to our practice.

5 In 2018, we were still doing some hiring
6 of judges at that time. And I would say there
7 were just, you know, dozens of different things
8 pretty much every day that would come to my
9 attention. The Board has been the subject of a
10 lot of attention, both from stakeholders, from
11 Congress. And so, we were kept, you know, very
12 busy responding to different inquiries, proposed
13 legislation. And as I say, try and keep the Board
14 running internally as well.

15 Q And in early 2018, how much of your time
16 was devoted to the Nike IPR?

17 A Very little. Although, when I was
18 looking at the case, I probably -- hard to say
19 exactly. But I mean, I might have spent, total
20 time, a couple of days on it, broken up in chunks,
21 reading opinions, looking at different issues.
22 But it was a small part of my day-to-day

1 activities.

2 Q Okay. And how much of your focus in
3 this time period was devoted to Michael
4 Fitzpatrick?

5 A Again, very little.

6 Q Okay. Between November 2016 and March
7 2018, what was taking place in the Nike case?

8 A So, pre-2016 and '18 -- well, among
9 other things, the panel, I believe that's in the
10 period where it had been expanded. Also going on
11 at the same time, and highly relevant to the
12 issues in the case, there was a case the Federal
13 Circuit had taken up en banc on the issue of
14 amendments. And it's on the tip of my tongue,
15 it'll come in a moment.

16 But that case -- sometimes, one of the
17 things that happens is when the Federal Circuit
18 takes up a case that's very relevant to something
19 ongoing, we want to see how the Federal Circuit
20 rules in that case, because that will impact what
21 we do. So, there was a pending case, so it
22 impacts us.

1 There was also, as I mentioned, just a
2 million other things happening at the Board in
3 parallel with the Nike case that both the chief
4 judge and I were involved in and demanded our
5 attention.

6 Q Is the case that is on the tip of your
7 tongue Aqua Products?

8 A Yes, thank you.

9 Q Okay.

10 A That's the one.

11 Q And so, why don't you explain to the
12 administrative judge how Aqua Products fit into
13 the disposition of Nike?

14 A Yes. So, Aqua Products dealt with the
15 question of who has the burden in our case to show
16 amended claims are not patentable. And our rule
17 had put that burden on the petitioner. And the
18 ultimate holding of Aqua Products was that -- or
19 excuse me, I've got that backwards. Excuse me.
20 Our rule put that burden on patent owner.

21 And the ultimate holding of a lot of
22 products was that petitioner was the one who had

1 the burden of showing an amended claim is
2 unpatentable, which was a complete flip of our
3 practice. And that's why that was a really
4 important issue, is it turned the practice on its
5 head as far as who had the burden.

6 Aqua Products was a very fractured
7 opinion by the Federal Circuit. And it's kind of
8 hard to make too much more of what it really
9 holds, other than that one clear holding is that
10 the burden cannot be on the patent owner. And so,
11 that flip in burden was the major outcome. And
12 that impacted the Nike case, because Nike had
13 initially, per our rule and practice, put that
14 burden on the patent owner. So, it required a
15 rethinking of who had the burden to show on
16 patentability.

17 Q Okay. And then you're aware of Idle
18 Free as well?

19 A I am. Idle Free was a decision of the
20 Board, and I believe was informative, that went
21 through what was needed to show some of the
22 different regulatory requirements that we put on

1 patent owners for amendments like what's a
2 reasonable number of substitute claims.

3 Just why that one was important is the
4 inter partes review replaced a practice that was
5 called inter partes re-exam, where it was the
6 regular practice of patent owners to put hundreds
7 of new claims into a case. And the AIA required
8 that the number of substitute plans be reasonable.
9 Idle Free put a little bit of a framework around
10 what is reasonable. Again, an informative case is
11 one that provides what we think of as kind of the
12 Board best practices.

13 Q Okay. And so, the relationship then
14 between Nike, Aqua Products, and Idle Free, just
15 to close this out.

16 A Okay. So, just kind of in a nutshell.
17 So, Aqua Products, from the Federal Circuit,
18 reversed the who has the burden to show a claim is
19 unpatentable. That essentially overruled the
20 framework in Idle Free for who has the burden.
21 There were other aspects of Idle Free that might
22 still potentially be relevant, such as what's a

1 reasonable number of substitute claims, just as an
2 example.

3 And Nike is a case that dealt with
4 amendments and had looked at, you know, the
5 burden. And one of the main issues was the number
6 of substitute claims reasonable in that case.

7 Q Okay. So, I'm going to ask you now to
8 go to Tab 32, page 79.

9 A Okay. You said 79?

10 Q Correct. Can you explain to us what's
11 going on here?

12 A Okay. Let's see. So, we have an order.
13 Just give me a moment to remember this one here.
14 Okay, yes. So, now, this is an order that I
15 issued shortly before the Nike panel issued its
16 decision, and was explaining some of the
17 circumstances that had taken place.

18 So, as I mentioned, the Nike case had
19 been remanded to us. The Federal Circuit had, in
20 the intervening time, decided Aqua Products, which
21 changed the burden that caused us to de-designate
22 our prior precedential. This MasterImage 3D case

1 was one that leveraged Idle Free in its reasoning,
2 and also Idle Free as well.

3 And there was just an explanation --
4 because there was some concern about the length of
5 time this case had been sitting. So, we wanted do
6 explain that, you know, what -- because of these
7 major policy issues and changes there -- you know,
8 we had essentially waited for Idle Free to come
9 out. It turns out, it did completely change the
10 law, and therefore, required extra time.

11 So, that's what this order was doing
12 here. It also noted a panel change where we had
13 replaced Judge Fitzpatrick on the panel at that
14 point in time.

15 Q Okay. And so, focusing on that panel
16 change, you said that you didn't discuss the
17 expansion of the panel in November 2016, or the
18 unexpansion in 2019.

19 A That's right. Because as I mentioned,
20 we'd never consider a panel expanded until it
21 issues with the expanded panel's names on it.

22 Q Okay. And so --

1 A I think we (inaudible) at any time as
2 this one was.

3 Q And why was this one unexpanded?

4 A Well, this one was unexpanded because
5 essentially, Aqua Products answered the questions
6 for us about burden. There really wasn't a need
7 to have the expanded panel. That's my
8 understanding.

9 Again, the chief judge made the call to
10 expand it. But, you know, my understanding of his
11 reasoning is that, you know, Aqua Products has
12 sorted this out for us.

13 Q And so, a three-judge panel issued a
14 final decision shortly after this order we're
15 looking at, right?

16 A That's right.

17 Q Now, to what extent did you dictate to
18 those three judges what the outcome was going to
19 be?

20 A I didn't.

21 Q Have you ever done that?

22 A No.

1 Q Okay. What do you think of the
2 allegation that that's what's happened?

3 A I don't think that's right.

4 Q Why?

5 A I don't think that we ever dictated what
6 the outcome was, you know, to judges when we were
7 not on the panel. I'm not sure in what fashion
8 that might be. I think that -- well, I just -- I
9 don't know why one would think that. I didn't say
10 how you needed to rule, you know, on the case.

11 Q Okay. So, you can imagine a situation
12 where the panel's expanded for the purpose of
13 putting -- getting the management involved,
14 correct?

15 A Right.

16 Q Okay. And that would probably be --
17 well, you tell me -- to maintain policy?
18 Consistency and policy, all the reasons --

19 A That's right. Yeah, that was one of the
20 main reasons. And it's an important issue. And
21 we needed consistency, yes.

22 Q And in that process, is it ever the

1 occasion where you dictate to any judge on the
2 panel, what the outcome's going to be?

3 A No. As I mentioned, you know, in my
4 mind, for judicial independence, that's where that
5 independence comes in. Each judge can vote as
6 they see fit, you know, given the policy, the
7 facts, the law at hand. So, they vote the way
8 that they want. We never tell a judge how they
9 must vote on a case.

10 Q Okay.

11 MR. HARRIGAN: I'd like to move this
12 document, Agency Exhibit 5, Tab 32, page 79 to 82
13 into evidence.

14 COURT REPORTER: Could you repeat that,
15 Mr. Harrigan?

16 JUDGE NIEDRICK: Any objection?

17 MR. HARRIGAN: Say again?

18 COURT REPORTER: Could you repeat that
19 louder, Mr. Harrigan?

20 MR. HARRIGAN: Of course. Agency -- Tab
21 32, pages to 82.

22 COURT REPORTER: Thank you.

1 JUDGE NIEDRICK: Any objections? Mr.
2 Abramic, any objection?

3 MR. SUAREZ: No objection. Sorry.

4 JUDGE NIEDRICK: I'm sorry. Mr. Suarez,
5 did you want to say something?

6 MR. SUAREZ: Yeah, I said no objections.

7 JUDGE NIEDRICK: Okay. Thank you.

8 Okay, that's admitted without objection.

9 MR. HERRIGAN: All right. Thank you.

10 BY MR. HERRIGAN:

11 Q And then I'd like to turn to page 14 of
12 the same document.

13 A Okay.

14 Q And what do you understand that to be?

15 A Okay. So, that is a -- okay, that is
16 the opinion that was entered, actually, in the
17 case, because it has Judge Daniels on it replacing
18 Judge Fitzpatrick.

19 Q Okay. And so, again, this was a
20 three-judge panel, correct?

21 A That's right.

22 Q And this is the final decision on

1 remand?

2 A That's the final decision on remand,
3 yes.

4 Q Okay.

5 MR. HERRIGAN: I'd like to move this
6 document into evidence, which is pages 14 to 78 of
7 Tab 32.

8 MR. SUAREZ: No objection.

9 JUDGE NIEDRICK: Thank you. That's
10 admitted without objection.

11 BY MR. HERRIGAN:

12 Q All right. Are you aware of other
13 occasions when a panel has been expanded?

14 A Yes.

15 Q And how many would you estimate?

16 A Probably about 6 to maybe 10. So, I'll
17 just give some examples. There were a number of
18 expanded panels in the wake of a prior Supreme
19 Court case called KSR that dealt with the issue of
20 obviousness. And there were a number of expanded
21 panel decisions of the Board in the wake of KSR,
22 because it was a very -- an important decision

1 that impacted the way we do our obvious analysis,
2 which was really one of the mainstays of our
3 judicial analysis.

4 Another occasion was there were some
5 decisions involving issues of sovereign immunity.
6 And again, the chief judge expanded some panels
7 for uniformity in some of these sovereign immunity
8 cases. So, it had been done. It is pretty rare,
9 just as the standard operating procedure
10 indicates.

11 Q Okay. But Idle Free was another
12 occasion on which a panel was expanded.

13 A It was -- oh, yes. Idle Free was
14 another expanded panel. That's true, yes.

15 Q Okay. And so, let's walk through Idle
16 Free real briefly. Tab 32, page 265, please.

17 A Okay, just a moment. Okay.

18 Q All right. And what are we looking at?

19 A So, this appears to be the three-judge
20 panel decision in Idle Free versus the expanded
21 panel.

22 Q Okay. This is the institution decision,

1 correct?

2 A Yes, that's right. Yes, the institution
3 decision.

4 Q Okay.

5 MR. HERRIGAN: And so, I'd like to move
6 Agency Exhibit 17, Tab 32, pages 265 to 293, into
7 evidence.

8 MR. SUAREZ: No objection.

9 JUDGE NIEDRICK: Did you say no
10 objection?

11 MR. SUAREZ: Correct, no --

12 MR. HERRIGAN: Oh, I'm sorry. I'm
13 sorry, it is -- you have already accepted that
14 document and one other (inaudible). My apologies.
15 When Mr. Fitzpatrick was testifying.

16 JUDGE NIEDRICK: Hang on one second. I
17 don't think I have that in my notes.

18 MR. HERRIGAN: Okay.

19 JUDGE NIEDRICK: What were -- it was 265
20 to --

21 MR. HERRIGAN: 293.

22 JUDGE NIEDRICK: On Tab 32, correct?

1 MR. HARRIGAN: Correct.

2 JUDGE NIEDRICK: Yes. Okay, that's
3 admitted without objection. I didn't have that in
4 my notes. Maybe I had it earlier. I didn't see
5 that.

6 MR. HARRIGAN: Okay. Either way is
7 fine. Okay, thank you.

8 BY MR. HARRIGAN:

9 Q And so, we're still in Tab 32. Let's go
10 to 253.

11 A All right. Okay.

12 Q And what's this?

13 A So, this is the expanded panel Idle Free
14 decision on the motion to amend.

15 Q Okay. And we see now that there was an
16 expanded panel, correct?

17 A That's right.

18 Q Which included you?

19 A It included me, yes.

20 Q And was notification given to the
21 parties before this document was issued that the
22 panel would expand?

1 A Not before it issued.

2 Q Okay. And again, what's the logic
3 there?

4 A So, the logic is when a panel is
5 expanded, it could be unexpanded. And until such
6 time as the decision was made to actually issue
7 the panel as decided, you know, with an expanded
8 panel, it didn't seem to be something that was
9 necessary. At least for due process, because the
10 parties would be notified once a decision was made
11 and issued -- of who was on that decision.

12 Q Do you recall --

13 A I mean, what do you do when -- you know,
14 if you know that various judges are, you know, on
15 your panel, you can't lobby them. You can't call
16 them. You know, as long as you know who made your
17 decision when the decision is made, we think that
18 comports with due process.

19 Q Okay. And you recall why this panel was
20 expanded?

21 A So, this panel was expanded to try to
22 give some guidance. Again, this is very early on,

1 since in 2013, recall that these AIA trials first
2 came to life in September of 2012. So, you know,
3 this was very early on.

4 And, you know, in the new practice of
5 AIA trials where everybody's trying to get their
6 footing, trying to get guidance to help the
7 parties, to tell them how to conduct themselves.
8 And one of the important things to do at that time
9 was to give guidance on motions to amend and try
10 to put a framework around how the Board would take
11 motions to amend and how it would decide them.

12 And so, this was a document that was
13 informing parties of how the Board would view
14 substitute claims, and, you know, some of the
15 regulatory requirements around motions to amend.

16 Q And to what extent do you understand
17 this expansion was taken under the chief judge's
18 authority in MPEP 1002.02(f)?

19 A I understand that's the authority that
20 would have been used to expand this panel.

21 Q What is your opinion on whether the
22 expansion of the panel in Idle Free was legal?

1 A I believe that it's legal.

2 Q What is your expansion -- your position
3 on the question of whether the expansion of the
4 panel here comported with SOP 1?

5 A It comported with SOP 1 because it was
6 an important issue where parties needed some
7 clarity.

8 Q Okay. And so, we're on -- still on the
9 front page of page -- on 253, Tab 32. Did Mr.
10 Fitzpatrick object to this expansion?

11 A No.

12 Q Okay.

13 MR. HARRIGAN: I'd like to move Agency
14 Exhibit 16, Tab 32, pages 253 to 264, into
15 evidence.

16 JUDGE NIEDRICK: Any objection?

17 MR. SUAREZ: No objection.

18 JUDGE NIEDRICK: Okay. That's admitted
19 without objection.

20 BY MR. HARRIGAN:

21 Q And then to close out Idle Free, let's
22 go to page 213 of the same document, Tab 32.

1 A Okay.

2 Q And what is this?

3 A So, this is the final written decision
4 in Idle Free with the three-judge panel.

5 Q Okay. And so, it was -- the panel was
6 unexpanded?

7 A That's right.

8 Q Do you recall why?

9 A It was expanded just for the issue of
10 how to handle motions to amend. That was the
11 important issue that was being dealt with. And
12 so, once that order on the motion to amend was
13 issued, there was no further need for expansion.
14 And it was unexpanded to the original panel.

15 Q And to what extent do you see a parallel
16 here to the Nike case?

17 A Well, I see parallels in that -- as I
18 mentioned, you know, panels can be expanded and
19 unexpanded, and that was a routine practice. And
20 so, similarly, between Idle Free, which was
21 expanded, there was then a further unexpansion.

22 In Nike, the expansion and expansion all

1 took place, but no decision -- I mean, one
2 difference is that no decision was issued by the
3 expanded panel. But otherwise, they were expanded
4 for important reasons in accordance with SOP 1
5 under the same authority, and then unexpanded when
6 the need was no longer there.

7 Q Okay.

8 MR. HARRIGAN: So, I'd like to move this
9 exhibit, Agency Exhibit 15, Tab 32, pages 213 to
10 252, into evidence.

11 MR. SUAREZ: No objection.

12 JUDGE NIEDRICK: Can you repeat the page
13 numbers for me again, please?

14 MR. HARRIGAN: 213 to 252.

15 JUDGE NIEDRICK: Thank you. Any
16 objection?

17 MR. SUAREZ: None.

18 JUDGE NIEDRICK: Okay. That's admitted
19 without objection.

20 BY MR. HARRIGAN:

21 Q All right. So, let me take you then to
22 Tab 7, page 391.

1 A Okay.

2 Q And what do you understand that to be?

3 A So, that is the draft decision in Nike
4 versus Adidas with the expanded panel of Chief
5 Judge Ruschke and myself, the initial decision on
6 remand from the Federal Circuit.

7 Q And when this draft decision was
8 circulated, would you have read it?

9 A Yes.

10 Q Okay. And so, then let's go to page
11 425.

12 A Oh, okay. Yeah, I'm there.

13 Q And you see that that's Mr.
14 Fitzpatrick's draft concurrence, correct?

15 A I see that, yes.

16 Q Okay. What is your position on
17 concurrences, generally?

18 A So, generally, we encourage judges to
19 concur or dissent against part of the judicial
20 independence on a case if they disagree with the
21 -- either outcome or reasoning of the majority to
22 put in a concurring or dissenting opinion.

1 Q Does it sometimes happen that you
2 disagree with something in the concurrence or
3 dissent?

4 A Yes. If I agreed with it, I would join
5 it. If I was on the panel -- and oftentimes, I am
6 not on the panel -- I'll read a concurrence or
7 dissent and think, yeah, I don't agree with that
8 point of view.

9 Q Okay. And if that happens, what do you
10 do as then the vice chief judge?

11 A Nothing. I mean, you just note that,
12 oh, okay, I don't agree with that reasoning.

13 Q Okay.

14 A But as I said, reasonable minds can
15 differ on a lot of our issues.

16 Q Okay. And with this particular
17 concurring opinion, what would you -- what did you
18 think of it?

19 A So, this particular one -- and I'm
20 trying to remember if this was the one that had
21 what we deemed to be confidential information, and
22 I thought it was fine to concur or not agree. But

1 I think the boundary that I think was crossed here
2 is that there was internal deliberative process
3 information in the concurrence that we felt should
4 not be in there.

5 Q And how did you become aware of that?

6 A Well, by reading the concurrence. It
7 leapt out of this that there were some things that
8 we deemed non-public and part of our deliberation
9 that were in here that should not have been in
10 here.

11 Q Okay. Then I'm going to refer you down
12 to page 434 of the same document, Tab 7.

13 A Okay. All right.

14 Q And are you familiar with this section
15 of the concurrence?

16 A Yes, I'm familiar with it.

17 Q How would you characterize the argument
18 that Mr. Fitzpatrick is making in sections 4 and
19 5?

20 A So, section 4, I mean, just looking at
21 the point heading, you know, he's arguing that the
22 director did not authorize the panel and that it

1 was inconsistent with statutory authority.

2 Q Okay. What did you think of Mr.
3 Fitzpatrick's arguments here?

4 A Right. Well, I thought he's wrong.
5 He's entitled to his opinion, but I think that
6 that's not a correct view of the law. But that's
7 his view.

8 Q Now, did you understand in section 4
9 that Mr. Fitzpatrick was arguing that you or Mr.
10 Ruschke had violated some affirmative law?

11 A I did not really understand that. No, I
12 think he was -- I mean, he's just saying -- I
13 mean, he didn't believe the chief judge had the
14 authority to expand. And as I explained, I don't
15 agree with his reading of initially.

16 Q And in section 5, to what extent did you
17 understand that he was arguing that the director
18 violated some affirmative law -- statute case.

19 A Give me just a moment to look that one
20 over, if that's --

21 Q Sure.

22 A Well, again, I think we just have the

1 disagreement over the authority of the director,
2 you know, by statute, when paneling is
3 permissible.

4 Q Now, even though you disagreed with the
5 argument that was presented here, did you have any
6 concerns about it being published?

7 A No. I mean, it was his view of the law.
8 And this was not something that, you know, we
9 required to be removed from the concurrence.

10 Q Now, in light of everything else that
11 you had going on at the time, so, at March 2018 --
12 April, maybe, when you saw it -- how big of a
13 thing was this for you?

14 A Not a very big thing. It was one of
15 many, many things. Certainly, it was not the most
16 important policy or legal matter I was dealing
17 with.

18 Q Okay. Let's turn to Tab 7, page 559.
19 So, same document.

20 A I'm sorry, could you repeat that again,
21 the page?

22 Q Sure, 559.

1 A Okay.

2 Q Okay. You brought this up, so let's
3 just make sure everybody's on the same page. What
4 do you understand this to be?

5 A So, this is an email from Susan Mitchell
6 to Judge Fitzpatrick talking about the
7 confidential information that we had flagged in
8 the concurrence that we thought was not
9 appropriate and should be removed.

10 Q Okay. And you see that she references
11 -- highlights in yellow on pages 6 to 9 of the
12 draft concurrence, correct?

13 A I see that.

14 Q Okay. And so, if you would go, please,
15 to 599.

16 A All right, 599. Just a moment. Okay.

17 Q Okay. And you see there's some
18 highlighted information, correct?

19 A That's right.

20 Q And scrolling down, then, you'll also
21 see we're on page 6 of the draft concurrence.

22 A That's right.

1 Q Okay. So, if you would scroll down to
2 602, and you'll see there's additional highlighted
3 information.

4 A That's right.

5 Q Okay. Now, what is your opinion on
6 whether that highlighted information is, in fact,
7 confidential information?

8 A Yeah, my opinion is that is confidential
9 Agency information that touches on non-public
10 aspects of our deliberations.

11 Q Okay. And why is it non-public? What's
12 confidential about it?

13 A Well, what's confidential is that it's
14 talking about interactions, you know, dates on
15 which expansion happened. But as I mentioned,
16 this case ended up being unexpanded. And so, at
17 least, you know, in our practice, that was not
18 something that -- if a panel is expanded and
19 unexpanded without issuing an expanded panel
20 decision, it was not something that entered into
21 the actual opinion as issued. The opinion as
22 issue was issued by three judges whose name

1 appears on the decision at the time it issues.

2 It's also talking about when -- you
3 know, what judges had done. And, you know, it's,
4 again, talking about kind of internal panel
5 interactions, including internal panel
6 communications that are not things that are part
7 of a public record.

8 Q And so, could you explain -- if you do
9 think this, how does this relate to deliberative
10 process?

11 A So, it relates to our deliberations on
12 whether it makes sense to expand the panel or not
13 expand the panel. And when the panel's expanded,
14 like any other panel, then all five members --
15 well, in this case, it's five panels. It can be
16 expanded to more than five, but five was the
17 typical number of judges in an expanded panel.

18 But, you know, when the panel is
19 expanded, deliberations occur. If it's
20 unexpanded, it's essentially as if those
21 deliberations never happened. We're back to the
22 original three judges. And their opinion on the

1 case is what counts and what's reflected in the
2 opinion that issues.

3 Q Okay. We just scrolled through pages 6
4 through 9 of the concurrence.

5 A Mm-hmm.

6 Q Do you see that -- none of the
7 highlighted information is in sections 4 or 5 of
8 the draft concurrence, correct?

9 A That's right.

10 Q Did you make any effort to change
11 sections 4 or 5 of the draft concurrence?

12 A No.

13 Q Okay. And so, let me ask you to turn to
14 page -- oh, I'm sorry. We're here. So, okay,
15 now, with respect to the arguments themselves that
16 we see here, okay?

17 A Mm-hmm.

18 Q You had an opportunity to review these?

19 A I did.

20 Q Okay. And we talked about your general
21 impression of the merits here, but let's focus
22 more narrowly. So, we'll go to the 603.

1 A Okay.

2 Q Okay. Do you see that?

3 A Yes.

4 Q And into 604.

5 A Okay.

6 Q Do you see the argument there?

7 A Okay. Is that section 5 that we're
8 talking about, or is that --

9 Q Yes.

10 A Okay. I see that.

11 Q Okay. What do you make of this
12 argument?

13 A Again, I think it misunderstands the
14 nature of a panel expansion and the authority to
15 expand an initial decision on remand.

16 Q Okay. All right. And so, you're
17 familiar then, scrolling up to sections 4, where
18 he's arguing about the -- that the director did
19 not, in fact, delegate authority to expand this
20 particular panel, correct?

21 A I see that. Again, I disagree. I do
22 think and believe that authority has been

1 delegated by the director to the chief judge. And
2 again, it's just routinely exercised by our
3 paneling branch. They panel thousands of cases a
4 year. So, obviously, director's not going to
5 panel thousands of cases him or herself.

6 Q So, reading through this, do you believe
7 that Mr. Fitzpatrick has identified a flaw in the
8 chain of delegation either at the 35 U.S.C. 6(c)
9 level or in the MPEP level?

10 A No, I don't think he has.

11 Q Do you believe a person with the Mr.
12 Fitzpatrick's experience and education and
13 understanding of this particular area of the law,
14 a reasonable person in that position, could think
15 that there's a violation of law somewhere in this
16 section?

17 A I don't think so.

18 Q Okay. All right. Nonetheless, with
19 that opinion, had Mr. Fitzpatrick not been taken
20 off AIA cases by Mr. Weidenfeller, as far as you
21 know, would this have gone out?

22 A Yes, it would have gone out, again,

1 hopefully with that yellow highlighted portion
2 redacted.

3 Q Okay. And would you have any qualms
4 with that?

5 A No.

6 Q Okay.

7 A We've had other concurring opinions at
8 issue, questioning certain policies in the past.
9 So, no, I wouldn't have a qualm about it.

10 Q Okay. To what extent did you understand
11 that you were personally being accused of
12 something in sections 4 and 5 of this concurrence?

13 A I never felt personally accused of any
14 wrongdoing in section 4 or 5.

15 Q To what extent did you understand this
16 argument to impact you professionally?

17 A I didn't understand it to impact me
18 professionally.

19 Q Now, with this decision, had it gone out
20 as is presented here, would this concurrence
21 represent the opinion of the Board?

22 A No, that would be the individual opinion

1 of the concurring judge.

2 Q And so, to what extent do you understand
3 that had that published, that would have been an
4 embarrassment to the Board?

5 A Well, it has no legal force or effect.
6 I mean, it's an opinion of one judge, but it's not
7 the opinion on the Board.

8 Q Okay.

9 A I mean, it's -- I disagree with it, but,
10 you know, I don't think it's a professional
11 embarrassment to the institution.

12 Q Now, are you aware that Mr. Weidenfeller
13 removed the Appellant from AIA cases in May 2018?

14 A I am aware of that.

15 Q And how did you become aware?

16 A So, he would have talked to me about,
17 you know, such matters.

18 Q Can you -- do you have any idea when
19 this -- when that was taking place?

20 A So, I'm trying to remember the exact
21 time, because there were a number of other things
22 going on, including the main reason he was taken

1 off. The AIA case was twice trying to countermand
2 Mr. Weidenfeller in a different case, not this
3 case. But there was a different case where he was
4 attempting to countermand the direction of a
5 supervisor two times. And that was sort of the
6 main thing that triggered his removal from AIA
7 cases.

8 Q And that was the decisions that -- the
9 institution decisions that implicated SAS, right?

10 A That's right, where he would not follow
11 Agency policy, and again, tried to countermand his
12 supervisor. And for that insubordinate conduct,
13 was removed from AIA cases.

14 Q Okay. And how did you become aware of
15 this?

16 A Well, so -- I mean, Mr. Weidenfeller,
17 as, you know, someone who I supervised, keeps me
18 informed of things that are transpiring. And, you
19 know, this is something that, you know, had been
20 transpiring. He talked to both the chief and I
21 about it. I believe it had been flagged, again,
22 through this AIA review committee, looking at

1 decisions that were about the issue. And Mr.
2 Weidenfeller had made, you know, some -- I believe
3 had made some calls about it. But he did tell me
4 generally what was going on.

5 Q Now, you're aware that the director
6 published some guidance on SAS, right?

7 A That's right.

8 Q Was there additional guidance given from
9 the director to the Board at some point?

10 A Yeah, I'm not sure. I mean, there was,
11 you know, initial guidance that we put out very
12 soon within a couple of days after SAS that guided
13 panels and, you know, instructed that we wanted,
14 you know, a fulsome discussion of all the grounds
15 that were being argued by the patent owner.

16 Q Why?

17 A We felt that that was a best practice.
18 And it's something that, you know, seemed more
19 appropriate to address early on to give a view of
20 how the Board felt about those grounds, because
21 that could help promote settlement if parties knew
22 better where they stood rather than just getting a

1 discussion of one and only one ground. They might
2 not have a full appreciation of where the case
3 sat.

4 Q And to your understanding, was that
5 policy direction from the director conveyed to the
6 APJs?

7 A Yes.

8 Q And how was that --

9 A We had training on SAS. We had that
10 training on SAS, and we've published some things
11 on our website about SAS.

12 Q Okay. When you became aware that Mr.
13 Weidenfeller had removed Mr. -- or that was going
14 to remove Mr. Fitzpatrick from AIA cases, did you
15 agree with that decision?

16 A Yes, I agreed because of the
17 insubordinate conduct. Again, he wasn't removed
18 from all cases. I recall that -- I don't recall
19 if I've actually mentioned, but the Board has
20 different types of cases. Essentially, he was
21 given a different type of case that didn't involve
22 the issues on which he had a problem with.

1 Q Okay. Was anything else -- when you
2 became aware of this, was there anything else that
3 informed your decision to agree with Mr.
4 Weidenfeller?

5 A That was, to me, sufficient.

6 Q Okay. And so, now, let me ask you to
7 turn to Tab 7, page 918.

8 A Okay.

9 Q Okay. Now, you see that this is Mr.
10 Fitzpatrick explaining his position with respect
11 to SAS, right?

12 A Yes.

13 Q Okay. And what did you think of this
14 particular email?

15 A So, what I recall -- let me see. So,
16 this one, again, I was -- it was brought to my
17 attention. It's not actually addressed to me.
18 This was addressed to Scott Weidenfeller.

19 Q Oh, I'm sorry. Have you -- are you
20 familiar with this document?

21 A I'm familiar. I've seen it, because I
22 believe this was part of his grievance package.

1 And I did -- I believe I would have looked at this
2 as part of his grievance.

3 Q Well, the argument that he presents here
4 concerns the written guidance. Isn't that
5 correct?

6 A Yes.

7 Q Okay. How does this argument here
8 relate to the informal guidance about being, you
9 know, a transparent with stakeholders and
10 discussing institution decisions?

11 A So, I mean, I think that my
12 understanding is that he disagreed, you know, with
13 that notion, that we should be more fulsome in our
14 discussions, and that we should, you know, follow
15 the narrower path of only looking at only one
16 claim, or rather than whatever else had been
17 argued by the patent owner.

18 Q Okay. But again, with respect to this
19 matter, what was the thing that concerned you?

20 A Well, the thing that concerned me is
21 that he had been given an instruction by his
22 supervisor or second-level supervisor, and he did

1 not comply with that, and in fact, attempted to
2 mail a decision that was directly against that
3 direction.

4 Q Now, in this discussion where you're
5 talking about removing Mr. Fitzpatrick from AIA
6 cases, what did Mr. Weidenfeller say about Mr.
7 Fitzpatrick's concurrence and his argument in the
8 concurrence about the legality of the panel?

9 A Nothing.

10 Q Okay. Did he mention this concurrence
11 at all?

12 A No, not the one -- we're talking about
13 the one in Nike. Is that right?

14 Q Right, that --

15 A Yeah. That was not part of it at all.
16 It was the --

17 Q What role did -- I'm sorry, go ahead.

18 A I was going to say, no it wasn't. Nike
19 didn't play a part. It was the direct
20 countermanding of his second-level supervisor
21 twice, in fact.

22 Q Okay. And to what extent did

1 Appellant's argument on the expansion of the
2 panels in his concurrence factor into your
3 agreement with Mr. Weidenfeller on this point?

4 A No, it didn't play a role.

5 Q Okay. And so, now, let me ask you to
6 turn to Tab 7, page 768. It's the same document.

7 A Okay.

8 Q All right. And so, are you familiar
9 with this document?

10 A Again, this is a document that I believe
11 was part of the grievance package. I have seen
12 this email before.

13 Q Okay. Well, let's go down to the end of
14 this, which is down on page 770, I think it is.

15 A Okay. Yeah.

16 Q Okay. And so, we see that Mr.
17 Fitzpatrick is writing to Mr. Ruschke, and you're
18 copied, correct?

19 A Let me see. I think I'm copied on the
20 prior page, but yes. Yep.

21 Q Well -- okay. So, you're on -- your
22 name appears in --

1 A But I'm on page 770. And yes, I was
2 copied on this email.

3 Q Good. Okay. And so, the argument that
4 Mr. Fitzpatrick makes, you're familiar with that?

5 A I'm familiar with this.

6 Q Okay. Were you familiar with Oil
7 States?

8 A Yes, I was.

9 Q Were you involved in the preparation for
10 oral argument in Oil States?

11 A Indirectly, we worked with our Office of
12 the Solicitor, who's essentially the Agency's
13 intellectual property counsel. They work with the
14 Department of Justice Civil Appellate, as well as
15 the Office of the Solicitor General, in looking at
16 the briefs, suggesting input to briefs, answering
17 any questions that the SG, your civil appellate,
18 have.

19 And then they sometimes bring us into or
20 relay those questions to us so we can help them
21 out. So, that was sort of the involvement that we
22 have.

1 Q Do you recall if that's what happened
2 with this particular issue?

3 A And yes, that happened with this issue.

4 Q To your understanding, is Mr. Stewart's
5 (phonetic) testimony here accurate?

6 A Yes, it's accurate, because as I
7 explained previously, the -- you know, in our way
8 of understanding expanded panels, Nike versus
9 Adidas never issued as an expanded panel. It was
10 expanded and unexpanded, and no expanded panel
11 ever had issued. So, it did not make Mr.
12 Stewart's statement untrue.

13 Q Okay.

14 A We did -- and I do recall bringing this
15 up to the solicitor. And they concurred with our
16 view that Mr. Stewart had not made any
17 misstatement.

18 Q So, what you just said, was that in
19 light of Mr. Fitzpatrick's argument here?

20 A That was in light of this -- of his
21 argument, yes, because although Chief Judge
22 Ruschke and I disagreed, we thought it was

1 important to bring it to the attention of the
2 solicitor. And when I say they, they agreed with
3 our view that this was an incorrect view, and no
4 misstatement had been made to the Supreme Court.

5 Q Okay. So, in your opinion, was there
6 any obligation to make any corrections for
7 anybody?

8 A No, there was nothing to correct.

9 Q Okay. Now, we see that up on page 768,
10 that Mr. Fitzpatrick forwards this to Joseph
11 Matal.

12 A Yes.

13 Q And I'm not sure it's in the record yet.
14 Who is Mr. Matal?

15 A So, Mr. Matal, at the time of this
16 email, was the person who was performing the
17 functions and duties of the director of the
18 Agency.

19 Q Okay. And then we see at the top that
20 Mr. Fitzpatrick forwards this email chain to
21 Andre Iancu.

22 A That's right.

1 Q And Mr. Iancu had recently taken over as
2 the director of the USPTO, correct?

3 A That's right. He had been nominated by
4 the President and confirmed by the Senate at that
5 point in time.

6 Q Now, is there anything wrong with Mr.
7 Fitzpatrick sending this to the director?

8 A No. He's free to make his views known.

9 Q Did you have any concerns about him
10 sending this to the director?

11 A No. People do similar things. It's
12 rare, but it does happen. And, you know, again, I
13 think it's fine if he wants to make his -- I mean,
14 he had made his views known to us. So, we didn't
15 agree, but he's free to talk to others up the
16 chain.

17 Q To what extent did you understand that
18 you personally were being accused of something
19 here?

20 A Again, I didn't take this as a personal
21 accusation. I thought he was trying to bring to
22 our attention something he felt was an inaccurate

1 statement, but we disagreed and did not view it as
2 an inaccurate statement. But we did, again, bring
3 that to the attention of the solicitor in case
4 there was disagreement over that.

5 Q And to what extent did you understand
6 that this accusation would impact you
7 professionally?

8 A I did not understand that.

9 Q To what extent do you understand this
10 accusation was an embarrassment to the USPTO?

11 A I don't understand that either.

12 Q When you spoke to Mr. Weidenfeller about
13 removing the Appellant from AIA cases, did he
14 mention this email chain?

15 A No.

16 Q Did he mention Mr. Fitzpatrick's
17 allegations in this email chain?

18 A No.

19 Q Did you mention it?

20 A No.

21 Q In agreeing to the removing of Appellant
22 from AIA cases, what role did Appellant's

1 allegations here play?

2 A They didn't play a role.

3 Q To your understanding, what role did it
4 play in Mr. Weidenfeller's decision?

5 A I don't understand it to play any role
6 in his decision either.

7 Q The Appellant claims that in May 2018,
8 Director Iancu voiced a desire to USPTO management
9 to terminate him, and that threat was conveyed to
10 him through intermediaries. So, how did you
11 communicate with the director?

12 A So, we had a weekly meeting with the
13 director where the senior management team of the
14 Board would meet with the director and his staff
15 and advisors.

16 Q And would Janet Gongola had been
17 involved in that?

18 A She would've been in some of those
19 meetings with the director. Yes, she was one of
20 the regular participants.

21 Q And were you one of the regular
22 participants?

1 A I was.

2 Q Do you remember, in those meetings, Mr.
3 Iancu saying anything along the lines, would have
4 led to?

5 A No.

6 Q Did you ever hear anybody else make such
7 a statement?

8 A I did not.

9 Q Now, assuming the director had made such
10 a statement and that he intended that action be
11 taken, how would he have done that?

12 A Well, I mean, if the director wants a
13 judge to be removed, there has to be some cause.
14 And again, the judges are subject to the civil
15 service protections. So, you know, that -- you
16 know, especially at this particular time, the
17 director could not remove a judge without cause.
18 So, the judge would've had to have done something
19 to warrant his removal.

20 Q Had somebody made any effort to remove
21 Mr. Fitzpatrick, would you have been aware of it?

22 A Yes, I would have, because we would've

1 had to have interfaced with Human Resources and
2 the Office of General Law. You know, we'd have to
3 figure out if it was a performance issue that was
4 unsatisfactory, or whether it was conduct that was
5 severe enough to warrant a penalty of removal.
6 So, I would have absolutely been aware of any such
7 activity.

8 Q Did any of that happen?

9 A No.

10 Q All right. And then finally, let me ask
11 you to turn to Tab 1, page 52.

12 A Okay.

13 Q And what is that?

14 A So, that's my decision on Judge
15 Fitzpatrick's formal grievance.

16 Q Now, how did you get involved in this?

17 A So, I was the -- at the time, the acting
18 chief judge. I got involved with it because there
19 had been an initial decision on this formal
20 grievance by Vice Chief Judge Tim Fink. And then
21 this was the next level in the process. It would
22 come up to me.

1 Q How did you go about making your
2 decision here?

3 A So, I reviewed the documents provided.
4 I looked at the record that had been provided to
5 me, which included Vice Chief Judge Fink's
6 decision, the various exhibits that are listed
7 here, and then decided that his decision was
8 reasonable under the facts of the cases as were
9 presented.

10 Q Okay. And then I'd like you to look at
11 page 53. The argument that begins, "In addition."

12 A Okay.

13 Q And continues through the page.

14 A Yes.

15 Q What point are you making here?

16 A So, the point I was trying to make here
17 is it had just -- it personally seemed to me, the
18 difficulty really had to do with Judge Fitzpatrick
19 having a difficult time adjusting to being a judge
20 within an administrative agency rather than a
21 judge who might have considerably more freedom in
22 terms of law and policy, say, in Article III, or

1 even an administrative law judge.

2 Which, APJs are not ALJs that are
3 subjected to different parts of the statute, and
4 so, are more constrained, because as I mentioned,
5 the Agency head, the director, is the one who sets
6 policy that APJs must follow.

7 What I was attempting to do is help him
8 come to grips with that, because in other
9 respects, Judge Fitzpatrick is a good judge on --
10 you know, legally, on the technology, you know.
11 But where he really seemed to have difficulty, to
12 me, was this figuring out what does judicial
13 independence mean in an administrative agency
14 where we have constraints.

15 So, again, that's what I was trying to
16 do, is -- that's where all of the friction came,
17 as he had friction with people. Sometimes, on
18 panels, a lot of the friction was of that nature.
19 But I didn't really have any concerns about his
20 legal skills or his technical skills.

21 Q Great, thank you.

22 MR. HARRIGAN: I have nothing further.

1 JUDGE NIEDRICK: Thank you very much,
2 Judge Boalick. I think, at this point, we're
3 going to take a lunch break for about 45 minutes.
4 You know, given where we're at here, it looks like
5 we are certainly going to need another day. I'm
6 wondering, is everybody available tomorrow? We
7 can continue the hearing for tomorrow.

8 MR. HERRIGAN: I'm sorry, I am not. And
9 I have not checked with my witnesses. Sorry.

10 JUDGE NIEDRICK: Okay. But you're
11 personally not available, Mr. Herrigan?

12 MR. HERRIGAN: Correct. Correct, I'm
13 not.

14 JUDGE NIEDRICK: Okay. So, we'll have
15 to kind of work through that and figure out --
16 we'll figure out how far we can get today. But
17 given the rate we're going, I just don't see us
18 even coming close. So, we're going to have to
19 figure out another day for -- to hold an
20 additional hearing, how we'll go from here.

21 MR. HERRIGAN: Sure. Tuesday, Wednesday
22 of next week would work fine with me. Of course,

1 I'd have to check with the witnesses, but --

2 JUDGE NIEDRICK: Sure. Does that work
3 for everybody else, Tuesday or Wednesday?

4 MR. ABRAMIC: Can you turn your mic off?
5 Your Honor, I'm not available on Tuesday. I may
6 be able to do Wednesday. I'd have to caucus with
7 my team, but I think -- Wednesday? Okay.

8 JUDGE NIEDRICK: I might be able to do
9 Wednesday. I have three conferences. I could
10 probably move them. Why don't you all check to
11 see if Wednesday will work with the witnesses, Mr.
12 Horrigan. And then Mr. Kappers, Mr. Suarez, Mr.
13 Abramic, check to see if that is going to work for
14 you. And then --

15 MR. ABRAMIC: What about Thursday?
16 Would Thursday- Friday be better for our schedule?

17 JUDGE NIEDRICK: Thursday works for me.
18 I'm wide open Thursday. Or Friday works much
19 better.

20 MR. ABRAMIC: I think those work for me
21 as well.

22 MR. HERRIGAN: Yes, that's fine with me

1 as well.

2 JUDGE NIEDRICK: Okay. So, that's
3 great. So, if you could check with your
4 witnesses, Mr. Horrigan, and see if that works for
5 them. Judge Fitzpatrick, does that work for you?

6 MR. FITZPATRICK: It does.

7 JUDGE NIEDRICK: Okay. So, like, you
8 know, in between, when you have a chance, just
9 check with folks. And we'll try and get that sort
10 of scheduled if we can.

11 MR. HERRIGAN: On Thursday?

12 JUDGE NIEDRICK: Yes, Thursday. Let's
13 take Thursday for now. If for whatever reason
14 that doesn't work, then we'll take over to Friday.
15 But let's just assume Thursday, the 19th, we'll
16 have the third day of the hearing. Sorry, Judge
17 Boalick. You're having to sit through this. But
18 in any event, we'll go ahead and take a 45-minute
19 break. We'll come back -- why don't we come back
20 at let's say 1:55, and we'll pick back up with
21 Judge Boalick's cross.

22 Does anybody have any questions before

1 we go off the record?

2 MR. HERRIGAN: Nothing from Agency.

3 MR. ABRAMIC: None.

4 JUDGE NIEDRICK: Great. Thank you all.

5 Ms. Dawson, if we can please go off the record.

6 COURT REPORTER: We are now off the
7 record at 1:21 p.m.

8 (Recess)

9 COURT REPORTER: And we are back on the
10 record at 1:57 p.m.

11 JUDGE NIEDRICK: Right. We're going to
12 continue with Judge Boalick's examination. Just
13 remember, Judge Boalick, you're still under oath.
14 Mr. Suarez, your witness.

15 CROSS-EXAMINATION

16 BY MR. SUAREZ:

17 Q Good afternoon, Judge Boalick. How are
18 you?

19 A I'm doing all right. Thank you.

20 Q Okay. My name is Christopher Suarez. I
21 represent the Appellant in this case. So, on
22 direct, you testified that you're in favor of

1 transparency, correct?

2 A Yes, as a general matter.

3 Q So, why as a general matter are you in
4 favor of transparency?

5 A Well, in general, I think that's, you
6 know, a good practice to operate under.

7 Q And -- oh, sorry.

8 A Yeah. No, I was just going to say, I
9 think, you know, as an Agency, you know, serving,
10 you know, the people, you know, we are in favor of
11 transparency.

12 Q And you would agree as a general
13 proposition that transparency is important to due
14 process, right?

15 A I would say in general, yes. There are
16 aspects of transparency that are important to due
17 process.

18 Q So, why are aspects of transparency
19 important to due process?

20 A Well, I think that the parties are
21 entitled to understand their decision, you know,
22 that they get from the Board. They're entitled to

1 know what the reasons are for the decision, and
2 who the decision-makers are, who made that
3 decision. So, there needs to be articulated
4 reasoning in the decision that explains how a
5 decision was arrived at.

6 Q So, you would agree then as a general
7 matter that litigants need to know who the
8 decision makers are in their cases, right?

9 A Right. Yeah, they need to know who made
10 that final decision.

11 Q Okay. So, you testified that you would
12 need to know the final decision, and don't agree
13 that they need to understand who might have
14 influenced the final decision?

15 A That's correct. As an example, you
16 know, judges frequently use law clerks to write
17 draft opinions, yet the name of the law clerk
18 never appears, you know, in the decision. The
19 judges on the panel put their names to the
20 decision. That's the one that is the -- that is
21 their decision.

22 Q Now, law clerks can never be placed onto

1 panels, correct?

2 A That's right. However, in -- actually,
3 in matters of institution, in the AIA, it does not
4 require the -- you know, at least by the Board
5 rules, do not require a judge to be on that panel.
6 So, there may be -- we've never practiced this,
7 but the rules were written in contemplation of
8 someone perhaps other than a judge being the
9 person who did an institution decision. And
10 before -- the final written decisions require a
11 judge as to our appeal decisions.

12 Q So, you would agree that if a law clerk
13 were to draft a decision, there has to be a person
14 listed on the issued opinion who is deemed the
15 decision maker for purposes of that opinion that's
16 issued, right?

17 A That's right.

18 Q Would you agree that the individuals who
19 are listed on an opinion will be perceived by the
20 public as the individuals who've made the decision
21 in a particular case?

22 A Yes, that's right. They're listed on

1 the decision. They are the ones who made the
2 decision.

3 Q And so, you would agree then that the
4 decision that is ultimately issued reflects on the
5 individuals who are listed on the final decision,
6 right?

7 A It's the decision of the panel, yes.
8 So, it's the decision of the Board. It's not --
9 you know, I'm not sure what you mean by "reflect
10 on the individuals." Could you --

11 Q Yeah, so --

12 A -- explain what you mean by that?

13 Q If a judge is on a panel, the decisions
14 they sign off on reflect on their abilities as a
15 judge, right?

16 A Well, it's the decision of the Board,
17 not on the individual's skills or ability of the
18 judge. But it reflected on the panel, I think, as
19 a whole.

20 Q So, like in the Federal Circuit, for
21 example, if a decision comes out from Judge Dyk,
22 that decision reflects on Judge Dyk as a judge,

1 right?

2 A I don't know that -- I mean, there are
3 two other judges on that panel, who presumably, in
4 your example, agreed with that.

5 Q Right, so --

6 A You know, unless they wrote separately.

7 Q So, it would reflect on all three judges
8 who sign off on the decision, right?

9 A Right. I mean, if Judge Dyk is writing
10 in dissent, then that probably reflects on him
11 because it's -- he's alone in that.

12 Q Okay. So, I'm going to direct you to
13 Tab 7 page 154.

14 A Okay, just a second. Was it 154? Okay.

15 Q Okay. And this is an email from James
16 Arpin to the AIA review committee from September
17 30 of 2016, right?

18 A Yes.

19 Q Okay. And this is the -- this email
20 concerns the Nike decision, correct?

21 A Yes.

22 Q And this is a decision that's informing

1 the ARC that the panel has approved a decision
2 after the remand from the Federal Circuit,
3 correct?

4 A That's right.

5 Q And so, this approval of the decision to
6 go out precedes your addition and Chief Judge
7 Ruschke's addition to the panel, correct?

8 A That's right.

9 Q And so, my question to you is -- and so,
10 you were eventually added to the panel, I believe,
11 in November of 2016, correct?

12 A I believe that's right. I don't have
13 the exact date. But I was added -- there was an
14 email earlier where we, you know, stated when it
15 was expanded. That sounds right.

16 Q And so, my question is this. If
17 yourself and Chief Judge Ruschke had never been
18 added to the panel, an expanded panel, the
19 decision in the Nike case on remand would have
20 gone out sometime in 2016, correct?

21 A Not necessarily, because sometimes, what
22 happens is when the ARC -- what they do is they

1 provide comments to a panel, and the panel then
2 considers those comments. Those comments aren't
3 mandatory, but they are suggestions from a -- the
4 ARC is made up of peer judges who look at all of
5 the decisions for consistency.

6 And quite frequently, opinions are
7 changed in view of our comments. So, what I -- I
8 would doubt that that decision that was submitted
9 to ARC would have been in the exact final form
10 from what would have, you know, eventually issued.

11 Q So, is it your testimony then, had the
12 panel not been expanded, ARC would have taken two
13 years to review and allow the decision to go out
14 for submission?

15 A I don't know how long ARC would have
16 taken. It's unusual that they would -- they
17 usually act very quickly, but the panel might have
18 taken longer to deliberate. I don't know, I'm
19 speculating how long --

20 Q Does the -- sorry. Does the PTO take
21 statistics on how long the ARC review process
22 typically takes?

1 A Not official statistics.

2 Q From your experience as the chief judge,
3 how long does the ARC review process typically
4 take?

5 A It takes usually a matter of days to a
6 week.

7 Q Okay. So, then it would be fair to say
8 that if the panel had never been expanded, this
9 opinion would have completed the ARC review
10 process and gone out within a few days of
11 September 30 of 2016, right?

12 A Well, I would have -- so, they would
13 have completed the ARC review process. I can't
14 speculate as to what the panel would have done
15 further.

16 Q Okay.

17 A But it would have been returned to the
18 panel within a few days.

19 Q And assuming the panel was eager to get
20 the opinion out, given that several months has
21 passed since the remand, it would be fair to say
22 that the panel would have gotten the decision out

1 in late 2016, correct?

2 A It would have been the panel's choice,
3 yes, so -- had they decided.

4 Q So, assuming they did then want the
5 decision to go out, it would have gone out then,
6 right?

7 A Yes, assuming that they got the ARC
8 comments back and they were ready to proceed, then
9 -- again, this is just assuming all of that. Then
10 yes, they would have proceeded.

11 Q Okay. And so, ultimately, what did
12 happen is you and Chief Judge Ruschke were added
13 to the panel in late 2016. November 2016 or so,
14 correct?

15 A That's right.

16 Q And you and Chief Judge Ruschke sat in
17 the panel for almost 2 years, correct?

18 A Yes, it was pending for about 2 years
19 before we -- the chief unexpanded the panel.

20 Q Right. And Judge Fitzpatrick was taken
21 off the AIA trials on May 30, 2018, correct?

22 A I believe that's the date, yes.

1 Q And sometime after that, the case was
2 repaneled to replace Judge Fitzpatrick with Judge
3 Daniels sometime in June of 2018, right?

4 A Yes.

5 Q And when that first happened, it was
6 still a five- judge panel, just with Judge Daniels
7 replacing Judge Fitzpatrick, correct?

8 A I don't recall if that's what it was.
9 That may have been -- I just don't know the timing
10 precisely, but I believe that's right.

11 Q Okay. And eventually, you and Chief
12 Judge Ruschke were removed from the panel sometime
13 after June 2018, right?

14 A Yes. I mean, Chief Judge Ruschke had
15 made the decision. I don't recall the date on
16 which he made that decision.

17 Q Okay. Now, before you and Chief Judge
18 Ruschke were removed from the panel, you, as of
19 the expanded panel, had considered the merits of
20 the IPR, correct?

21 A We -- yes, we had, you know, considered
22 it, and, you know, had -- Chief Judge Ruschke had

1 even, you know, drafted a draft opinion.

2 Q Right. And he circulated that draft --
3 so, to be clear, then. You had a draft opinion,
4 and you also had telephone conference calls
5 discussing the merits, correct?

6 A That's right. There were some telephone
7 conference calls. I don't recall the number, but
8 there were some telephone calls.

9 Q Okay. So, you just mentioned the draft
10 opinion. I'd like to go to that. So, let's go to
11 Tab 5, page 222.

12 A Okay.

13 Q So, this is a draft opinion authored by
14 David Ruschke from March of 2018, correct?

15 A Yes.

16 Q And you're listed on this draft opinion,
17 right?

18 A I am.

19 Q And the opinion discusses the merits of
20 patentability of the proposed amended claims,
21 right?

22 A Yes.

1 Q And in this draft, there were draft
2 concurrences from Judges Arpin and Judge
3 Fitzpatrick, with Judge Fitzpatrick's concurrence
4 expressing concerns about panel expansion,
5 correct?

6 A That's right.

7 Q And you also -- after this decision was
8 circulated amongst the expanded panel in March of
9 2018, you had conferences discussing the merits
10 after that, correct?

11 A You mean after the draft opinion was
12 circulated, or --

13 Q Yes.

14 A With the concurrences, I don't recall.
15 I would imagine that we -- that's the typical
16 practice. I would think we probably did.

17 Q Okay, just to refresh your recollection,
18 let's go to Tab 7 at page 656.

19 A Okay.

20 Q Are you there?

21 A Yes.

22 Q Okay. So, this is an email from Michael

1 Fitzpatrick to David Ruschke in which you are
2 cc'd, correct?

3 A Yes.

4 Q And this is an email amongst the five
5 members of the expanded panel, correct?

6 A That's right.

7 Q And he writes, "David, I was
8 disappointed that during the May 7, 2018
9 conference call among the expanded panel members,
10 you stated that the decision on remand will not go
11 out so long as I continue to discuss panel
12 expansion in my concurring opinion." Do you see
13 that?

14 A Yes.

15 Q Okay. So, first off, then, this would
16 refresh your recollection that there was a
17 conference on May 7, 2018, right?

18 A Right. So, that would indicate there
19 had been a conference, which, again, is pretty
20 common practice, so, yeah.

21 Q Right. And Judge Fitzpatrick is telling
22 the members of the expanded panel -- and you would

1 have been on this conference call, right?

2 A I would have been on the -- typically,
3 you gather all members of the panel for these
4 calls.

5 Q Okay. And it says here, "you,"
6 referring to Chief Judge Ruschke, stated that "the
7 decision on remand will not go out as long as I
8 continue to discuss panel expansion in my
9 concurring opinion, my view being that it was not
10 authorized by statute or by the director, and that
11 it was contrary to 35 U.S.C. 6, 316, and 318." Do
12 you see that?

13 A I see that.

14 Q Okay. You never responded to this email
15 and indicated you disagreed with Judge
16 Fitzpatrick's characterization of this phone call,
17 correct?

18 A That's right. I was cc'd on it.

19 Q And you don't dispute that Chief Judge
20 Ruschke stated during this conference call back
21 the decision on remand would not go out so long as
22 he continued -- that being Judge Fitzpatrick ---

1 to discuss panel expansion in his concurring
2 opinion, right?

3 A Actually, I do dispute an aspect of
4 that. I'd like to maybe clarify. My
5 understanding is that Chief Judge Ruschke had said
6 it can't go out with the confidential information
7 in it; that confidential information discussing,
8 for example, the date the panel was expanded, and
9 communications amongst the expanded panel members.

10 So, with that clarification, that's what
11 I understood Chief Judge Ruschke to be holding the
12 opinion on, as perhaps further shown by the edits
13 that were desired that would clear the opinion for
14 (inaudible).

15 Q And when you're referring to the
16 portions of the opinion that were confidential,
17 you're talking about the highlighted portions of
18 the opinion you discussed on direct, right?

19 A That's right.

20 Q Now, are you aware that Judge
21 Fitzpatrick agreed to remove the highlighted
22 portions from his opinion?

1 A I am.

2 Q Okay. So, given that, then, there was a
3 broader concern from Chief Judge Ruschke about
4 issuing any opinion that discussed panel
5 expansion, right?

6 A I don't believe there was. I believe
7 his concern was the -- with the confidential
8 information.

9 Q Okay. So, if the concern was about
10 confidential information, and Judge Fitzpatrick
11 agreed to remove the highlighted confidential
12 information, then what concern remained?

13 A I think you would have to ask Chief
14 Judge Ruschke. But what I could add is that Judge
15 Fitzpatrick did not unconditionally agree he had
16 conditioned his removal on, you know, certain
17 actions. So, I don't know whether -- how Chief
18 Judge Ruschke viewed that conditioning.

19 Q Okay. Now, the existence of the
20 expanded panel that is at issue in this email, the
21 five members, that was never disclosed to the
22 public or to the parties in the case, correct?

1 A That's right.

2 Q And the parties don't even know that
3 now, right?

4 A As far as I know, they don't.

5 Q And you're aware, as the chief judge of
6 the PTAB, that Nike versus Adidas case is up at
7 the Federal Circuit again right now, right?

8 A That's right. This is a live case at
9 the Federal Circuit.

10 Q It's in fact the third time it's been up
11 at the Federal Circuit, correct?

12 A I may have not counted, but that could
13 well be. It's been up multiple times.

14 Q And you understand --

15 A I think that this was the third time.
16 Yeah, I --

17 Q Okay.

18 A No. Now, that I think about it, it
19 probably is.

20 Q And you understand that it's been fully
21 briefed before the Federal Circuit, right?

22 A I'm not aware of the status, but I would

1 -- I mean, I could well believe it's fully briefed
2 to the Federal Circuit. I haven't followed the
3 case. So, I -- you know, I'm not aware. But if
4 you say it's fully briefed, I would believe that.

5 Q And you're aware that the PTAB has -- or
6 the PTO has intervened in that case, correct?

7 A I actually wasn't sure whether we had
8 intervened in that case. So, I'm not -- I haven't
9 actually seen any of the briefing entered by PTO
10 in this case.

11 Q And you're not aware of any briefing by
12 the PTO in the case that informs the Federal
13 Circuit about the panel expansion that occurred in
14 Nike versus Adidas, right?

15 A I'm not aware of any. I don't imagine
16 there would be any.

17 Q Okay. We'll get back to that. So, now,
18 Judge Fitzpatrick -- we talked -- you talked a
19 little bit about this on direct. Judge
20 Fitzpatrick -- I'm going to go to 685. Judge
21 Fitzpatrick sent you an email expressing concerns
22 about Oil States, right?

1 A Yes.

2 Q And Judge Fitzpatrick noted things that
3 the justice department's lawyer stated that he
4 believed were incorrect, right?

5 A That's right.

6 Q So, you testified that this statement
7 was not wrong, right? On direct.

8 A Which statement? I just want to
9 understand which statement was not wrong.

10 Q So, the statement that says, "Panel
11 expansion has not been done at the merit stage."

12 A You mean the statement from Mr. Stewart.
13 Is that --

14 Q Yes.

15 A That's the one? Yes.

16 Q So, I guess my question is this -- when
17 an institution decision issues, is the case in the
18 merit stage yet?

19 A I don't know whether you would call that
20 the merit stage -- it's an institution stage, so
21 what's ultimately being decided is whether we are
22 going to institute the trial, not the merits.

1 Q Okay. As of the final written decision,
2 is an IPR at the merit stage?

3 A Yes.

4 Q Okay, how about the time between the
5 institution and the final written decision, is the
6 IPR at the merit stage?

7 A Again, we don't call it the merit stage
8 -- that's not a term I'm familiar or how one would
9 define merit stage, but merits are being discussed
10 and debated during the trial, and then the
11 decision at the end of the trial makes the PTAB's
12 decision public on the merits.

13 Q So would you or would you not agree that
14 the time between the institution decision and the
15 final written decision is the merit stage of an
16 IPR proceeding?

17 A It is debating the merits, but the
18 merits aren't decided until the end.

19 Q And the merits of an IPR case relate to
20 the patent ability issues, right?

21 A That is right.

22 Q And you would agree that between the

1 institution decision and the final written
2 decision that the patent ability issues of the
3 case are being evaluated by the panel, correct?

4 A That is right.

5 Q And that's true whether the panel has
6 been expanded or has not been expanded, correct?

7 A That is right. The merits are being
8 evaluated, and briefing and evidence is being
9 collected, hearings taking place, regardless of
10 who is on the panel or not on the panel.

11 Q Right, and you would agree that a
12 decision that comes down after remand from the
13 Federal Circuit is remanded to consider the
14 merits, correct?

15 A It would depend on the instructions of
16 the Federal Circuit, but in this case, it was
17 remanded to consider the merits of the substitute
18 claims.

19 Q And when you say in this case, you're
20 referring to the Nike case, correct?

21 A I'm referring to Nike, yes.

22 Q And so it would be reasonable then to

1 believe that there was merits consideration by an
2 expanded panel prior to this representation made
3 by Mr. Stewart before the Supreme Court, right?

4 A Yes, the expanded panel was considering
5 merits.

6 Q And Judge Fitzpatrick's concern here was
7 a reasonable one to raise, right?

8 A Again, I don't believe it was reasonable
9 because the expanded panel is not truly expanded
10 until it issues as an expanded panel because, as I
11 mentioned previously, it can be unexpanded at any
12 time prior to issuance. So, at least in my mind,
13 no, that wasn't an expanded panel in the sense of
14 what Mr. Stewart was saying to the Supreme Court.
15 There was no issued decision that had been
16 expanded on an actual trial at that point.

17 Q Do you think Chief Justice Roberts would
18 not have been interested in knowing that the panel
19 expansion in the Nike case at the time of this
20 argument?

21 A I don't know what the Chief Justice
22 would have been interested in knowing. I believe

1 he was referring to decisions that were issued,
2 but I don't know what his interest would have
3 been.

4 Q Well, the question from Chief Justice
5 Roberts was does it comport to due process to
6 change the composition of the adjudicatory body
7 halfway through the proceeding, right?

8 A Right.

9 Q And you would agree, certainly, that a
10 decision that comes back on remand is more than
11 halfway through the proceeding, right?

12 A Right. As we had mentioned before, when
13 it comes back on remand there is an opportunity to
14 change the panel before the decision issues.

15 Q And you're aware that there are
16 procedures before the Supreme Court that allow you
17 to correct the record, right?

18 A Yes, if the record needs correcting.

19 Q Now, you did issue, and this was
20 discussed on your direct I believe, a public order
21 to the parties on September 17, 2018.

22 A That is right.

1 Q So, let's go to that. I have it at Tab
2 7.

3 COURT REPORTER: Mr. Suarez, could you
4 repeat that, you cut out.

5 Q Sorry, Tab 7, page 950.

6 A Thanks, I also didn't hear the page
7 number but I'm there.

8 Q Okay, this is the same document you
9 discussed in direct, I think it's under a
10 different number. This is the Order you issued
11 September 17, 2018, Order (inaudible) proceedings
12 in the Nike case, correct?

13 A Yes.

14 Q Okay. Let's walk through this because
15 you testified about this on direct and I want to
16 clarify a few things.

17 A Okay.

18 Q One of the things you said on direct,
19 and I don't want to misquote you, so I am going to
20 go to my notes -- is that Aqua Products is what
21 caused the delay in the issuance of the Nike
22 decision, correct?

1 A Yes, Aqua Products was one of the
2 reasons why we delayed.

3 Q Right. And what you say here -- in the
4 second paragraph you reference Aqua Products being
5 Mattel, correct?

6 A That is right.

7 Q And you're aware that -- first of all,
8 it says in the citation it was decided in 2017,
9 right?

10 A Right.

11 Q And you're aware that it was decided on
12 October 4, 2017, correct?

13 A If I were to look at it -- I don't
14 recall the date, but that sounds correct. That's
15 in the letter, right? So, yes.

16 Q So, around October 4, 2017, Aqua Product
17 (inaudible), right? Alright. Yes, you were
18 nodding, sorry.

19 A Yes, October 4, is when Aqua Products
20 was when the Federal Circuit issued their
21 decision.

22 Q Okay. And you testified on direct as

1 well that Aqua Products was the reason why the
2 Board designated certain precedent and informative
3 decisions and designated another decision as
4 informative, correct?

5 A That is right.

6 Q And so all of the delay was based on
7 Aqua Product, right?

8 A Well, that portion of the delay because
9 Aqua Products implicated the same issues that were
10 at hand in the Nike decision.

11 Q Now, who controls the process of
12 designating or de- designating precedence or
13 informative decisions and things of the like?

14 A At the that time that this happened, the
15 chief judge could designate cases as informative,
16 and the Director at least had to be offered the
17 opportunity to look at anything designated as
18 precedential. So, to summarize, chief judge is
19 the one who would designate as informative, and
20 the Director would designate or de-designate
21 something as precedential.

22 Q And so the chief judge and/or the

1 Director can make the decision to designate, or
2 de-designate, or relabel a precedent as
3 informative whenever it wants, right?

4 A The process has since changed, but at
5 the time in question, yes, that was the process.

6 Q So it then would have been possible for
7 the Director and the chief judge to have received
8 any Aqua Products v Mattel ruling and issued a
9 decision to de-designate or redesignate Master
10 Image, Idol Free, and Western Digital Corp shortly
11 after October 4, 2017, right?

12 A I'm sorry, would you repeat the
13 question.

14 Q So you testified that as of this
15 timeframe, the chief judge and the Director
16 essentially had plenary authority to redesignate
17 decisions, correct?

18 A Yes, that's right.

19 Q And given that Aqua Products, per your
20 testimony, was the basis for redesignating and
21 de-designating these decisions, that redesignation
22 and de-designation of Master Image, Idol Free, and

1 Western Digital -- that could have occurred, for
2 example, in November of 2017, right?

3 A It could have; however, I will note that
4 both the Director and the chief judge have a lot
5 of other very high priority items they are dealing
6 with and are constrained by time as are we all.

7 Q Understood. Now, you understand that
8 administrative patent judge -- because Judge
9 Fitzpatrick was removed from AIH trials on May 30,
10 correct?

11 A That is right.

12 Q And this de-designation and
13 redesignation occurred just two days later on June
14 1, 2018, correct?

15 A I believe so.

16 Q So, let's continue -- the real reason
17 that this happened was because the PTAB management
18 needed to say something that occurred after May 30
19 to justify the delay in the issuance of the Nike
20 decision, right?

21 A We didn't need to. We have issued many
22 other decisions that have been equally long -- or

1 pending even longer -- without explanation, but
2 the panel had desired to have an explanation, and
3 the relevant explanation really had to do with
4 once we got caught up in Aqua Products we wanted
5 to wait and see how that turned out.

6 Q And you don't mention that there was
7 frustration that Justice Fitzpatrick wanted to
8 publicly explain his views about panel expansion
9 and that the delay was in part due to PTAB's
10 management's unwillingness to issue such an
11 opinion, right?

12 A I understand he wanted to, but at least
13 portions of that was confidential Agency and
14 deliberative process information. I understand he
15 wanted to say that.

16 Q Right, but portions he wanted to remove,
17 right?

18 A Right, those were the highlighted
19 portions that we discussed.

20 Q Okay, so now going further down in this,
21 you write, "in addition, the parties are notified
22 that the panel has changed in the above-referenced

1 proceeding by the order of the chief judge."

2 A I see that.

3 Q And then you state, "Administrative
4 Patent Judge Daniels replaces Administrative
5 Patent Judge Fitzpatrick on the panel, right?"

6 A That is right.

7 Q Now, you don't give a reason in this
8 Order that Judge Fitzpatrick was replaced,
9 correct?

10 A That's right -- that was our practice at
11 the time -- we generally didn't give reasons.

12 Q And you don't, for example, say he was
13 unavailable or conflicted off the case, or
14 anything like that, right?

15 A No, that was a later practice change.

16 Q Right, we're going to get there.

17 A Okay.

18 Q Now, you don't mention to the parties
19 that the panel had been expanded to include you
20 and Chief Judge Ruschke for almost two years,
21 right?

22 A That is right.

1 Q You also don't mention that the panel
2 had been unexpanded back down to three members,
3 correct?

4 A No.

5 Q And you don't mention that the panel
6 expansion and contraction had impact on the timing
7 and substantive considerations of the decision,
8 right?

9 A No.

10 Q So that is correct, right?

11 A That's correct, this letter does not
12 mention the panel expansion or contraction.

13 Q Sorry, sometimes when you say correct
14 and there is a no, I just to make sure it's clear.

15 A Alright.

16 Q And we can go back to the (inaudible)
17 and see it, but the Nike v Adidas case was issued
18 the very next day after this Order on September
19 18, 2018, correct?

20 A Yes, I believe that's true.

21 Q And that decision that came out the next
22 day had the three panel members that are listed in

1 your Order of September 17th, right?

2 A That is right.

3 Q So now we'll get to what you were just
4 talking about. At the time of this decision that
5 we are talking about now, the September 17th
6 decision, there was a standard operating procedure
7 called SOP1, correct?

8 A Yes.

9 Q What is SOP1?

10 A SOP1 is the standard operating procedure
11 that describes how the Board handles cases -- it
12 gives overview of our paneling process.

13 Q And on direct, you were shown revision
14 14 of SOP1 by counsel, right?

15 A Yes.

16 Q And you said that revision 14 had been
17 superseded, right?

18 A Yes.

19 Q And the new version is revision 15,
20 correct?

21 A Yes.

22 Q Now you testified on direct that the

1 current version of SOP1 came out long after the
2 events in this case. Do you remember that
3 testimony?

4 A I'm not sure which testimony -- the SOP1
5 has been in place -- I'm sorry would you repeat
6 that, I'm a little confused by your question.

7 Q Okay, I'll circle back because I want to
8 establish a different foundation first. Okay,
9 first off, who decides to revise sops?

10 A It's usually a decision made by the
11 Chief Judge in consultation with the Director.

12 Q Okay, so would it be fair to say that
13 the Chief Judge and the Director have the plenary
14 authority to revise the SOPs?

15 A Yes.

16 Q And they can choose when to issue a
17 revision of an SOP, right?

18 A They can.

19 Q Okay. So, we can go through the
20 documents -- I have some questions on that, but
21 from your recollection, what were the differences
22 between SOP1 revision 14 and SOP1 revision 15?

1 A So, one of the revisions was updating
2 the practice when panel changes are made -- that
3 if a panel has already appeared to the public,
4 that any further changes will be accompanied by a
5 Panel Change Order, so that was one. And the PCO
6 would describe which judge is coming on, which
7 judge is coming off a case, and would select from
8 one of -- I believe it's three -- reasons for that
9 change.

10 Q And so under revision 15, PCOs are
11 issued as a matter of course when a panel is
12 either changed or expanded, correct?

13 A That is right. After the panel has
14 first appeared. So, if the panel has not first
15 appeared to the public, there can be changes that
16 happen without PCOs issuing.

17 Q So why did the Patent Office decide it
18 was a desirable policy to at least prospectively
19 announce panel changes, including expanded panel
20 changes, as they occur?

21 A It was a decision of Director Iancu and
22 Chief Justice Ruschke. My understanding of what

1 they wanted was some increased transparency when
2 changes are made, so that was a practice that was
3 put in place to try to give that additional
4 transparency.

5 Q And despite the issuance of revision 15,
6 despite the fact that the Nike v Adidas case had
7 an expanded panel, the litigants in that case
8 still don't know that the panel was ever expanded,
9 right?

10 A Right. That all happened prior to that
11 practice change.

12 Q Right, and are you aware as you sit here
13 today how many days prior it happened before the
14 practice change?

15 A No, I don't.

16 Q Your Honor, may I share my screen
17 briefly, please?

18 A Yes, you should have permission to do
19 that.

20 Q Let me lay a foundation before I share
21 my screen first. Judge Boalick, you're familiar
22 with the U. S. Patent and Trade Office website,

1 correct?

2 A Yes.

3 Q And you understand that SOPs, including
4 SOP1, are posted on the U. S. Patent and Trade
5 Office website, correct?

6 A That is right.

7 Q And you're aware that the dates that
8 such policies are adopted are also placed on the
9 United States Patent and Trademark Office's
10 website, right?

11 A Right.

12 Q Okay, so I'm going to share my screen.

13 MR. HARRIGAN: And I'm going to object.
14 Opposing Party had plenty of time to put these
15 documents into evidence as they were told to do
16 and chose not to.

17 A He hasn't even moved to put these into
18 evidence, so I'm going to let him ask a question
19 and to the extent he does that you can raise your
20 objection. So, go ahead and ask your question.

21 Q Thank you, your Honor, I probably will
22 not need to admit this, I just need it for

1 purposes of establishing the facts at issue. So,
2 you recognize this screen as the United States
3 Patent and Trademark Office website, correct?

4 A Yes.

5 Q Okay, the url in the box is
6 USPTO.gov/patents/ptab/procedures/revisions/standa
7 rds/operation, correct?

8 A Yes.

9 Q And this is a landing page that refers
10 to revisions to the sopsx correct?

11 A Yes.

12 Q And it refers to revised SOP1 and
13 revised SOP2, right?

14 A That is right.

15 Q Now, scrolling down on the page, it
16 says, "for full details for SOP1 and SOP2, please
17 see," and there's two bulleted links, correct?

18 A Yes.

19 Q Okay. So, SOP1 revision 15, that's the
20 assignment of judges the panels SOP we've been
21 discussing, correct?

22 A That is right.

1 Q And it says in parenthesis 20 September
2 2018, correct?

3 A That is right.

4 Q And so September 20, 2018, would have
5 been the date that SOP1 revision 15 was issued by
6 the Director and the Chief Judge, correct?

7 A That is right.

8 Q And that's the same day that revision 10
9 of SOP2 was issued, right?

10 A Yes.

11 Q And so this revision of SOP1 came out
12 three days after you issued your order
13 substituting panelists in the Nike case, correct?

14 A Yes.

15 Q And so the timing of the issuance of the
16 SOP1 was selected so that what happened in the
17 Nike case would need to be disclosed, but that
18 perfectly the Board would be more transparent
19 in the composition of the panels, right?

20 A I don't believe that was part of our
21 discussion.

22 Q So as you sit here today, do you think

1 it is a coincidence that the de-designation of
2 precedence at issue in your September 17 order
3 occurred just two days after Judge Fitzpatrick was
4 demoted to AIA Appeals, non-IA cases, and that the
5 change to SOP1 occurred just three days after you
6 issued your order without the panel change in
7 mind?

8 A Many things were happening very quickly,
9 so I don't know. I also would say I would take
10 issue with your characterization of changing the
11 docket from AIA trials to Appeals as a demotion.
12 All cases at the Board are equally prestigious,
13 they are all impactful, and they all matter to the
14 judges. All judges take every case very seriously
15 -- none are more important than others.

16 Q Great. And you understand that that's
17 not all AIA's views of their roles at the patent
18 office, correct?

19 A Do I understand -- I'm sorry, I missed
20 the last part of your question.

21 Q Do you understand many judges at the
22 PTAB, including Justice Fitzpatrick would view the

1 reassignment to purely examination fields as a
2 demotion or a significant change in responsibility
3 that is negative, correct?

4 A They may subjectively think that, but
5 there is no case that is unimportant at the Board,
6 and as I said, none are more important than
7 others. They are just different cases, they
8 involved different procedures. Judges pay and
9 benefits and status are unaffected by what docket
10 they worked on. I personally worked on a docket
11 of Appeals. I feel no slight in having been an
12 appeals judge -- I wear that label proudly.

13 Q And to be clear, you've been at the PTAB
14 now for about years, correct?

15 A That is right.

16 Q You've been a good soldier at the PTAB?

17 A I believe I've been a good judge at the
18 PTAB. I don't know what one means by a good
19 soldier, but I have been here 15 years.

20 Q And you wanted to advance and you want
21 to be successful there, right?

22 A I want to help out with the Board. I

1 want the Board to be successful. I, like many
2 judges at the Board, care deeply as I believe
3 Judge Fitzpatrick cares deeply about the Board
4 also.

5 Q Okay, I'm going to turn you now to
6 (inaudible) 32.

7 MR. HERRIGAN: So it's time to address
8 my objection. This is completely improper. This
9 is a document. The fact that it's electronic
10 doesn't mean it's not a document. There is
11 nothing in the record about this -- point one, and
12 it needs to be fixed. And point 2, this opposing
13 counsel had plenty to put this into the record and
14 chose not to. This is a gotcha -- it should not
15 be allowed.

16 Q I can respond to that, unless you don't
17 want me to.

18 JUDGE NIEDRICK: Your objection is noted
19 for the record. It is overruled. Please proceed.

20 MR. HERRIGAN: And what will you be
21 doing to fix the record, excuse me, Administrative
22 Judge?

1 JUDGE NIEDRICK: What do you mean what
2 am I going to do to fix the record?

3 MR. HERRIGAN: How are we going to
4 (inaudible) for the record.

5 JUDGE NIEDRICK: Mr. Herrigan, you made
6 your objection, it's noted for the record, and we
7 are moving on.

8 MR. HERRIGAN: My objection though is
9 that this is not in the record.

10 JUDGE NIEDRICK: It's not in the record,
11 he just testified. In response to Mr. Suarez
12 showing him this document that's on the public
13 site of the PTO.

14 MR. HERRIGAN: And so to be clear,
15 you're overruling my objection on that point?

16 JUDGE NIEDRICK: Yes.

17 MR. HERRIGAN: Thank you.

18 BY MR. HERRIGAN:

19 Q So, I'd like to go to tab 32, page 333.
20 Okay, so tab 32, and I'm sorry I didn't catch the
21 page.

22 A Yes, it's page 333. 333. Okay, I'm

1 there.

2 Q And I stopped the screen share. So,
3 this document expands from pages 333 to 357. This
4 is revision 15 of SOP1 that we've been discussing,
5 correct?

6 A Yes, yes, this is revision 15.

7 Q And so this is the version of SOP1 that
8 was released on September 20, 2018, correct?

9 A Right, this is that version.

10 Q Okay. Are you aware when the PTAB began
11 drafting revision 15 of SOP1?

12 A No, I don't recall.

13 Q So would that have been closely in the
14 hands of the Chief Judge and the Director then?

15 A It would have been in the hands of the
16 Chief Judge, you know, probably in consultation
17 with the Director, the Chief would have delegated
18 it to certain individuals at the Board to have
19 drafted this, although I don't recall precisely
20 who was drafting this one.

21 Q Understood. Okay, now this I don't
22 think technically is in evidence yet. So I ask

1 permission to admit it's actually the Government's
2 Exhibit 20, pages 333 -- 357 of Tab 32. Judge:
3 Any objection, Mr. Horrigan?

4 MR. HERRIGAN: No.

5 JUDGE NIEDRICK: Okay. That's admitted.

6 And it's 333 to what did you say, 357?

7 MR. SUAREZ: Correct, your Honor.

8 JUDGE NIEDRICK: Thank you.

9 BY MR. HERRIGAN:

10 Q Okay, so the first 16 pages of this
11 document, from page 333 to 348, that's the revised
12 SOP, right?

13 A So, you said 333 to -- what was the end
14 page?

15 Q 348.

16 A Yes, that's the revised SOP.

17 Q And the last 8 pages from page 349 to
18 357 are two appendices that are representative
19 orders that can be used for panel changes or
20 expanded panel changes, correct?

21 A That is right.

22 Q And now, let's look at page 13, page

1 345.

2 A Okay.

3 Q So page 13 refers to a section called
4 Panel Changes, right?

5 A That is right.

6 Q And so on the next page, page 14, there
7 is a Section 4 that goes through all proceedings
8 in which a panel has appeared, panel changes made
9 by the designees that result in a substitution of
10 one or more judges, must be finally approved by
11 the Chief Judge or the Deputy Chief Judge. Do you
12 see that?

13 A I do.

14 Q And then it says under A, if finally
15 approved, designees will instruct a trial
16 paralegal to enter a Panel Change Order of the
17 Chief Judge or the Deputy Chief Judge into the
18 record, notifying the parties of the panel change,
19 right?

20 A That is right.

21 Q So that's directive language, that's not
22 permissive, right?

1 A Yes, it says they will instruct the
2 paralegal to enter an order.

3 Q And so looking at the next page, page 15
4 -- that's page 347 under the tab -- expanded
5 Panels is under Section M, right?

6 A Yes.

7 Q And there we also have, under 7 -- if
8 you'll look at page 16, page 348 of the record,
9 when an expanded panel is designated after a case
10 has initially been assigned to a panel -- and
11 before a decision is entered by a panel -- the
12 judges initially designated should be designated
13 as part of the expanded panel. Do you see that?

14 A Are you talking about 7a, or just 7?

15 Q Well, that was 7 generally.

16 A Okay.

17 Q And then (a) says if an expanded panel
18 is approved, designated judges will instruct the
19 trial paralegal to enter a Panel Change Order of
20 the Chief Judge or Deputy Chief Judge into the
21 record, notifying the parties of the panel change.
22 See that?

1 A Yes.

2 Q So again that's directive language,
3 right?

4 A Yes.

5 Q So as of September 20 of 2018, it was
6 required to notify public and the litigant that
7 the panel had been expanded, right?

8 A That is right.

9 Q And that's the case even if a final
10 decision had not been reached, correct?

11 A No, not if -- so when a panel had
12 previously been expanded, we didn't view it as
13 being retroactive to prior cases, we were thinking
14 of it as prospective.

15 Q Yes, that wasn't my question.

16 A Okay.

17 Q My question was simply that as of this
18 date, that was a requirement to notify of an
19 expanded panel even if there had not been a final
20 decision yet in the case, right?

21 A Right.

22 Q And so why was that policy adopted by

1 your office?

2 A Again, my understanding is that the
3 Director and the Chief Judge wanted to be more
4 transparent in our cases and changes that occurred
5 in those cases. That's my understanding of the
6 reason this was adopted.

7 Q Now, I briefly want to look at -- and
8 I'll cut it short, I'll just do one of the orders.
9 Let's look at the Expanded Panel Change Order, and
10 that's in Appendix 2 for the Expanded Panel Change
11 Order.

12 A That's on --

13 Q 353.

14 A 353. Okay, yes.

15 Q And so, 354 to 356 is a sample Panel
16 Change Order for expanded panels that exist today,
17 right?

18 A That is right.

19 Q Looking at the sample Order on 355, it
20 says, "The parties are notified that an expanded
21 panel has been designated in the above-referenced
22 proceeding," right?

1 A Yes.

2 Q And then it says, see PTAB Standard
3 Operating Procedure, revision 15, right?

4 A That is right.

5 Q And then it says, "Administrative Patent
6 Judges A and B are into the panel, thus,
7 Administrative Judges A, B, X, Y and Z now
8 constitute the panel for consideration for all
9 matters in this proceeding," right? Judge
10 Boalick, can you hear me?

11 JUDGE NIEDRICK: It looks like we lost
12 his audio.

13 MR. SUAREZ: Yes.

14 COURT REPORTER: Judge Boalick, this is
15 the Court Reporter, can you hear me?

16 MR. SUAREZ: Judge Boalick. Can you
17 hear us? Raise your hand if you can hear us.
18 Okay, so it's just his audio for whatever reason.
19 Why don't you try and leave the meeting and then
20 log back in and I'll let you in, okay? Thank you.

21 JUDGE NIEDRICK: Alright, can you hear
22 me now?

1 MR. SUAREZ: Yes, we can hear you. Can
2 you hear us?

3 JUDGE NIEDRICK: Yes, I can. That's
4 really weird. I could hear you all fine, I don't
5 know what happened to my audio. Okay, hopefully
6 you can recall where you are Mr. Suarez, and pick
7 up.

8 BY MR. SUAREZ:

9 Q So we're talking about the appendix to
10 the Expanded Panel Order under revision 15, and so
11 I believe I had asked that this states that the
12 this states that the Administrative Patent Judges
13 A and B have been added to the panel, right?

14 A That is right.

15 Q And then there's transparency around who
16 the five judges are in the panel because it lists
17 them in the sample order, right?

18 A That is correct.

19 Q And then it says, the parties may
20 contact the Board of Trials at the USPTO.gov if
21 they have any questions, do you see that?

22 A That is right.

1 Q Why is that opportunity now afforded to
2 the litigants?

3 A Again, I believe this was in an effort
4 to be more transparent about who is on your panel
5 at any given moment, just as if a panel were
6 unexpanded you would have another pco.

7 Q Now you know a Judge Weidenfeller,
8 right?

9 A Yes.

10 Q Okay. So, you understand that he left
11 the Board and now he's a partner at Covington &
12 Burling, correct?

13 A That is right.

14 Q And he might litigate before the PTAB
15 from time to time, right?

16 A That is right.

17 Q And so let's say he had a friend on the
18 Board who was on the expanded panel. If this
19 announcement came out, it would probably be useful
20 for Judge Weidenfeller to email the Board to note
21 that he might have a conflict, right?

22 A Right.

1 Q So, it's a good idea to release the
2 names of the panelists as soon as they are changed
3 so that parties may contact the Board about
4 conflicts.

5 A I mean, that's a potential, yes.

6 Q Because if Judge Wei were on a case for
7 Covington representing a party, and the panel came
8 out for his best friend, ___ of the PTAB, that
9 would probably be an issue, right?

10 A It may or may not. It would depend on
11 the particulars of the situation. I can't say
12 blanket that would be a problem. I should also
13 point out that the judges have a responsibility
14 when they come on to a panel to look at who the
15 parties are and who counsel are, and we've even
16 had judges recuse themselves when they were coming
17 on to a case, and then take themselves off because
18 -- for example -- they had hired an expert witness
19 who was in the case. So, judges -- making this
20 available doesn't suddenly create the opportunity
21 to create conflicts where none was before. Judges
22 could easily, if they are such good friends with

1 Judge Weidenfeller, would have said, don't put me
2 on this case.

3 Q So, I go back to my question then: Why
4 invite questions to trial at USPTO.gov if there
5 isn't a need to seek clarification for conflicts
6 in other matters.

7 A I think this is just sort of a courtesy
8 that we throw in. Parties are always encouraged
9 at any time if they have any questions to contact
10 trails@uspto.gov. I should add trials@uspto.gov
11 is staffed by our paralegals, so that doesn't go
12 directly to judges. Paralegals take the messages
13 and decide where or what should be done with them.

14 Q And to be clear, the paralegals who
15 monitor the trials inbox they forward those emails
16 on to the panel specifically, right?

17 A They do, yes, they forward those. They
18 monitor, they ask questions about what they should
19 do, or this is a question from a party. We pretty
20 much always encourage parties -- if there is ever
21 any question at any time -- I mean this isn't
22 unique to this order, this is something that we

1 ask parties always at all times -- if you have
2 questions, reach out.

3 Q Okay. You also testified in direct
4 about Justice Fitzpatrick's grievance, correct?

5 A I'm sorry, can you repeat the word, I
6 didn't catch that.

7 Q On direct you testified about Justice
8 Fitzpatrick's grievance, correct?

9 A Grievance, yes, that's the word I didn't
10 catch. Yes.

11 Q No problem. I think I covered my mouth
12 or something. So you decided Justice
13 Fitzpatrick's formal grievance, but you were also
14 involved in some ways of the processing of the
15 informal grievance, correct?

16 A I'm not recalling the informal -- I
17 might have been, but I don't really recall
18 processing the informal grievance.

19 Q Well, and maybe you (inaudible)
20 processing. Do you recall that you were the one
21 that assigned the judges to ultimately decide at
22 the informal grievance.

1 A Yes, I did assign that.

2 Q And so you initially assigned the
3 informal grievance to Judge Gongola, right?

4 A That is right.

5 Q And the grievances are supposed to be
6 processed within about 30 days, correct?

7 A That is right.

8 Q And almost 90 days had passed and Judge
9 Gongola did not issue a decision, correct?

10 A That is right.

11 Q And she had a sickness and was out for a
12 week, and so then you decided to substitute her
13 with Judge Fink, correct?

14 A That is right. In order to expedite the
15 processing, I reassigned it.

16 Q Okay, so let's look at your decision in
17 the grievance. I'm going to Tab 5, and it is 52.
18 I misspoke, it is 22.

19 A Okay, I'm there, and I see the grievance
20 first page, and the decision rather on the formal
21 grievance first page.

22 Q And so these pages 22 and 23 of Tab 5 is

1 a true and correct copy of the grievance that you
2 issued?

3 A Yes. I mean the decision on grievance,
4 but yes.

5 Q On the first page 22, it says you
6 consider the formal grievance, the decision on
7 grievance, the informal grievance, and exhibits A
8 through ZZ10, correct?

9 A That is right.

10 Q And then you say that you discussed the
11 matter with Vice Chief Administrative Patent Judge
12 Fink and Vice Chief Administrative Patent Judge
13 Weidenfeller, correct?

14 A You mean in assigning this to them?

15 Q No, I'm looking at -- it says you
16 considered the following documents, and there is a
17 list of documents.

18 A Yes, yes, I see what you're saying, yes.

19 Q And so to the extent you had discussions
20 beyond the documents, you had discussions with
21 Vice Chief Administrative Patent Judge Fink and
22 Vice Chief Administrative Patent Judge

1 Weidenfeller, correct?

2 A Yes.

3 Q You didn't have any discussions with
4 Judge Fitzpatrick about his formal grievance,
5 correct?

6 A I did not.

7 Q And you did not have any discussions
8 with his front-line supervisor Judge Mitchell,
9 correct?

10 A That is right.

11 Q Okay. You first say, in the cases of
12 IPR 2018 129 through IPR 2018 132, your concurring
13 opinion (inaudible) policy guidance of the
14 Director to provide Folsom information and
15 institution decision after SAS. It is not
16 acceptable for a judge in a patent trial of an
17 appeal Board for refusal to follow the policy
18 guidance of the Director. Do you see that?

19 A I see that.

20 Q Okay, so, we've been really struggling
21 with this throughout the hearing, and so we just
22 want to know the answer. What is the specific

1 document that expresses policy guidance of the
2 Director on SAS?

3 A I'm not sure I recall at that moment. I
4 know that we have given guidance on that, and part
5 of that guidance is that we would provide the
6 Folsom and an institution decision, not just
7 analysis of one claim and one ground. I can't
8 right now point you to that, where that was. I
9 know that was the policy.

10 Q And to be clear for the record on this
11 sentence I just read, it spans pages 22 and 23,
12 Tab 5, you did not provide a citation to any
13 specific policy guidance, correct?

14 A Right, Folsom.

15 Q So as you sit here today, you're not
16 aware of any written policy guidance relating to
17 SAS that Justice Fitzpatrick's didn't follow,
18 right?

19 A I don't at the moment. I can't think of
20 which document -- I know that was the policy, but
21 which document I can't tell you right now.

22 Q And to be clear, when you say Folsom

1 information institution, you mean that the
2 institution decision needs to analyze more than
3 one challenge claim of the patent, correct?

4 A That is right.

5 Q In all claims ideally, correct?

6 A Ideally all claims, certainly all claims
7 the patent owner addresses in their patent owner
8 preliminary response.

9 Q Are you aware that in May 2018 and even
10 after May 2018, numerous decisions by judges other
11 than Judge Fitzpatrick were instituting IPRs based
12 on analysis of a single claim?

13 A I'm not aware if those went out or if
14 guidance was provided to those judges. I don't
15 know about the timing. I know that this was a
16 policy that we were trying to train and tell
17 judges they needed to follow. Generally when
18 either the ARC or a management reviewer would tell
19 the panels they would follow that guidance on the
20 cases that were flagged.

21 Q Aside from Judge Fitzpatrick, are you
22 aware of any Administrative Judges at the PTAB who

1 were punished for declining to follow the alleged
2 SAS guidance that required discussion of more than
3 one claim at institution.

4 A No because I'm not aware of any judges
5 other than Judge Fitzpatrick who declined to
6 follow that. And I should say declined to follow
7 that once that had been pointed out. They may
8 have missed it, and they might not have caught it
9 -- we might not have caught it -- it is possible.
10 Sometimes decisions slip through that we don't
11 catch, but I'm not aware of any judge who was
12 informed that this was the policy, please do a
13 Folsom decision, and then refused to do that.

14 Q Might there have been other reasons that
15 Judge Fitzpatrick was informed that this was a
16 problem but not other judges?

17 A No, what I'm saying that I believe other
18 judges were informed that this was the policy and
19 they complied.

20 Q And you believe they complied if they
21 instituted single- claim institution decisions
22 after Judge Fitzpatrick was disciplined?

1 A What I'm saying, I don't know of any
2 judges other than Judge Fitzpatrick who when a
3 decision was looked at and it was caught that
4 there was a single-claim institution and they were
5 told prior to issuance to fix it, as far as I know
6 all of those judges fixed it. I'm not aware of
7 any other judges that refused the request to fix
8 it to be in accordance with policy. I'm only
9 aware of one such instance, which is Judge
10 Fitzpatrick.

11 Q Now didn't you testify in direct that
12 concurrences and dissents aren't the decision of
13 the Board and they are a good thing.

14 A They are -- they are generally a good
15 thing to have a concurrence and dissent. The
16 thing that I think makes Judge Fitzpatrick's
17 decision here different is that it's just an in-
18 your-face refusal to follow Agency policy and
19 that's not a good thing.

20 Q So it's something that Judge
21 Weidenfeller in your office took personally.

22 A We did not take it personally. We don't

1 take any of this personally.

2 Q How many judges got requests to fix
3 their single-claim institution decisions?

4 A I don't know. That's something that was
5 done by the AIA review committee and Judge
6 Weidenfeller would have been more on the front
7 lines of that. I don't know how many would have
8 gotten that request.

9 Q The PTO would be able to show who was
10 asked to fix their single-claim institution
11 decisions, correct?

12 A I am not really sure what records at
13 this point may or may not exist from there. I
14 just don't know what we have or don't have, or
15 what we remember from this long ago.

16 Q Now if this SAS informal guidance we
17 keep discussing were such critical directive
18 guidance, wouldn't ARC have seen to it that no
19 decisions of any judge got out that analyzed a
20 single claim?

21 A ARC does their best, but they're looking
22 at a lot of different issues, you know. They are

1 human.

2 Q After ARC it goes to management,
3 correct?

4 A Yes, if ARC flags it -- they can flag
5 things to management. Of course, if ARC misses
6 it, management misses it, too.

7 Q Again, if this were such an unequivocal
8 policy directive wouldn't it be the case that no
9 decisions that instituted on a single claim would
10 have gotten out after SAS.

11 A I wish I could say that, but the reality
12 is that ARC does sometimes miss things. Things do
13 slip through, and especially in the early days
14 when policy is being issued, sometimes they don't
15 catch everything. So, I would never guarantee
16 that ARC would catch 100 percent of any particular
17 issue -- they do their best.

18 Q But management has oversight over what
19 ARC does, correct?

20 A They do. They give ARC a list of issues
21 to look out for, but it's not a single issue.
22 This isn't the only thing on their list. They

1 have a lot of other issues that they look out for
2 at any given time, so ARC is looking for any or
3 all of those to give comments back.

4 Q You mentioned, I don't think you
5 mentioned it by name, but on direct you talked
6 about the Arthrex case, correct?

7 A I probably had referenced it at some
8 point, yes.

9 Q The Arthrex case was a 2021 decision,
10 correct?

11 A Uh-huh.

12 Q And that case as I think you alluded to
13 in your direct testimony set up a Director review
14 process in cases after Arthrex, correct?

15 A That is right.

16 Q It required that under the Appointments
17 clause of the constitution, correct?

18 A That is right.

19 Q And so now because of that, there is
20 transparency around the panel that decided the
21 decision and the Director's views as far as the
22 Director may disturb the panel's decision,

1 correct?

2 A Right. In other words, the Director now
3 may change the final written decision of a panel
4 singlehandedly. That wasn't clear prior to
5 Arthrex.

6 Q And now we're obviously post-Arthrex.
7 In this case, I think it's pending for I think 8
8 years.

9 A Yes.

10 Q But pre-Arthrex, the Administrative
11 Judges were deemed to have adjudicative authority
12 that was akin to that of a principal officer,
13 correct?

14 A We did not agree with that. We, the
15 Government, disagreed. We also maintained the
16 Administrative Judges were inferior officers under
17 the direction and control of the Directors. The
18 Supreme Court by 5-4 disagreed with that, but that
19 had been the position of the Agency is the
20 Director had sufficient supervision and control of
21 the judges that they were inferior officers.

22 Q Right. And so pre-Arthrex, reasonable

1 minds could disagree, including reasonable minds
2 on the Supreme Court about the degree of
3 independence that Administrative Judges have,
4 correct?

5 A I'm not sure about what the Supreme
6 Court disagreed with. I mean they read the
7 Appointments clause and they read the Supervision,
8 and they read the Section 6C differently than the
9 Agency had, but --

10 Q You did testify in direct that in your
11 view that Administrative Judges have at least some
12 degree of independence, correct?

13 A That is right. Yes, I believe that.

14 Q Okay, so reasonable minds might disagree
15 to the extent the Administrative Judges have
16 independence, correct?

17 A To some reasonable extent, I suppose,
18 but there are boundaries of reason.

19 Q Okay. So let's go now to the grievance
20 again. We're now on page 23. I want to go to the
21 second full paragraph, I believe counsel might
22 have pointed it to you. It says: In addition, I

1 note that your difficulties seem to arise from a
2 misapprehension of --

3 JUDGE NIEDRICK: I'm sorry, Mr. Suarez,
4 for some reason and I have no idea why, it's
5 getting muffled sometimes. I don't know if there
6 is something in front of your microphone.

7 MR. SUAREZ: I think I cover my mouth
8 sometimes.

9 JUDGE NIEDRICK: No, it's not that, it
10 just all the sudden starts gargling and we can
11 barely hear you.

12 MR. SUAREZ: It's probably I'm not
13 speaking directly, I think I'm turning.

14 JUDGE NIEDRICK: No, it's okay. It'll
15 just help to be more vigilant about facing the
16 computer.

17 MR. SUAREZ: You can hear me now, right?

18 JUDGE NIEDRICK: Yes, yes.

19 MR. SUAREZ: So I think it's when I turn
20 my head that it happens sometimes.

21 BY MR. SUAREZ:

22 Q So again, we are on the sentence that

1 says: I note that your difficulty seems to arise
2 from a misapprehension of the nature of your
3 employment. Do you see that?

4 A I see that.

5 Q Okay. So, if your view that the nature
6 of Judge Fitzpatrick's employment is such that he
7 must always follow the direction of PTAB
8 management?

9 A I mean always is a tricky word. He has
10 to follow you know the lawful direction of PTAB
11 management.

12 Q And when you say the lawful direction of
13 PTAB management, you would agree that PTAB
14 management might take positions that are
15 inconsistent with the constitution and laws of the
16 United States?

17 A I don't believe that we do.

18 Q Well, that's not my question, my
19 question is: You would agree that the Director
20 cannot mandate Administrative Judges to do things
21 that are inconsistent with the constitution and
22 laws.

1 A I agree with that. That is right.

2 Q And if an Administrative Judge has views
3 that are reasonable that the Director may be
4 adopting policy that is contrary to the
5 constitution and laws of the United States, that
6 is an okay thing to do, right?

7 A Right.

8 Q And so expressing those views isn't
9 necessarily insubordination, correct?

10 A Expressing a view that something is
11 contrary to law, no, I don't that that is
12 insubordination. A reasonable view.

13 Q Now in the bottom paragraph, I really
14 want to understand something you said, it says:
15 Under your command and the authorities above, you
16 must comply with United States Patent and
17 Trademark Office policies and supervisory
18 directions whether oral or written in any
19 applicable guidance applicable to PTAB
20 proceedings. Do you see that?

21 A Yes.

22 Q Okay, and here you do have a cite. You

1 say: See fiscal year 18, I believe that's
2 performance appraisal plan, is that right?

3 A That is right.

4 Q And it says decisions are consistent
5 with binding legal authority and legal guidance
6 applicable to PTAB issued by the Director or the
7 Director's delegate, right?

8 A That is right.

9 Q So what you cite there doesn't refer to
10 oral guidance, right?

11 A That part of the path does not.

12 Q And you don't cite anything in here that
13 references oral guidance that's authoritative,
14 correct?

15 A Not in that cite.

16 Q And when you quote binding legal
17 authority, you'd agree that includes the
18 constitution, correct?

19 A Yes.

20 Q You'd agree that includes the Supreme
21 Court processes, correct?

22 A Yes.

1 Q You'd agree that includes the Federal
2 Circuit processes, correct?

3 A That is right.

4 Q Okay. So, what in your view is written
5 guidance in that sentence?

6 A Written guidance can be either written
7 policies from the Director, it could be emails, it
8 could be presentations that are explaining the
9 Director's policies. It could be a pretty wide
10 variety -- it doesn't have to be a letter from the
11 Director signed necessarily by the Director. It
12 could be other written guidance that comes from
13 the Director.

14 Q When you say other written guidance that
15 comes from the Director, what forms -- in your
16 opinion -- could that be?

17 A It could be something on a webpage
18 telling parties how to conduct themselves -- there
19 could be other forms, I can't think of other
20 examples right now, but the webpage is one that
21 comes to mind.

22 Q Okay. You say in this sentence again:

1 You must comply with United States Patent and
2 Trademark Office policies and supervisory
3 directions -- whether oral or written -- and any
4 applicable written guidance applicable to PTAB
5 proceedings, right?

6 A Yes.

7 Q Okay. Let's say we have a three-judge
8 panel, and the Director tells the panelists: I
9 want you to rule this way, you need to change your
10 opinion, otherwise I'm going to fire or demote you
11 for insubordination. The panelists would have to
12 do that, correct?

13 A You're saying if the Director says you
14 must vote a certain way in a case -- is that the
15 example? I'm not sure if I understood your
16 example of what the Director's telling them.

17 Q If there is a Director guidance -- a
18 policy or supervisory direction, whether oral or
19 written. So, if the Director orally communicated
20 to a panel: I don't agree with your position, you
21 need to change your position, rewrite it, and if
22 you do not, I will discipline you for

1 insubordination. It's your opinion that those
2 three judges must follow the directive, correct?

3 A I'm not sure which way it's being
4 re-written. Are you saying to find for a
5 different than the evidence shows? I'm not really
6 following the example.

7 Q I'll try to be a little more specific.

8 A Okay.

9 Q Now I'll make the example very simple,
10 okay? Let's say a three-judge panel confers and
11 they decide the patent is not obvious. They make
12 that decision.

13 A Right.

14 Q And they unanimously make that decision.
15 But the Director comes in and then gives an oral
16 directive and says: I have taken it upon myself
17 to look at this case and I disagree. You need to
18 make this patent invalid, and you need to change
19 your opinion. Is it your view that the Director
20 is permitted to do that?

21 A In that example, no. That gets to that
22 sphere of independence before. You can't and we

1 don't tell judges how to vote on a case. As far
2 as whether a claim is patentable or unpatentable,
3 that's not I think a proper thing for the Director
4 to tell a panel member to do.

5 Q Okay. What if a three-judge decides
6 unanimously that Director guidance is
7 unconstitutional under the laws and the
8 constitution of the United States, and decides to
9 put out an opinion that it believes the Director
10 guidance is unconstitutional. In that situation,
11 do you believe that the Director has plenary
12 authority to change the opinion and to terminate
13 those individuals if they are insubordinate.

14 A No, not if they have a reasonable belief
15 that the guidance is against the constitution.

16 Q So then you would agree that if Judge
17 Fitzpatrick had a reasonable belief that what the
18 Director was doing was against the constitution,
19 then he should not have been terminated or
20 demoted, right?

21 A And he wasn't terminated or demoted.

22 Q If as is a matter of law, the

1 Administrative Law Judge disagrees with you as to
2 whether an adverse action was taken, you agree
3 that it was inappropriate for a government to have
4 taken an adverse action against Judge Fitzpatrick
5 if he had a reasonable belief that what the
6 Director was doing was unconstitutional.

7 A I don't believe that there is a
8 reasonable belief that what the Director was doing
9 was unconstitutional.

10 Q So if the Administrative Law Judge
11 disagrees with you as to whether there was a
12 reasonable belief, then you would agree that was
13 inappropriate for the Agency to take an adverse
14 action against Judge Fitzpatrick.

15 A Well, with all due respect, there is the
16 possibility of appealing that decision if we still
17 disagree, so at some point that gets resolve. I
18 mean I think we still can respectfully maintain
19 the ability to disagree if that was the decision
20 of the Administrative Judge.

21 Q And in that circumstance -- the
22 hypothetical I've been discussing -- let's say

1 they were forced to change their decision by the
2 Director per his policy, and the panelist said we
3 want to cite something, we want to say the
4 Director us to do this because we don't want this
5 on our name. Let's say that happened. Is it your
6 position that a panelist cannot say the Director
7 told us to reverse this decision -- this guidance
8 or this Director -- if policy is the reason for
9 it?

10 A I believe the panel could say: We're
11 deciding this according to the Director's policy.

12 Q So if the Director's guidance was oral,
13 and the panel wanted to say orally that the
14 Director had orally told them to do this, you're
15 okay with that?

16 A If the guidance was oral, then I think
17 they could say: Per the Director's oral policy
18 guidance, this is the way we're deciding the case.
19 I think they could do that.

20 Q Now, this reminds me. I did want to ask
21 you a question about deliberative process. You
22 invoked that several times in your direct, do you

1 recall that?

2 A Yes.

3 Q Now is it your position that the facts
4 pertaining to the composition of the panel are
5 themselves deliberative process?

6 A I'm not sure which facts?

7 Q So for example the fact that a panel was
8 expanded from 3 judges to 5, is that sheer fact
9 part of the deliberative process in your opinion?

10 A In my opinion as far as the way that we
11 exercise expanded panel practice because it could
12 be and, in fact, here was unexpanded, that is part
13 of deliberations of something that there was an
14 expansion and an unexpansion and, therefore, it's
15 essentially as if it never was. Just because the
16 final decision there was made by the 3 judges who
17 are listed on the decision.

18 Q So your opinion is that in the Nike case
19 the deliberative process privilege shields the
20 existence of the expanded panel and the
21 de-expansion of the panel. That is your position?

22 A It's my position, yes, that that's

1 confidential information that should not be
2 disclosed. I think that is part of our
3 deliberations is whether we expand or not.

4 Q Now given revision of the policy under
5 SOP1, you would agree that you are now waiving
6 that alleged privilege going forward in every
7 case, correct?

8 A That is right. That was a decision that
9 was made to no longer keep that practice. So from
10 that point onward that is something that as you
11 say was waived in a sense because we now choose to
12 disclose it.

13 Q So your position as we sit here today is
14 that for the Nike case -- and essentially for the
15 Nike case alone -- that the deliberative process
16 privilege protects the fact -- the pure fact --
17 that the panel was expanded and contracted, but
18 you're okay with waiving that privilege as the
19 Chief Judge sitting here today going forward?

20 A And I would say not just the Nike case
21 alone. Any case prior to the revision to SOP1,
22 the fact that an expansion had been done -- if was

1 then unexpanded prior to becoming public would be
2 protected. So, any such case, not just that
3 particular one, but in the latest revision we at
4 the Board and, in particular, the Director and
5 Chief Judge at the time decided to make a change
6 and reveal that going forward.

7 Q Now are you familiar with the law. You
8 said you're a lawyer, right?

9 A I am.

10 Q Are you familiar with the law of
11 deliberative process privilege?

12 A I'm not an expert in it, no.

13 Q Do you understand that it's a qualified
14 executive privilege?

15 A I'm not an expert in executive
16 privilege.

17 Q Are you aware of an indication of the
18 deliberative process privilege at any time by the
19 Director or by the delegate of the Director as to
20 the existence of panel expansion?

21 A I'm not sure I understand what you're
22 asking.

1 Q Can you understand that deliberative
2 process privilege actually has to be invoked,
3 right?

4 A Invoked in what sense, in what context?

5 Q Do you understand it's not a blanket
6 privilege?

7 A I don't know what you mean by blanket
8 privilege. I'm not sure who his requiring it to
9 be invoked. We invoke a privilege when we said
10 this is confidential information that should not
11 be disclosed because it pertains to our
12 deliberations.

13 Q You're the Chief Judge of the entire
14 PTAB, right?

15 A I am.

16 Q And you've mentioned deliberative
17 process probably during your direct.

18 A Yes.

19 Q Shouldn't you be familiar with the law
20 of deliberative process and how is invoked and
21 when it applies.

22 A I would say, I'm familiar, but I am not

1 an expert in that area.

2 Q You're aware that prior to May of 2018,
3 Judge Fitzpatrick uniformly received positive
4 performance appraisals, right?

5 A I'm not sure that I'm aware -- I believe
6 that is true. At least, I've seen nothing to the
7 contrary. I have not personally reviewed his
8 prior personal performance appraisals, but I
9 believe that's true.

10 Q Okay. I have nothing further. Thank
11 you.

12 JUDGE NIEDRICK: Okay, thank you. I
13 have a few questions. I know we talked a little
14 bit on cross about the Supreme Court's decision on
15 Arthrex. I want to see if you agree that -- with
16 my understanding of Arthrex is that -- the Supreme
17 Court essentially said that in practice up until
18 that point, Administrative Judges were essentially
19 acting as principal officers in this executive
20 Agency. Is that your understanding?

21 THE WITNESS: Yes. What they said is
22 because the Director in their view could not

1 unilaterally review the final decisions the
2 Administrative Judges were essentially acting
3 beyond their appointment.

4 JUDGE NIEDRICK: And it sounded like you
5 sort of disagreed with the court's finding there
6 and their reliance on the authority that they sort
7 of considered -- or at least your office had a
8 different view of what the authority was, is that
9 fair?

10 THE WITNESS: Yes, that's right. We had
11 a different view. Obviously we follow the Supreme
12 Court. Their decision is the decision that we
13 follow. We had a different view because the
14 Director had many ways of supervising the work of
15 the Administrative Judges. But, again, the
16 Supreme Court majority did not find that.

17 JUDGE NIEDRICK: And who is the
18 principal officer at the PTO?

19 THE WITNESS: That's the Director.

20 JUDGE NIEDRICK: So the court up to that
21 point was saying in practice, essentially the
22 Administrative Judges were on the same level as

1 the Director, and so to fix that, they sort of
2 directed the PTO to make some changes to make sure
3 that those decisions would not be final without
4 sort of having a politician at the Agency review.
5 Is that right?

6 THE WITNESS: That is right. And that's
7 the new Director review process where, at least in
8 the final written decisions. And Arthrex, just to
9 be clear, only spoke the final written decisions
10 in interparties review decision, so it didn't
11 speak to our other types of decisions that we
12 made. But, yes, the new process would cure that
13 problem.

14 JUDGE NIEDRICK: Okay. And so as far as
15 the court's understanding of judicial independence
16 up to that point, was it as broad? Do you think
17 that they viewed them as principal officers -- or
18 that effectively they were acting as principal
19 officers -- that they had as much authority as an
20 Article 3 judge?

21 THE WITNESS: Not as an Article 3 judge.
22 There's a difference I think between Article 3. I

1 think what the court was saying was essentially
2 judges had too much independence. The problem
3 with Arthrex is not that judges had too little,
4 but that they had too much independence from the
5 Director, and that's what Director review was
6 meant to fix.

7 JUDGE NIEDRICK: Okay. So, in essence,
8 the issue there was they were saying they had as
9 much judicial independence as the Director did,
10 and that had to be fixed.

11 THE WITNESS: That is right. That's
12 what I believe was the point of the Supreme Court
13 majority.

14 JUDGE NIEDRICK: Okay. Again, with
15 judicial independence is -- I'm kind of struggling
16 -- because one of the things I have to look at is
17 whether a reasonable person in JK's position with
18 regard to these disclosures that he made could
19 have been under the assumption or believe that
20 under the law they had the authority to issue
21 without review or without interference from the
22 management or the Director. And so that's what

1 I'm struggling with, and that's why I want to
2 understand your view on that. You had also
3 testified that Administrative Judges don't have
4 much authority as ALJs -- that apparently they
5 have a narrower scope. What do you mean by that?

6 THE WITNESS: What I mean by that is
7 that the statute for ALJs I believe -- and it's
8 been a while since I looked at this -- I looked at
9 it some time ago, but it is more strict. For
10 example, ALJs don't get performance reviews at the
11 end of the year. There's no performance appraisal
12 process for ALJs. So in that sense they have more
13 independence than RPJs at the patent office.

14 JUDGE NIEDRICK: Do you know, can ALJs
15 be disciplined for poor performance?

16 THE WITNESS: I don't know that they
17 can. I'm not aware that they're able to be
18 disciplined for poor performance.

19 JUDGE NIEDRICK: Do you know if they can
20 be disciplined for failing to comply with the
21 policy of the principal at the Agency they are at
22 -- the principal officer?

1 THE WITNESS: That's also a good
2 question. I'm not sure about that. I think they
3 have another aspect of their independence is that
4 whether anyone other than the ALJ can talk to them
5 about their decision to give them devise or to
6 tell them you might not be following the policy.
7 I think they have a little more protection that
8 way. I haven't reviewed the statute before today,
9 so I'm a little rusty on that.

10 JUDGE NIEDRICK: As far as judicial
11 independence. If an Administrative Judge believed
12 that the Director or some other management
13 authority at PTAB was usurping their autonomy,
14 their judicial independence, would that be a
15 violation of anything?

16 THE WITNESS: I may have heard you
17 backwards, would you mind repeating that?

18 JUDGE NIEDRICK: It wasn't that clear.
19 If the Director for the management person at PTAB,
20 if an Administrative Judge believes that one of
21 those folks was interfering with their judicial
22 independence -- sort of their autonomy as a judge

1 -- would that be a violation?

2 THE WITNESS: Okay. I'm trying to think
3 of an example of that. Such as if a Director told
4 them how to vote on a case or something.

5 JUDGE NIEDRICK: Sure, that's a good
6 example, yes.

7 THE WITNESS: Okay. I mean that does
8 seem improper. I don't believe you can tell the
9 judge how to vote in a particular case. That does
10 seem to be a due process problem because the
11 decision maker needs to arrive at their decision
12 based on the facts before them. If they think the
13 facts lean a different way but they're told you
14 have to decide the case the other way, then that
15 seems to be a problem. If they're told you're not
16 following the right policy, the right law, I think
17 that's a different matter -- you're applying the
18 wrong law or policy, then I think they should go
19 back and apply the right policy or law.

20 JUDGE NIEDRICK: You mentioned that is a
21 due process violation. What are you basing that
22 on? What law or statute are you saying is being

1 violated when you say that there's a due process
2 violation.

3 THE WITNESS: I don't know that I have a
4 completely formed legal theory on that. It could
5 be the APA, for example, that the (inaudible)

6 JUDGE NIEDRICK: Could it be that the
7 Director exceeded the scope of whatever statutory
8 they had to sort of manage and regulate the
9 Administrative Judges?

10 THE WITNESS: According to Arthrex, I
11 think they have quite a bit of authority to manage
12 and regulate the Administrative Judges.

13 JUDGE NIEDRICK: Did the court think
14 they had that authority before the court fixed the
15 problem?

16 THE WITNESS: Well, I don't the court
17 ever thought the Director had the authority to
18 tell the judges how they must vote -- they don't
19 want outcomes in a case. I don't think they
20 thought they had that authority, but as far as the
21 authority to set policy or the framework under
22 which decisions are made, I do think the court

1 thought the Director has the authority to tell
2 judges that.

3 JUDGE NIEDRICK: Okay. I'm wondering
4 what you think the purpose is -- we've kind of
5 gone through this whole issue with the expansion
6 and unexpansion and notification with regard to
7 parties, and why do that -- why does it matter the
8 identity of the panel amounts in a case before the
9 PTAB?

10 THE WITNESS: Why does it matter? I
11 don't know that it necessarily matters other than
12 at the end of the day you want to know who made
13 your decision, but I --

14 JUDGE NIEDRICK: But isn't it at the end
15 of the day the Director the one with the authority
16 to make the decision? So if employees are acting
17 at the direction of the Director, then it doesn't
18 matter who those employees are because ultimately
19 the decision that they are issuing are at the
20 direction of the Director.

21 THE WITNESS: At least in some sense,
22 although in the way that the statute is written

1 the Board does have to have a panel of three
2 judges to decide each case. Again, the Director
3 -- even though it's under the Director's
4 authority, the Director isn't the one who tells
5 them you have to weigh this evidence in favor of
6 patentability or against patentability -- there's
7 not that boundary.

8 JUDGE NIEDRICK: Do you think the
9 Supreme Court and the Federal Circuit have
10 expressed concern in the past about expanding
11 panels.

12 THE WITNESS: Some judges individually
13 have expressed concern. They have never come out
14 to say that is improper, but there were
15 individuals judges who expressed misgivings.

16 JUDGE NIEDRICK: But I guess my question
17 is, from the research that I have done in this
18 case -- and you know so much more than me, and I'm
19 learning -- but it seems to me that both the
20 Federal Circuit and the Supreme Court have
21 expressed concern about expanding panels, and sort
22 of the authority to do that and when it's done and

1 for what reason it is done. Is that a fair
2 statement?

3 THE WITNESS: I think it's a fair
4 statement they have expressed concern, although
5 they have never had that case squarely presented
6 to them and has never had the opportunity to
7 reasons why that might make sense or reasons why
8 that might be okay. It is just very foreign to
9 Article 3 practice, and I think what you hear
10 might be a reaction to that being very foreign to
11 what happens in Article 3 courts.

12 JUDGE NIEDRICK: But it seems to me that
13 this whole issue is about due process, and the
14 idea that you acknowledge that if the Director
15 tells a judge to change their decision that could
16 be a due process violation, and it seems to me
17 that both courts -- the Federal Circuit and the
18 Supreme Court -- have expressed concern about that
19 very issue. That the idea that due process could
20 be implicated -- if as Chief Justice Roberts
21 indicated the panel composition was expanded
22 midway through the proceeding. Isn't that right/

1 THE WITNESS: Well, again, I think that
2 they expressed some concern about it, but I don't
3 think that they have actually gone through and
4 fully considered all of the arguments on both
5 sides. I think it is more of every action of
6 first impression, but it's not a final
7 pronouncement that hey that was improper, I might
8 have concerns about that -- it doesn't mean that
9 was a problem.

10 JUDGE NIEDRICK: But you, yourself, said
11 it's a problem. You testified that you think it
12 is a problem if a Director tells a judge to change
13 their decision.

14 THE WITNESS: Right. That would be a
15 problem. Just to be clear that has not happened
16 and that hasn't happened in this case and any case
17 that I am aware of -- that is a hypothetical
18 situation that as far as I am aware has not come
19 to pass.

20 JUDGE NIEDRICK: And so for the reason
21 of the expansion of the panels under the guidance
22 of the Patent and Trademark Offices for sort of

1 several reasons -- I guess if you have something
2 that is a big issue, and I've heard during
3 testimony from other witnesses that it is akin to
4 the Federal Circuit going on (inaudible). I don't
5 know if that is an accurate analogy, but it seems
6 to me that if a case comes to the Director and
7 through designated authority -- whoever does it --
8 the Chief Judge, whoever designates a panel -- it
9 seems to me that that would be the time to expand
10 the panel when they initially designate it. We
11 have an issue that is particularly touch or
12 difficult and you would do it at the front end --
13 you wouldn't make a determination in the middle
14 unless I guess something changed in the law after
15 the panel had been designated. But I'm just
16 wondering about this whole process. In practice,
17 are you aware of concerns from the private bar,
18 the folks who are litigants in these cases about
19 panel expansion? Has that been a concern?

20 THE WITNESS: It has been a concern that
21 we have heard and, as I believe I pointed out
22 earlier -- that panel expansion was something that

1 was done rarely, it was the primary tool up until
2 very recently for making precedential
3 pronouncements in cases where we were trying to
4 resolve splits. Something that has sort of taken
5 over more recently is we have a new process where
6 we have something called a Precedential Opinion
7 Panel. It's a new process -- we still have on the
8 books the ability to expand panels, but it hasn't
9 been done for a long time. We have heard concerns
10 and whether we think that we could do it, we have
11 decided to kind of take a different approach.

12 JUDGE NIEDRICK: And why is there
13 concern? I have kind of heard that the SOP states
14 that it is not favored, that you do it rarely. We
15 talk about people being concerned about it -- the
16 litigants are concerned, other judges are
17 concerned -- what is the basis for the concern?

18 THE WITNESS: I don't know that I
19 necessarily share that concern. I think it is
20 just the concern is it is different than other
21 processes that you normally see -- it is not a
22 process that is generally used in the Federal

1 Courts. It is something that was fairly unique to
2 the Board practice. Our sister board, the
3 trademark trial appeal board, sometimes does
4 similar things I believe, but that wasn't a
5 practice outside of our Board that was done widely
6 and I think because -- as was a remark in Arthrex
7 -- we are kind of a unique creature. I think the
8 uniqueness is something that catches people's
9 attention.

10 JUDGE NIEDRICK: Isn't the concern more
11 of that essentially due process violations occur
12 because of the political or the management
13 officials at the Agency are going to stack the
14 court to reach a certain decision. I don't know
15 if you want to call it a court, but the panel --
16 is going to stack that panel.

17 THE WITNESS: Sorry, I am losing the
18 pace here --

19 JUDGE NIEDRICK: No, I understand.

20 THE WITNESS: In Alapat -- what happened
21 the Director picked people. The Director didn't
22 tell the people he picked how to voted, but he

1 picked people he suspected would vote his way, and
2 that is something that some folks weren't happy
3 about as a way to get the result -- is that he
4 shouldn't be able to pick. Well, at least that's
5 the way the statute is written, the Director can
6 pick who is on the case, but some folks were
7 concerned I guess about that. Again, that was
8 Alapat, that's what happened there, Federal
9 Circuit (inaudible).

10 JUDGE NIEDRICK: So let me ask you this.
11 So there is a three- judge panel, the panel issues
12 a decision. There is a two to one decision, there
13 is one dissent -- comes up through the management
14 review in ARC, and the Director looks at it and
15 says: Hey, you know what, I think it should go
16 the other way. So what I'm going to do is I am
17 going to get rid of these two folks here that
18 voted to find a patent or that there was not
19 patentability -- whatever it is, but I am going to
20 replace them with two other people and see what
21 they do. And you just keep doing that through the
22 whole process until the decision is issued. Is

1 there a problem with that? Is there anything
2 inappropriate in doing that?

3 THE WITNESS: Well, at least the panel
4 expansion worked, rather than removing the two, he
5 would add two more rather than removing people who
6 have already shown how they are voting, so I don't
7 know. I think that is, you know, at least right
8 now in the power of the Director to do.

9 JUDGE NIEDRICK: Okay. Alright, thank
10 you. Why did the SOP change again? What was the
11 reasoning behind notifying parties now of the
12 expansion? Why did the policy change on that?

13 THE WITNESS: So again, I think the
14 policy had changed in order to try to bring a
15 little more transparency to our operations and
16 what we do. It was something that our then new
17 Director Iancu was very interested in increasing
18 transparency, so that was my understanding of his
19 reason for wanting to make that change.

20 JUDGE NIEDRICK: And when Judge
21 Fitzpatrick wanted to initially on this -- the
22 Nike panel -- asked to go ahead and just disclose

1 that. That was one of the things he wanted to do
2 early on. He asked can we just disclose that the
3 panel has been expanded so the parties that are
4 paying all this money to litigate these cases
5 understand that's what happened. Why didn't the
6 office just agree to do that then? I mean if the
7 idea is that we want to be transparent, I don't
8 see that as waiving any sort of privilege relating
9 to deliberative process. I mean that's just what
10 one of the judges on the panel thinks that that's
11 an important thing to them, which apparently now
12 the office agrees with, but why didn't you guys
13 just go ahead and do that at the time when the
14 issue was raised?

15 THE WITNESS: I think it is just that at
16 the time that wasn't our procedure. We had never
17 done that before -- it is just something that at
18 the time we didn't do, it's the way that we
19 operated and had operated for decades.

20 JUDGE NIEDRICK: We talked a little bit
21 about in your direct, I believe -- or maybe it was
22 the cross -- you talked about in the meetings that

1 you participated with the Director where you guys
2 maybe talked about the personnel act.

3 THE WITNESS: Right.

4 JUDGE NIEDRICK: Do you recall at all in
5 any of those meetings talking about Judge
6 Fitzpatrick for any reason?

7 THE WITNESS: I think we may have
8 brought this case -- you know, it may have come up
9 because Judge Fitzpatrick emailed the Director
10 about it, so I believe -- but I believe that was
11 more a conversation with Chief Judge Ruschke. I'm
12 trying to recall whether I talked to the Director
13 about this particular case.

14 JUDGE NIEDRICK: Is this Nike that we
15 are talking about, or is this the Supreme Court
16 order.

17 THE WITNESS: Yes, the Nike case. Yes.
18 And so I know Chief Judge Ruschke talked with the
19 Director about the Nike case because of the email,
20 but I don't recall us discussing much about it
21 other than that.

22 JUDGE NIEDRICK: But you do recall his

1 name did come up with regard to that case in one
2 of those discussions.

3 THE WITNESS: I know that his name had
4 come up because again because of the email and I
5 believe that -- I don't recall being in the
6 meeting, but I do believe that Chief Judge Ruschke
7 and Director met one-on-one to talk about it.

8 JUDGE NIEDRICK: With regard to the
9 issue with the issue with the Supreme Court
10 transcript and Judge Fitzpatrick's concern about
11 that -- and that maybe there was a
12 misrepresentation or a mistake made during that
13 about whether expansion had happened during a
14 merits proceeding. And you testify that you
15 thought about that. You discussed it with Judge
16 Ruschke and ultimately determined that he was just
17 plain wrong. So, I guess my question is, do you
18 think that he was reasonable in raising that to
19 you? I mean do you think someone in his position
20 should have just know that that was wrong, so it
21 was unreasonable for him to even bring it to you
22 in the first place?

1 THE WITNESS: I don't think there is any
2 merit to that. No decision had ever been made by
3 an expanded panel, so I don't think that was a
4 reasonable concern, but because it was a concern
5 saying that the Solicitor General may have made a
6 misrepresentation I decided I should bring this
7 up. I didn't want to let that lie. I wanted to
8 alert our legal team to it. They came to the same
9 conclusion that there was no misrepresentation.

10 JUDGE NIEDRICK: So even you thought it
11 was an unreasonable (inaudible) you felt that it
12 was reasonable to go ahead it with the Solicitor
13 General just in case somebody else might think it
14 was reasonable?

15 THE WITNESS: I mean, essentially, yes.
16 I don't for us to ever have been accused of hiding
17 something from the Supreme Court. So, just the
18 nature of the allegation was such that it could
19 have said do you that the moon is made of cheese,
20 I probably still would have brought it up.

21 JUDGE NIEDRICK: Okay. And why didn't
22 you tell Judge Fitzpatrick that you were going to

1 address the issue. You certainly didn't have to
2 tell him what you were going to do, but you were
3 going to take it under consideration. Because --
4 unless I'm missing something -- in the record, he
5 sent I think 3 emails to 3 different management
6 officials and nobody even had the courtesy of
7 responding to him. And for the life of me I don't
8 understand that. Why wouldn't management
9 officials at least say: Thank you for this, we
10 will take it under consideration.

11 THE WITNESS: At some point I thought
12 that may have been conveyed back, but perhaps it
13 was not. I know that I had discussed it with the
14 Chief Judge.

15 JUDGE NIEDRICK: I mean I hope that it
16 is in there some place. I'm happy to hear this --
17 look on at your face --

18 THE WITNESS: I'm not sure that it is on
19 the record, but I know I had discussed with the
20 Chief Judge the concern. It felt appropriate to
21 me since the communication was addressed to him
22 that he be the one to call back.

1 JUDGE NIEDRICK: Okay. And you
2 testified that with regard to sort of 2 acts of
3 insubordination, where he had refused to do
4 certain things, that sort of reassigning him to
5 this ex parte docket was not -- you didn't
6 consider that disciplinary act, is that correct?

7 THE WITNESS: No, I don't consider that
8 discipline. I consider that assigning him to a
9 docket where the issues seem to be troubling and
10 causing problems won't arise, and so we won't, you
11 know, it would be better that he won't have to
12 worry about that, and it would just be best for
13 all because those issues don't arise there.

14 JUDGE NIEDRICK: But it wasn't the
15 issues was it? It was the fact that you felt he
16 was insubordinate by not complying with the
17 directives that he was getting. Wasn't that the
18 issue -- the failure to follow the instructions
19 that he was given?

20 THE WITNESS: No, that's right.

21 JUDGE NIEDRICK: And so you also testify
22 that these cases that you put them on -- they are

1 all equal and there is the same value and prestige
2 and everything, no matter what types of cases you
3 doing. All of these judges do cases that are of
4 equal value. So my question would be, why
5 reassign him then? If the issue is he is not
6 complying with directives and you put him on other
7 cases that are equally prestigious, equally
8 important, what makes you think that by doing that
9 he is going to follow directives?

10 THE WITNESS: I thought it was the
11 particular directive that he did not agree with,
12 and again these issues in SAS and on institution
13 aren't ever issues that arise in our appeals, so
14 that issue just isn't going to be present, right?
15 I took the disagreement to be with that particular
16 piece of policy not being generally disagreeable
17 following any particular direction. So, there
18 have never been any problems with any -- following
19 the Agency policy in appeal decisions, it seemed
20 that would be a more appropriate docket where --
21 and indeed to this day -- I have not heard of any
22 policy or any insubordinate conduct occurring in

1 any of the appeals cases. So it seems to have,
2 you know, worked out that he hasn't felt the need
3 to go against Agency policy in appeals.

4 JUDGE NIEDRICK: You said at one point
5 that apparently -- I guess you guys were doing
6 some of your research -- to determine how many
7 times the panel had actually been expanded. You
8 had said that I guess it was between 6 and 10
9 times, am I right with that?

10 THE WITNESS: Offhand, I know we looked
11 into it, and we had done some studies of expanded
12 panels -- there is one on our website -- it is
13 old, but it was there looking at expanded panels,
14 but it was fairly rare. I was just thinking of
15 some of the KSR cases, some of the cases in NIA,
16 and the sovereign immunity cases, and it is a
17 fairly low number of cases over those many years
18 that were expanded.

19 JUDGE NIEDRICK: Okay. And how many
20 times -- if you know -- how many times were
21 expanded panels unexpanded before you issued this
22 final decision?

1 THE WITNESS: I don't know how many
2 times. I do believe that expanded panels were
3 unexpanded in the past, although expanded panels
4 themselves are pretty rare. Unexpanding, it does
5 happen, I couldn't tell you the number of times
6 where it happens, but I do believe that it has
7 been done.

8 JUDGE NIEDRICK: And the reason for
9 unexpanding -- what would be the reason for
10 unexpanding?

11 THE WITNESS: Well, a reason could be
12 that the important legal issue or the split of
13 authority had been resolved by the Federal Circuit
14 so there is no need for binding guidance from the
15 Board on it anymore because we had our binding
16 guidance from the Federal Circuit.

17 JUDGE NIEDRICK: And so, for example, in
18 the Nike case, when Aqua Products decision came
19 out, then at that point it was appropriate to
20 unexpand.

21 THE WITNESS: Right.

22 JUDGE NIEDRICK: And how long after Aqua

1 Products did you take the action to unexpand?

2 THE WITNESS: You know, I don't recall
3 exactly how long it took, but -- I don't remember
4 the exact dates, but it was something that was
5 talked about. Again, things kind of proceed at
6 their pace because at any given time the Chief
7 Judge, Deputy Chief are juggling a lot of
8 different priorities. They don't always get to
9 things right away, so sometimes some things drag
10 on longer than we would like.

11 JUDGE NIEDRICK: We heard some testimony
12 that the Federal Circuit -- or at least there was
13 this impression -- that the Federal Circuit was
14 concerned with timeliness issues on cases that
15 they were remanding or vacating sent back for
16 another look, and that was something that PTAB
17 management was aware of. Is that accurate?

18 THE WITNESS: That is accurate, and we
19 put in place another standard operating procedure
20 for Federal Circuit remands that sets some goals
21 or targets for timely remands -- the new goal was
22 6 months from the time a mandate issues. Now I

1 have to say, we have not always met that, and we
2 still have occasionally some cases due to various
3 reasons that have still lingered about two years
4 after remand. So this case is not unique, it's
5 not the longest, it's not the oldest case on
6 remand -- it does happen from time to time for
7 various reasons.

8 JUDGE NIEDRICK: So let me just kind of
9 understand it and see if I can get the timing
10 right. With Aqua Products comes out by the
11 Federal Circuit some time in 2017 maybe?

12 THE WITNESS: Aqua Products. Uh-huh.

13 JUDGE NIEDRICK: You all still work on
14 the Nike case -- the decision in Nike -- for like
15 another 5 months or so. And then we get to March
16 of 2018. You haven't unexpanded it, even though
17 Aqua Products came out, and there is this sort of
18 dispute going on between Judge Fitzpatrick and
19 Judge Ruschke, and these conditions that Judge
20 Fitzpatrick is putting on things with regard to
21 his different opinion, but the decision had
22 already been written by all of you, I assume. All

1 of you had looked at it and you had drafted an
2 opinion and it's ready to go in March of 2018, why
3 not just issue the decision and take Judge
4 Fitzpatrick off at that point? I mean you had a
5 panel -- you had a decision -- why delay it more,
6 especially when you know that the Federal Circuit
7 is concerned about these types of delays. Why go
8 to the trouble of having -- spending all of these
9 resources, everybody looking at this thing,
10 putting the time in -- and then not issuing it for
11 another 6 months after that?

12 THE WITNESS: I don't recall the precise
13 deliberations, I just know that -- I mean, I think
14 it may have just more come down to, you know, the
15 time that we had to give to it, it took a while to
16 get around to looking at it and coming to focus
17 our attention on it.

18 JUDGE NIEDRICK: Okay. Alright. I
19 don't think. Was Judge Fitzpatrick removed from
20 the Nike decision because of his concurrence -- in
21 that draft concurrence that he wrote -- or the
22 decision is concurrent --

1 THE WITNESS: No, it was due to the
2 insubordinate conduct he was taken off all AIA
3 cases of which Nike happened to be one of the ones
4 he was still on.

5 JUDGE NIEDRICK: Wouldn't it have been a
6 more appropriate and efficient way to deal with it
7 is to leave him on -- he had spent all this time
8 -- he was on the original panel the first time it
9 went up to the circuit. He comes back, he spends
10 all the time to go through all of this work, and I
11 understand the issue with the insubordination, but
12 nevertheless, I don't understand the flipside if
13 all the cases are the same -- how the
14 insubordination issue is okay in one case but not
15 another if they are all equal. But why not just
16 leave him on that panel, address that specific
17 issue, and let him issue the decision. Why take
18 him off that panel? You know, Judge Weidenfeller
19 talked about that there is a variety of dockets --
20 some dockets have all the IPR cases, or AIA cases,
21 some have a mixed batch with the ex parte __NA,
22 and others have just the ex parte. Why not just

1 leave him on those panels that he had worked on --
2 that the Agency had expended resources on -- and
3 let him finish those out. Why take him off of
4 those.

5 THE WITNESS: You know, that was a
6 decision that Judge Weidenfeller thought was best,
7 and I thought his decision was reasonable in light
8 of that conduct -- that we didn't know what else
9 might come. I will say though -- and I am not
10 sure how I can explain this better -- but the type
11 of conduct that concerned us in the AIA cases was
12 on a point of procedure that just is unique to AIA
13 cases, it doesn't arise in ex parte, and that's
14 why putting someone on ex parte cases would ensure
15 that they are not going to be disturbed by having
16 to address that policy again because it just
17 doesn't come up.

18 JUDGE NIEDRICK: And this is the SAS,
19 the issue with the SAS?

20 THE WITNESS: This SAS. Yes, that's
21 unique to AIA cases -- it is never part of an ex
22 parte case.

1 JUDGE NIEDRICK: Okay. Did you
2 understand with regard to his insubordination did
3 you understand Judge Weidenfeller had determined
4 that Judge Fitzpatrick had failed to comply with
5 the written policy that the PTAB had issued or the
6 Director had issued.

7 THE WITNESS: Yes, I understood that
8 Judge Weidenfeller concluded he failed to follow,
9 I believe written policy or at least the policy of
10 the Director.

11 JUDGE NIEDRICK: Right.

12 THE WITNESS: As explained by Judge
13 Weidenfeller.

14 JUDGE NIEDRICK: Because it seemed like
15 during that conversation there is two different
16 versions of what the policy is -- there is the
17 version that was transparent to all of the
18 litigants which was published on the website --
19 and then there was this other policy that was
20 internal and apparently not transparent to anyone
21 -- and that is where the sort of discrepancy
22 arose. Did you understand that nuance when Judge

1 Weidenfeller was taking the action?

2 THE WITNESS: Well, I understood that
3 the Director's policy was to have Folsom
4 decisions. Like I say, I don't know that I could
5 point to if it was written or where it was
6 written, but I do know -- because I had heard the
7 Director communicate that to us in the various
8 meetings that we had that that was his policy.

9 JUDGE NIEDRICK: I understand. Alright,
10 thank you very much. Mr. Horrigan, are you good
11 to go, do you need a break?

12 MR. HERRIGAN: I just need a few
13 minutes.

14 JUDGE NIEDRICK: Sure.

15 MR. HERRIGAN: Okay.

16 JUDGE NIEDRICK: Okay, Judge Boalick,
17 are you good to go?

18 THE WITNESS: Yes, I'm good to go.

19 REDIRECT EXAMINATION

20 BY MR. HERRIGAN:

21 Q Okay, I won't be long. So the
22 Administrative Judge was asking you about the

1 delay from like March though I think September
2 when the decision was issued, do you remember
3 that?

4 A Yes.

5 Q Okay. When did Mr. Iancu take over as
6 Director?

7 A I believe he was confirmed in I thought
8 February of 2018.

9 Q And Mr. Iancu came on Board, what did
10 you understand your responsibility was to keep him
11 apprised of what was going on?

12 A Well, we tried to apprise him of all of
13 these significant cases at the Board -- that was
14 something that either in the weekly meetings or
15 meetings between the Chief Judge and the Director
16 that they would discuss.

17 Q Would you say Mr. Iancu was a hands-on
18 guy or not?

19 A Very hands-on, yes.

20 Q And to what extent Mr. Iancu was
21 concerned about how the Nike decision would
22 ultimately play out in light of Aqua Products?

1 A Well, I think that he wanted to make
2 sure that we would follow Aqua Products and that
3 the decision be consistent with it. I was going
4 to say -- as I mentioned though -- because the
5 precedential decision was out there, I don't know
6 that he saw a need for the Board to be making it's
7 own precedent in that area.

8 Q Did Mr. Iancu play any role in the
9 de-designation of Idol Free and the other cases
10 that had been discussed?

11 A Yes, the Director is the one who
12 de-designates, who ultimately is the authority to
13 de-designate precedential cases.

14 Q Even under the (inaudible)

15 A Yes.

16 Q Did that factor in in any in the
17 schedule?

18 A Well, I believe, yes. We wanted to
19 de-designate those cases before we were to issue
20 new cases because otherwise it would look odd that
21 maybe we are going against our own precedent.
22 There was also some questions on remand about Idol

1 Free itself, and so there were some different
2 views as to well Idol Free should still be
3 addressed even though it had been de-designated,
4 it was no longer even truly informative on the
5 point.

6 Q Mr. Suarez insinuated that there was
7 some connection between the de-designation of Idol
8 Free and removing Judge Fitzpatrick from the AIA
9 cases. Do you even see any logical connection
10 between the two?

11 A I don't.

12 Q Are you aware of any connection between
13 those two things?

14 A I'm sorry. I'm not aware of a
15 connection between de- designation of Idol Free
16 and Judge Fitzpatrick removal from AIA cases.

17 Q Okay. And Mr. Suarez also insinuated
18 that there was a connection between the revision
19 to SOP1 and the ultimate decision in Nike,
20 correct?

21 A Yes.

22 Q Are you aware of any connection between

1 those two things?

2 A I'm not aware of a connection, it's just
3 that all of these things were happening at about
4 the same time.

5 Q Now, you realize that at some point you
6 said that the SOP1 was changed well after the Nike
7 decision.

8 A Okay, so what I meant -- well after --
9 well after the initial expansion of Nike. Nike --
10 because of it's long pendency, I guess I should
11 try to clarify that because what I meant is when
12 Nike was initially expanded that was long before
13 the 2018 change to SOP1. Even though Nike -- and
14 I can see how that might be confusing because Nike
15 was still pending until almost that point. I
16 meant way back at the beginning point of Nike,
17 when I was talking about that.

18 Q Okay. And when you were talking about
19 that, did you have a clear understanding at that
20 point of when the revision came out?

21 A To tell you the truth, I had forgotten
22 exactly when that came out. I knew it was 2018,

1 but I just didn't have the formal timeline in
2 mind.

3 Q Great, thank you. That's all I have.

4 A Thank you.

5 RECROSS EXAMINATION

6 BY MR. SUAREZ:

7 Q Okay, I have a few things based on both
8 yours and his. First off, Judge Niedrick asked
9 you about law that relates to the due process
10 issue. Would you agree that the Fifth Amendment
11 to the U.S. Constitution is a law that implicates
12 due process, correct?

13 A Yes.

14 Q Okay. You also were asked about how
15 individual judges had discussed misgivings about
16 the due process concerns. So when this case does
17 eventually become public record and the Federal
18 Circuit judges and the Supreme Court judges are
19 made aware of that, you would agree that some of
20 them are going to have concerns about what
21 happened in the Nike case in terms of the panel
22 expansion and de-expansion, right?

1 A Again, I don't know that they would
2 because ultimately, thought expanded influence
3 remained -- when the case issued -- it was 3
4 judges, so I don't know that they would have that
5 same concern as if an expanded panel decision
6 would have issued. I think that would have been
7 more concerning. From my understanding of their
8 concerns, that would have been more concerning to
9 them than an expansion and an unexpansion
10 happening because ultimately -- as I mentioned --
11 that the decision that was issued was the decision
12 of the 3 judges whose name appeared on the
13 decision. So, I --

14 Q And you agreed that the Federal Circuit
15 was concerned about the delay, right?

16 A So their concerned about delay. The
17 don't like it. We don't necessarily like it
18 either but sometimes things are harder to avoid,
19 and there are cases we have that are delayed, and
20 we are not happy about it, but it does happen from
21 time to time.

22 Q So understanding both that you're under

1 oath and that your testimony in this case will
2 likely be in a brief before the Federal Circuit at
3 some point, you do not believe that any judges of
4 the Federal Circuit are going to be troubled by
5 what has happened in the Nike case in terms of the
6 panel expansion and the de-expansion.

7 A You know, it's hard to get inside their
8 heads. I mean, it's conceivable that judges might
9 be troubled, but my understanding that the thing
10 that troubles them is the addition of extra panel
11 members who might be predisposed to vote a certain
12 way. That was my understanding of the thing that
13 troubled them. For example, there was a judge who
14 expressed concern about the Director adding judges
15 who might be predisposed to vote a certain way.
16 That's the thing that I thought was troubling to
17 them. When that ultimately doesn't happen, if 2
18 judges are added and 2 judges are subtracted --
19 the same 2 judges -- I don't know that the same
20 concern, you know, arises. I can't guarantee you
21 that they won't have that concern. Again, it is
22 just my understanding their concern was that

1 people were added to a case who might be
2 predisposed to vote a certain way and that was
3 what troubled them.

4 Q So as the current Chief Judge of the
5 PTAB, is it your testimony that you have never
6 been worried or concerned about how the Federal
7 Circuit reacts when this fact patten that happened
8 in this case -- with the panel expansion
9 de-expansion goes public and goes before the
10 Federal Circuit -- is that your testimony.

11 A I think they will understand what
12 happened -- that an expansion happened, it
13 de-expanded, and that ultimately 3 judges booked
14 here on the case cited the case.

15 Q Okay, we will see what happens. So, you
16 briefly discussed in your answer to the judge that
17 how Administrative Judges are different from ALJs
18 because they have performance assessment plans.
19 Do you recall that?

20 A Yes.

21 Q Does the PTAB have a performance
22 improvement plan process?

1 A We do.

2 Q So in lieu of immediate discipline,
3 there are procedures in the PTAB that allow
4 individuals to be counseled to improve their
5 performance before an adverse action is taken, is
6 that correct?

7 A That is when the problem is
8 performance-based -- when it is conduct based,
9 such as refusal to follow the direction of a
10 supervisor -- that is not addressed under a
11 performance improvement plan. That's generally
12 handled differently.

13 Q You understand that Judge Weidenfeller
14 read standard 3 about interpersonal interactions
15 to the judge, and that was the premise of his
16 action, correct?

17 A So sometimes the same action can
18 implicate both conduct and performance.

19 Q I see, so your view is there should
20 never have been a Performance Improvement Plan at
21 a minimum, it was appropriate because it was
22 conduct, and just immediately demote him.

1 A Well, again, I take issue with demotion.
2 I don't call that a demotion. But there are a
3 range of possibilities, but again here, because of
4 the conduct, I thought the action was appropriate
5 rather than go through the Performance Improvement
6 Plan process. Again, sometimes the same action
7 can trigger concerns of conduct and performance
8 because of what is in the performance plan.

9 Q Now you understand that 4 years have
10 transpired since the action was taken and viewed
11 by Judge Weidenfeller, correct?

12 A I didn't catch the last part -- 4 years
13 transpired since --

14 Q Four years had transpired since the
15 Judge Fitzpatrick was reassigned to the ex parte
16 appeal, correct?

17 A Yes, that's about right.

18 Q And as the Chief Judge who is now the
19 chief, you think it is appropriate to have left
20 him in that position for 4 years and counting,
21 correct?

22 A I think he is doing a fine job right

1 now, yes.

2 Q Okay. So even if he does not
3 appropriate for him to be there, you are fine with
4 him remaining there indefinitely based on conduct
5 in your words that occurred in one particular
6 month during his 7 or 8-year tenure at the PTAB.

7 A I'm not saying that. I'm not saying he
8 would never reassigned. I don't think anybody has
9 ever said he would never be reassigned. It is
10 always the possibility that a judge can have their
11 docket reassigned. Because if -- maybe the
12 problem is I am not getting confident that he
13 would follow Agency policy if he doesn't agree
14 with that policy. I still have that lingering
15 concern.

16 Q Sorry, can you just hold on one second.
17 I think we may have lost our back-up.

18 Okay, great. So you also testified in
19 the questions from the judge your interaction with
20 Judge Ruschke relating to the oil states issue and
21 how you escalated that issue, right?

22 A Yes.

1 Q I believe you testified on direct that
2 Judge Ruschke disagreed with you about escalating
3 that issue, is that right?

4 A No, I don't believe I said that. If I
5 did, that's mistaken. I don't think he disagreed
6 with me about escalating it. I don't recall him
7 disagreeing.

8 Q So then he did think it was a reasonable
9 thing to run that up the flagpole?

10 A I think perhaps -- again, you would have
11 to ask him, but my impression was like myself, we
12 wanted to make extra sure that nobody would be
13 able to accuse the Solicitor General of hyping
14 something from the Supreme Court. Again, we
15 didn't think that was the case, but it is a
16 serious enough allegation that we wanted to raise
17 it.

18 Q Okay, great. And I just have a couple
19 questions about SAS and Aqua Products and we will
20 wrap it up. First on the SAS issue. The SAS
21 issue was not an issue in the Nike case, correct?

22 A Yes, that's correct.

1 Q And Nike was already instituted so there
2 was no danger of Fitzpatrick not following SAS
3 guidance in that, correct?

4 A That is right.

5 Q Yet he was removed from the panel, is
6 that correct?

7 A That is right.

8 Q And with regard to Aqua Products, that
9 case was decided by the Federal Circuit on October
10 4, 2017, right?

11 A Yes.

12 Q And it took the PTAB about a year --
13 until September 18 of 2018 -- to issue a decision
14 after Aqua Products, right?

15 A Yes.

16 Q And are you aware that the members of
17 the original panel indicated to the expanded panel
18 that Aqua Products actually had no effect on their
19 decision in Nike?

20 A I believe that they said that, but we
21 thought it was an important case -- again, because
22 of the burden shift -- that it needed, you know,

1 that it was an important enough issue to wait.

2 Q Right, but a majority of the expanded
3 panel did not think that Aqua Products had any
4 relevance in the issuance of the decision, right?

5 A I don't know if it was a majority, but I
6 know the members of the original of the original
7 panel didn't believe that.

8 Q Right. And as you testified on cross
9 with regard to resignation of precedence, the
10 Director and the Chief Judge are the ones who have
11 primary responsibility going back during this
12 timeframe, right?

13 A Yes, over designating and
14 de-designating.

15 Q Not you, right?

16 A No.

17 Q And they designated these precedence --
18 the 3 that were in your order, 2 days after Judge
19 Fitzpatrick was taken off his panels, correct?

20 A Yes.

21 Q And so you also testified with regard to
22 SOPs that the Chief Judge and the Director are

1 ones who had plenary authority to determine the
2 timing of when those SOPs would be changed,
3 correct?

4 A That is right.

5 Q You're not involved in that, right?

6 A I mean other than -- I'm involved in
7 reviewing drafts of the SOPs -- as I said I can't
8 recall who was delegated to write up the drafts.
9 Draft SOPs just get circulated and commented on.
10 I have that role, but as far as when they actually
11 go into effect, when they are deemed to be finally
12 done, that's not something that is my decision.

13 Q Right. So they were in charge of the
14 date that the SOP revision 15 was issued to the
15 public, correct?

16 A That is right.

17 Q And that occurred just 3 days after you
18 issued your order relating to the change in the
19 composition of the panel and the justifications,
20 right?

21 A Right.

22 Q Hold on, I have one last question.

1 Let's see if I can find it. Oh, okay. It's Tab
2 7, 312. Actually it starts at 311.

3 A Okay.

4 Q Okay. So this is an email from Jim
5 Arpin to the members of the expanded panel from
6 October 6, 2017, correct?

7 A Yes, at the bottom of the page there is
8 one, yes.

9 Q This is a few days after Aqua Products
10 came out on (inaudible) on October 4 of 2017,
11 correct?

12 A Yes.

13 Q Judge Arpin says, Jackie -- to Judge
14 Bonilla -- I am Aqua ProductsG1, in cite here
15 201367, the mandate Nike on 201367 issued on April
16 4, 2016, 18 months ago, do you see that?

17 A Yes.

18 Q And he highlights 18 months ago because
19 of the concern about delay after the remand,
20 correct?

21 A That is right.

22 Q And then the panel members say: We are

1 not waiting on any action by the CFC in this
2 proceeding, the ball is and has been entirely in
3 our court, right?

4 A Okay, I see that.

5 Q And then he says, I am also the
6 authoring judge in the Aqua Products final written
7 decision. Right?

8 A Yes.

9 Q I firmly believe that the CFC's decision
10 on Aqua Products should have no effect on this
11 remand decision, no additional briefing is
12 necessary, and remand decision should be issued as
13 soon as possible. Do you see that?

14 A Yes.

15 Q And so Jim Arpin is saying that Aqua
16 Products has no effect on the issuance of Nike,
17 correct?

18 A He is saying that.

19 Q Okay. Let's scroll up to 310.

20 A Okay.

21 Q This is Jim Arpin again on October 10,
22 2017, 5:11 p.m., right?

1 A Right.

2 Q You're on the email, right?

3 A Yes.

4 Q It is, in fact, addressed to you and it
5 says, Scott, right?

6 A It says that.

7 Q So it says: Dear Scott, the 3 original
8 panel members now have conferred and we agree that
9 no further briefing appears necessary in Adidas v
10 Nike given the particular facts and circumstances
11 of the case. Do you see that?

12 A Yes.

13 Q So, this hopefully refreshes your
14 recollection. The 3 panel members originally on
15 the case did not believe Aqua Products had any
16 impact on the influence of their decision, right?

17 A They believe that, yes.

18 Q It has been proven the expanded panel, a
19 majority as of October 10, 2017, wanted to issue
20 the decision. Right?

21 A Right.

22 Q And the panel was changed, in fact,

1 further to make these 3 judges the minority,
2 right?

3 A Well, I don't know we are a minority, in
4 what sense? As to the ultimate issue? I am not
5 sure -- I don't think we were in the minority as
6 --

7 Q So, do the 2 Chief Judge and Deputy
8 Chief Judge have like super votes or extra votes
9 over the 3 other panelists on the expanded panel?

10 MR. HERRIGAN: Objection.

11 Argumentative.

12 JUDGE NIEDRICK: Sustained. Mr. Suarez,
13 can you ask your initial question again. I think
14 there is some clarification as to whether there
15 was actually a dissent.

16 BY MR. SUAREZ:

17 Q Yes. So, based on this email we
18 confirmed that the o_ any effect on the decision.

19 MR. HERRIGAN: Objection. Asked and
20 answered, and we are getting well beyond the scope
21 of cross and the Administrative Judge's own
22 questioning.

1 JUDGE NIEDRICK: Overruled. Please
2 answer.

3 THE WITNESS: So can you ask your
4 question again?

5 BY MR. SUAREZ:

6 Q Yes. So based on this email about the 3
7 original panel members conferring, you would agree
8 that there was no dissent amongst the original 3
9 panelists on the Nike panel as to the fact that
10 Aqua Products did not have an impact on the final
11 decision.

12 A That's what the email says. One thing
13 that was happening here, and I think it is also
14 contained in the email from then Vice Chief Judge
15 Bonilla, is that the Chief Judge had wanted to
16 have all panels with any Aqua Products issue
17 uniformly as a matter of procedure to reach out to
18 the parties to ask their views so we know that,
19 even though the original 3 judges didn't agree,
20 the parties might have something different to say
21 about it and may wish to provide briefing. A
22 concern that we would have is that if we were to

1 proceed and a concern was raised at the Federal
2 Circuit, it could cause a remand due to our
3 failure to get briefing from the parties. So that
4 was part of what was happening here, as I think
5 shows up in the email chain.

6 Q Understood. But independent of that
7 dispute, the 3 original panelists were of the view
8 that no further briefing was necessary because
9 Aqua Products did not have any impact on the
10 substantive outcome of the decision from their
11 perspective. Correct?

12 A Right.

13 Q No further questions.

14 JUDGE NIEDRICK: Okay, thank you. Judge
15 Boalick, one quick question. You had talked about
16 the sort of discipline and sort of counseling for
17 performance, and it seems to me that based on your
18 understanding of what happened in this case with
19 insubordination towards Judge Weidenfeller, that
20 you believe this was sort of disciplinary
21 counseling. Is that accurate?

22 THE WITNESS: Yes. Well I was

1 (inaudible) for a consequence of the insubordinate
2 conduct, though again, it could touch areas of
3 performance, but I don't believe Judge
4 Fitzpatrick's performance rating as far as I know
5 was not impacted by this.

6 JUDGE NIEDRICK: And was it your
7 understanding that when Judge Fitzpatrick was told
8 he was being assigned to the ex parte appeals that
9 he would be upset about that, he would consider
10 that a bad thing.

11 THE WITNESS: I am sure he wouldn't be
12 happy about it. So, yes, I think he would not
13 welcome it.

14 JUDGE NIEDRICK: And so would it fair to
15 say that he would view that as punishment?

16 THE WITNESS: I don't know if he would
17 view it as a punishment. I view it as more of a
18 way to try to make sure we didn't have any more
19 conduct of that sort. But he would not welcome
20 it. I know that was not his choice to go have an
21 ex parte docket.

22 JUDGE NIEDRICK: Okay, thank you. Mr.

1 Horrigan, any follow up on our questions?

2 MR. HARRIGAN: No, thanks.

3 JUDGE NIEDRICK: Thank you very much,
4 Judge Boalick, very much for your patience. I
5 know it's been a long run -- longer than I think
6 anybody expected, so I appreciate your testimony.
7 Please don't discuss it with anyone. If you have
8 any questions, please contact Mr. Horrigan. Okay?

9 THE WITNESS: Okay. I will. Thank you.

10 JUDGE NIEDRICK: Thank you. And you
11 just hit the leave button on there and that will
12 take you out.

13 THE WITNESS: Alright, I'm hitting that
14 now. Thanks. Have a good afternoon.

15 JUDGE NIEDRICK: You too. Okay, do we
16 have -- it looks like Judge Ruschke is still on
17 here.

18 JUDGE RUSCHKE: My thought is since we
19 are going to have to reconvene on Thursday anyway,
20 I suggest we just take him then. All of the
21 witnesses have said they are available.

22 JUDGE NIEDRICK: What are your thoughts,

1 Mr. Suarez, Mr. (inaudible)? Oops. Can I ask you
2 Mr. Horrigan how long you think it will be for
3 your direct. Is it going to be a similar
4 timeframe that we just had with Judge Boalick?

5 MR. HERRIGAN: Yes.

6 COURT REPORTER: I'm sorry. You said
7 yes?

8 MR. HERRIGAN: Yes, I did. I'm
9 wondering if we can get through his direct today.

10 MR. ABRAMIC: I don't really feel
11 comfortable having a direct and then having a huge
12 gap. I don't necessarily think that would be fair
13 to the Agency. I'm okay to pushing through if you
14 all are willing to do that. I mean, if we are
15 here until 8 or 9 that's okay with me. But again,
16 I don't want to step on anybody's toes if you have
17 other plans. I am fine with doing it on Thursday.
18 I think there is no doubt we would get done on
19 Thursday.

20 JUDGE NIEDRICK: Okay. So you both
21 agree if we do this on Thursday we're going to be
22 okay. Because we still have Fink, Tierney, and

1 Paulraj, in addition to Ruschke, and if Ruschke
2 goes as long as Judge Boalick who just went 5
3 hours.

4 MR. HERRIGAN: I won't speak for Chris,
5 but I guess I will ask him, I would anticipate
6 that Paulraj and Tierney will be very short.

7 MR. SUAREZ: Fairly short, yes.

8 JUDGE NIEDRICK: You agree with that Mr.
9 Herrigan?

10 MR. HERRIGAN: I would say, yes. I have
11 scheduled 20 minutes each one.

12 JUDGE NIEDRICK: Okay, and if that's the
13 case we can go on Thursday. And again, do you
14 anticipate, Mr. Abramic, at this point having
15 Judge Fitzpatrick follow up with some testimony?

16 MR. ABRAMIC: I believe so, I don't
17 think it would be likely.

18 JUDGE NIEDRICK: And if it is, I assume
19 it wouldn't be more than like an hour at most?

20 Ab: I think that's right.

21 JUDGE NIEDRICK: Okay. Then I think we
22 are good. So we will go ahead and adjourn for

1 today. Do you want me to bring Judge Ruschke in,
2 Mr. Horrigan, or do you want to email him?

3 MR. HERRIGAN: I can email him. If
4 you'd like to bring him in and express our
5 apologies that would be appropriate as well.

6 JUDGE NIEDRICK: Sure, let's do that.
7 Hi Judge Ruschke, this is Administrative Judge
8 Niedrick, can you hear me? If you can -- on the
9 bottom left hand corner you will see a little
10 microphone -- if you hover over that and click on
11 it, it will unmute you. Do you see that? Judge
12 Ruschke, can you hear me? I've asked him to
13 unmute -- there is a little button I can ask him,
14 but I don't know if he is able to.

15 MR. HERRIGAN: Well, I think you made a
16 good faith effort. I will certainly email him.

17 JUDGE NIEDRICK: Oh, there he goes. I
18 think he just figured it out. Judge Ruschke, can
19 you hear me? Can you raise your hand if you can
20 hear me? Oh, apparently he's not. There he is.
21 Judge Ruschke, can you hear me. This is Judge
22 Niedrick.

1 JUDGE RUSCHKE: Hey, sorry about that.

2 JUDGE NIEDRICK: No problem. I am sorry
3 about this. Unfortunately, you have waited all of
4 this time. I am very sorry, but we went a lot
5 long than we thought with our last witness, and so
6 what we are proposing to do is come back next
7 Thursday. I've been told that you are available,
8 is that right?

9 JUDGE RUSCHKE: That is correct.

10 JUDGE NIEDRICK: Okay. So, yes,
11 unfortunately, I hate to do this to you, but I
12 have to say hello and goodbye.

13 JUDGE RUSCHKE: It's okay, I understand.

14 JUDGE NIEDRICK: Okay, so we will see
15 you next Thursday. So if you can just hit that
16 leave button after waiting all of this time. Just
17 hit leave and we will see you first thing on
18 Thursday.

19 JUDGE RUSCHKE: I am just glad the video
20 connection worked. I wasn't sure if I was there
21 or not. So now know it works.

22 JUDGE NIEDRICK: Yes, it finally works.

1 JUDGE RUSCHKE: I'll hit leave and I'll
2 see you next week.

3 JUDGE NIEDRICK: Okay, thank you. Okay,
4 anything before we go off the record. Mr.
5 Horrigan, anything?

6 MR. HERRIGAN: Nothing.

7 JUDGE NIEDRICK: Okay, Mr. Abramic, Mr.
8 Kappers, Mr. Suarez, anything? Oh, it looks like
9 we lost Mr. Suarez. He's right there. Okay,
10 great.

11 JUDGE NIEDRICK: Mr. Fitzpatrick, any
12 questions, comments, anything. Are you good?

13 COURT REPORTER: Yes. I'm sorry about
14 my back-up, it conked out and I hope I didn't
15 interrupt anything. I caught everything else.

16 JUDGE NIEDRICK: Okay, great. Okay
17 thank you all very much. We will see you at 8:30.
18 I'll just issue a little order saying that will
19 reconvene at 8:30. It's going to be the same link
20 that we used for the last few days, and we should
21 be good to go. If anything changes or if anybody
22 has any questions in the interim, or if you want

1 to discuss settlement, always open to that.
2 Otherwise, I'll see you at 8:30. Thank you all.
3 Good night. We are off the record at 4:47 p.m.

4 (Whereupon, at 4:47 p.m., the
5 HEARING was continued.)

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1 CERTIFICATE OF NOTARY PUBLIC

2 I, Carleton J. Anderson, III do hereby
3 certify that the forgoing electronic file when
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15

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3 corrections thereof, on this errata sheet. Any
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UNITED STATES OF AMERICA
MERIT SYSTEMS PROTECTION BOARD
WASHINGTON REGIONAL OFFICE

MICHAEL FITZPATRICK v. U.S. DEPARTMENT OF COMMERCE

Case No. DC-1221-21-0423-W-1

HEARING (VOL. 3)

BEFORE:

ANDREW NIEDRICK
Administrative Law Judge

Alexandria, Virginia

Tuesday, May 24, 2022

1 PARTICIPANTS:

2 On behalf of Appellant:

3 JOHN L. ABRAMIC, ESQUIRE
4 ROBERT KAPPERS, ESQUIRE
5 Steptoe & Johnson LLP
6 227 West Monroe Street, Suite 4700
7 Chicago, Illinois 60606
8 (312) 577-1300

9 CHRISTOPHER A. SUAREZ, ESQUIRE
10 Steptoe & Johnson LLP
11 1330 Connecticut Avenue, NW.
12 Washington, D.C. 20036
13 (202) 429-8131

14 On behalf of Agency:

15 WILLIAM HORRIGAN, ESQUIRE
16 U.S. Patent and Trademark Office
17 U.S. Department of Commerce
18 600 Dulany Street
19 Alexandria, Virginia 22314
20 (571) 272-3000

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C O N T E N T S

WITNESS:	DIRECT	CROSS	REDIRECT	RECROSS
David Ruschke	7	136	247	
William Fink	256	296		
Christopher Paulraj	322	339		
Janet Gongola	393	400		
Michael Tierney	407	431		
Michael Fitzpatrick			449	

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1 P R O C E E D I N G S

2 (8:30 a.m.)

3 COURT REPORTER: We are on the record at
4 8:30 a.m.

5 JUDGE NIEDRICK: Good morning. This is
6 Administrative Judge Andrew Niedrick. Today's
7 date is May 24th, 2022, and it's approximately
8 8:31 a.m. Eastern Time.

9 The United States Merit Systems
10 Protection Board has before it the individual
11 right of action appeal, caption Michael
12 Fitzpatrick v. the Department of Commerce. The
13 MSPB Docket Number for the appeal is
14 DC-1221-21-0423-W-1.

15 This hearing is being conduct via Zoom
16 for government platform. The Appellant is present
17 along with his representatives of record, John
18 Abramic, Robert Kappers, and Christopher Suarez.
19 And Agency's representative of record, William
20 Horrigan, is also present for the hearing. The
21 Board's court reporter, Ms. Shandra Dawson, is
22 also on the line and she'll be making a digital

1 recording of the hearing.

2 This is the third day of hearing in this
3 case. The first two days were held on May 11th
4 and May 12th, and I heard from a total of five
5 witnesses on those two days. Today we're going to
6 pick up with the testimony of the Agency's next
7 witness, David Ruschke. And I'm going to go ahead
8 and admit Judge Ruschke into the hearing.

9 Hi, Judge Ruschke. This is
10 Administrative Judge Andrew Niedrick. Can you
11 hear me? If you look down at the corner there on
12 the left-hand bottom corner you'll see a little
13 microphone. If you could hover over that and
14 click it. There you go. Can you hear me okay?

15 THE WITNESS: Hello.

16 JUDGE NIEDRICK: Hello.

17 THE WITNESS: Yes.

18 JUDGE NIEDRICK: Welcome back.

19 Hopefully, today it's going to happen. I think
20 we're in good shape so far.

21 So, just to kind of give you an
22 understanding of who's on the call, Shandra

1 Morelli Dawson is on the line. She's our court
2 reporter. She also has a telephone backup line
3 and then also another one of those boxes as her
4 backup. I know you know Mr. Horrigan. And then
5 we have Mr. Kappers, Mr. Abramic, and Mr. Suarez.
6 They're Judge Fitzpatrick's attorneys. And then
7 Judge Fitzpatrick.

8 So, thank you very much for your
9 patience and we'll jump right into it. Do you
10 have any objection to swearing an oath?

11 THE WITNESS: No, I don't.

12 JUDGE NIEDRICK: Okay. Can you please
13 raise your right hand?

14 Whereupon,

15 DAVID RUSCHKE

16 was called as a witness and, having been first
17 duly sworn, was examined and testified as follows:

18 JUDGE NIEDRICK: If you could please
19 state and spell your first and last names for the
20 record.

21 THE WITNESS: David Ruschke, D-A-V-I-D
22 R-U-S-C-H- K-E.

1 JUDGE NIEDRICK: Thank you. And as we
2 go along, if there's an objection, please hold
3 your answer. I'll rule on the objection and then
4 instruct you on how to proceed. Okay?

5 THE WITNESS: Okay.

6 JUDGE NIEDRICK: Great. Mr. Horrigan,
7 your witness.

8 MR. HARRIGAN: Thank you.

9 DIRECT EXAMINATION

10 BY MR. HARRIGAN:

11 Q All right, sir. Thank you for joining
12 us this morning. What is your current position?

13 A Director of the Central Reexamination
14 Unit at the United States Patent and Trademark
15 Office.

16 Q And what is the Central Reexamination
17 Unit?

18 A The Central Reexamination Unit is a
19 group of approximately 100 USPTO employees who
20 handle a number of different post-grant
21 proceedings within the Patents Business Unit
22 organization, including ex parte reexamination,

1 inter partes reexamination, reissue applications,
2 and supplemental applications.

3 Q How long have you been with the USPTO?

4 A Since May of 2016.

5 Q Does your experience include clerking
6 for a federal judge?

7 A Yes, it does.

8 Q And who was that?

9 A I clerked for two. The first one was
10 Glenn L. Archer, Jr., who at the time was the
11 chief judge of the Court of Appeals for the
12 Federal Circuit. And then subsequent to that
13 clerkship I clerked with Arthur J. Gajarsa,
14 G-A-J-A-R- S-A. He was a circuit judge at the
15 Court of Appeals for the Federal Circuit.

16 Q Okay. And while you were at the Federal
17 Circuit did you have involvement with intellectual
18 property issues?

19 A Yes. All the appeals that came from the
20 District Courts as well as from the USPTO went to
21 the Federal Circuit.

22 Q After clerking what did you do?

1 A After clerking I went to Covington &
2 Burling in Washington, D.C.

3 Q And what area did you practice with
4 them?

5 A That was almost exclusively intellectual
6 property law, both litigation and due diligence
7 for corporate acquisitions, as well as patent
8 prosecution.

9 Q How long were you with them?

10 A Just under four years.

11 Q And after you left Covington & Burling
12 what did you do?

13 A I went to be in-house counsel at
14 Medtronic, Inc., in Minneapolis, Minnesota.

15 Q And what did you specialize in there?

16 A That was contract law, but primarily
17 intellectual property law, overseeing a great deal
18 of patent prosecution, essentially in charge of
19 their central R&D group, which was about 100, 150
20 scientists and engineers.

21 Q And how long were you with Medtronic?

22 A I was with the Minneapolis group for

1 about two and a half years, and then I was
2 promoted to be the chief patent counsel of
3 Medtronic Cardiovascular in Santa Rosa,
4 California.

5 Q And how long were you in that position?

6 A I was in the Cardiovascular chief patent
7 counsel role from 2006 until 2016.

8 Q And you served for a time as the chief
9 administrative patent judge here at the USPTO,
10 correct?

11 A I did.

12 Q When was that?

13 A May 2016 to September 2018.

14 Q And how did you become the chief
15 administrative patent judge?

16 A I applied through USA Jobs.

17 Q Okay. And who appointed you?

18 A I was hired by former Undersecretary
19 Michelle Lee.

20 Q You are an attorney, is that right?

21 A Yes, I am.

22 Q How many years have you practiced in the

1 field of intellectual property?

2 A I've -- I started practicing even before
3 I was an attorney, when I was a patent agent. And
4 that would have been essentially two years, '93 to
5 '95. And then I became an agent in '95 to '97.
6 And then I became an attorney in '97. So, since
7 1993 essentially.

8 Q Okay. So, are you familiar with the
9 hiring of administrative patent judges?

10 A Yes, I am.

11 Q As chief judge were you involved in that
12 process?

13 A I was.

14 Q And then who was the decision maker on
15 who hired APJs while you were there?

16 A Ultimately it would -- we went through
17 the interview process within the PTAB, but then
18 the decisions on who to hire were made by the
19 director of the USPTO, the undersecretary.

20 Q Okay. And then the Secretary of
21 Commerce had to approve them, correct?

22 A Sign off, yes, exactly.

1 Q Okay. To your understanding, are APJs
2 subject to the direction and control of the
3 director of USPTO?

4 A Yes, they are.

5 Q When you were chief judge were APJs
6 subject to your direction?

7 A Yes.

8 Q Did the PTAB employ attorneys who were
9 not APJs?

10 A Yes.

11 Q And what did they do?

12 A There were -- we had patent attorneys
13 who helped out the APJs by drafting draft
14 opinions, usually in the ex parte appeals realm,
15 as well as just any other projects that we had
16 them directed to do at any given point in time.

17 Q Were APJs managed differently than the
18 other attorneys in the PTAB?

19 A Managed differently. They may have had
20 a different PAP, a -- you know, their Performance
21 Appraisal Program. But generally, they were all
22 subject to the same sort of lines of authority

1 within the PTAB.

2 Q And were they all subject to the same
3 disciplinary procedures as other USPTO employees?

4 A Yes, they were.

5 Q And were they all subject to Human
6 Resources policies like other USPTO employees?

7 A Yes, everyone was.

8 Q And are APJs expected to comply with
9 instructions from their supervisors like other
10 USPTO employees?

11 A Yes, every -- yes, they are.

12 Q All right. With that context then,
13 you're familiar with the phrase "judicial
14 independence," correct?

15 A Yes, I am.

16 Q And what does that phrase mean to you in
17 this context of an APJ?

18 A In the context of an APJ, judicial
19 independence, particularly during the term that I
20 was up there, we tried to allow the APJs to have
21 as much independence as possible, meaning that
22 they would be able to independently determine the

1 merits of cases primarily. Because we always
2 viewed that APJs were hired for their technical
3 expertise and their independence and, you know,
4 essentially their independent knowledge of the
5 technology was paramount in deciding a lot of the
6 validity and invalidity cases that came before us.

7 But there was definitely a distinction
8 between judicial independence that one would
9 normally think of with, let's say, Article III
10 judges that were appointed in the United States
11 Federal Court system. That was a very different
12 type of judicial independence because obviously
13 the APJs were not appointed in the same way.

14 Q Okay. Are APJs free to ignore statutory
15 law when writing their decisions?

16 A Ignore? No, they're not.

17 Q Are they required to follow Supreme
18 Court precedent?

19 A Yes, they are.

20 Q Do you they have to follow precedent
21 from the Federal Circuit?

22 A Yes, they do.

1 Q And to what extent does the director of
2 the USPTO provide similar direction for an APJ?

3 A The director provides a lot of direction
4 to the APJs in terms of the policy on, you know,
5 essentially statutory interpretation, rule
6 interpretation, case law interpretation from the
7 Supreme Court as well as the Federal Circuit.

8 Q And how might the director go about
9 providing that guidance to an APJ?

10 A A lot of the guidance that came down
11 from the undersecretary was, frankly, done via
12 verbal communications frequently that we had. We
13 had weekly meetings with the undersecretary, at
14 least weekly meetings, if not more frequently,
15 frankly. We were definitely talking with not only
16 the undersecretary, but the various other -- you
17 know, business units within the USPTO.

18 The director also would occasionally
19 issue written guidance in the form of essentially
20 a letter directed at the PTAB. And so that one --
21 that actually -- an example of that just happened
22 a year or so ago, not even maybe a year ago, on

1 applicant-admitted prior art. And so that just
2 came down as an official memo from the
3 undersecretary.

4 Another way that the undersecretary
5 would provide guidance is to issue Notices of
6 Proposed Rulemaking, asking -- or Request for
7 Comment, so asking for stakeholder feedback. And
8 then ultimately issuing a final rule in which
9 certain policy matters were adopted.

10 Another way that the undersecretary
11 frequently issued policy determinations were the
12 briefings that the Solicitor's Office would file
13 at the Federal Circuit. So, that was another
14 great way of figuring out where the
15 undersecretary's policy lies. And that took a
16 little bit more digging, of course, because not
17 every single issue would be going through the
18 Solicitor's Office.

19 And then one of the great areas of
20 policy that we had were precedential and
21 informative opinions written by the PTAB judges
22 themselves. Those provide -- those were

1 essentially made precedential and informative by
2 virtue of the undersecretary. And that was a
3 great source of information as to which policy
4 direction the undersecretary was moving in.

5 Q Okay. So, just to clarify a couple of
6 points. First you say the undersecretary. What
7 you mean is the undersecretary of the Department
8 of Commerce for Intellectual Property, which is
9 also the director of the USPTO, correct?

10 A Yeah, sorry. Yes. If you want me to
11 use a certain term, I will, but I would refer to
12 them as usually the director or the
13 undersecretary. It's the same person.

14 Q Okay. And when you said early in your
15 statement there that we had weekly meetings with
16 the director, who's "we"?

17 A "We" would have been the management of
18 the PTAB, so that would have been myself as chief
19 judge, deputy chief judge, the four or five vice
20 chief judges, and then any other folks that we
21 needed to have specifically on a topic, they would
22 come to the weekly meetings.

1 Q And so how would this guidance from the
2 director get to an individual APJ?

3 A Occasionally, it would be -- well, it
4 certainly would be raised at meetings that we had
5 with -- we had also weekly meetings with the lead
6 judges. There were about 20 to 25 lead APJs. And
7 then we would also have meetings with the entire
8 corps of APJs. And so we would often give
9 guidance coming through that means, those meetings
10 that we would have, teleconference, video
11 conferences that we would have. And then, of
12 course, if something was made -- if a case were
13 made precedential or informative, that would also
14 then be discussed and that would be made known, of
15 course, to the APJs as well.

16 And then occasionally, we would also
17 have guidance that came down from myself.
18 Similarly to the undersecretary giving the PTAB
19 guidance, then I would give guidance to -- written
20 guidance, that is, to the APJs.

21 Q And so when this guidance was conveyed
22 to the APJs was it commonly verbal or was it in

1 writing?

2 A It was both. It was both. I'm not sure
3 of the division between the two. A lot of the
4 business carried on at the USPTO, certainly at the
5 higher levels, was done all verbally.

6 Q Okay. And did you have any concerns
7 about that at the time?

8 A Well, you know, I would prefer to have a
9 lot more written guidance. And there were
10 certainly voices out there that said nothing other
11 short of official notice and comment rulemaking
12 can provide guidance. You know, and then, you
13 know, the difficulty we always had was even a
14 Supreme Court case coming down might not answer
15 all the questions that were intended to be
16 answered and would be subject to further
17 interpretation. So, even a Supreme Court case
18 that everybody was required to follow might
19 require follow-up guidance, if you will, from the
20 undersecretary or from the management of PTAB.

21 Q Okay. You said some people insisted
22 that things be in writing?

1 A Yes, some did, yeah.

2 Q What was your view on that?

3 A That we -- I wish we could put a -- as
4 much as we can in writing and we tried to do that
5 as much as we possibly could. But some things
6 were just -- you know, if there wasn't an official
7 guidance document, we typically did not send out
8 -- at least I didn't send out emails as a general
9 rule to the entire PTAB and to the APJs.

10 Ideally, it would have been nice to have
11 everything in writing, then people can refer to
12 it. That's one (phonetic) something that I wish
13 we could have done more of. And I think we did
14 actually move in that direction over the two, two
15 and a half years that I was there towards giving
16 the judges things to cite in their case, so that
17 they would have something that they could cite to.

18 Q Okay. Now, we spent a lot of time
19 talking about the director's guidance. How about
20 the guidance from the chief judge? Was there such
21 a thing at the time?

22 A Yes. As I mentioned, there was, you

1 know, many meetings that we would have where we
2 would discuss issues that had come down that we
3 were discussing, how we were going to implementing
4 them, for instance. A lot of that guidance came
5 down verbally. But, again, we also issued written
6 guidance in the form of memos that would come from
7 the chief judge or sometimes from the deputy chief
8 judge.

9 And one of the sources that we were
10 trying to work through and we changed a lot of
11 that and it was an ongoing process for the entire
12 time that I was chief judge were how cases were
13 made precedential and informative. And these were
14 PTAB cases directly.

15 So, if a case was made precedential,
16 that provided a lot of -- obviously, the judges
17 and the APJs had to follow that precedent.
18 Similarly, informative cases, although not
19 necessarily binding on the APJs as the
20 precedential cases were, any cases that were made
21 informative would be viewed and were essentially
22 looked at as being that is the direction and it

1 essentially embodies in written form a certain
2 policy of the USPTO.

3 Q Okay. And with all that then, the
4 guidance from the director, guidance from you at
5 the time, again, to the issue of judicial
6 independence, how did all that play in as far as
7 you were concerned at the time?

8 A Well, ultimately, the judicial
9 independence of the APJs was, again, I always felt
10 in the form of focusing on the technology. Then
11 they were able to decide independently the merits
12 of the cases. But if there were, for instance, a
13 procedural issue or a form of statutory
14 interpretation of interpretation of a new rule or
15 a recent rule, that had to be looked at by means
16 of these various policy determinations that were
17 coming down from the undersecretary.

18 Q Okay. That was helpful. Why don't you
19 just tease out just a little bit what you mean
20 when you "merits"?

21 A Oh, okay. So, the primary focus of the
22 APJs were to determine whether claims of an issued

1 patent, and these are -- we're talking about AIA,
2 which is the, excuse me, the law that was passed
3 back in 2011 that essentially formed this group of
4 APJs to handle these post-grant proceedings and
5 particularly IPRs. And what the merits of the
6 cases were, were essentially whether the claims
7 were valid or invalid claims. And this is after
8 they had been issued by the Patent side of the
9 USPTO. So, it was a review post-grant.

10 And on the merits it looked at the prior
11 art. So, the references, the other patents, the
12 non-patent literature, prior uses, things like
13 that, all issues that were raised by a third-party
14 petitioner if that third-party petitioner felt
15 that certain claims had been issued incorrectly.
16 And then the patent owner would respond in kind.

17 And that is separate and apart from a
18 lot of the procedural issues. Because remember at
19 this time, the PTAB was still fairly new in
20 dealing with the AIA, which was enacted in 2011.
21 And so there were still a lot of procedural
22 glitches and issues to play out as the rules and

1 statutes and the case law developed.

2 Q Okay. Before we get to that, let me ask
3 you, let's say an administrative patent judge is
4 unclear or has doubts about what they've heard
5 about what the director may have said or what you
6 may have said. What might they do about that?

7 A We had created a hierarchy, so each APJ
8 was a part of a group typically based on
9 technology. Again, because that was the paramount
10 thing that the judges should be deciding on. And
11 then that group of judges maybe between -- I'm
12 going to -- I can't remember the number, but it
13 was somewhere maybe around 10 to 15 per group had
14 a lead judge. And the lead judge then -- well,
15 there were about 20 to 25 lead judges. And each
16 one of those, there was a group of lead judges
17 then that reported into vice chief judges, and we
18 had four operational vice chief judges. And then
19 the deputy chief judge also was sort of the main
20 person in charge of the general operations and the
21 PTAB. And they could also, of course, come to me.
22 So, there were definitely different levels that

1 they could go through directly in their line of
2 authority, if you will, and supervision.

3 There was also just a number of senior
4 judges that had been on the Board prior to the
5 formation of the AIA. And these are judges that
6 had been on the Board for 20, 30 years. And so
7 there were informal avenues as well to decide if
8 there were some issues that were coming up that
9 needed to have further resolution.

10 And then there were certainly -- we
11 worked with the Solicitor's Office, for instance,
12 on issues as well. So, if there were things that
13 overlapped between the PTAB and issues that were
14 going up to the Federal Circuit or that were being
15 briefed, we made sure that we were going to be
16 copacetic and working hand-in-hand with the
17 Solicitor's Office so the office would be speaking
18 with one voice in front of the Federal Circuit.

19 Q And you mentioned that there were
20 meetings with the APJs. You held meetings with
21 the APJs, is that right?

22 A Yes, we did.

1 Q And how often would that be?

2 A I feel -- I think they were -- they were
3 certainly whenever there was a big issue that came
4 down. For instance, when we had a Supreme Court
5 case that came down, then we would have a meeting,
6 a subsequent meeting, at some point to discuss the
7 effect of that Supreme Court case. And that would
8 -- it would describe the holdings; we might
9 describe any outstanding issues, things that we're
10 working on with either the Solicitor's Office or
11 with the undersecretary to hash through, things
12 that we should be holding off on deciding, that
13 there was still some uncertainty even based on a
14 Supreme Court case; Federal Circuit cases also
15 that came down that were important, that were
16 precedential.

17 And then, of course, we also involved
18 all of the judges in deciding at the time what
19 cases were going to be precedential. And we did
20 that by majority vote of all the APJs. And when a
21 case was made precedential, then we would have a
22 seminar after that to describe what the effect of

1 making of that case informative or precedential
2 was.

3 Q At these meetings that you mentioned,
4 were APJs able to ask for clarification on issues?

5 A Oh, yes, absolutely. It was a very open
6 conversation.

7 Q Did, in fact, people ask you for
8 clarification on a matter?

9 A Yes, they would.

10 Q Okay. Now, you mentioned the AIA. You
11 said it came into effect in 2011, correct?

12 A Yes.

13 Q Okay. And so prior to 2011, there was
14 no infrastructure for AIA cases, right?

15 A No, because they didn't exist.

16 Q Okay. And so how did they become
17 formed?

18 A Really from scratch. Right after the
19 statute was passed, I believe the administration
20 at that time, that would have been the
21 commissioner -- or the commissioner, the
22 undersecretary was Dave Kappos, and I think

1 Congress gave the PTAB -- the USPTO essentially a
2 year to put in place formal rules implementing the
3 statute.

4 Q Now, at the time you were chief judge to
5 what extent were you still building that
6 infrastructure?

7 A Oh, very much so. There were a number
8 of issues that we had identified that needed
9 resolution and that, frankly, were being handled
10 differently by different panels at the PTAB. Most
11 of it -- again, these are things of statutory or
12 rule interpretation or just, frankly, policy that
13 hadn't been formally decided yet or, frankly,
14 changed. Because certain policies, of course,
15 would change over time.

16 You had a number of folks that were in
17 either the undersecretary role or the acting
18 undersecretary role that had different
19 perspectives on the policy, and so those would
20 change over time. So, even though they might not
21 be embodied in any of the formal written guidance,
22 there would essentially be guidance that would be

1 coming down based on the changing personnel at the
2 office at any given point.

3 Q Now, you mentioned different panels.
4 Why don't you explain what you mean by that?

5 A So, we would see and hear cases that
6 were filed. And again, primarily there were three
7 that were created underneath the AIA, the American
8 Inventors Protection Act. Essentially you had --
9 or American Invents Act. You had IPRs, PGRs, and
10 CBMs. And those three -- of those three IPRs were
11 by far and away the most heavily used. So,
12 typically I would -- when I speak I would usually
13 say something about an IPR, which typically that
14 encompasses the other two just because there were
15 so many more IPRs.

16 And so of all of those cases that were
17 essentially forms of a way of challenging issued
18 patents, we heard those at the PTAB in three-APJ
19 panels. And so those three APJs then would be
20 assigned a case and there was an initiation phase
21 where we would determine whether a trial would be
22 instituted or not. That's the institution phase.

1 And then if that case were instituted,
2 then there would be a year-long trial. And we had
3 a statutory deadline of getting cases done by
4 about -- with a year's timeframe from institution.
5 And so it would be that -- typically it would
6 still be that same three-judge panel that had been
7 assigned from the beginning to do institution as
8 well as the trial.

9 Q Okay. But then one panel of three
10 judges makes a decision on an issue and then a
11 separate panel makes a separate decision on an
12 issue. Is that what you mean?

13 A Yeah, exactly. Each one of them were
14 empowered to decide the issues of the case that
15 came before it. And so, yeah, so if the same
16 issue came up in front of Panel A and then it
17 began Panel B, there was a chance that the same
18 issue would be decided differently based on the
19 decision-making of that APJ panel.

20 Q Now, let's say that that happened on the
21 merits. What was the issue for the PTAB itself?

22 A Oh, on the merits of the case that would

1 have been essentially whether the claims were
2 going to be maintained in the form that they had
3 been issued, if they were going to be held invalid
4 completely, or, in a small percentage of cases,
5 whether a proposed amendment was going to be
6 allowed to the claims. It's --

7 Q Right. So, on the merits could -- I'm
8 sorry, go ahead.

9 A Yeah. No, go ahead. Yeah, so,
10 essentially on merits there would be a potential
11 for having differing views on whether the claims
12 were invalid or not.

13 Q Okay. And was that a concern to the
14 PTAB as an organization?

15 A You know, it's -- I wouldn't say that it
16 was a concern because it was something that we,
17 frankly, encouraged folks to -- on issues, if
18 there were differing opinions, that was fine,
19 particularly on the merits. Because one APJ might
20 look at a reference from, you know, 1975, for
21 instance, and think of it in a different way than
22 that APJ's colleague looking at the exact same

1 reference. So, there was a possibility that they
2 might look at it differently.

3 One of the, also, things that we always
4 have to do in these proceedings is claim
5 construction. So, you have to construe the terms
6 of the claim. And when you construe the terms of
7 the claim it's the English language. And as we
8 all know, particularly as lawyers, the English
9 language is subject to a lot of differing
10 interpretations, even though we might be looking
11 at the exact same words on a page.

12 So, there were definitely opportunities
13 for split panels, if you will. Typically, a lot
14 of those panels would resolve any issues between
15 the APJs during the drafting process. So,
16 initially, if an APJ had seen something in the
17 majority opinion, for instance, that they just
18 didn't agree with, there might be a process, in
19 informal process, going through the comment and
20 drafting stage where those differences would be
21 resolved and then there wouldn't be a necessity
22 for either a concurring or a dissenting opinion.

1 Q Okay. So, we were just talking about
2 the merits. Now, is it -- were there occasions on
3 which different panels had different positions on
4 procedural matters?

5 A Yes, quite a few. And that's primarily,
6 I think, where there were some differences of
7 opinion. And that was actually one of the
8 reasons, I think, we put together what was called
9 a Trial Practice Guide. And that Trial Practice
10 Guide, I forget the year that it was initially put
11 out, fairly early on after the AIA was passed, and
12 then during my tenure we put out a revised
13 version. And this was essentially an updated
14 guide not only for the APJs, but it was a public
15 document that we gave to the stakeholders, so that
16 they would know what to expect procedurally when
17 they would come in to do a trial before the PTAB.
18 And that was a very good reference point for
19 coming up with procedural guidance for the APJs as
20 well as the stakeholders.

21 Q Did the PTAB institutionally have an
22 interest in different panels having different

1 positions on procedural matters?

2 A Yes. One of the things that we were
3 trying to do at all times was to come to a
4 consensus as to a particular way of handling
5 issues. And because the PTAB proceedings were so
6 new and because, you know, these things were
7 moving fairly quickly -- again, it was a year and
8 a half timeframe on these things, but going up to
9 the Fed Circuit and coming back was taking a
10 while. So, while we were waiting for guidance
11 from let's say at the Fed Circuit level on a
12 number of different issues, there was a lot of
13 cases that would come up where there -- when a
14 panel might decide a procedural issue differently
15 than the panel that would decide the issues let's
16 say next week or the week after. And so there was
17 a real importance that we wanted to be consistent
18 within the PTAB on procedural issues and how the
19 stakeholders were viewing their experience in
20 front of the PTAB, but also to help the APJs, so
21 that they wouldn't have to look at every single
22 issue de novo and come up essentially their own

1 take on every single issue that came up before us.

2 And so typically, on some of the --
3 there were a number of issues that were very, very
4 -- that hadn't really been decided yet. And so we
5 did get a number of situations where there were
6 different panels deciding different -- deciding
7 the same issue in vastly different ways. And
8 sometimes that impacted the parties themselves.
9 And so we were very careful in certain
10 circumstances, of course, that if a party was
11 raising the same issue before us, that they would
12 be -- essentially have the same answer for the
13 same issue that came up.

14 Q Okay. So, in the process of building
15 all these rules, you're making all these
16 interpretations, to what extent is the Federal
17 Circuit overseeing this process?

18 A They didn't provide us really any
19 guidance on any of this until a case was formally
20 presented before it.

21 Q Okay.

22 A Excuse me.

1 Q But then when it was, were they
2 reluctant to get involved or were they eager to
3 get involved? How would you describe it?

4 A They were -- before the AIA was passed,
5 if I remember correctly, the cases from the USPTO
6 were about I want to say about 30 percent of the
7 Federal Circuit's entire docket. And then after
8 the AIA was passed, it became 70 -- I want to say
9 70 to 80 percent of the Federal Circuit's docket.
10 And so it really became their primary bread and
11 butter, and so they were issuing a lot of
12 opinions. Because, again, a lot of these issues,
13 particularly procedural, hadn't been heard before
14 and they had -- they were interpretation of rules
15 and interpretation of statutes. And so the
16 Federal Circuit was very, very active and still is
17 quite active in interpreting PTAB rules and
18 statutes.

19 Q And if the Federal Circuit disagrees
20 with a position that's taken by PTAB, what
21 happens?

22 A As in any case, if they disagree with

1 the tribunal below, they reverse, they remand,
2 they vacate, they do anything like that to send a
3 decision back down to us to rehear the case and
4 look at it one more time.

5 Q But more broadly than just the case,
6 what would PTAB be doing with such a decisions?

7 A So, typically, when something would come
8 down, particularly if we had let's say an issue
9 that had gone up to the Fed Circuit that was we
10 thought of particular importance, in that case the
11 USPTO Solicitor's Office would usually enter as a
12 party. Okay? So, it wasn't just the petitioner
13 and the patent owner that would make the appeal,
14 but the USPTO would appear before the Federal
15 Circuit and it would participate in the briefing.

16 And so if our position was maintained at
17 the Federal Circuit or if our position was
18 determined not to be correct the Federal Circuit,
19 those decisions would come back to us and we would
20 have to implement those decisions across the
21 entire agency, not just necessarily at the PTAB.
22 So, anytime we were reversed, remanded, vacated,

1 we took a hard look at every single one of those
2 cases to make sure that we were implementing that
3 as correctly as we possibly could.

4 And sometimes it was fairly easy. We
5 would get a directive from the Fed Circuit to
6 let's say just -- you know, we were just wrong on
7 the merits, for instance, or we were wrong in
8 interpreting a rule. But typically, in those
9 early days they would be remanded to us and so we
10 would have a second shot at it. And it was a
11 little tricky sometimes because it wasn't
12 necessarily clear from the Fed Circuit exactly
13 what their intentions were.

14 And so then there would be, frankly,
15 another case that we would decide that would go
16 back up to the Fed Circuit that could be
17 subsequently remanded back and forth, and that
18 ping pong would happen. Occasionally, we would
19 try to avoid that, of course, but that was not an
20 ideal situation. So, it was a little tricky
21 sometimes even though it seems obvious that we
22 follow what the Federal Circuit told us to do.

1 The actual implementation of that could be tricky.

2 Q And what role did you personally have in
3 that as the chief judge?

4 A We had weekly staff meetings with my
5 team and I had assigned certain vice chief judges
6 and, of course, the deputy chief judge, who is
7 charge of all the operations at the PTAB, the
8 day-to-day operations of the PTAB. We would make
9 sure that we had analyzed the case, that we had
10 brought it up, of course, to the director, the
11 undersecretary.

12 The undersecretary also would have a
13 team of advisors. And those teams of advisors
14 would be on board and be very much aware of these
15 cases that were coming down. And we would discuss
16 them frequently at our weekly meetings with the
17 undersecretary and we would discuss them with our
18 daily meetings, frankly, with the executive team
19 and management team at PTAB as to what we would be
20 needing to do in order to implement those cases.

21 Q All right. So, now let me take you now
22 to Adidas v. Nike, IPR 2013-00067. You're

1 familiar with that?

2 A I am.

3 Q And do you recall that the Federal
4 Circuit reversed in part and remanded a PTAB
5 decision in that case?

6 A I do remember it did come back to us,
7 yes.

8 Q And do you recall what the issue was
9 that it came back to you on?

10 A This was a case that was dealing with
11 the amendment practice. I had mentioned this just
12 a little bit early. Under the AIA patent owners,
13 if their claims were found to be invalid, had an
14 opportunity to amend the claims to make them
15 valid, if you will, over the given prior art. And
16 this was still something that was in the sort of
17 beginning stages of being sorted through as to how
18 the amendment practice would work at the PTAB.

19 And the primary issue, I believe, in the
20 Nike case -- well, there were a lot of issues, but
21 one of the issues I think that was percolating,
22 that was -- and was being discussed quite

1 frequently was essentially who bore the burden of
2 proving whether the claims were -- the amended --
3 the proposed amended claims or substitute claims
4 were valid or not?

5 Q Okay. Let me ask you to turn to tab 32,
6 page 170.

7 A Tab 32. What page?

8 Q One-seven-zero.

9 A One-seven-zero, okay.

10 Q Have you previously had an opportunity
11 to familiarize yourself with this document?

12 A Which one is this? Is this the -- was
13 this the original final written decision that went
14 to the Fed Circuit the first time? I'm looking at
15 the date, April --

16 Q That's my question to you, yes.

17 A It probably was. It was April 28th,
18 2014, was the date it was entered, so this was
19 before my time, but probably would have been the
20 one that -- the final written decision after trial
21 that went up to the Fed Circuit.

22 Q And we see from page 170 that it was, in

1 fact, the final written decision, correct?

2 A Yes, it is.

3 MR. HERRIGAN: Okay. I'd like to move
4 this document into evidence, Agency Exhibit 14,
5 tab 32, pages 170 to 212.

6 JUDGE NIEDRICK: Any objection?

7 MR. KAPPERS: No objection.

8 JUDGE NIEDRICK: Okay. That's admitted
9 without objection.

10 BY MR. HERRIGAN:

11 Q All right. Let me ask you then about
12 Idle Free Systems v. Bergstrom, IPR 2012-00027.
13 Are you familiar with that case?

14 A Yes, I was.

15 Q And what was the core of that case that
16 concerned you?

17 A That case essentially was, I believe, an
18 informative case, so it wasn't a precedential case
19 of the PTAB, but it was informative, making --
20 even though it wasn't necessarily binding, it was
21 to indicate to the practitioners and to the Board,
22 the APJs, that this was the "policy" of the Board

1 and of the USPTO at a given time.

2 And I believe the issue in Idle Free
3 also was this notion of who bears the burden of
4 proving invalidity of substitute claims that are
5 proposed during an AIA trial?

6 Q Now, you mentioned informative opinions
7 and that has come up before in this case. But who
8 decides what is an informative opinion and what
9 isn't?

10 A So, that was determined by one of our
11 internal standard operating procedures. When I
12 came on board there was an existing -- there were
13 existing SOPs that decided -- that sort of laid
14 out the procedure as to how cases would be made
15 precedential and how cases would be made
16 informative. There was also a third category
17 called representative cases. And those we got rid
18 of within the first year or so of my tenure up
19 there to make it a little bit more streamlined.

20 But ultimately, precedential cases were
21 made precedential by vote, by majority vote of the
22 APJs. And then also, informative decisions, these

1 went through so many iterations, these SOPs were
2 in a constant state of flux and revision. I
3 believe informative could have been made by the
4 recommendation of the PTAB to the director, if I'm
5 not mistaken --

6 Q Okay. Now --

7 A -- and it didn't require majority vote
8 of the judges.

9 Q In this particular case, you're
10 referring to SOP 2, is that right?

11 A I guess it would have been SOP 2, yes.

12 Q So, during the time that you were there
13 was that also being reconsidered and readjusted
14 and that sort of thing?

15 A Yeah, it -- the very first -- one of the
16 things that we -- because the Federal Circuit was,
17 frankly, not hearing cases in a very timely
18 manner, it's just, you know, the nature of
19 appeals, right? It just takes a while sometimes.
20 And some of the issues that we wanted to have the
21 Fed Circuit resolve just weren't being resolved
22 quickly enough. Many discussions were had is that

1 what can we do to move cases through the PTAB and
2 make them precedential and informative? That was
3 another way, again, of making formal written
4 policy decisions at any given point before the
5 Federal Circuit has had a chance to opine on the
6 same issue.

7 Q Okay. Now let's go to tab 32, page 253.

8 A Thirty-two, 2-5-3?

9 Q Correct.

10 A Two-five-three, okay.

11 Q All right. Are you familiar with that
12 being the informative decision in Idle Free?

13 A I believe so, yes.

14 Q Okay. All right. And so we see that
15 this was an expanded panel, correct?

16 A Yes, it looks like it was. One, two,
17 three, four --

18 Q Now, you were not --

19 A -- five, six. Yeah, this was -- when
20 was it entered? It was entered, yeah, 2013.
21 Yeah, and I didn't come on board until 2016.

22 Q Okay. So, let's turn to tab 26.

1 A Tab 26.

2 Q And go to page 45.

3 A Twenty-six, 45, okay.

4 Q All right. So, you're familiar with
5 this as SOP 1?

6 A This is SOP 1, yes.

7 Q Okay. Why don't you tell us what you
8 understand SOP to be?

9 A So, there were essentially I want to say
10 nine, at the time, standard operating procedures
11 that we used to guide our -- essentially our
12 procedural administrative pieces at the PTAB. And
13 SOP 1 is when -- essentially it was the docketing,
14 if you will, the assignment of judges to panels
15 and expanded panels. So, it was how the judges,
16 the APJs, were assigned to their cases.

17 Q Okay. Now let's turn down to page 47,
18 so we can look at section 3.

19 A Okay, Expanded Panels, yep.

20 Q All right. And what do you understand
21 this to mean?

22 A This was essentially the guidance that

1 we used in deciding whether to expand a panel or
2 not. Again, this typical panel were three judges
3 and an expanded panel would have been governed by
4 this SOP 1, section 3, Expanded Panels.

5 Q Okay. So, we just looked at the
6 informative decision in Idle Free, correct?

7 A Correct.

8 Q And you understand -- you explained what
9 you understand that the issue was in that case
10 that was informative?

11 A Correct.

12 Q Now, based on your understanding of Idle
13 Free and section 3 here of SOP 1, was it a proper
14 thing to do to expand the panel in Idle Free?

15 A Again, the decision would have been made
16 by the chief judge at that point, in 2013. But if
17 you looked at Reasons for Expanding a Panel
18 underneath, which is section -- subsection A, and
19 then 1 and 2 is primarily the ones that we would
20 use. One and 2 were essentially -- section --
21 subsection A1 would have been the exceptional
22 importance and section A2 would have been the

1 uniformity or consistency. And so those were our
2 two primary drivers in any time that we would look
3 at an expanded panel.

4 And so if it was an issue of exceptional
5 importance, again, serious -- it says here,
6 "serious questions having been raised," and,
7 again, if that -- there was a conflict with a
8 previous precedential decision of the Board or
9 with an authoritative decision of the Board's
10 reviewing courts, that means primarily the Federal
11 Circuit or the Supreme Court, that would make that
12 case exceptional. It would also make it
13 exceptional when essentially we had made a
14 decision on an issue that was new, for instance.
15 That was, again, something that we hadn't seen
16 before. And if that was n issue that we wanted to
17 sort of nail down in terms of policy, then we
18 would expand the panel underneath section 1.

19 And then section 2 is -- they sort of
20 play together typically, the exceptional
21 importance and uniformity. Sometimes in order to
22 maintain uniformity of the Board decisions we

1 would make sure that we would expand a panel in
2 order to make sure that the cases were heard
3 similarly for the similarly situated parties.

4 And I recall there was one -- there was
5 a series of cases, for instance, where all of the
6 claims were going to be required to be construed
7 underneath our statute the old 1126, "means plus
8 function" statute. And because there were so many
9 IPRs filed that a single panel -- typically, we
10 would try to assign all the cases to the same
11 panel for efficiency purposes, but the workload
12 would have been enormous. And so in order to
13 avoid a non-uniformity of claim construction, we
14 expanded the panel so that the workload of the
15 judges was appropriate, but that essentially there
16 would be a lot of overlap amongst the APJs, so
17 that those issues of claim construction would be
18 decided the same for the same parties that were
19 filing the IPRs and were the patent owner.

20 Q Do you have an opinion on whether the
21 expansion of the panel in Idle Free was legal?

22 A Was legal? I believe it wasn't legal.

1 Q Why?

2 A So, if you note, the -- of course, this
3 happened before my time, but if you note at the
4 top of this page, what is it, page 47, "An
5 expanded panel is not favored and ordinarily will
6 not be used. However, from time to time it may be
7 necessary to expand a merits or interlocutory
8 panel." And that came down from -- obviously, it
9 was part of the Board's procedures for many, many,
10 many, many years. And it had seen review at the
11 Federal Circuit in an en banc decision in the
12 mid-'90s and it was called In re Alappat. And I'm
13 sure we're all familiar with that because that's
14 sort of the driving force behind these expanded
15 panel decisions.

16 Q Okay. So, then let me close out Idle
17 Free by referring you to tab 32 page 213.

18 A Thirty-two, 213? Yes, okay.

19 Q Correct.

20 A Yes, okay.

21 Q Okay. And what do you understand that
22 to be?

1 A Okay. So, this looks like it's a final
2 written decision in Idle Free dated January 7th,
3 2014. And it was written by Jameson Lee.

4 Q Okay. And so we see now that there's
5 three APJs, correct?

6 A That's correct.

7 Q What happened? We just saw six, now
8 we're seeing three.

9 A Right. So, panels could be expanded and
10 unexpanded based on the SOP. So, what must have
11 happened was that during the course of the trial
12 the composition of the panel changed. And for
13 that specific issue, I believe in -- when we talk
14 about Idle Free, the specific issue was the burden
15 of proving patentability. On that issue, to
16 resolve that issue the panel was expanded. But
17 then it looks like the final written decision for
18 the trial on the merits then went forward with the
19 -- I don't know if this was the original
20 three-judge panel, but it might have been the
21 original three-judge panel.

22 Q All right. And so to your understanding

1 is the unexpansion of the panel a legal thing to
2 do?

3 A Yes.

4 Q Okay. All right. So, let's get back to
5 Nike then. So, we just talked Idle Free and you
6 mentioned the amendment issue a number of times.
7 So, when the matter comes back from the Federal
8 Circuit what did you understand the issue to be
9 that was presented to the PTAB again?

10 A One of the, excuse me, one of the issues
11 that the Federal Circuit had raised on appeal, I
12 believe it was Judge Chen, was the way that
13 substitute claims were looked at in terms of how
14 they compared and how they looked in terms of
15 scope with the original claims that were at issue.
16 Okay? So, one of the things that was required
17 about proposing a substitute claim, that the scope
18 of the claim could not be broader than what the
19 original claims were. And that makes sense. If
20 your original claim is invalid, your substitute
21 claim should be more narrow in order to make it --
22 attempt to make it valid at that point.

1 And so one of the issues was -- I know
2 it was hotly debated at the oral argument, if I'm
3 not mistaken, was what test does the PTAB use in
4 order to determine whether those -- the proposed
5 substitute claims are patentably distinct from the
6 original claims? And we were relying on another
7 doctrine within the U.S. Patent and Trademark
8 Office dealing with double patenting. So, you can
9 get one patent, you can't get two. You can only
10 get the one. And so if the claims are identical
11 or very close to each other, not patentably
12 distinct, we're essentially going to keep those as
13 a single patent, if you will.

14 And so, the tests for determining that
15 and how we were going to import those into the
16 PTAB proceedings were a procedural issue that was
17 at issue in the Nike remand.

18 Q Okay. Now, was this is the first you'd
19 ever seen a remand from the Federal Circuit?

20 A I don't believe it was the first, no,
21 but there was an initial wave of cases. So, this
22 was one of the earlier cases. And at the time, we

1 actually were putting together a standard
2 operating procedure, I think it was number 9 or it
3 might have been number 10, to deal with remands
4 from the Federal Circuit. So, we were trying to
5 provide internal guidance to the APJs.

6 Q Now, at the time, you were in the vice
7 chief -- or the chief judge chair. But what was
8 the policy on the staffing of these panels?

9 A Which panels, the regular --

10 Q No, on remand. So, a case comes back
11 from the Federal Circuit --

12 A Oh, on remand? Yeah, so, we were -- you
13 know, we were strapped because there was so much
14 activity at the PTAB, so we were
15 resource-constrained. So, we tried to keep as
16 much as we could the same panel. We kept the same
17 panel from institution to final, so that the folks
18 -- the APJs that had done the work on the
19 institution's decision would normally be the same
20 judges that did the final written decision. And
21 there was some criticism of that policy that we
22 did, but we did it for resource reasons.

1 Similarly, on remand, when the case
2 would come back from the Federal Circuit it would
3 go back to the same panel, so that the same panel
4 would be able to look at the exact same prior art,
5 the same claims, they would be familiar with it,
6 and they would be able to -- they wouldn't have to
7 start from scratch. But that wasn't always the
8 case. There were various situations sometimes
9 where the panel -- or when it would be remanded
10 back and it wouldn't go to the same panel.

11 Sometimes conflicts arose, for instance, or
12 workload. So, there were a number of different
13 reasons as to why panels would not be constituted
14 exactly the same.

15 Q Okay. So, when the Nike case came back
16 on remand could you have appointed a different
17 panel?

18 A Oh, yeah, mm-hmm, I could have appointed
19 a different panel, but we didn't do that as a
20 routine matter.

21 Q Okay. Now, you said "so much activity".
22 I'm not sure that that point has come across yet,

1 but what do you mean by that when you say there
2 was so much activity at PTAB? What's going on at
3 this time?

4 A So, remember, this was, you know, over
5 five years ago. The AIA was, you know, 2011,
6 2012, passed and implemented. And my predecessor,
7 he was in essentially hiring mode. So, from 2011,
8 2012 timeframe until he left in 2015, he hired,
9 gosh, I want to say close to over 100, if not 150
10 APJs, essentially expanding the APJ population
11 enormously.

12 And as I mentioned before -- so, and we
13 were getting a lot of activity, meaning that there
14 were a lot of filings at any given point. And at
15 that point, we were just -- the one thing that was
16 driving the PTAB at that time was that there was a
17 statutory one-year deadline to get the final
18 written decision out. And so policy at that
19 point, my understanding from the prior
20 undersecretary, was that the PTAB would make those
21 one-year deadlines.

22 There was a provision where they could

1 be extended for various reasons, but they wanted
2 to -- essentially the PTAB wanted to prove that
3 this was a forum for looking at invalidity and
4 that the parties could rely on that one-year
5 statutory timeframe. So, that was driving a lot
6 of the activity, too, was just getting the panels
7 together, getting the time -- the clock running,
8 making sure the trials were up and running.

9 And then, again, as I said, the overlay
10 to all of this was that an enormous rules package
11 had been formulated. And so all of those rules
12 were at that point subject to interpretation,
13 implementation. And as with anything, you put a
14 rules package in place thinking it's going to take
15 care of all of the outstanding issues and it never
16 does. There's always something outstanding to be
17 decided.

18 Q Okay. Let me ask you to go to tab 5,
19 page 126.

20 A Five. Okay.

21 Q Okay. So, we're looking at an email
22 chain, so I'd like to go to the beginning of the

1 email chain, which is at 129.

2 A One-two-nine, okay, hold on.

3 Q Okay.

4 A Okay.

5 Q So, now we're talking about the Nike
6 remand decision, correct?

7 A It looks like it is, yes.

8 Q Okay. And at the bottom of page --

9 A Remand review.

10 Q -- 129, Mr. Arpin has submitted a draft,
11 is that right?

12 A Am I on 129 or 130, 129. Yeah, it looks
13 like he's submitted a draft to the AIA Review
14 Committee, to ARC.

15 Q Okay. And then at the top, what do we
16 see?

17 A Mr. Horrigan, I'm not sure if I'm on the
18 right page that you want me to be on, 129.

19 Q Okay. So, we're on tab 5, 129, the top
20 part from AIA Review Committee.

21 A Yeah, and it says, "Jim, ARC has
22 completed its review. Because the --"

1 Q So, what does that mean?

2 A Oh, I'm sorry. So, what would happen is
3 that, again, my predecessor had put in place
4 something called this AIA Review Committee, which
5 we abbreviated as ARC. And ARC was a group of
6 APJs, volunteer APJs, who rotated on and off their
7 service in order to review AIA institution
8 decisions and final decisions before they were
9 actually mailed to the parties.

10 And so the AIA Review Committee, it was
11 just a mailbox, but it represented the committee
12 as a whole, I guess. And then they would -- when
13 a decision was submitted and it was reviewed, then
14 the ARC would review it and then send an email
15 back to the author of the decision. And it -- and
16 Jim Arpin was the author of the -- I guess he was
17 the author of the initial final written decision
18 and then also of this draft remand decision.

19 Q Okay. And so we're looking at 129. The
20 middle paragraph, "Because the decision"?

21 A "Includes a concurrence," right.

22 Q But why is that there?

1 A So, one of the things that we wanted to
2 make sure -- if a decision went out 3-0, that
3 typically would go out without a lot of issues,
4 frankly, because three APJs had decided the issue
5 in the exact same way. But if there was some sort
6 of split between the three-judge panel, management
7 wanted to see it in order to see what the issue
8 was and whether that issue could be resolved and
9 whether it was a concurrence or a dissent. While
10 certainly on issues that were up for grabs, that
11 was -- or hadn't been decided yet, that actually
12 was a form that we used, Concurrences and
13 Dissents, in order to sort of flesh out the issue
14 in hopes that some of these issues might go up to
15 the Fed Circuit and get decided. But because it
16 had a concurrence here, this had a concurrence,
17 not a dissent, then it was brought to --
18 essentially it was elevated to the next level of
19 review, which would have been to me and to Scott
20 Boalick, the deputy.

21 Q Okay. And on 128 we see that Mr. Arpin
22 then does send that to you guys, management,

1 right?

2 A It looks like he did, yes.

3 Q Okay. And then at the top of 128 he's
4 asking you what the status is, you see that?

5 A Yes, I see that, yep.

6 Q All right. So, a seven-month
7 anniversary of the issuance of the mandate from
8 the Federal Circuit. What does that mean to you?

9 A So, again, this -- since this is the --
10 just to be clear, the one-year deadline that I was
11 talking about earlier only applies to the original
12 final written decision. So, coming back on
13 remand, then we weren't governed by any particular
14 clock. There was no statutory clock, either one
15 year for final written decision or six months to
16 institution. So, that just meant that the Federal
17 Circuit had decided the case and issued its
18 mandate seven months before. That's all it really
19 was. It was just a heads-up.

20 Q Okay. I'm going to ask you then to turn
21 to tab 7, page 110.

22 A One-one-zero. Okay.

1 Q Okay. Do you recognize that as the
2 draft opinion that Mr. Arpin sent to you?

3 A Sorry, it didn't come up. One-one-zero?
4 One-one- zero. Okay, there it is. Okay. And
5 what was your question again? I'm sorry.

6 Q Do you recognize that as the draft
7 opinion that was sent to you?

8 A It looks like it is, yes. It doesn't
9 have a specific date. It is October of 2016. And
10 it was -- right, and the opinion of the Board was
11 filed by Jim Arpin and Michael Fitzpatrick filed a
12 concurring opinion.

13 Q Okay. Now, when Mr. Arpin forwarded
14 this to you in October of 2016, would you have
15 read it?

16 A I would not have read it necessarily in
17 depth. I rely very heavily, because of the
18 workload, on the ARC committee. The ARC's job was
19 to read these cover to cover and if there was an
20 issue, raise the issue up to us. So, I'm not sure
21 if I read this cover to cover to be totally honest
22 with you.

1 Q Okay. And so then let's go back to tab
2 5, page 128.

3 A Okay.

4 Q All right. And then we're going to
5 scroll up to 127.

6 A Okay.

7 Q And we're still in October 2016, still
8 trying to get this decision moving. And then
9 we're scrolling up to 126.

10 A Okay.

11 Q Mr. Arpin's still asking for status,
12 correct?

13 A Looks like it, yes.

14 Q Okay. And then at the very top of 126
15 we see the email from Mr. Boalick expanding the
16 panel in November.

17 A Yes, I see that.

18 Q Early November. Okay.

19 A Yes.

20 Q Can you explain what's going on here?

21 A So, because of the concurrence, ARC
22 raised it to management's attention and management

1 would have included the vice chief judges, Scott
2 Boalick as my deputy and myself as chief judge.
3 And then they would have made a recommendation to
4 me upon their review as to whether the panel
5 should be expanded and whether there was an issue
6 that needed to be -- that should be decided for
7 either exceptional importance or for uniformity to
8 be decided.

9 And so based on that recommendation I
10 made the decision to expand the panel. And in my
11 prerogative as chief judge, I could dictate who
12 would be on that expanded panel.

13 And what we typically did, again, with
14 our situation, we were -- I always took the
15 viewpoint on expanding a panel as to be done --
16 something that is rare and was done on a rare
17 occasion. And when I did expand a panel it was
18 not to overturn the result necessarily. In fact,
19 I never wanted to expand a panel to overturn the
20 result, but it was to emphasize the importance of
21 the decision.

22 And by putting myself and the deputy

1 chief judge on that would send a signal, a
2 definitive signal, to the APJs, but as well as to
3 the parties and the public that this was an
4 important decision, not only because the panel was
5 expanded, but it was expanded to include myself
6 and the deputy.

7 Q Okay. When you say you didn't intend to
8 overturn the result, what do you mean by "result"?

9 A So, typically, the result of the case,
10 whether -- you know, essentially the merits
11 outcome of the case, right? So, if the decision
12 were to find let's say the claims invalid, just as
13 an example, and then because there was some
14 underlying procedural issue that had not been
15 decided yet or had changed in importance or the
16 commissioner had changed or a Federal Circuit case
17 had come down that changed, in those situations we
18 might decide that issue, but, hopefully, we would
19 not change the merits result as to whether the
20 claims were invalid or valid. Because, again, to
21 me the most important judicial independence of the
22 judges was to get to the merits of the cases and

1 decide the invalidity of the claims.

2 Q Okay. Then with that explanation, why
3 did you decide to expand the panel in this case?

4 A So, in this case it was -- again, the
5 issues that were raised in this case, they were
6 actually -- so, the amendment practice, although
7 it was fleshed out in the statute and it was
8 fleshed out in the rules to some extent, how we
9 actually implemented that was not entirely clear
10 at all. And partially because the rule -- how we
11 were interpreting the rules and how we were
12 implementing the rules and the statute, the
13 parties were confused as to what they could and
14 couldn't do. And one of the issues that was very,
15 very important were when -- let's say, and I think
16 in Idle -- or not Idle Free, excuse me, in Nike
17 the issues were, you know, how many substitute
18 claims could you put into the case? Okay.

19 So, you could imagine if you have one
20 claim before us and then, all of a sudden, you're
21 allowed pretty much by right to present substitute
22 claims, well, if you have 100 substitute claims

1 that you put before us, that's unwieldy and
2 unmanageable. We can't do that.

3 And so another one of the big issues
4 with Nike were what is the permissible number of
5 substitute claims that could be put back into a
6 case when the original claims were found
7 unpatentable? So, that was a big issue that
8 needed to be decided and it needed to be decided
9 consistently amongst the panels. And it was a
10 very, very important issue as to how we were
11 dealing with amendments.

12 And, again, as I mentioned before, then
13 another issue that was of exceptional importance
14 based on the remand decision was when you look at
15 those substitute claims, how do you know whether
16 they're different, patentably distinct, than the
17 claims that were originally found to be invalid?
18 And what test, if any, should be used? And that
19 was also an issue of pretty -- very much of
20 importance, so that the panels would consistently
21 determine this is the way you decide a substitute
22 claim, whether it's patentably distinct or not.

1 And then, of course, sort of the
2 subsidiary issue, and I shouldn't really say
3 subsidiary issue, but if the burden were to shift,
4 is it proper to put the burden on the patent
5 owner, which is where it stood before underneath
6 Idle Free, I believe, on the patent owner to prove
7 patentability of his or her claims? Or should the
8 burden be on the petitioner to prove
9 unpatentability of the substitute claims? And
10 that was a big deal because, of course, burden
11 makes a difference in these proceedings.

12 Q And what is your understanding of
13 whether those three issues you just described were
14 procedural or went to the merits?

15 A Mostly they were procedural except that
16 second issue of the patentably distinct aspect of
17 proposed substitute claims. That has -- I mean,
18 it's -- the test -- which test we implement and
19 use, that's a procedural piece to it. But
20 ultimately, when you've applied that test,
21 whatever test that might be, that would be sort of
22 a merits decision.

1 Q Okay. And what is your opinion on
2 whether the expansion of the panel in this Nike
3 remand was consistent with that SOP 1?

4 A It was entirely consistent with SOP 1.

5 Q Why?

6 A Because it fell underneath, if I
7 remember -- the first two prongs, again, the first
8 prong is exceptional importance and the second
9 prong is consistency among panels, consistency
10 across the PTAB. And it really hit both of those
11 pieces, the reasons I was talking about. It was
12 exceptionally important because it was an issue
13 that we hadn't decided yet. Some panels -- or
14 definitively decided. There were some panels that
15 were determining it one way or the other.

16 The stakeholders were asking for advice
17 and were unclear as to what papers they needed to
18 file, when they needed to file them, what tests we
19 were going to be used, all of that was of vast --
20 of very much importance, exceptional importance,
21 in order to decide that case.

22 Q Okay. At this time, was there any

1 question in your mind about your legal authority
2 to expand that panel?

3 A At that time, absolutely not.

4 Q Had anyone suggested to you that there
5 was a question about whether you had the legal
6 authority to expand that panel?

7 A No, that was a common practice that,
8 again, had -- was originated prior to AIA. I
9 don't even know when that -- this was a Board
10 practice from a long time ago, years and years.

11 Q And you testified just a bit ago that
12 you did not intend to overturn the outcome of a
13 case when you expanded the panel, correct?

14 A That was -- yes, if at all possible I
15 did not want to overturn an underlying panel.
16 That had been done by my predecessors and it was
17 something that, you can imagine, creates a lot of
18 -- how should we say it, it creates issues with
19 the original panel when they feel like they've
20 been overruled. And I never wanted to overrule a
21 panel on the merits.

22 Q Okay. Then with respect to the decision

1 to expand the panel here, how is it that you did
2 not understand that you were trying to change the
3 outcome?

4 A Well, because I think the way I was -- I
5 remember having a conversation with -- it might
6 have been with -- well, with -- when the issue
7 came up to us, again, the decision was so highly
8 procedural and I could understand where the
9 original draft remand was trying to come and be --
10 it was trying to be as honoring the remand coming
11 down from the Fed Circuit. We wanted to always
12 answer the question or do exactly what the Fed
13 Circuit told us.

14 But one of my mantras had always been
15 when we stick to the merits of a case, we do much
16 better on appeal and we do much better with the
17 public. Because that is our mandate is to know
18 the technology and do what's right for the --
19 actually the substance of the claims, whether the
20 claims are valid or invalid. That's the merits
21 decision.

22 And so for me that was the primary

1 decision. And when we looked at the case, I did
2 not disagree with how the panel had come out with
3 -- on whether the claims were valid or invalid.
4 That wasn't an issue for me. It was how it got to
5 that, the procedural steps that got there. And
6 those procedural steps were of exceptional
7 importance and were not being applied, from my
8 understanding, panel to panel to panel
9 consistently.

10 Q Okay. So, we'll note that the date here
11 when you expanded the panel was November 4, 2016,
12 correct?

13 A That's what it said, yes.

14 Q Okay. Do you recall that in August 2016
15 the Federal Circuit vacated its own decision in In
16 re Aqua Products and set the case for en banc
17 review?

18 A I don't remember the exact date, but it
19 was the -- shortly after -- there was a lot of
20 activity that summer. I came on in May of 2016.
21 And that summer the Supreme Court had come down
22 with a decision that was very, very important to

1 the Board. We had been upheld, I believe it was 7
2 to 2. And then the Aqua Products decision had
3 been vacated in favor of an en banc decision. And
4 anytime the Fed Circuit took a case en banc, that
5 was a very, very important signal to us that that
6 was an extremely important issue that needed to be
7 resolved. And Aqua Products was dealing with the
8 amendment practice.

9 Q Okay. And so what was the relationship
10 between Aqua Products and Idle Free?

11 A The issue there, the Aqua -- I think --
12 I'd have to go back and look at what the en banc
13 order was because typically, like the Supreme
14 Court, they would have certain questions that
15 would be asked, intended to be answered. But
16 definitely, one of the questions that Aqua
17 Products wanted to decide was who bears this
18 burden of proving either patentability or
19 unpatentability of substitute claims. And that
20 would be the patent owner, which is what
21 essentially what Idle Free had held and what the
22 policy, if you will, of the Board had been, or as

1 was going to be argued at the Federal Circuit en
2 banc was that burden on the petitioner who's
3 challenging the claims to prove unpatentability?

4 Q Okay. So, then what was the
5 relationship between Aqua Products and the Nike
6 case on remand?

7 A Similarly, that -- again, that was an
8 important issue as to who bore the burden to prove
9 patentability or unpatentability, so it was sort
10 of a cascade, if you will. So, you know, and this
11 happens on a number of issues, particularly in a
12 situation where the Board is brand new, if you
13 will. It's only been a few years old, frankly.
14 Any policy that we had put in place, which was
15 Idle Free, was going to now be revisited by the
16 Fed Circuit underneath Aqua Products and en banc.
17 And that was a big deal for them to take it en
18 banc. It wasn't just a regular precedential
19 opinion. And to see whether that case then would
20 impact all of our pending amendment cases.

21 Q Okay. So, now let me -- let's move
22 forward in time. If I could ask you to go to tab

1 7, page 241.

2 A Tab 7, excuse me, okay.

3 Q All right. And we see that Mr. Arpin
4 has submitted another draft in the Nike remand
5 decision, right?

6 A Two forty-one, yes.

7 Q Okay. And so then if we could just go
8 down to 243, which is the beginning of the text.

9 A Okay.

10 Q All right. So, what do you see there?

11 A Two forty-three looks like the draft
12 opinion of the expanded panel that we circulated
13 for review to the expanded panel. So, Scott and I
14 had been added and the original panel, Josiah,
15 Michael, and Jim, were still on the panel.

16 Q Okay. And at this point had the
17 decision come out in Aqua Products?

18 A What date is this? This is August of
19 2016. I don't believe it had.

20 Q Okay. And what do we make of the fact
21 that we have two concurring opinions here, if
22 anything?

1 A It's just that there were -- you know,
2 whenever there's an occurring -- or, excuse me, a
3 concurring or dissenting opinion it, frankly,
4 indicates that there's an issue that's unsettled
5 at the Board potentially. And that was always --
6 that's why we wanted to see it before it got
7 mailed for the ARC committee, so that those sorts
8 of issues were, frankly, raised to us, so that we
9 could raise it to the undersecretary. That was a
10 good means of us to say, you know, hey, this issue
11 is percolating at the Board. We've got concurring
12 and dissenting opinions out there that are taking
13 different sides of the same issue.

14 So, that's -- the fact that there was a
15 concurring opinion just meant that -- I'm not sure
16 if they had concurred in the result or not. I
17 don't recall that or not. But essentially, the
18 fact that there were concurring opinions meant
19 that there was an issue of importance and sort of
20 reinforced, if you will, the need to have an
21 expanded panel.

22 Q Okay. And so now let me ask you to go

1 to tab 5, page 134 and into 135, so at the bottom
2 of 134.

3 A One thirty-four? Okay.

4 Q All right. And so we see a fairly
5 lengthy email from Mr. Arpin to the members of the
6 panel, correct?

7 A At the very -- at the beginning of that,
8 yes, okay.

9 Q Okay. And so what is Mr. Arpin's point
10 here? What's going on?

11 A Let me just take a quick look if I
12 could.

13 Q Well, how about --

14 MR. KAPPERS: Yeah, take your time.

15 THE WITNESS: Yeah, I haven't read this
16 in ages, so let's see.

17 BY MR. HARRIGAN:

18 Q Okay. Well, about how this? Can I
19 refer you to Oil States in particular?

20 A Okay.

21 Q What does the Oil States have to do with
22 this?

1 A Okay. So, Oil States was a Supreme
2 Court case that essentially challenged the entire
3 -- it essentially challenged the constitutionality
4 of the Board, whether it existed or not. This is
5 one of those extremely important cases that if it
6 had come down a different way and we had been
7 found unconstitutional, it would have upended
8 everything, everything at the Board, everything
9 that we had done for the previous five or six
10 years. So, it was hugely important. So, that was
11 the Oil States decision.

12 Q Okay. And what does Oil States, Nidek,
13 Yissum have to do with Nike?

14 A Let me look. Whew, let's see.

15 Q Okay. And if you don't recall, that's
16 fine, we'll just move on.

17 A Well, just one thing, I guess. I'm just
18 reading the -- his email. I don't recall this. I
19 don't recall what was in the Oil States opening
20 brief. But he says, "Note that it discusses both
21 Nidek and Yissum." Nidek was a case that did go
22 up to the Fed Circuit and, if I remember

1 correctly, that was one of the issues that was
2 raised, but not -- it wasn't decided at the Fed
3 Circuit. I believe it came down as an "additional
4 views" it might have been styled by Judge -- oh,
5 I'm drawing a blank as to which judge, as to the
6 usefulness, if you will, of expanded panels.

7 And Yissum, I don't recall the issue in
8 Yissum to be totally honest with you, so, I mean,
9 I really don't feel comfortable commenting on
10 Yissum. But I do remember Nidek came out -- I'd
11 have to go back and look at the date of that, but
12 there was an issue. There was a concurring or
13 additional views that came down in Nidek that did
14 raise an issue about expanded panels.

15 Q Okay. And then we see that in the
16 second paragraph Mr. Arpin's saying that "we need
17 to act in Nike now." What is, from your
18 perspective, what is the advantage in getting
19 ahead of, in this case, the Federal Circuit or the
20 Supreme Court?

21 A Well, the advantage, I'm not sure there
22 is an advantage. One of the things that, you

1 know, is something that we -- as an agency we have
2 to be very conscious of is that our reviewing
3 court, when an issue is presented before it and an
4 issue is going to be decided, sometimes we want to
5 see what happens at that reviewing court before we
6 act. And certainly, underneath -- under Iancu
7 that's something we did constantly. We waited all
8 the time, that if there was an argument or an
9 issue that was pending before the Fed Circuit and
10 it squarely controlled an issue that the Board was
11 dealing with, it was very, very rare that we would
12 act ahead of our reviewing court when that issue
13 was squarely presented to it.

14 Q Okay. And you see on the rest of page
15 134 that Mr. Arpin is arguing three times that you
16 need to get ahead of Aqua Products. What did you
17 think of that?

18 A I'm not sure I understood why,
19 particularly when if they had taken -- if the Fed
20 Circuit is going to be resolve the issue for us,
21 that's the best route for it. The absolutely best
22 route for them to decide it, the same issue that

1 we're deciding, that's the best route for us to
2 know what our policy should be, frankly.

3 Q Okay. And then we're scrolling up now
4 into 133 and Mr. Arpin is continuing to try to get
5 movement.

6 A Okay.

7 Q All right. And then you were --

8 A I see it.

9 Q Pardon me?

10 A Go ahead.

11 Q One thirty-two, you responded.

12 A Yes.

13 Q And why don't you explain the point
14 you're trying to make here?

15 A Yeah. So, the point, again, is when --
16 I'm not exactly sure of the timing of this email,
17 but this would have been what? This was August
18 31st of 2017. So, you know, the back-and-forth
19 would have been once the draft opinion gets
20 circulated, then the other judges can either vote
21 thumbs up or thumbs down. And if they vote thumbs
22 down, they can either concur or they can dissent.

1 And so when we saw, again, that there
2 were two concurrences, both Jim and Mike had
3 concurred, then the drafting party needs to take a
4 look at that and say does that impact anything in
5 the majority opinion? Do they want to respond?
6 Do we want to drop a footnote? Is there language
7 that we want to review that we can all come to
8 agreement on, so that it might obviate a need for
9 a concurrence or a dissent?

10 So, that's, I think, what was going on
11 in this email is saying, you know, these are some
12 of the -- you know, based on your concurrence now,
13 these are some of the issues that we want to look
14 at before the decision mails because maybe the
15 decision might mail in a much more streamlined
16 form; or, frankly, if a concurrence or dissent is
17 particularly persuasive, it could change the
18 entire tone or outcome of the majority opinion.

19 Q Okay. And then if we look at pages 131
20 to 132, we see a lengthy respond to your email
21 from Mr. Arpin. Just quickly, what is your take
22 on his response?

1 A He was just trying to address in my
2 email some of the concerns that I raised in order
3 to try to get me to feel more comfortable with his
4 concurring opinion.

5 Q Okay. Now, the second --

6 A That's what it looks like to me.

7 Q The second half of his email concerns
8 disclosed confidential information. Do you see
9 that?

10 A Hold on. Yes, I see that.

11 Q Do you recall what the issue was there?

12 A Yeah. So, there was procedural
13 discussion, I believe, in this opinion that talked
14 about our -- some of our internal SOPs as to how
15 and when we would panel cases, how and when we
16 would expand panels, how and when we would
17 unexpand panels, things like that. And in
18 particular, I think this was confidential
19 information that -- I can't remember exactly what
20 it was. This is a highlighted sentence in bright
21 yellow in the draft.

22 So, that was something that we raised or

1 that I raised it looks like as something that
2 shouldn't be out in the public domain. And I
3 don't exactly remember what was in the sentence,
4 but it had to do with the paneling decisions.

5 Q And so what do you understand

6 "confidential information" to mean?

7 A Well, confidential information, you
8 know, to me it's typical of things like a FOIA
9 request. One of the things we're taught at the
10 agency, of course, and particularly in the PTAB
11 setting, is that anything that's "pre-decisional,"
12 if you will, is confidential information and will
13 never be disclosed to the public. We had gone
14 through multiple FOIA trainings on this and that's
15 something that we, you know, implemented on a
16 day-to-day basis because we were inundated with
17 FOIA requests as well and asking for documents
18 from lots of people, including the APJs.

19 So, that was something that when I look
20 at confidential, anything pre-decisional was
21 viewed as confidential. And that would have been
22 draft opinions, for instances, discussion of

1 policy that still hasn't been completely
2 formulated, a draft to our Trial Practice Guide,
3 draft memos, draft orders, anything like that
4 would be labeled "pre-decisional" and would not --
5 and would be viewed as confidential.

6 Q Okay. And so why do you think it's
7 important to withhold that information?

8 A Well, because things change. Policy
9 changes. We -- myself, I was under the
10 undersecretary's direction of one -- essentially
11 four different -- in the short, you know, two and
12 a half years that I was up there, which was not a
13 very long time, I had four -- essentially four
14 different undersecretaries that I was dealing with
15 and policy changes. And so if something isn't set
16 in stone, if you will, we don't want to be putting
17 things out to the public that are going to be used
18 as let's say evidence of a certain policy of the
19 USPTO when it, in fact, is not policy.

20 And you might -- this -- and this is
21 actually something that, you know, is very well,
22 known at the agencies because there is many times

1 when something goes out to the Patent corps and
2 the Patent examination corps is 10,000 members.
3 And when something gets sent, even though it might
4 be labeled as pre-decisional or confidential,
5 it'll always get leaked to the public. And that's
6 not something that helps the public or the agency
7 because we want to make sure that what we put out
8 is the policy at that given time.

9 Q Okay. And so let's scroll to the top of
10 131 just to note that this email is on August
11 31st, 2017. You see that, correct?

12 A Yes, that's the date of it.

13 Q All right. So, the Aqua Products en
14 banc decision issued on October 4th, 2017, does
15 that sound right?

16 A It was late 2017, yes.

17 Q Okay. What impact did that decision
18 have on the PTAB?

19 A Well, I remember it coming down. One of
20 the biggest impacts it had and it's not the one
21 you might think because it was a decision that was
22 very -- I don't want to say necessarily it was

1 controversial, but it was very complex. It was
2 one of those decisions where there was no clear
3 majority. It had multiple opinions. There were
4 multiple pages coming out. And that was tricky,
5 right, because we want to implement -- and it came
6 out as a precedential en banc case. So, we had to
7 decipher what the holdings of that case were. And
8 obviously, that can't be done overnight. That
9 takes a long time.

10 And one of the major effects that came
11 out of that case, though, is because it was
12 dealing with our amendment practice, we had a
13 handful of cases that needed to be mailed I think
14 within the next week or even in the next couple of
15 days in order to meet our one-year statutory
16 deadline for final written decisions. And so one
17 of the big steps we did -- and, again, this sort
18 of -- and, again, it goes to all of the activity
19 that was going on. This essentially created an
20 issue for us, so that we had to turn on a dime and
21 focus our attention as to how we were going to now
22 extend the deadline past the one-year statutory

1 deadline. And we had a six-month window that we
2 were allowed to do that in certain circumstances.
3 And we decided at that point that this was going
4 to be one of those situations. And that was not
5 an easy decision to make.

6 So, that decision, which sort of, you
7 know, you wouldn't necessarily expect that coming
8 out of the Fed Circuit's en banc decision on
9 another issue, but that essentially really
10 affected our procedure and process and dominated
11 our thinking up at the Board for quite some time
12 afterwards. So, that was one of the big effects.

13 Q Okay. And so moving forward again --

14 A I think it's -- I'm sorry about that,
15 but I use that as an example of we had to turn on
16 a dime. There were so many issues percolating out
17 of these cases. It wasn't as clean as some people
18 would have liked to have seen, of course.

19 Q Okay. And so let me move you forward in
20 time by going to the bottom of page 138 in tab 5.

21 A Excuse me, 138. Okay.

22 Q Okay. You see now there's another draft

1 decision out, right?

2 A Yes, it looks like it.

3 Q Okay. And so between --

4 A March of 2018, yes, okay.

5 Q So, between October when the decision
6 came out and March when this next draft is issued
7 what's going on with respect to the implementation
8 of Aqua Products at the PTAB?

9 A So, this timeframe would have been
10 October of 2017 until March of 2018. So, this
11 would have been -- they had identified a candidate
12 I think by this point, Andrei Iancu, to be the
13 next undersecretary of Commerce. He'd probably
14 been nominated at this point. We had been working
15 with Joe Matal, who was essentially the acting
16 undersecretary at that point. We were hoping that
17 Andrei would get appointed and would get on board
18 quickly because he's -- as the only presidential-
19 appointed and Senate-confirmed political appointee
20 at the USPTO, he is in charge of all --
21 ultimately, in charge of all of the policy
22 decisions. And on important policy issues we

1 wanted to have him weigh in on issues.

2 And so one of the big issues that came
3 out of this decision during this timeframe was to
4 how to frame the holding of Aqua Products. As I
5 said, it was a split decision and some people read
6 the case as being an overturning of our policy to
7 put the burden on the patent owner to prove
8 patentability of substitute claims. And there
9 were some decisions that initially went out that
10 said the burden after Aqua Products is now on the
11 petitioner.

12 That was not -- although it seems that's
13 how everything turned out, the process of getting
14 to that was -- you know, it's like making
15 sausages, particularly when you have multiple
16 undersecretaries and people coming in and out of
17 the offices during this timeframe. So, during
18 this timeframe, with respect to Aqua Products, we
19 were trying to decipher the case, come up with our
20 options, figure out what the best vehicle was to
21 put this out, whether it be a panel decision,
22 whether it be guidance from the undersecretary,

1 whether it be guidance from the chief judge. Does
2 there need to be formal notice and rulemaking on
3 this issue or is the Fed Circuit's opinion clear
4 enough?

5 I just -- Andrei came on board in
6 February, if I'm not mistaken, of 2018. And this
7 issue actually had not even been decided at that
8 point. I know that sounds strange, but I remember
9 distinctly in early March having a discussion with
10 Andrei over the phone because he had -- he came in
11 in February and he didn't know where he fell on
12 this issue even after the Aqua Products en banc
13 case.

14 So, there was just a lot of balls in the
15 air, a lot of voices being heard. And frankly,
16 there was a lot of -- as we always do and we did
17 it again this time with the Biden appointee, a lot
18 of issues get put on the shelf to be waited
19 (phonetic) until you get the confirmed nominee in.
20 That, unfortunately, happens. And sometimes you
21 can do things quickly and sometimes it just takes
22 a long time for these issues to get resolved.

1 Q All right. So, we're in tab 5. If we
2 could look at page 137. And we see that the draft
3 now is submitted for management review, correct?

4 A Okay, yes.

5 Q Okay. Did you become aware of the
6 concern that there was confidential information in
7 Appellant's concurrence?

8 A Yes, I -- it was raised I believe in one
9 of our management review -- or one of my
10 management meetings, if I'm mistaken [sic].

11 Q Okay. And what did you understand the
12 issue to be?

13 A That in the concurrence there was
14 confidential information on the process, the
15 pre-decisional processes that we were undergoing
16 with the expansion of the panel.

17 Q So, would this be similar to what we've
18 just seen with respect to Mr. Arpin's draft?

19 A Yeah, it's all the same thing. It's
20 things that are pre-decisional that under FOIA
21 would never have been -- would never be allowed by
22 the Office of General Law to be out in the public.

1 And, you know, frankly, we always viewed it as,
2 you know, the panel is not expanded technically
3 until the decision goes out.

4 Q Okay. So, I'm going to ask you then to
5 go to page 599 of tab 7.

6 A Seven, 599.

7 Q And you've had an opportunity to review
8 this draft concurrence from Mr. Fitzpatrick?

9 A Is it this -- wait a second. Oh, this
10 is -- okay, this is --

11 JUDGE NIEDRICK: I'm sorry. Mr.
12 Horrigan, can you please give me the cite one more
13 time?

14 MR. HARRIGAN: Sure, 5-9-9 on tab 7.

15 JUDGE NIEDRICK: Thank you.

16 THE WITNESS: And so this is Michael's
17 concurrence to that -- was it the March timeframe
18 or is it May of 2018? Yeah.

19 BY MR. HARRIGAN:

20 Q Well, let's just -- the issue right now
21 is the highlighted language that you see in
22 yellow?

1 A Yes, 599, the panel was expanded, yep.

2 Q If you could scroll that from 599 to
3 602, that's where the highlighted language is
4 found, correct?

5 A Yes, that is.

6 Q You had an opportunity to review that?

7 A Yes, I did.

8 Q What is your opinion on whether that's
9 confidential information?

10 A It is confidential information until the
11 panel -- until the -- it's confidential
12 information, frankly, period. And the -- we
13 never, ever would have gone into any sort of
14 detail as to the expansion and, you know, who
15 decided what and who was at it and why, those
16 sorts of things would not have been something that
17 we wanted to put out that was pre- decisional
18 information, that was confidential.

19 Q Why should the public or the parties in
20 this case be made aware of this?

21 A I don't think there's any reason for
22 them to be made aware of this.

1 Q Okay. From your perspective is there
2 any concern about the parties' understanding, you
3 know, who's making decisions on their cases?

4 A Yes, it's important that they know who
5 makes the decision on their case and that's why
6 when the opinion is published they have the list
7 of the panel members.

8 Q Okay. And so then with that
9 understanding why do you keep this information
10 confidential here?

11 A Well, we keep the information
12 confidential just because, you know, again, things
13 can change. In a situation -- I mean, we have had
14 situations, if I'm not mistaken, where we have had
15 to change the membership of a panel prior to the
16 decision going out. And it's not until the final
17 decision goes out that you want to say that this
18 is essentially who decided your case.

19 Q Now, you're aware that that has changed,
20 correct?

21 A Oh, yes, and we supported that.

22 Q And who's "we"?

1 A So, one of the things that we had been
2 -- if you recall, the whole notion of precedential
3 and informative cases, the entire time that I was
4 up there we were trying to figure out how to make
5 that a more -- a smooth process and a more visible
6 process. And so that was something that we had
7 gone through many, many discussions with all of
8 the undersecretaries, the acting undersecretaries,
9 and Andrei in particular. And so when Andrei came
10 on board in February of 2018, we had proposed a
11 number of different options for revisions to SOP 1
12 and SOP 2.

13 And so that then took -- I mean, we
14 essentially -- that was one of his top priorities
15 and it was one of ours, too, frankly, that we
16 wanted to clear this up so that the public would
17 be made aware, that there would not be this
18 viewpoint that things were being done behind a
19 party's back, that there would be a lot more
20 transparency and visibility. And ultimately, I
21 mean, it took a long time, unfortunately, but, I
22 mean, that process started when I started in 2016

1 and then really got going when Andrei came on
2 board in February of 2018.

3 Q Okay. But in March 2018, when you
4 reviewed this document here with this highlighted
5 information, could this opinion have been
6 published in this form?

7 A No, I don't believe it could have.

8 Q Why not?

9 A This is not -- well, wait a second. Let
10 me -- I'm not sure if I'm understanding your
11 question. So, at the time --

12 Q So, I'm sorry, you reviewed this as part
13 of management counsel in March 2018, correct?

14 A Yes, I think that's right. Yes.

15 Q Okay. So, do you agree that this is
16 confidential information at that point?

17 A At this point, yes, it was.

18 Q All right. Could this opinion have been
19 mailed with this information in it?

20 A I would say no.

21 Q And the question is why then?

22 A This, again, goes to -- I'm just reading

1 the language again. That's why -- I just want to
2 make sure I'm understanding your question. So,
3 this goes to the pre- decisional processes that we
4 go through on the Board that are extraneous to the
5 merits of the case and doesn't necessarily impact
6 the outcome of the decision at all.

7 Q All right. So, let me ask you to turn
8 to tab 5, page 137.

9 A Okay.

10 Q All right. Let's -- I'm trying to get
11 to the close this, the timeline here, but we see
12 we're in April, April 20th, 2018?

13 A Okay.

14 Q And Scott Weidenfeller is sending out an
15 explanation. Do you see that?

16 A Oh, yes, to Josiah, yes, mm-hmm.

17 Q Okay. Do you recall what Bosch and Idle
18 Free had to do with this?

19 A Yeah. So, again, trying to implement
20 Aqua Products, which was decided back in October
21 of 2017, so now we're essentially six months in
22 and we're still trying to figure out how to

1 implement the Aqua Products decision. And so
2 there was a case called Bosch, which I think it
3 was an order or maybe it was a decision or maybe
4 it was an order, that we had decided to use as the
5 vehicle to formally get out interpretation of the
6 Aqua Products decision.

7 Q Okay. And we see that this email from
8 Mr. Weidenfeller is at 1:04 on April 20th, 2018,
9 correct?

10 A Yes, that's correct.

11 Q Okay. So, if we could then go to tab 6,
12 page 52. Okay. So, if we go down towards the --
13 just above Mr. Weidenfeller's section, Mr.
14 Fitzpatrick responds at 1:43. Do you see that?

15 A I'm sorry, say that again. All right,
16 143, yes. Yes.

17 Q Right.

18 A Michael's comments, yes, mm-hmm.

19 Q Okay. And what did you make of his
20 response here?

21 A Well, it was a little confrontational,
22 frankly, to put in there that "I do not agree with

1 the premise that such content may not be
2 disclosed, but I am agreeable to making the
3 edits," and then underlined, "if they facilitate
4 the prompt mailing of this decision." That can be
5 read as sort of a -- I don't want to say the word
6 "threat," but it's a pretty strong comment that I
7 will do something only if you -- only unless you
8 do this.

9 Q Okay. Did you understand from this
10 email that Mr. Fitzpatrick had removed the
11 confidential information from his draft
12 concurrence?

13 A I don't -- I wouldn't -- I don't recall
14 what draft was floating around at this point, but
15 it doesn't look like it probably was. It was
16 still in there.

17 Q Okay. All right. So, then let's go
18 back to tab 5, page 136.

19 A Okay.

20 Q All right. And Mr. Weidenfeller
21 provides more information. I'm sorry.

22 A Oh, this is the Bosch, yeah, okay.

1 Q Yeah, I'm sorry. Okay. Okay, just a
2 second, please. Okay. So, the point I wanted to
3 make here is on this statement from Mr.
4 Weidenfeller about, "The director's decision was
5 delivered to us orally at a meeting." So, we
6 talked about this a little bit, but -- or perhaps
7 a lot, but what is your understanding and then of
8 the director's involvement in this particular
9 matter?

10 A Well, he was very involved. It was on
11 his radar screen from the moment he walked in in
12 February. And, as I said, we had multiple
13 conversations, including one that I was walking
14 into the PTAB Bar Association Annual Meeting, the
15 first annual meeting, and I was late because
16 Andrei wanted to discuss this exact issue with the
17 Solicitor's Office.

18 And, again, it was the combination of
19 not only, you know, interpreting his
20 interpretation and his team's interpretation of
21 Aqua Products, how we would deliver that to the
22 Board and to the public, but then, you know, it

1 also says there in the next piece there where the
2 panel has drafted an order that would replace Idle
3 Free, allowing it to be de- designated. So, that
4 also -- there was a lot of moving parts that we
5 had to make sure in order to get -- implement the
6 new undersecretary's policy decisions.

7 Q Okay. Let me ask you to turn to tab 7,
8 656 at the bottom, into 657.

9 A Six fifty-six. Okay.

10 Q All right. And we see the date here is
11 April 30th, 2018, correct?

12 A I'm sorry, am I on the right page? I
13 see --

14 Q So, the email's broken between --

15 A -- 2018 --

16 Q The email's broken between 656 and 657.
17 Do you see that?

18 A Okay. Okay.

19 Q At the very top -- at the very bottom of
20 656 we see the header for an email from Mr.
21 Fitzpatrick? You see that?

22 A Yes, I see that.

1 Q And the date is April 30th, 2018,
2 correct?

3 A Yes. Correct, yes.

4 Q Okay. And the text of the e-message is
5 on the following page, 657, right?

6 A Yes.

7 Q Okay. And so I'm referring you then to
8 Mr. Fitzpatrick's message. What do you understand
9 him to be saying here?

10 A The -- this was the April 30th, 2018, at
11 4:38, is that right?

12 Q Correct, yes.

13 A Yes. I think he's just asking for a
14 status update.

15 Q Okay. And so we see at the -- you
16 responded on 656. Okay. I have not had a chance
17 to look at your edits, so why don't you explain
18 what's going on there?

19 A Oh, yeah, so then I responded, right. I
20 had not looked at -- apparently, Michael had put
21 edits into the concurring opinion. And, oh, yeah
22 so this is actually -- this is April, right.

1 There was a conference in Korea with the chief
2 judges of the five international IP offices, so
3 the U.S., EPO, European Patent Office, Korea,
4 Japan, and China. So, this was a big conference
5 that we were invited to. And I attended on behalf
6 of the PTAB.

7 And, simultaneously, that was actually a
8 lot of travel happening at that point as well, but
9 also at the point, yeah, "Just returned yesterday
10 to deal with SAS." So, if you recall, we
11 mentioned -- we talked about Oil States. There
12 were -- but that was only one opinion that had
13 gone up to the Fed -- or to the Supreme Court.
14 The other one was SAS, S-A-S. So, we had two
15 cases pending up at the Federal Circuit -- or,
16 sorry, up at the Supreme Court that were
17 game-changers.

18 Again, the Oil States decision dealt
19 with the constitutionality of the PTAB itself.
20 SAS dealt with when a petition is made are we free
21 as a Board to pick and choose which claims and
22 which grounds to move forward with on a trial?

1 And so in advance of those two decisions we were
2 very, very focused on coming up with scenario
3 planning and putting plans in place because we
4 wanted to be able to turn on a dime when these
5 decisions came down. So, if we were found
6 unconstitutional or if we had to deal with all of
7 the implementations of SAS, meaning instead of
8 being able to pick and choose smaller subsets of
9 grounds and claims, that we would have to deal
10 with everything.

11 So, that was what was on Andrei's mind.
12 That was what was on our mind for the last two
13 months. I had gone to Korea and while I was gone,
14 those two decisions came down. Oil States came in
15 our favor, which did not require us to make any
16 set changes, but SAS did not. SAS required us to
17 implement a policy and procedural changes very,
18 very quickly to implement that appropriately. And
19 it increased our workload enormously because we
20 were required to look at everything that was
21 raised in the petition.

22 Q All right. So, then we're on 656 at the

1 top, the last piece of this chain.

2 A Okay.

3 Q All right. And so let me first refer
4 you -- well, you see that it's May 10th, 2018,
5 correct?

6 A Yes.

7 Q And so Mr. Fitzpatrick starts off
8 referring to a conference call on May 7th.

9 A Okay.

10 Q Do you recall that happening?

11 A We had one or two conference calls. I
12 think we had one when the panel was originally
13 expanded and then I do remember another call and
14 it might have been this one. I'm not really sure.
15 There might have been a third one as well.

16 Q Okay. And then he continues, referring
17 to you, "You stated that the decision on remand
18 will not go out so long as I continue to discuss
19 panel expansion in my concurring opinion, my view
20 that it was not authorized by statute or by the
21 director, and it was contrary to 35 U.S.C. 6316
22 and 318." Is that what happened?

1 A That's not my recollection at all.

2 Q What is your recollection?

3 A I thought at this point, based on what
4 we -- the documents that we were looking at, what
5 we were talking about was the confidential
6 information that we were discussing just a few
7 minutes ago that was in that -- the highlighted
8 confidential information.

9 Q Do you recall having a discussion with
10 Mr. Fitzpatrick about his argument about the view
11 that it's not authorized, the expansion wasn't
12 authorized?

13 A I may have, I don't remember. I do
14 remember that I think this might have been the
15 call -- we had a call where Michael was very, very
16 agitated and he raised his voice to me in
17 particular, but also to Scott B., Scott Boalick.
18 And it -- I'm not sure if this was that call where
19 that happened or not. I know he was very
20 frustrated. I know Jim Arpin was very frustrated.
21 We wanted to get this opinion out, but it wasn't a
22 matter of us trying to delay this unnecessarily.

1 As I hopefully mentioned, that there was a lot of
2 moving parts, particularly at this point when
3 Andrei had come on board.

4 Q Okay. Now, on May 7th, during this
5 conference call, were you aware that Mr.
6 Fitzpatrick had taken the confidential information
7 out of his concurring opinion?

8 A I have no idea. I don't recall if I had
9 looked at the latest draft or not.

10 Q Well, had there been a draft since -- we
11 -- the March one we'd seen?

12 A There must have been, yes.

13 Q And how would that have come to your
14 attention?

15 A Again, if -- it probably would have gone
16 through -- let's see, this is to -- please send to
17 management review. I'm not sure if it would have
18 gone through the ARC committee or if it would have
19 gone directly to management. So, it would have
20 gone through to Scott Boalick and the vice chief
21 judges. I'm not sure which route it went to.

22 Q Okay. But I'm talking about you in

1 particular. We just had a discussion about you
2 being out of the country for a while, so I'm just
3 -- that's what I'm trying to get to is what were
4 you aware of on May 7th?

5 A Oh, it would have just been whatever had
6 been raised to me by Scott Boalick and the vice
7 chiefs that had reviewed the decision and maybe
8 some of the ARC members.

9 Q Okay. And so, again, on May 7th, during
10 this conference call were you aware that that
11 confidential information was still in there or it
12 had been taken out or what?

13 A My understanding was that it was still
14 there.

15 Q Okay.

16 A Yeah, because that was the issue ---
17 it's -- you know, again, based on what Jim had
18 first put in there, I know -- I'm not sure if it
19 was this conference call as well, but I -- there
20 was a status conference that the original panel
21 had with the parties. And I remember that the
22 panel, the APJs, had wanted to disclose to them,

1 to the parties, at that time that the panel had
2 "been expanded" and that that was the reason for
3 the delay. And because the panel -- or because
4 the parties never asked, they did not disclose
5 that confidential information during that
6 conference call with the parties. So, in my mind,
7 this was all about confidential information being
8 disclosed.

9 Q Okay. And so we see, you know, this is
10 May 10th. What's the status of the remand
11 decision in Nike?

12 A It's still going through draft phase it
13 looks like, that there's still -- there still
14 needs to be -- you know, I'm not sure if I had
15 totally reviewed the concurring opinions and
16 modified the majority opinion accordingly yet.

17 Q Okay. And so let me move you forward in
18 time by looking at page 673 of this same tab,
19 which is tab 7.

20 A Six seventy-three, okay.

21 Q All right. And so we see that Mr.
22 Fitzpatrick has been removed from this case,

1 correct?

2 A That's what that email is, yes.

3 Q And did you have any involvement with
4 this?

5 A No, I did not.

6 Q Now, in fact, Mr. Fitzpatrick was
7 removed on May 30th. Are you aware of that now?

8 A I'm aware of it now. I wasn't aware of
9 it then.

10 Q And can you explain that?

11 A Again, my role is to expand the panels.
12 I had delegated all authority on the composition
13 of the panels to the administrative side of the
14 Board. We had folks that were -- their whole
15 purpose in life is to panel the decisions,
16 primarily based on technology, but also based on
17 workload and availability and, of course,
18 conflicts. That's what their job was. So, I did
19 not get involved with the day-to-day paneling.
20 Frankly, that was just something that I just -- it
21 was not on my radar screen whatsoever.

22 Q Did you tell Mr. Boalick to remove Mr.

1 Fitzpatrick from this panel?

2 A No, I did not.

3 Q All right. Then let's go to tab 32,
4 page 14.

5 A Thirty-two, 14?

6 Q Correct.

7 JUDGE NIEDRICK: Mr. Horrigan, I'd like
8 to take like a five-minute break at some point.
9 So, whenever you feel it's a good time to sort of
10 break, just let us know. Okay?

11 MR. HERRIGAN: Yeah. Let me just close
12 out Nike and then I think that would be a good
13 time.

14 JUDGE NIEDRICK: Okay. Thanks.

15 BY MR. HERRIGAN:

16 Q All right. So, Mr. Ruschke, we're
17 looking at the final decision in the Nike remand
18 decision, correct?

19 A It looks to be that, yes.

20 Q Okay. And then we see that this is a
21 three-judge panel, correct?

22 A That's correct.

1 Q Do you know what happened? Do you know
2 why this was issued by a three-judge panel?

3 A I do not. The date is September 18th
4 and I moved into my new position I believe it was
5 September -- the first week of September of 2018.

6 Q And do you recall who unexpanded the
7 panel?

8 A No, I don't actually. It probably would
9 have been me.

10 Q And so if you don't recall doing it, I'm
11 sure you don't recall why, but just to ask the
12 question, do you recall why you unexpanded the
13 panel?

14 A Yeah, I mean, again, my role was to
15 expand and then unexpand under SOP 1. That was
16 the power of the chief judge. I think because at
17 that point, frankly, the issues for the reasoning
18 for expanding the panel in the beginning had, you
19 know, lots of machinations going, you know, via
20 the Fed Circuit's en banc decision and Aqua
21 Products. The order coming out in Bosch, the new
22 director's policy determinations on this very,

1 very issue, and the de-designation of Idle Free,
2 at that point there wasn't a need to expand the
3 panel at that point to handle that issue of
4 exceptional importance under SOP 1.

5 Q Okay. And on Idle Free, Mr.
6 Fitzpatrick's attorney has insinuated there's a
7 relationship between Mr. Fitzpatrick being removed
8 from AIA cases and the decision to de-designate
9 Idle Free as informative. What is your opinion of
10 that contention?

11 A I am not aware of anything that would
12 support that, nothing.

13 Q Was there any relationship as far as you
14 knew?

15 A None.

16 MR. HARRIGAN: All right. Judge, this
17 would be a time.

18 JUDGE NIEDRICK: Okay, great. Why don't
19 we take a five-minute break unless somebody needs
20 a longer. We'll come back at 10:35. Everybody
21 good with that? Okay.

22 Ms. Dawson, if we could go off the

1 record for five minutes and we'll come back on at
2 10:36.

3 COURT REPORTER: We are off the record
4 at 10:31 a.m.

5 (Recess)

6 COURT REPORTER: We are back on the
7 record at 10:36 a.m.

8 JUDGE NIEDRICK: Thank you. And we're
9 going to continue with Judge Ruschke's testimony.
10 Please remember, Judge Ruschke, you're still under
11 oath.

12 THE WITNESS: Understood.

13 BY MR. HERRIGAN:

14 Q All right. You are aware that that
15 Appellant claims that your expansion in the panel
16 in Nike was illegal, correct?

17 A Correct.

18 Q Was it illegal?

19 A No.

20 Q Okay. You mentioned Alappat previously.
21 Why don't you explain what your understanding of
22 what Alappat is about?

1 A Alappat was a case that was decided en
2 banc at the Federal Circuit in the mid-'90s, I
3 believe. And it addressed this issue of the
4 authority of -- at the USPTO to hear cases
5 underneath expanded panels. Now, again, remember
6 that at this point AIA had not been passed, so
7 this was underneath the old name. Instead of
8 being the PTAB, it was the Board of Patent Appeals
9 and Interferences, the BPAI. So, but it was the
10 predecessor board to the PTAB.

11 Q Okay. And what is your understanding of
12 the holding as it relates to the panel expansion?

13 A The holding was that panel expansion was
14 legal and approved and there was nothing
15 circumspect or illegal about it.

16 Q Okay. And what understanding do you
17 have of the constraints that the Federal Circuit
18 put on your ability to exercise that authority?

19 A I don't think there were any constraints
20 that they put on the PTO.

21 Q Now, you mentioned that this was
22 pre-AIA. Did something change after AIA on that

1 score?

2 A Not on this issue, no.

3 Q Are you aware of any holding from the
4 Federal Circuit or the Supreme Court which
5 constrains the authority of the director or of the
6 chief judge to expand a panel?

7 A No, there's been no change, no
8 constraint.

9 Q Okay. Let's then -- I'm going to take
10 you to MPEP 1002.02(f), which you will find at tab
11 32, page 161. So, are you familiar with this?

12 A Yes, I am familiar with the MPEP.

13 Q Okay. And what do you understand the
14 MPEP to be?

15 A The MPEP is a very, very large document
16 and it's a compilation of the policy at the USPTO
17 reflecting, as detailed as a way as possible, how
18 we are going to be implementing statutes, rules,
19 and case law that affect all matters in front of
20 the USPTO.

21 Q And what do you understand section
22 1002.02(f) to be doing?

1 A This is, again, it looks like it's a
2 delegation provision. So, while statutes might
3 put all of the authority, if you will, in charge
4 of -- you know, in essentially one person's
5 bucket, that is never the case and is typically --
6 it's just -- it would be unworkable for that to
7 happen. And so, of course, there has to be
8 delegations and then redelegations as necessary.
9 So, this would have been the delegation to me to
10 decide these issues. And then it looks like is
11 authorized also to redelegate to the -- any of
12 this -- any of the work down to the Executive
13 Committee, the lead judges, as well as the APJs
14 themselves.

15 Q Okay. And who is delegating this to
16 you?

17 A This would be the political appointee,
18 the director.

19 Q Okay. And so let's --

20 A Or the undersecretary.

21 Q Okay. Let's scroll down to paragraph 3
22 of this section.

1 A Okay.

2 Q And what do you understand that to be
3 doing with respect to AIA cases?

4 A So, this would be the delegation to
5 panel all of the cases that are appearing before
6 the PTAB.

7 Q You are aware that the director's
8 authority to staff panels is found at 35 U.S.C.
9 6(c), correct?

10 A Yes, I am.

11 Q To what -- what is your understanding of
12 the relationship between the director's authority
13 under that statute and this delegation we see
14 right here?

15 A Well, it's the direct consequence of the
16 statutory delegation. Then the policy of the PTO
17 longstanding has been that that is going to be
18 delegated to the chief judge of the PTAB.

19 Q To what extent do you believe that the
20 director is constraining your authority here in
21 section 1002.02(f)?

22 A Certainly, I don't see any constraint

1 here in the MPEP. And in practice that never,
2 ever happened.

3 Q And we've talked about SOP 1. Did you
4 understand there would be any constraints on your
5 authority there?

6 A No, not at all.

7 Q All right. So, then let's go to tab 7,
8 page 391. Okay. We've already looked --

9 A Okay.

10 Q -- at this draft once. This was, just
11 to be clear, though, was going to be issued under
12 your name, correct?

13 A Yes, this would have -- yes, exactly.

14 Q Okay. And then if we go to 425 we see
15 Mr. Fitzpatrick's draft concurrence, correct?

16 A Hold on. Yes, okay.

17 Q Okay. Now, give us your philosophy on
18 concurrences generally.

19 A So, yeah, one of the things that the
20 PTAB had discussed is why with all of the judges
21 and all of the issues out there, there's very few
22 concurrences and dissents? And, again, as I said

1 before, part of that was that the three-judge
2 panel, if somebody wasn't comfortable with
3 something in the majority opinion, there would be
4 a back-and-forth conference, potentially just by
5 email, potentially by draft, by editing draft,
6 line edits, if you will. And things would be
7 changed and then the person that was feeling
8 uncomfortable with joining the majority opinion
9 would join. And so -- and that's all well and
10 good.

11 But particularly on issues where there
12 was -- there wasn't like settled case law or a lot
13 of the -- again, the procedural issues that we
14 were dealing with at the PTAB in its early years,
15 a lot of those issues had never, ever been
16 decided. And so I actually encouraged folks to
17 put out concurring and dissenting opinions to
18 flesh out the issue.

19 Because, ultimately, what we really
20 wanted to do, and we said this over and over
21 again, is if we don't decide the issue uniformly
22 amongst us and we don't have direct policy

1 guidance from the director or the undersecretary,
2 our best source is ultimately going to be the Fed
3 Circuit. So, let's try to frame the case as much
4 as we can so that when it goes up on appeal, the
5 Fed Circuit will see that we have looked at all of
6 the issues from all different sides, hopefully
7 have a concurrence or a dissent with an
8 alternative viewpoint, and then the Fed Circuit
9 can decide.

10 Q Okay.

11 A And that's actually exactly what
12 happened. One of the biggest issues we ever did
13 -- well, there's two issues that we did. One was
14 on joinder and another issue was on sovereign
15 immunity. And in both of those cases we had a lot
16 of varying opinions on how those should be
17 handled. And ultimately, we wanted to frame those
18 as best we could to go up to the Fed Circuit, so
19 that we could get a decision. But ultimately, of
20 course, that takes a lot of time. You can't just
21 as the Fed Circuit for an opinion. You've got to
22 get the case ready for them to review.

1 Q Did that philosophy apply any
2 differently to this particular draft concurrence?

3 A No.

4 Q Okay. So, let's go to page 434 of this
5 same tab, which is tab 7.

6 A Four thirty-four, okay.

7 Q Have you had an opportunity to review
8 sections 4 and of this draft concurrence?

9 A I do believe I did, yes.

10 Q What do you think of the argument
11 generally?

12 A I don't think it's well-founded. I
13 think it's contrary to In re Alappat. It is
14 certainly contrary to longstanding practice at the
15 USPTO following In re Alappat.

16 Sorry, is there -- I feel like I'm
17 hearing a noise.

18 JUDGE NIEDRICK: Yeah, it sounds like
19 there's a vacuum or something going.

20 THE WITNESS: Okay. If you can hear me,
21 I should still keep going, Administrative Judge?

22 JUDGE NIEDRICK: Yeah. Let's just see

1 if we can figure out where it's coming from.

2 Okay, hang on one sec.

3 There, it seems to have stopped.

4 THE WITNESS: Okay.

5 JUDGE NIEDRICK: Okay. If you could
6 please proceed, Judge Ruschke.

7 THE WITNESS: Thank you.

8 MR. HERRIGAN: Okay. So --

9 THE WITNESS: Yeah, go ahead.

10 BY MR. HERRIGAN:

11 Q Okay. So, let me pose a question for
12 you. So, what is your opinion on whether it was
13 appropriate for Mr. Fitzpatrick to put this
14 discussion into a concurrence?

15 A Appropriate. I didn't think it was
16 correct, but I -- you know, on the sovereign
17 immunity issue I didn't think some of the panel's
18 decisions were correct either, but it was an issue
19 to get out there to be discussed. And, of course,
20 in the sovereign immunity context that was
21 something that hadn't been decided, whereas with
22 this situation, you know, the issue was decided by

1 an en banc Federal Circuit opinion 25 years or 20
2 years previous. And it was settled case law,
3 settled policy, but it was his opinion. It wasn't
4 going to be the Board's opinion. It wasn't going
5 to be the USPTO's opinion. It was going to be his
6 opinion. His name solely appeared on it, so
7 that's what he wrote.

8 Q Did you have any objections to the
9 Appellant publishing these two sections of this
10 draft concurrence?

11 A No, it would have gone out the way it
12 is.

13 Q Aside from that --

14 A As long as --

15 Q I'm sorry.

16 A Yeah, as long as the confidential
17 information was removed, I would have been fine
18 with it.

19 Q Okay. What steps did you take to keep
20 this from being published?

21 A I didn't take any steps from it being
22 published.

1 Q All right. So, back in 2018, how
2 closely would you say you read this concurrence?

3 A I'll e honest, the scheduling and --
4 and, again, we're talking -- you were -- this is
5 September of 2018? Or what was the date of this?

6 Q This would be in March/April timeframe.

7 A Oh, March/April. Yeah, again, that was
8 that -- you know, again, Andrei had come on board,
9 we were doing the Korean travel, we were doing the
10 two Supreme Court opinions, getting together our
11 policies for implementing all different sorts of
12 outcomes. I probably did not read this very
13 carefully and would have relied very heavily on my
14 team to read the decisions and to provide me
15 advice. And if they came up with some advice, I
16 would have almost certainly gone along with it.

17 Q But you've since had an opportunity to
18 review these two sections, is that right?

19 A Yeah, I have in getting ready for this
20 -- I wanted to -- you know, as I was reminding
21 myself of the different versions of the opinion as
22 it went through over time.

1 Q Okay. And so looking at section 4, do
2 you see that the Appellant is arguing that the
3 director did not have -- did not delegate his
4 authority to expand panels to you in MPEP
5 1002.02(f)?

6 A Yes, I see that.

7 Q What is your opinion on the merits of
8 that argument?

9 A I think it is completely incorrect based
10 on In re Alappat.

11 Q Okay. And so to your understanding what
12 affirmative law is the Appellant claiming was
13 violated in the expansion of the panel?

14 A I don't think he -- well, I don't think
15 he -- well, it looks like he's alleging -- well,
16 he's citing 35 U.S.C. 6, he's citing MPEP
17 1002.02(f).

18 Q Well, to your understanding is there
19 anything in -- I'm sorry.

20 A No, go ahead.

21 Q To your understanding is there anything
22 in 35 U.S.C. 36(c) that prohibits the director

1 from expanding a panel?

2 A No, there isn't.

3 Q Okay. And so in section 5 he's arguing
4 that the director did not -- that the director did
5 not delegate this -- the authority -- (inaudible)
6 me, that the director himself did not have that
7 authority to expand the panel.

8 A Okay.

9 Q Do you recall that?

10 A Yes, and I see it now.

11 Q Okay. And what is your opinion of the
12 merits of that argument?

13 A I don't think that has any merits.

14 Q To your understanding, having read this,
15 is the Appellant arguing that the director
16 violated some law?

17 A Yes.

18 Q What?

19 A 35 U.S.C. 6(c).

20 Q But, again, is there anything into it,
21 35 U.S.C. 6(c), which would prohibit the director
22 from expanding a panel?

1 A Nothing.

2 Q Are you aware of any precedential case
3 that would constrain the authority -- the ability
4 of the director to expand the panel in the Nike
5 case?

6 A None.

7 Q In your opinion as an expert in
8 intellectual property law and the authorities of
9 the PTAB, do you have an opinion on whether a
10 reasonable person with Appellant's education,
11 background, and experience could believe that the
12 expansion of the panel violated some affirmative
13 law or precedential case?

14 A No, I don't think it's a reasonable
15 position based on the statutory language, the
16 MPEP, and the case law, precedential cases out
17 there.

18 Q Do you believe that such a reasonable
19 person could conclude that you or anyone else
20 abused authority in expanding the panel in the
21 Nike IPR remand decision?

22 A No, I don't believe a reasonable person

1 would.

2 Q If the draft concurrence had published,
3 to what extent would it have reflected the
4 position of the PTAB or of the USPTO?

5 A It wouldn't have. As I said before,
6 concurrences and dissents go over the heading of a
7 single judge.

8 Q To what extent did you believe the
9 Appellant's concurrence in the Nike IPR was an
10 embarrassment to the Board or to the USPTO?

11 A Well, it wasn't an embarrassment. It
12 was just his opinion. As faulty as I thought it
13 was, and I think, you know, based on the existing
14 practice and In re Alappat, I think reasonable
15 people would disagree with it. But he's entitled
16 to his opinion.

17 Q To your understanding to what extent was
18 Appellant's arguments in section 4 and 5 of his
19 draft concurrence a reason why he was removed from
20 AIA panels?

21 A I think there's no relationship
22 whatsoever.

1 Q Okay. Can I ask you to turn -- I think
2 we're still in tab 7, go to page 768.

3 A Seven sixty-eight.

4 Q All right. And you'll see an email
5 chain there.

6 A Okay.

7 Q Are you familiar with this email chain?

8 A Let me take a quick look.

9 Q Sure.

10 A Yes, uh-huh.

11 Q Okay. So, we see that basically Mr.
12 Fitzpatrick is arguing that the deputy solicitor
13 general misrepresented the facts to the Supreme
14 Court during oral argument in Oil States. Do you
15 see that?

16 A Yes, I do see that.

17 Q Do you have an opinion on the accuracy
18 of his claims here?

19 A I don't believe that any
20 misrepresentation was made at the Supreme Court.

21 Q And what leads you to that conclusion?

22 A Well, I was there, actually. And, of

1 course, it was very important for us to hear both
2 this and SAS was argued on the same day.

3 A little bit of an aside, I mean, the
4 thing that I recall about the argument was Chief
5 Justice Roberts making a comment when Mr. Stewart
6 made a comment about the chief judge of the PTAB.
7 And Chief Justice Roberts piped up and said, oh,
8 are you talking about the USPTO employee? So,
9 that was my one, you know, three seconds of fame,
10 I guess, before the Supreme Court.

11 So, that's what -- you know, again,
12 that's with something that's -- I know it's a
13 little bit anecdotal, of course, but this was not
14 something that was even on my radar screen that
15 somehow this was an incorrect statement at all.

16 Q Well, when Mr. Fitzpatrick brought this
17 to your attention what did you think of it?

18 A Well, you know, I said -- you know, I --
19 actually, I think I went back and looked at the
20 transcript because I was looking at the transcript
21 anyway just to make sure I didn't miss anything
22 that I was looking for, frankly, that we would

1 have to implement as the result of Oil States.
2 And I -- you know, this is something that I would
3 have delegated to the team to track down and say
4 is there -- you know, is there something here that
5 we need to look at? And then the team would have
6 taken it and run it to ground on my behalf.

7 Q Okay. And so you understand that Mr.
8 Fitzpatrick is saying that the Nike expansion
9 should have factored into either the
10 back-and-forth between the Chief Justice and Mr.
11 Stewart or that next sentence, right?

12 A I believe --

13 Q Do you understand that's what he's
14 saying?

15 A I think that's what he's saying. And,
16 again, I'm not sure which -- you know, the problem
17 is that, you know, when you talk about this, what
18 was the -- on the three occasions, you know,
19 again, it's like what three occasions are you
20 talking about? And, again, because our -- the
21 Nike case was still fluid and it was still being
22 decided. And at the time our expansion of the

1 panel was not something that we announced publicly
2 until the decision actually issued. So,
3 technically, it had not been expanded at that
4 point.

5 Q To what extent do you understand that
6 Mr. Fitzpatrick's allegations here contributed to
7 him being removed from AIA cases?

8 A I don't think it had any relationship
9 with him being removed.

10 Q Appellant claims that in May 2018, USPTO
11 Director Andre Yanko voiced a desire to USPTO
12 management to terminate him, and the threat was
13 conveyed to him through intermediaries. Did you
14 ever hear Mr. Yanko make such a statement?

15 A I never heard Andre say anything of the
16 sort.

17 Q Did you ever hear anyone else suggest
18 such a thing?

19 A Never.

20 Q If somebody had wanted to make an effort
21 to remove Mr. Fitzpatrick, would you have been
22 aware of it?

1 A Not necessarily.

2 Q Okay. Are you aware of anybody taking
3 any action to remove him?

4 A No.

5 Q All right. So the SOP one revision
6 we've talked about. You recall that?

7 A Yes, I do recall.

8 Q And that would -- that actually was
9 finalized after you left, correct?

10 A Yes, essentially, just as I was leaving
11 to take the new position.

12 Q Okay. Mr. Fitzpatrick's attorney
13 insinuated there's a relationship between the
14 timing of the decision in Nike and the revision to
15 SOQ1. What is your opinion of that?

16 A You know again it -- I don't think
17 there's any relationship to that whatsoever. And
18 so things were working through the system as they
19 work through the systems and as they needed to be
20 coordinated, they were needed to be coordinated.
21 But this was I don't remember, there was -- in my
22 mind, again, I was transitioning out at that point

1 trying to get a lot of things transitioned over to
2 the acting. And so at that point, I certainly
3 don't think there was any relationship whatsoever.

4 Q All right. Thank you. That's my --
5 that's all my questions.

6 A Okay.

7 JUDGE NIEDRICK: Great. Thank you very
8 much, Mr. Horrigan. Who's going to conduct the
9 cross examination?

10 MR. KAPPERS: I will, Your Honor.

11 JUDGE NIEDRICK: Okay, great. And
12 that's Mr. Kappers. Mr. Kappers, your witness.

13 CROSS-EXAMINATION

14 BY MR. KAPPERS:

15 Q Ruschke, if you could turn to tab 5 at
16 page 221. Let me know when you're there.

17 A 221. Hold on.

18 Q That's right.

19 A Okay.

20 Q And this is an email from Judge Mitchell
21 to Judge Fitzpatrick dated April 19th. Is that
22 right?

1 A It looks to be.

2 Q Okay. In this email, she references
3 what management has identified as confidential
4 information in your concurring opinion. Did I
5 read that right?

6 A It looks to be, yes.

7 Q All right. Now turn to page 261 of tab
8 5. And this is a portion of Judge Fitzpatrick's
9 concurring opinion with highlighted material. I
10 believe you, you looked at this earlier. Is that
11 right?

12 A I remember saying this earlier. Again,
13 there was a lot of drafts going back and forth.
14 So I just want to try to figure out which one this
15 is. Okay. This is Michael's concurrence in May.
16 Is that what it is?

17 Q Yes. Maybe I can help you out. Turn
18 back to page 256.

19 A Okay.

20 Q March. It's March 2018, and it's Judge
21 Fitzpatrick's concurring opinion. Is that right?

22 A Yes. Looks to be.

1 Q All right. Now turn back to page 261.

2 A Yes.

3 Q I believe you said that this highlighted
4 material in 261 was confidential pre decisional
5 information. Is that right?

6 A Yes, I believe that's what I said. Yes.

7 Q And the reason you gave was because
8 things might change before the final draft goes
9 out. Is that right?

10 A I think it was one of the reasons that
11 it's confidential. Yes.

12 Q Okay. But once this goes out, things
13 wouldn't change. So it wouldn't need to be
14 confidential. Is that right?

15 A Potentially.

16 Q Okay. Now, some of the agency witnesses
17 have described this information as deliberative,
18 process, privileged. Do you agree with that?

19 A Well, I would. Yeah, I would. I think
20 you said it that way. I think I was calling
21 things, you know, pre decisional. I think they
22 might be the same.

1 Q Okay, so when you say pre decisional,
2 you're referring to this deliberative process
3 privilege that might be asserted by the PTO.

4 A I would guess so.

5 Q Okay. And in -- When this when this
6 concurring opinion was drafted, the SOP1 that you
7 walked through did not require notice to the
8 parties of panel expansion. Is that right?

9 A I believe that's correct.

10 Q But later, the SOP1 was revised and now
11 it requires notice to the parties of panel
12 expansion. That sound right?

13 A Yes. That's what we had been working on
14 with Andre, since February of that year.

15 Q Okay. And what's the reason for giving
16 notice to the parties of penal expansion?

17 A Well, one of the things that we'd always
18 wanted to do, not only with this issue, but with
19 all issues and this is you know, with my
20 experience now on the patent side of the House is
21 transparency to the public. So this is something
22 that's very, very important. And we try to do

1 this on examination of patents, for instance,
2 where we try to put things out there so that the
3 public knows what to expect and that they're going
4 to be treated fairly and consistently.

5 Q So transparency to the parties and the
6 public is important. Is that right?

7 A Yes, it is important. You know, within
8 the confines of you know, as we said, like when
9 I'm thinking in particular of things that are in
10 the draft form where there is a, you know, a
11 something that's potentially going to change or
12 that hasn't been put in stone. You know, certainly
13 under FOIA, it's the same thing, the pre
14 decisional what you were calling pre decisional
15 privilege. That is something that's used not to
16 issue something to the public.

17 Q And the current Chief Judge, Bolek, told
18 us that after the revision to the SOP one, there
19 was a waiver of that pre decisional information as
20 it relates to the issue of penal expansion and
21 IPRs. Do you agree with that?

22 A I'm not familiar with that at all.

1 Q Okay. So would you agree, though, that
2 SOP1, now that it's revised to provide for notice
3 to the parties of penal expansion, has waived any
4 privilege with respect to that particular issue?

5 A That it would be. I'm not trying to
6 avoid your question, Mr. -- Is it Kappers? I
7 really can't comment on that. I am not that
8 familiar with the revised SOP1 as it presently
9 issued is how it's being implemented.

10 Q Okay. Do you know if any waiver of
11 privilege apply to the penal expansion that
12 occurred in the Nike IPR?

13 A I am again unfamiliar with this. The
14 use of your term waiver.

15 Q Okay. Jodorowsky turned to tab 7 at
16 page 256.

17 A 256?

18 Q Yes, this is the May 10th email from
19 Judge Fitzpatrick to you. And he CCs Judge
20 Bullock, Judge Cox and Judge Arfin.

21 A I'm sorry. What's tab number, you said
22 seven?

1 MR. KAPPERS: I'm sorry. Tab 7 and page
2 256.

3 JUDGE NIEDRICK: Yes, I don't think
4 that's the right citation. That's the -- sort of
5 the middle part of a decision.

6 THE WITNESS: Yes, that's what I'm
7 coming up.

8 BY MR. KAPPERS:

9 Q I'm sorry. I misspoke Judge Ruschke,
10 tab 7 at 656. Can we try that?

11 A Okay. Hold on.

12 JUDGE NIEDRICK: Thank you. That's it.

13 BY MR. KAPPERS:

14 Q Okay.

15 A I'm there.

16 Q Okay and this concerns a -- the May 7th,
17 2018 call between you and the rest of the Nike IPR
18 panel. Is that right?

19 A Yes, it looks to be.

20 Q And do you agree with how Judge
21 Fitzpatrick memorialized the call on May 7th?

22 A You know, again, we had a few calls, and

1 I do not recall that this is an accurate
2 representation of what we discussed now.

3 Q Do you remember having the call?

4 A Yes, as I said, I think I -- you know,
5 again, I remember the call when we first expanded
6 the panel and we discussed, you know, about where
7 we were generally on viewpoints, just sort of
8 generally, again, that the result wasn't going to
9 change, but the reasoning might change and was
10 going to be focusing on the merits as opposed to
11 procedural issues. I remember that call and we
12 were just sort of in limbo about whether we were
13 going to because nothing had been written at that
14 point. This one, if I'm remembering correctly,
15 this was the call again where I mentioned that
16 there were voices that were raised.

17 Michael was very agitated. He did yell
18 at me and my team and he was heard by the staff
19 outside in the hall. And I knew he was going
20 through some issues with his family, so I wanted
21 to give him a pass on all of that. So I don't
22 recall, though, that the issue here had anything

1 to do with expansion. The issue for me again was
2 the confidential pre decisional information in the
3 opinions, that was that was what my focus was.
4 That is what my team had told me that needed to be
5 removed. And if that were going to be removed,
6 then I thought we were going to be able to move
7 forward.

8 Q Okay. But as of May 7th, when that call
9 occurred, Judge Fitzpatrick had already removed
10 that confidential information. Is that right?

11 A I don't recall that. In fact, I don't
12 think so. I wasn't aware of that.

13 Q You weren't aware of that? Turn to tab
14 5 at 305. Judge Ruschke, this is a voicemail that
15 Judge Weidenfeller left Judge Fitzpatrick on April
16 20th. I'm going to play it for you. Hi, Michael.
17 It's Scott Wheaton fellow. I was just calling
18 first to thank you for making the edits that you
19 made yesterday when -- in response to Susan's
20 requests and you can ignore this message. Did you
21 recognize Judge Weidenfeller's voice?

22 A Yes, I did.

1 Q Okay, so on -- as of April 20th, Judge
2 Fitzpatrick had removed confidential information
3 from his opinion. Is that correct?

4 A Again, I have no knowledge of whether
5 that happened or not.

6 Q Okay. Well, let's turn back to tab 7 at
7 656, which is the May 10 email.

8 A Okay.

9 Q And so is it your testimony today that,
10 Judge Fitzpatrick on May 7th just had a
11 misunderstanding of what occurred on that call.

12 A Well, yes, I think that's what it seems
13 like to be to me. I mean, he's -- yes, I don't
14 have any memory of telling him that I dealt with
15 the issue with the decision would not issue
16 because of his expanded panel discussion.

17 Q Well, let's look at that first
18 paragraph, that first sentence. Judge Fitzpatrick
19 says, I was disappointed that during the May 7th,
20 2018 conference call among the expanded panel
21 members, you stated that the decision on remand
22 will not go out so long as I continue to discuss

1 panel expansion in my concurring opinion. Did I
2 read that, right?

3 A Yes, that's what's written there.

4 Q And that has nothing to do with
5 confidential pre decisional information, correct?

6 A No, that's not what he put down.

7 Q All right. And turn to the third
8 paragraph there. He says, during the call, you
9 asserted that you have an opinion from the Office
10 of General Law opining that the panel's expansion
11 was, quote, completely legal. Did I read that
12 right?

13 A You read it correctly.

14 Q Okay. And that paragraph doesn't have
15 anything to do with confidential pre decisional
16 information in his concurring opinion, right?

17 A No, it doesn't.

18 Q Okay. The last paragraph also, I was
19 disturbed by your suggestion during the call that
20 the panel could be expanded and a decision be
21 entered that would not discuss the panel's
22 expansion. Which decision would erroneously

1 characterize the cause of the enormous delay in
2 ruling on other factors? I read that right.

3 A Yes, you did.

4 Q And again, I had nothing to do with
5 confidential pre decisional information that might
6 have been in his concurring opinion. Is that
7 right?

8 A Well, no, it does talk about, you know.
9 I mean, the whole notion of if the panel were
10 unexpanded and then essentially all of the pre
11 decisional things that had occurred prior to that
12 final decision, that would be pre decisional
13 information.

14 Q Does Judge Fitzpatrick state in this
15 paragraph that he's disturbed by some suggestion
16 that he can't include pre decisional information
17 about the penile expansion?

18 A I'm sorry. Say that again. I didn't
19 follow that question.

20 Q Does he state anywhere in this paragraph
21 that he might be disturbed by you suggesting that
22 he can't include pre decisional information in his

1 opinion?

2 A Well, but it's subsumed within the
3 question, right. Or within the statement. I would
4 that's how I would read that statement or that
5 sentence.

6 Q Okay. Well, let me ask you this. Did
7 you respond to Judge Fitzpatrick's May 10, email
8 memorializing the May 7 call?

9 A I have I don't recall whether I did or
10 not. It certainly and just, you know, to be clear
11 on that issue. Again, the practice at the PTO is
12 to do pretty much everything verbally,
13 particularly at the higher levels of management.
14 I hardly ever responded by email, particularly on
15 particular cases that were percolating through the
16 office at any given time. That's just something
17 that just was not in my purview.

18 Q Okay, so is the answer that you don't
19 you don't know if you responded or don't remember
20 if you responded?

21 A Well, you know, typically it would have
22 come in. It was Scott Bullock was on the email.

1 Scott and I might have discussed it one on one.
2 We may have discussed it in a management meeting.
3 But again, with all of the things that we had on
4 our plate, you know, trying to get this decision
5 done, although that was we wanted to get it done
6 because we knew the panel, Michael, in particular,
7 was very upset about the timing of it. It just
8 was not something that I would have responded to
9 immediately.

10 Q Okay. You said that things were done
11 orally. Did you ever pick up the phone and call
12 Judge Fitzpatrick and say, Mike, I think you
13 misunderstood me when on the May 7th call?

14 A I don't know if I ever did call him.

15 Q Okay. Do you know Judge Bullock who on
16 this email ever responded by email to Judge
17 Fitzpatrick to correct any misstatements that he
18 made in this May 10 email?

19 A I have no idea whether he responded or
20 not, either by email or verbally or through, you
21 know, through (phonetic) or it could have been
22 through, I guess Susan was his lead judge at the

1 time, so I don't know what the communication would
2 have been.

3 Q Well, if this was a big
4 misunderstanding, Judge Ruschke, couldn't you have
5 just picked up the phone and talked to Judge
6 Fitzpatrick and try to resolve the
7 miscommunication?

8 A It's -- yes, you know, in an ideal
9 world, in 2020 hindsight, I would love to have
10 just picked this up and Michael would have said,
11 you know, I'm sorry, David, for yelling at you. I
12 am sorry that I have caused all this issues. And I
13 would have said, you know, I'm sorry this has been
14 so delayed. I -- you know, I hope you understand
15 all of the things that have been going on. But I
16 got to tell you, you know, there's only so many
17 hours -- things that I had on in a day. And at
18 this point, I was trying to implement Supreme
19 Court decisions with a new under-secretary. And
20 those were my priorities, frankly. I'm sorry.
21 That's just the way it was.

22 Q Okay. Well, how about Judge Cox and

1 Judge Arpin that are colleagues of yours and Judge
2 Fitzpatrick? Do you know if they ever responded
3 to this email?

4 A I have no idea.

5 Q Do you know if they ever called up Judge
6 Fitzpatrick and said something like, Mike, I think
7 you need to calm down. That's not what Judge
8 Ruschke said on May 7th.

9 A I would have no idea. That would be
10 completely speculation on my part.

11 Q Do you know if -- you mention you might
12 have talked to Judge Bullock, did Judge Bullock
13 forward you this email and ask you what in the
14 world is Judge Fitzpatrick talking about?

15 A I have no idea. That would again be
16 speculation. I have no idea.

17 Q Well, I mean, it wouldn't be speculation
18 because the email would have gone to you. That's
19 what I'm asking. Did he email you anything along
20 those lines?

21 A I haven't reviewed the thousands of
22 emails that I've gotten. I'm sorry. I just I

1 haven't. So I am not aware that he forward this
2 to me at all.

3 Q Do you remember if Judge Bullock called
4 you and said, David? Judge Fitzpatrick clearly
5 has a misunderstanding of what happened on May
6 7th. Did he call you about that?

7 A I have absolutely no recollection
8 whether he did or did not.

9 Q All right, let's just talk generally
10 about excuse me, generally about an IPR. What do
11 you consider what would you call the period
12 between an institution decision and a final
13 written decision?

14 A Let's see, what would I call that
15 period?

16 Q Yes.

17 A That would have been -- that would be
18 the trial.

19 Q Would it be okay if you referred to it
20 or if I referred to it as the marriage stage of
21 the IPR?

22 A I would call it the trial. You can

1 refer to it how you'd like to, but I would call
2 it. It's typically referred to as the trial
3 phase.

4 Q Trial phase. And in that phase, that's
5 when the judges on the panel are determining the
6 patentability of the claims in a patent or
7 substitute claims proposed by the patent owner.
8 Is that right?

9 A Yes.

10 Q All right, Judge Ruschke, would you
11 please turn to tab 7 at 163? Let me know, when
12 you're there.

13 A Okay, I'm there.

14 Q Okay and so on page 163, we see that on
15 November 4th, 2016, you expanded the panel in the
16 Nike IPR to include yourself and Judge Bullock.
17 Is that right?

18 A Yes.

19 Q Now, earlier, you testified that -- and
20 I'll try to try to quote you here, the panel is
21 not expanded until the decision goes out. Did I
22 get that right?

1 A Well, as I was saying, I think I've said
2 this a number of times, that the expansion of a
3 panel is not official until the decision goes out.

4 Q Okay. So there's an unofficial panel
5 expansion and then an official panel expansion, is
6 that what you're saying?

7 A No, I don't want to get into official or
8 official. But again, under the procedures that we
9 were operating under during this time frame, the
10 announcement of the expanded panel was not done
11 until the decision was actually mailed.

12 Q Sure, I'm not talking about the
13 announcement. I'm actually talking about whether
14 or not the panel is expanded. You said earlier
15 that the panel was not expanded until a decision
16 goes out or another thing you said was,
17 technically, it's not expanded until that goes
18 out, is that -- we have you, right?

19 A No. Well, again, I know where you're
20 going with this, but I mean, I would try to sort
21 of analogize it to you know, sometimes you would
22 have a panel decision or a panel that was

1 originally panelled when a petition was filed,
2 excuse me. And then for one reason or another,
3 that panel changes for some reason, whether it be
4 retirement after a rising conflicts of interest,
5 for instance.

6 And then that panel changed. Well, we
7 just didn't, you know, even though that panel was
8 changed or, you know, in your -- in the analogy
9 here was expanded, the panel composition had
10 changed. It wasn't officially changed until the
11 decision had went out. And then the parties
12 usually, unfortunately for the first time, saw at
13 that point who their new panel members were.

14 Q Okay. Just let me -- I just need to
15 understand this. So on November 4th, 2016, do you
16 consider the Nike IPR panel to have been expanded?

17 A Well, it was expanded for the purposes
18 of sorting through the issues that were raised in
19 the remand. But that wasn't a decision that it
20 would be expanded forever and ever.

21 Q Okay. But at least as November 14,
22 2016. Yes. The Nike IPR panel was expanded, in

1 your view?

2 A Well, I'm going to leave it. I think
3 I've answered that a number of different ways, so
4 I'm going to leave it with that. The answer I
5 gave you, Mr. Kappers.

6 Q Okay. So say now, say later on, expand
7 a panel and a decision goes out on an expanded
8 panel. Is it your view that the panel in that
9 sort of like IPR has never been expanded?

10 A But because the important part is that
11 when the decision mails, it's the names on the
12 decision as to whether the panel was expanded or
13 not.

14 Q Right. And so in that case, where a
15 panel is unexpectedly expanded and then unexpanded
16 and a decision gets mailed, your testimony is that
17 the panel in that IPR was not expanded. Is that
18 right?

19 A No, I'm not sure I'm going to -- I would
20 say that.

21 Q Okay. How would you describe that
22 situation?

1 A Now, as I've said before, that when you
2 -- when the panel is initially expanded in quotes,
3 you know, typically then the process goes through
4 the opinion drafting, the concurrences, the
5 dissents. And there's times, of course, when there
6 can be resolution amongst all the panel members,
7 in which case, if that is the case, the panel can
8 be expanded and the decision issued underneath
9 whatever combination of judges are on the panel at
10 that time.

11 Q In November 20 -- November 4th, 2016.
12 When you expanded the Nike IPR panel, was the Nike
13 IPR in the trial phase, as you described it?

14 A Well, you describe the phase. You're
15 saying you wanted me to say. What is it between
16 the decision on institution and the final written
17 decision? Right. That's the trial phase.

18 Q Okay, well, let me back up. What do you
19 what do you refer to the phase of an IPR when it's
20 back on remand from the federal circuit to decide
21 the patentability of claims or substitute claims?

22 A Well, it was -- it would be post appeal

1 and it would be in the, I guess, remand phase.

2 Q And during this remand phase of the Nike
3 IPR, was the patent ability of Nike substitute
4 claims being determined?

5 A Yes, I believe so.

6 Q All right. And so on November 4th,
7 2016, will you agree with me at least that the
8 Nike IPR was in a phase where Nike's substitute
9 claims the patentability of those claims was being
10 determined?

11 A On the Reimann Faith. I'd have to go
12 back and look at the Federal Circuit remand. I
13 don't remember -- because the focus in the remand
14 decision from the feds circuit focused again on
15 the number of substitute claims, and specifically,
16 I believe, on the test that Judge Arpin wanted to
17 use for determining the substantial -- whether
18 they were substantially patentable, distinct or
19 not. So technically, that decision may have
20 already been determined, and it was just these
21 procedural issues that were happening afterwards.

22 Q All right. Judge Ruschke, if you could

1 turn to tab at page 195. And you see at the
2 bottom of page 195, there's an email from Judge
3 Arpin on November 28th, 2016, and he CCs Judge
4 Bullock and the rest of the expanded panel. Is
5 that right?

6 A Yes.

7 Q And Judge Arpin says it's been it's been
8 six weeks since we forwarded this decision for
9 review and almost two weeks since our conference.
10 Did I read that, right?

11 A Yes.

12 Q Now, at the conference, were you and the
13 rest of the expanded panel deciding the
14 patentability of Nike substitute claims?

15 A I don't recall what the substance of
16 that conference was other than this. If I'm
17 thinking correctly and I can't guarantee it, but
18 this would have been the conference I mentioned
19 earlier where we all got together to discuss sort
20 of how we were moving forward on that. And
21 probably at that point had said that, you know,
22 had indicated our separate opinions as to where we

1 were on the issues on remand.

2 Q What were the issues on remand in the
3 Nike IPR?

4 A Well, the ones that I just previously
5 spoke about and testified on direct.

6 Q Okay. And you didn't respond to this
7 email from Judge Arpin, did you?

8 A I have no idea whether I did or did not.

9 Q And Judge Fitzpatrick responds on
10 November 29th, 2016.

11 A Okay.

12 Q All right.

13 A I do see that.

14 Q And Judge Fitzpatrick says at today's
15 call, I think one of you mentioned that no
16 remanded case had ever been expanded. However,
17 this case was expanded, at least internally. Are
18 you considering ultimately removing yourselves
19 from the panel on this case? If you do, there
20 will be no public record that the panel has ever
21 temporarily expanded, and the delay in issuing the
22 decision will reflect on the original panel, even

1 though the original panel is ready to issue its
2 decision. Did I read that right?

3 A It looks like you did.

4 Q Okay. And so Judge Fitzpatrick is
5 telling you that this delay in the Nike IPR is
6 reflecting on the original panel. Is that right?

7 A Well, that's what his -- that's what
8 he's saying. Yes.

9 Q And did you -- do you agree with that?

10 A I don't think I agree with that, no.

11 Q Did you respond to Judge Fitzpatrick's
12 email on November 29th?

13 A I have no -- it would be speculation
14 again, I'm sorry. I don't know whether I
15 responded or had anybody else respond, for that
16 matter.

17 Q Okay. Turn to tab 7 at page 191,
18 please. And let's look at the email dated
19 December 19th from Judge Arpin to you, Judge
20 Bullock and the rest of the expanded panel. And
21 you see that in the second sentence there Judge
22 Arpin says we have at least four options for going

1 forward. Did I read that, right?

2 A I'm sorry, where are you? Are you in --
3 oh, Judge Arpins. Okay.

4 Q Okay. And he says we have at least four
5 options for going forward. You see that?

6 A Okay.

7 Q Okay, and the first option, according to
8 Judge Arpin is Judge -- Chief Judge Ruschke and
9 Deputy Chief Judge Bullock, withdraw from the
10 panel and the existing decision issues. Is that
11 right?

12 A Which did you read? Just the first one,
13 Chief Judge Ruschke and Deputy Chief Judge Bullock
14 withdraw from the panel and the existing decision
15 issues, is that right?

16 Q That's the first option for you guys,
17 according to Judge --

18 A Okay. Well, that's all that's listed
19 there underneath number one.

20 Q Sure. Now, go down to towards the end
21 there, where he says, however. He says, however,
22 if CJ Ruschke and DCJ Bullock withdraw from the

1 panel, they and the rest of the board can distance
2 themselves from the remand decision and avoid any
3 panel stacking concerns, such as those currently
4 being raised in the ZhongShan appeal. What's your
5 understanding of the panel stacking concerns being
6 raised in that appeal?

7 A I have no idea what that is.

8 Q Okay. Well, and would you agree that
9 Judge Arpin in this paragraph is suggesting a way
10 for you and Deputy Chief Judge Bullock to avoid
11 these panel stacking concerns?

12 A I haven't seen this email if I saw it at
13 all. So sorry, I don't know how to respond to
14 that. It's a very dense email.

15 Q I think on direct you were talking about
16 the director's authority to control APJs. Do you
17 recall that?

18 A Director's authority? Yes.

19 Q Okay. And I believe you were drawing a
20 distinction between process and the merits.

21 A No. He has the authority to do all.

22 Q Okay.

1 A The entire operation of the board. I was
2 drawing a distinction between where I've always
3 said that we were hired as APJs for our technical
4 abilities, frankly. And when we rely on the
5 merits of cases, we put ourselves in a better
6 position because the stakeholders will respect us
7 as AJs, because that's what our job is. And we
8 have a better chance of being affirmed and getting
9 the right decision through the federal circuit.

10 Q Okay. Got it. Now, would you agree
11 that the directors authority to control an APJs
12 presiding over an IPR is constrained at least by
13 the due process rights of the parties to the IPR?

14 A I don't think there's any constraints on
15 the director's authority.

16 Q Okay, so your testimony is that the
17 director is not limited in the director's
18 authority over APJs presiding on an IPR by due
19 process rights?

20 A No, that's not my testimony. I'm just
21 saying that if you. I'm not I don't think there's
22 any constraints on the director's authority. Of

1 course, if he, you know, does something criminal,
2 then that is a constraint. Obviously, he's not
3 allowed to do that.

4 Q Is due process a constraint on the
5 Director's authority?

6 A What due process are you referring to?

7 Q The due process clause of the United
8 States Constitution.

9 A Okay. In what respect? How is that --
10 Is there something you could point me to that's
11 specifically a due process issue here? I mean,
12 due process is very, very broad, right in my mind.
13 Right?

14 Q Okay. Let me ask you a few examples --
15 about a few examples, okay? Can the director tell
16 a panel of APJs how to rule on the merits of an
17 IPR without violating a party's due process
18 rights?

19 A I'm not sure about that last clause, but
20 under the Arthrex Supreme Court decision, the
21 directors ability to decide the merits and the
22 procedural issues of any case seemed pretty clear.

1 Q How about before Arthrex?

2 A I don't think Arthrex necessarily
3 changed anything.

4 Q Okay. Can the director -- so the
5 director can tell a panel of APJs how to how to
6 rule on a particular case. Is that right?

7 A Yes, I believe he can.

8 Q Do you think that the director can stack
9 a panel to add APJs to reach a desired outcome
10 without violating due process of the parties?

11 A Well, again, panel stacking is
12 something, you know, that's a loaded term and you
13 haven't necessarily defined what that means. But
14 I know from my standpoint and from the
15 undersecretaries that I worked with and I worked
16 with three, technically four depending on the
17 term, there was no interest or desire to do any
18 sort of panel stacking to achieve a result that
19 occurred well before my tenure. And again
20 happened on that, I think it was the issue of same
21 party joinder. That was really the issue, that
22 was a lightning rod for that discussion.

1 Q In your view, can the director expand a
2 panel without notifying the parties? And then
3 when the panels expanded, basically swap and
4 change the composition of the panel until the
5 panel reaches the desired outcome and then
6 unexpand, the panel and let the decision out.

7 A Well, that's a very complex question.
8 Again, I think the director's authority to panel
9 the cases that come before the PTAB are not
10 constrained.

11 Q If -- so if the director has the power
12 to tell APJs how to rule in a given IPR why have
13 panels in the first place?

14 A I think that's a congressional question.

15 Q And so you mentioned Arthrex, right?
16 And that's the Supreme Court case where the court
17 found that the director didn't have enough
18 authority over APJs, is that right?

19 A Well dealt with a number of different
20 issues. But one of the -- it was really an
21 appointments clause case.

22 Q Right. It was appointments clause case.

1 And it found that APAs were not inferior officers.
2 And so one of the results was that the Supreme
3 Court created a Director of Youth Authority in
4 Section 6C. Does that sound right?

5 A Yes. Well, my memory was that now,
6 Chief Judge Moore, the Federal Circuit had decided
7 that the authority exerted by the director laid in
8 the fact that all APJs were subject to the same.
9 I'm going to get the statute number wrong. I'm
10 never really good with statute numbers, but the
11 same employment prescriptions, restrictions as all
12 other government employees and that they could be
13 removed. And as a result of that period, any
14 defect in the appointment clause and then the
15 Supreme Court essentially said, no, that's not
16 really quite sufficient. There has to be more of
17 a involvement by the director.

18 Q And that involvement now is this
19 Director of due process. Is that right?

20 A Yes, that's been, that's -- there was a
21 -- let's see, a I don't know if it was temporary
22 or if it wasn't. Well, it was -- again, because

1 we were in the midst of changing, the acting
2 undersecretary implemented that decision by
3 putting in a director review process. And I
4 believe that the new undersecretary, Kathy Vidal,
5 I'm not sure if she's put out a request for
6 comments for that or if she is just asked for
7 comments informally to get more input on that. I
8 mean, that's typically how these things happen is
9 particularly when there's a big decision that
10 comes down. But I'm not sure that that changed.
11 I'm not sure that should change the director's
12 authority. It just changed his abilities and
13 mechanisms for existing or for exerting that sort
14 of control.

15 Q Well, that's my question. Why would the
16 Supreme Court need to create a review authority
17 for the director if all along the director had
18 this power to tell judges how to rule?

19 A Well, you'd have to ask them. You know,
20 that's -- I think there's been a lot of commentary
21 on that, frankly.

22 Q All right, Judge Ruschke if you could

1 turn to tab 7 at page 179 through 183.

2 A Okay.

3 Q Okay. And I want to start on an email
4 on page 182, and it goes through page 183.

5 A Okay.

6 Q All right. And it's an email from Judge
7 Arpin, dated August 26, 2017. Are you there?

8 A At 11:13 a.m.?

9 Q At 11:13 a.m., that's right? And Judge
10 Arpin tells you further to our discussion in Nike
11 yesterday. If you haven't seen it, here's the oil
12 State's opening brief. Note that it discusses
13 both Nidec, pages 45, 46 and Eskom, pages 10 and
14 46. With respect to expanded panels and the
15 possible lack of panel independence. Bottom line,
16 given the possibility of undue influence by
17 political appointees, oil states argues that the
18 board can't be trusted to act as a substitute for
19 an Article III Court and Jury. Did I read that
20 right?

21 A That's what's on the email.

22 Q What's your understanding of what Judge

1 Arpin is referring to with respect to the Nidec
2 and is some decisions with respect to expanded
3 panels?

4 A I'm not sure what he's referring to as I
5 testified on direct. I don't recall (phonetic)
6 them at all. And Nidec again, was a federal
7 circuit case that the issue of expanded panels
8 came up and was written about by one of the judges
9 in I think it was additional views or might have
10 been a concurrence, but it had, it really wasn't
11 at issue and it wasn't a holding at all.

12 Q Well, the parties in Nidec argued that
13 the panel expansion practice at the PTAB violated
14 due process. Do you recall that?

15 A Not particularly, to be totally honest
16 with you.

17 Q And the judge you're referring to on the
18 federal circuit is Judge Dyke. Does that sound
19 familiar?

20 A It could be. I'm not sure.

21 Q Okay. And he raised concerns with the
22 expanded panel practice. Is that right?

1 A I don't know.

2 Q All right. Turn to page 183. And this
3 is the second paragraph of Judge Arpin's email.
4 And towards the end, he starts a sentence with
5 given the current climate, I think that asking
6 Judge Cox to assume responsibility as author of
7 the majority opinion might be desirable. Did I
8 read that right?

9 A I guess you did, yes. Sorry. I was
10 just reading to think for myself. Sorry.

11 Q Okay. What's your understanding of the
12 current climate at the time?

13 A I'm not sure what he was referring to.

14 Q And don't you think that Judge Arpin is
15 suggesting a way for you and Judge Bullock to
16 avoid the perception in the public?

17 A I'm sorry, perception of what in the
18 public?

19 Q The negative perception in the current
20 climate and the public by having Judge Cox assume
21 responsibility as offered.

22 A Again, you know, I'm not sure exactly

1 what he's referring to is the current climate, but
2 I would say that again, my policy when it came to
3 expanded panels was not -- was to do it very, very
4 rarely. And only in those situations where we
5 would not be changing the overall result with
6 respect to the positions of the parties. And by
7 placing myself and by placing Deputy Judge --
8 Deputy Chief Judge Bullock on the panel, that
9 would send a message to the judges, as well as the
10 public, the stakeholders, but that is where the
11 PTAB was heading at a given point.

12 And again, that was due to the fact that
13 we had run into an impasse with our precedential
14 cases. And Judge Arpin was actually a driving
15 force on that committee, and we were not able to
16 get any recommendations from that committee for
17 vote because we were still under the still under
18 the regime where we had to have a majority vote of
19 the judges in order to make a panel precedential.
20 So this was a way of sending a message by putting
21 myself and Deputy Chief Judge Bullock on an
22 expanded panel.

1 Q Okay. So you want to send a message, but
2 did you ever notify Nike and Adidas that the panel
3 was expanded in their IPR?

4 A Well, I again, day to day operations of
5 the of panelling and the board were were not
6 something that I handled. And the existing
7 practice during that time period was not to notify
8 the parties until the opinion issued.

9 Q Okay. So the parties weren't notified
10 that their panel was expanded.

11 A Again, I don't know who had, had
12 conversations, as I mentioned before. I know that
13 Michael had indicated at one point that he wanted
14 to tell them, he wanted to alert them to the fact
15 that the panel was expanded and that was the
16 result of the delay. But because the panel didn't
17 or not the panel, but because the parties didn't
18 ask him specifically, he refrained from disclosing
19 that confidential information.

20 Q Chief Judge Ruschke, if you could turn
21 back to page 198. I'm sorry turn to page 198 of
22 tab 7.

1 A 198?

2 Q Yes. And it's an email thread and I
3 want you to look at the bottom there. You're
4 responding on February 28th, 2017. And if you
5 flip the page to 199 --

6 A Okay.

7 Q You see you're responding to an email
8 from Judge Arpin on February 28th, 2017. Is that
9 right?

10 A Looks like it came from my email. But
11 underneath me and Scott's name, is that the one
12 you're referring to?

13 Q Yes. And in the first line, you say,
14 Jim, as we instructed you previously, PTAB does
15 not issue notifications of expanded panels. Did I
16 read that right?

17 A Yes, that's what's written.

18 Q Okay. So in the Nike IPR, the original
19 panel wanted to notify the parties and you told
20 them no, because at that time, PTAB didn't notify
21 the parties. Is that right?

22 A Well, that's just you know, again, this

1 is -- this the practice of the PTAB when I joined
2 and this is a few months later. Well, now it's
3 about 6 to 8 months later. That was the policy
4 and that we did not notify the parties of expanded
5 panels. This email -- and again, one of the
6 things that you have to be careful about sometimes
7 the emails, you know again, if it came from me and
8 Scott, Scott might have issued this, but I sent it
9 over my name, which is entirely possible.

10 Q Okay. So it's possible that Chief Judge
11 Bullock instructed the original panel members to
12 not notify the parties.

13 A I have no idea whether he did or not,
14 but it was at that time, you know, again and I
15 don't think anything was the issue of notification
16 of the panels was not an issue that occurred or
17 that I recall at the time of the expansion and was
18 not, you know. And then the other panels where it
19 was the other panels that had been expanded
20 throughout the my tenure. I don't recall anybody
21 raising this kind of issue either.

22 Q But Judge Fitzpatrick and Judge Arpin

1 are raising the issue directly. They want to
2 notify the parties. So they're --

3 A They just wanted to notify the parties.
4 Yes.

5 Q Okay. And you and Judge Bullock told
6 them no and said we're not going to notify the
7 parties in the Nike IPR.

8 A That's correct. We were not going to
9 notify them based on the existing, pre-existing
10 policy for how and the board's interpretation of
11 SOP1.

12 Q Okay. Turn back to page 182 of the same
13 tab 7. Okay. I believe you walked through this
14 with Mr. Horrigan earlier, but Judge Arpin emails
15 you on August 28th. No response on August 29th?
16 No response. Is that right?

17 A So again Jim was sending -- you can this
18 might just be a little snippet of it, but Jim
19 would be sending reminder emails constantly. So
20 again, as a general matter, I would not be
21 responding to these sorts of inquiries. So please
22 don't try to make something out of the fact that I

1 didn't respond to these, particularly when Jim was
2 texting. Looks like every other day at some point
3 on this issue. Again, the it's an important. It
4 was -- and just so I can be clear, the issues were
5 important very important for the board to speak
6 consistently on reflect the USPTO's policy. And
7 that's why the panel was originally expanded. But
8 at the same time, the day to day operation of what
9 I was doing as the chief judge, this was not a
10 super high priority for me. And I know I don't
11 want to diminish the importance of this case and I
12 don't want to diminish the importance of Michael's
13 concerns. But again, the day to day operation of
14 any particular case was not necessarily something
15 that was on the top of my to do list every day.

16 Q Okay. Well, on August 30th, Judge Arpin
17 asked you please have the courtesy to acknowledge
18 my emails. Did I read that right?

19 A I don't -- where are you? Where is
20 that? I don't even know.

21 Q Page 182. August 30th.

22 A Yes, I see that. Yes.

1 Q Okay. And what you're saying is that
2 Judge Arpin's emails did not rise to the
3 importance for you to give him a response?

4 A No, I'm not saying that. You know,
5 again, you know, I had some conversations with
6 Jim. I visited the Denver office on multiple
7 occasions and talk with Jim directly about issues.
8 Michael was on (phonetic) in Chicago where we
9 didn't have a regional office, so I was -- never
10 had the opportunity to visit him in person. But
11 Jim and I spoke and again, there was entirely
12 possible that Scott or somebody else in his chain
13 of command responded to him.

14 Q Okay, well, flip the page to 181 and Jim
15 sends you another email the next day on August
16 31st, 2017. And in the end of the second
17 paragraph he says, I intend to submit the decision
18 for mailing at 9 a.m. ET on Friday, September 1st,
19 2017. Did I read that right?

20 A Yes.

21 Q Now, that must have got your attention,
22 because if you turn to page 180. At the bottom

1 you respond to Judge Arpin. Is that right?

2 A Yes.

3 Q All right. In that second paragraph,
4 you say, I have instructed Dave and Maria not to
5 make this decision until they hear directly from
6 me. Is that right?

7 A Yes, that's what it says.

8 Q Okay. Now, let's go through the email
9 from Judge Arpin and starting on page 179. And
10 you walked through this with Mr. Horrigan a little
11 bit. This is dated August 31st, 2017, is that
12 correct?

13 A August 13, 2017. Yes.

14 Q August 31st.

15 A Oh, 31st. Yes.

16 Q Yes. Okay. Now, I want to look at the
17 paragraph, starting with regardless. Judge Arpin
18 says, regardless of whether the federal circuit in
19 Aqua Products shifts the burden from the movement.
20 As we discussed last week, Adidas Petitioner
21 produce the evidence and argument in its petition
22 in opposition to the motion amend that persuaded

1 all of us that the substitute claims are
2 unpatentable. So Judge, Judge Arpin here is
3 telling everybody that Aqua Products didn't have
4 an impact on the Nike decision being mailed. Is
5 that right?

6 A I'm reading it with you. I don't
7 recall.

8 Q Okay. And let's go to page 180 again.
9 This is the end of Judge Arpins email, Judge
10 Ruschke.

11 A Yes.

12 Q Okay. Judge Arpin says, mention of
13 Nidec brings me to a final thought on this
14 decision. As I said at our conference last week,
15 the due process and quote, elephant in the room is
16 the expansion of the panel. Did I read that
17 right?

18 A You read the first sentence? Yes.

19 Q Do you agree with Judge Arpin that the
20 due process elephant in the room was the expansion
21 of the Nike IPR panel?

22 A I'm not sure what exactly he means by

1 that specifically, but that probably would not
2 agree with that, because I'm not sure there was an
3 elephant in the room. And under In re Alappat.
4 There wasn't any due process issue with respect to
5 that expansion.

6 Q Let's look at what else he says. He
7 says in Nike, the expansion of the panel has
8 unquestionably altered the decision from the way
9 it was written in September of 2016, because
10 before panel expansion, we told the parties one
11 thing about how we would treat multiple substitute
12 claims, and after expansion, we're going to tell
13 them something quite different. The panel
14 expansion itself may raise due process concerns.
15 Did I read that, right?

16 A Yes. That's what he wrote.

17 Q Okay. And do you at least agree now
18 that Judge Arfpin is coming out and saying that
19 there are possibly due process concerns, that his
20 belief is at least reasonable?

21 A That's not how in In re Alappat. I read
22 in In re Alappat.

1 Q Do you believe that it's at least
2 reasonable to think that their due process
3 concerns with the way you expanded the panel in
4 the Nike IPR?

5 A Now again, if you read In re Alappat, I
6 don't believe that that is a reasonable
7 conclusion.

8 Q Okay and so if this testimony becomes
9 public, your testimony is going to be that Judge
10 Arpin, your colleague, when he expresses due
11 process concerns about the panel expansion, was
12 being unreasonable?

13 A I don't think it's unreasonable, but I
14 mean, again, it's his opinion and I don't think
15 it's comports with In re Alappat.

16 Q Okay. Well, let's set aside whether
17 it's right or wrong. The binary question, is it
18 at least a reasonable belief to think that there's
19 due process concerns that occurred?

20 A Not -- based on this, it's a very small
21 little segment that's written here. You know,
22 again, you'd have to parse through about telling

1 them something quite different before and after
2 expansion. I don't think it's reasonable, given
3 how expanded panels had been dealt with in the
4 past, where there were no due process issues
5 raised that I was aware of that to have them
6 raised in this situation, because the main issue
7 here for the judges was timing. They wanted to
8 get this out. They wanted to get it off their
9 plates. That, to me is not a reasonable position.

10 Q Well, timing was an important position
11 in concern of Judge Arpin, but he's being very
12 clear here that he's concerned about due process
13 issues. Right?

14 A Well, that's what he writes, but I don't
15 think that's reasonable in light of the whole
16 situation as to how the remand decision drafts
17 were going back and forth.

18 Q And one of the one of the reasons that
19 you think it's unreasonable is because of this
20 federal circuit case called Alappat. Right. You
21 mentioned Alappat a few times in your direct.

22 A Yes.

1 Q And Judge Arpin actually cites Alappat
2 in this email, doesn't he?

3 A Yes, he does.

4 Q Judge Arpin cites Alappat for his
5 position that the penal expansion and the Nike IPR
6 raises due process concerns. Did I get that
7 right?

8 A Well, he says see Alappat Judge
9 Ruschke's opinion footnote four.

10 Q Okay and he's citing Alappat the same
11 decision that you're saying unquestionably
12 supports panel expansion of the PTAB for the issue
13 that what you did in the Nike IPR may raise due
14 process concerns. All right?

15 A I'm sorry. I don't -- is there a
16 question or was it just a statement?

17 Q Do you agree that Judge Arpin's
18 suggestion that what you did in the Nike IPR
19 violates due process of the parties is at least a
20 serious accusation.

21 A Well, violation of any constitutional
22 right is a serious issue, but we get due process

1 concerns raised to us as the PTAB, frankly, almost
2 in every single petition, particularly now
3 underneath the new well, fairly new presidential
4 opinions with respect to concurrent district court
5 proceedings. So yeah, of course, any sort of
6 constitutional violation is something somebody is
7 concerned about. But just raising the
8 quote-unquote notion of due process, if you will,
9 particularly when there's an end bond case that's
10 from 20 years ago, you know that that quote-
11 unquote, decided the issue and that the PTO has
12 been implementing for the last 20 years.

13 That would be my answer as to how to
14 address those sorts of issues. And please
15 remember, it wasn't as if I you know, again, when
16 some of these issues were raised, it wasn't as if
17 people ignored Jim and Michael. These were, you
18 know, delegated down to the team to sort through,
19 again, those decisions on a day to day case basis.
20 We're not something that we're on my plate. Those
21 were delegated down through the structure that we
22 had put in place to manage the board.

1 Q Did you respond to Judge Arpin's email
2 raising due process concerns about the Nike IPR
3 panel expansion?

4 A I think -- I don't know. I think I've
5 answered that, you know.

6 Q I'm asking --

7 A Pardon me?

8 Q I was asking about this specific email.
9 Could you respond?

10 A Yes, again, I don't recall if I
11 responded, if Scott Bullock responded, if Stacy
12 Margulies responded, if somebody responded to him
13 on these issues, whether I was there in person at
14 any given point in Denver. I just don't I have no
15 memory of this whatsoever. Whether we know
16 exactly how we responded and who responded.

17 Q All right, Chief Judge Ruschke or Judge
18 Ruschke, if you could please turn to tab 7 and
19 let's start at 425.

20 A Okay.

21 Q Okay. And I think we've looked at this
22 and I know you looked at this with Mr. Horrigan.

1 This is Judge Fitzpatrick's concurring opinion in
2 the Nike IPR, and it's in March, is that right?

3 A Sometime in March 2018. Yes.

4 Q All right. Now turn to page 438,
5 please. And actually let me direct you just to
6 start at page 435.

7 A 435. Okay.

8 Q All right. And Judge Fitzpatrick and
9 his concurring opinion has a Section V titled
10 Expansion of the Panel was not authorized by the
11 statute and is inconsistent with statutes. Is
12 that right?

13 A Yes.

14 Q All right. Now turn to page 438 for 38.
15 Yes, please. And at the very top, Judge
16 Fitzpatrick cites Alappat 33F Third at 1532.
17 Footnote four.

18 A Okay.

19 Q Did I get that right? And that is at
20 the same footnote that Judge Turpin cited when he
21 expressed to you that the elephant in the room was
22 your panel expansion in the Nike IPR.

1 A I have no idea. He said, footnote four
2 and this is footnote four, but I'm not sure if
3 it's. I assume it would be the same, but I don't
4 know that.

5 Q Okay. And would you read the footnote
6 for here on page 438?

7 A This is not to say that the
8 commissioner's authority to designate the members
9 of a board panel may or may not be constrained by
10 principles of due process or by Title IV, the APA.
11 However, as noted here in Alappat has not raised
12 any such arguments in this appeal, and therefore
13 we need not address such issues.

14 Q So the issue of due process. Let me
15 withdraw that. The issue of the of whether panel
16 expansion PTAB violates due process was not an
17 issue actually resolved by the Alappat decision.
18 Is that right?

19 A Well, that's what's written in the foot
20 -- that seems like that's what's written in the
21 footnote. But I don't recall the whole the entire
22 context of whose opinion this was, was this a

1 majority opinion? Who joined this opinion? I
2 just don't recall those details.

3 Q Would you please turn to tab 7 at 472?
4 I think earlier on your direct let me back up.
5 This is the March 20 email from Judge Cox, and
6 he's including the decision on remand in the Nike
7 IPR.

8 A Okay.

9 Q Is that right? Okay. And Judge Cox
10 says the decision includes a majority opinion
11 authored by Chief Judge Ruschke. Is that right?

12 A Yes, that's what it says. Yes.

13 Q Okay. And you drafted the majority
14 opinion in the Nike IPR remand. Is that correct?

15 A Somebody drafted it for me.

16 Q Well, had your name on it?

17 A It had my name on it. I did not draft
18 it.

19 Q Did you review it before it was
20 circulated? Did you approve it before it was
21 circulated?

22 A Yes.

1 Q All right. Now, when you approved this
2 drafted majority opinion in the Nike IPR, were you
3 determining patentability of Nike substitute
4 claims in that decision?

5 A I don't recall.

6 Q What is the relationship between your
7 draft opinion in March 20, 2018 and the final
8 majority opinion that was mailed in the Nike IPR
9 in September 2018?

10 A What's the -- you said relationship?

11 Q Yes. Well, let me back up. I'll try to
12 help you out. You were on the majority opinion
13 that was actually mailed in September. That's
14 right.

15 A What? I'm sorry. I'm confused. What
16 happened? My name never was associated --
17 ultimately, my name was never associated with this
18 case.

19 Q Right. And I'm asking, what is the
20 difference? What are the differences between the
21 majority opinion that you drafted in March 2018
22 and the majority opinion that was actually mailed

1 in September 2018 that you were not on?

2 A I mean, I haven't done a what do you
3 call that where you, you know, you do an overlay?

4 Q Like a red line?

5 A Yes. I don't know what the differences
6 are. I'm sure it was, it was authored by somebody
7 completely different, wasn't it. I don't. Did
8 Josiah draft it. I don't recall who drafted that
9 decision.

10 Q Did the author of the majority decision
11 that was ultimately mailed rely on your decision
12 that you drafted in March 20, 2018?

13 A I did not review the decision that went
14 out and I have no recollection of what was in that
15 majority opinion.

16 Q Now, to this day, do you know if Nike or
17 Adidas have been notified that not only were you
18 on the panel on the IPR, but that you drafted the
19 a majority decision on remand?

20 A I have no idea. I'm not part of that.
21 I was not part of that communication with the with
22 the parties subsequent to the decision.

1 Q Did you know that they're still
2 litigating this IPR at the federal circuit?

3 A I have not followed this. No, I have
4 not.

5 Q Do you think that Nike or Adidas would
6 want to know that you were on the panel and that
7 you drafted the majority decision in March 2018?

8 A I don't -- I have no idea whether that
9 would they would consider that to be important or
10 not. It's the final decision that was drafted
11 that they're going to be focused on.

12 Q If the facts of the Nike panel expansion
13 were to come out and Nike were to argue that what
14 you did in expanding the panel in the Nike IPR
15 violated its due process rights. Do you think
16 that argument would be reasonable or unreasonable?

17 A That would be. You know, again, due
18 process gets raised all the time in PTAB decisions
19 and that has been particularly of late a very
20 fertile area of attack on all PTAB processes and
21 procedures and just the general operation at the
22 board.

1 Q Well Judge Ruschke two things. It looks
2 like there's a little strip above your camera.

3 A Oh, sorry.

4 Q Okay, no worries. Getting back to that
5 point, so set aside whether these arguments are
6 made. I'm asking whether you think it would be
7 unreasonable or reasonable if Nike were to argue
8 that their due process rights were violated in the
9 Nike IPR.

10 A I don't know how to respond to that. I
11 don't haven't thought about whether it's
12 reasonable or unreasonable.

13 Q So how about the federal circuit judges
14 deciding the Nike IPR? Don't you think they would
15 want to know that you were on the panel? Now, you
16 drafted the majority decision in March 20, 2018.

17 A I don't know what they would want to
18 know. I mean, one of the problems, of course, on
19 appeal always is that you want to limit your
20 issues. And what typically happens, of course, if
21 the merits of your appeal are fairly weak, then
22 there would be a need to try to gin up another

1 issue potentially in order to get the judges
2 attention. And there's 12 of them up there, not
3 including the senior judges. And each one of them
4 has a reputation on various issues about PTAB
5 practice. And so what one what one judge might
6 consider important, the other judge might not
7 consider important at all.

8 Q Okay. Well, let's say that one of those
9 12 judges on the federal circuit finds out that
10 the Nike IPR panel was expanded and says that
11 that's a violation of Nike's due process rights.
12 Are you telling me that that judge would be
13 unreasonable in thinking that.

14 A I'm not going to opine on the
15 reasonableness of a federal circuit judge? I'm
16 sorry. That's just not my role.

17 Q I'm asking you to -- Is it reasonable or
18 unreasonable to think that Nike's due process
19 rights were violated during the Nike IPR because
20 of the secret panel expansion?

21 A Again, my role is to implement federal
22 circuit presidential decisions. What role? Well,

1 I'm in a different context now, but at the time
2 was to implement those decisions to the best of my
3 ability, in conjunction with the politically
4 appointed undersecretary and the policy enunciated
5 by that by that appointee. So --

6 Q Okay, that's fine. Is it is it your
7 testimony at this hearing that you don't have a
8 position one way or the other, whether the panel
9 expansion that occurred in the Nike IPR violated
10 due process?

11 A No, I don't think I've said that. I
12 mean, I think I've tried to be very clear that in
13 my mind it's the panel expansion process as it
14 existed during my tenure. Given what it was, was
15 completely in line with In re Alappat and anything
16 contrary to that would not -- I would not view as
17 a reasonable interpretation of In re Alappat.

18 Q And so if a federal circuit judge came
19 out the opposite way and said it was a reasonable
20 interpretation. Your testimony today is that that
21 view is unreasonable.

22 A No, my testimony is, is that he or she

1 is a federal circuit judge. And as the Supreme
2 Court has always said, you know, they're not
3 necessarily right, but they're the last ones. And
4 in many situations, in our situation with the feds
5 circuit, they are the ones that review us and
6 reviewing courts. You know, it matters what they
7 say in there, particularly in their precedential
8 opinions. That's what we try to follow.

9 Q All right. Let's turn to tab 7 at page
10 685, please.

11 A Okay.

12 Q All right. And this is the email from
13 Judge Fitzpatrick on November 29th, 2017, where he
14 raises what he believes are misrepresentations
15 that Mr. Stewart made to Justice Roberts. Is that
16 right?

17 A It looks to be, yes.

18 Q Okay. Now, I believe on direct, you
19 said that this issue was not on your radar screen.
20 Did I get that right?

21 A Well, when I'm sitting there at the oral
22 argument, I believe I said that this statement

1 that is quoted here, this has been done on three
2 occasions. It's been done at the institution
3 stage, those quotes. That was not something that
4 raised any concerns for me at the oral argument.

5 Q But now when Judge Fitzpatrick emails
6 you on November 29, 2017, would you agree it's now
7 at least on your radar screen then?

8 A Right, yes.

9 Q Okay. Did you respond to Judge
10 Fitzpatrick's email?

11 A I don't know if I responded to him
12 directly, but this would have been, again, one of
13 those situations where because both Jackie and
14 Scott B, they would have raised it with me at our
15 periodic, if not daily meetings, and they would
16 have handled it through their channels that they
17 would have normally taken care of these sorts of
18 things.

19 Q Why not just respond to Judge
20 Fitzpatrick and say, Mike, thanks for this serious
21 concern. We'll look into it.

22 A You're absolutely right. Hindsight is

1 2020. But again, I don't know what was in my
2 inbox on Wednesday, November 29th. Was this the
3 day of the oral argument? Or Monday, November
4 27th? There was a lot of discussion happening at
5 this point, again, based on the oral argument,
6 trying to unpack it, to try to figure out how we
7 were going to be responding internally should the
8 decision either oil states or SAS go against us.
9 So again, you know, I wish I had, you know, 87
10 hours in a day to respond to all of these issues.

11 And I'm not trying to minimize Michael's
12 concern, but I believe this was addressed and I'm
13 not sure exactly the situation as to how it was
14 addressed. But again, my habit was not to respond
15 to every single one of these emails. That just is
16 something that I didn't do unless I had time. So
17 I imagine that there would have been there was a
18 lot of activity going on at the USPTO. Certainly
19 when there are not one, but two Supreme Court
20 cases pending before us or before them.

21 Q I think on direct, you testified that
22 you don't think Mr. Stewart's response to Chief

1 Justice Roberts was incorrect?

2 A I didn't think it was. And I believe
3 when whoever tracked down the issue and ran that
4 to ground said it wasn't. It was it was correct.

5 Q Okay. I'm sorry. Go ahead.

6 A No, no. I said that. That's all I
7 needed to say.

8 Q Okay. All right. And when Mr. Stewart
9 says this has been done on three occasions, do you
10 know if the Nike IPR was one of those three
11 occasions he's referring to?

12 A I have no idea when he said three. To
13 me, the important part was it was done in a small
14 percentage of a very small number of cases. And
15 again, all before my time, because I believe that
16 they were talking about the overturning and the
17 changing of a decision below.

18 Q Well, look at Chief Just -- look at
19 Chief Justice Roberts question.

20 A Can you give me the site again? I seem
21 to have moved off of it.

22 Q Sorry, it's tab 7 at 685.

1 A 685. Okay. Sorry. Yeah.

2 Q Let's look at just Chief Justice Roberts
3 question he asked. Does it comport to due process
4 to change the composition of the adjudicatory body
5 halfway through the proceeding? I read that,
6 right?

7 A Yes. That's what that's what's in the
8 email here. If it's the same as what's in the
9 oral or the transcript.

10 Q He doesn't ask, does it comport with due
11 process to change the composition of a panel to
12 overturn a decision? Does he?

13 A So I don't recall -- this is again, just
14 a snippet. I don't -- I could be totally
15 misremembering. But the context of this whole
16 discussion was on changing the composition of a
17 panel in order to change the underlying result.

18 Q Is that what Chief Justice Roberts
19 asked, is that what you're saying?

20 A I don't have the transcript. You'd have
21 to look at the transcript. But my memory of the
22 oral argument was that that was the issue that

1 they were concerned about, not the whole notion
2 of, again, what he's saying here. Does it comport
3 to due process to change the composition of the
4 judiciary body halfway through the proceeding?

5 Q What you're saying that that there's no
6 false or incorrect statement made by Mr. Stewart.
7 So what's your understanding of halfway through
8 the proceeding as referred to by Chief Justice
9 Roberts?

10 A I don't have any. Not sure what he was
11 referring to. And it could mean a lot of
12 different things, I guess, in his mind. Well, I'm
13 not sure he's -- I'm not sure how familiar he is
14 with the whole PTAB proceedings.

15 Q But you were saying that Mr. Stewart was
16 correct to answer his question and say it's
17 happened three times. How do you --

18 A No -- I think what I think what I said
19 was that regardless of the number that was done,
20 it was done on a very it was done on a very small
21 number of occasions. And again, that is more
22 reflective. That that's more reflective of when

1 the underlying -- when an underlying decision was
2 changed by an expanded panel.

3 Q All right. Well, let's go to Mr.
4 Stewart's second statement here, and that's at the
5 bottom of this paragraph. He says that the panel
6 expansion hasn't been done at the merit stage, if
7 you will, when patentability was actually being
8 determined in the Nike IPR, when you had expanded
9 the panel and had it notified the parties, were
10 you determining the patentability of Nike
11 substitute claims?

12 A So again, I understand where you're
13 trying to shoehorn this in. I don't want to make
14 too much of the you know, again, of the merits
15 stage. I don't know, Mr. Stewart. I've never met
16 him. I've never had any discussions with him. I
17 don't know what his information was. But again, I
18 think what he's saying is that, again, it was done
19 in a very, very limited time. And he said it was
20 done at the institution stage.

21 Q Set aside what, Mr. Stewart says, Chief
22 Judge Ruschke, let me ask you, when you were on

1 the panel in the Nike IPR, when it was expanded,
2 was the expanded panel determining the
3 patentability of Nike substitute claims?

4 A Well, again I, you know, I think that's
5 a very you know, I don't want it know, when you
6 decide a case, it certainly decides procedural
7 issues as well as substantive issues. Right. And
8 you can say that that's merits decision, if you
9 will.

10 Q Well, we can we can set up set aside the
11 actual language of merits versus trial. I just
12 want to know when you were deciding, when you were
13 on the expanded panel and Nike was the expanded
14 panel determining the patentability of Nike
15 substitute claims.

16 A Well, again, I think my answer before is
17 what is the best one that I had is that based on
18 the you'd have to go back and look at, I believe
19 it was Judge Chan's remand decision and to see
20 what issues he left open for the board to relook
21 at it on remand.

22 Q All right. Could you turn to tab 7 at

1 page 391, please?

2 A Okay.

3 Q All right. And what we're looking at
4 here is the draft March opinion that you didn't
5 author, but you reviewed and you approved in the
6 Nike IPR. Is that right?

7 A I guess so.

8 Q Okay. Now turn to page 396, of the same
9 tab. And in the second paragraph, the last
10 sentence. Why don't you read that for us?

11 A For the reasons that follow, when
12 considering the entirety of the record before us,
13 we conclude that the preponderance of the evidence
14 established that substitute claims 47 to 50 are
15 unpatentable.

16 Q Okay. So when you were on the expanded
17 panel in the Nike IPR, will you agree with me that
18 the expanded panel was determining the
19 patentability of Nike substitute claims?

20 A Well, as I said, I think I testified
21 before that the I had encouraged the panel to get
22 to the merits of the decision as opposed to use

1 procedural outs. So if this is reflective of that,
2 then so that would be the case, I guess.

3 Q All right, Judge Ruschke. Anyways.

4 A Okay.

5 Q Yes. Let's turn to tab 7 at page 765.

6 And here, Judge Fitzpatrick forwards an email to
7 Acting Director McCall. Is that right?

8 A Hold up let me get there. 765, got it.
9 Okay.

10 Q Is that right?

11 A Yes.

12 Q Okay. So in December, he now elevates
13 this oil state's issue from the Chief Judge
14 (phonetic) to Acting Director of the Patent and
15 Trademark Office. Is that right?

16 A To Joseph Natale? Yes.

17 Q And did you respond to Judge
18 Fitzpatrick's email in December 2017?

19 A I have no -- again, same answer that I
20 had before on the previous email that he sent.

21 Q Okay. And did you know that he
22 forwarded this email to Acting Director Natale to

1 then sworn in Director Yonkou.

2 A I have -- I don't know whether he
3 forwarded it to Andre or not.

4 Q Did you talk to Director Yonkou about
5 Judge Fitzpatrick in the Nike IPR?

6 A No, I don't believe we did.

7 Q All right. So Director Yonkou, was
8 sworn in, I think you said, what, February 2018?

9 A Is that right? That's my recollection,
10 yes.

11 Q And then he starts -- and then he learns
12 about what's going on in the Nike IPR. Is that
13 right?

14 A Who?

15 Q Director Yonkou?

16 A Well, I guess if Michael forwarded it to
17 Andre, then I guess that's how he became aware of
18 it.

19 Q Did the Director Yonkou ever ask you
20 what was going on with the Nike IPR remand?

21 A I don't believe -- I don't have any
22 memory that he did ask. No.

1 Q Okay. Did you ever tell him that you
2 expanded the panel in the Nike IPR without
3 notifying the parties or the public?

4 A I don't remember having any discussion
5 with Andre about the expansion of the Nike Adidas
6 case.

7 Q Okay. You don't remember -- Do you
8 remember having any discussion with Director
9 Yonkou about the Nike IPR at all?

10 A No, I don't recall.

11 Q Do you remember having any discussion
12 with Director Yonkou about Judge Fitzpatrick?

13 A I believe that he -- didn't Michael call
14 him?

15 Q Do you -- You haven't -- You think that
16 Director Yonkou spoke to Judge Fitzpatrick by the
17 phone?

18 A I thought -- I have a vague memory that
19 I thought Michael called Andre. But that would
20 have -- that's my only memory that I have.

21 Q Okay. Just so I understand this timing,
22 Judge Fitzpatrick was then pulled off of the AIA

1 trials around May 2018. Is that right?

2 A I don't know the timing on that. Again,
3 that was not something that I was involved in.

4 Q Okay. How about the mailing of the Nike
5 IPR remand decision? That was in September 2018.
6 Is that right?

7 A Again, I was onto my new position at
8 that point, so you'd have to look at the dates on
9 the front of the opinion to see when it was
10 mailed.

11 Q Okay. And when were you on to your new
12 position?

13 A I was transitioning end of August into
14 September.

15 MR. KAPPERS: Okay. I have nothing
16 further.

17 BY JUDGE NIEDRICK:

18 Q Okay. Thank you. I just have a few
19 questions. You testified that you wanted to make
20 sure that you had consistency in procedures. And
21 that was not only for the APJ Corps, but also
22 within the PTO and for stakeholders and the public

1 with regard to the expansions that occurred. And
2 I'm assuming this all my questions all relate to
3 after the AIA was passed. How many times are you
4 aware of an expansion occurring? Either all the
5 way through and final decision issued by the
6 expansion panel or it being expanded like it was
7 in the Nike case and then unexpanded. How many
8 times are you aware of that?

9 A So one of the things that we did before
10 -- between political appointees was try to pull
11 together data. We have a fairly good data
12 collection system at the PTAB. And so if you look
13 at the PTABs website, there is a -- there should
14 be at least we had put together a number of data
15 studies and one of those data studies was on the
16 frequency and reasons for expansion of panels. And
17 so I remember we presented that data at, we did --
18 I think every monthly sort of like board side
19 chats.

20 And we presented that data to the
21 public, the stakeholders, at least on one occasion
22 I recall, and I, if I remember correctly, that

1 data showed, you know, it was it was quite
2 infrequent and it really went to sort of again,
3 the consistency that the example I used I remember
4 was there were 10 or 12 cases that we were worried
5 were going to have different claim constructions
6 because of the way the panelling was. And so we
7 wanted to have overlap of panels.

8 So a big chunk of the cases were that
9 for that reason, and again, it wasn't for
10 overturning a panel decision or anything like
11 that. Another group of cases that was important
12 to us to be consistent on dealt with sovereign
13 immunity. And this was an issue that hadn't been
14 decided by the board or by the Fed circuit, and
15 the cases had been coming down. There were
16 multiple petitioners and multiple patent owners,
17 and we were worried that the -- they could be
18 decided a lot of different ways. And this had to
19 do with whether the university had sovereign
20 immunity as a patent owner.

21 And it could either be that they did
22 have sovereign immunity. In which case they would

1 be immune from PTAB. They didn't, in which case
2 they would be subject to them. Or they had
3 sovereign immunity, but they had waived it by
4 participating in the process. So there were three
5 options and it was unclear as to which option
6 would actually prevail. And this was one of those
7 situations where we expanded the panels in order
8 to make sure that there was going to be
9 consistency of the parties.

10 Because I remember I think it was the
11 University of Minnesota, it was definitely one
12 party that might have been treated separately. So
13 we needed to expand the panels in order to have
14 significant weights so that we would get one
15 message sent up to the Fed circuit. And in that
16 situation, actually, the decision that went up was
17 that sovereign immunity did apply, but that the
18 patent owner had waived it and we were reversed,
19 but at least we had our answer. And that was the
20 purpose of expanding the panel, was to make sure
21 that you set the issue up directly for the Fed's
22 circuit. That was a key feature.

1 Q Okay. And you mentioned at one point
2 that your predecessor had expanded, or at least
3 you suggested I just want to get more information
4 on that, that your predecessor had expanded a
5 panel to change an outcome. Can you give me some
6 more details on what that was when that occurred?
7 I'm assuming that was after the AIA?

8 A Yes, it was after the AIA and it was so
9 there were essentially I had it there was an
10 acting Chief Judge before I came on, Nate Kelley.
11 And then before Nate, there was James Smith. And
12 James Smith was the first Chief Judge of the
13 reconstituted PTAB. And the issue that was
14 really, really dividing the board was on this
15 procedural issue of same party joinder. And it
16 was an important issue. And I don't -- Michael
17 can tell you all about it. He's well versed in
18 it. I've been -- not going to know all the facts
19 as well as he does, but my understanding was that
20 there was a decision by -- I can't remember which
21 way it went.

22 But literally we took a straw poll at

1 the board and the board was split 50-50. And so
2 it really was whoever happened to be assigned that
3 panel, they got to sign that panel. It might come
4 out a different way. And if I remember correctly,
5 James expanded the panel once. And he didn't get
6 the result he wanted. So then he expanded the
7 panel again. And I'm not sure if he expanded it
8 again or changed the composition, but he did that
9 in order to get the result that was at that point
10 that he felt was the policy of the USPTO at that
11 point. So that was definitely I mean, again, how
12 do you count this judge? Is that two panel
13 expansions per case? And is it one docketing
14 number? Is that one case or is it the same
15 parties, one case?

16 So it gets a little confusing there when
17 you try to count. And then underneath Nate
18 Kelley, when he was acting, I believe the exact
19 same issue came up and he expanded the panel as
20 well in order to resolve that. And that again
21 flipped the underlying result. But it was that --
22 I'm pretty sure, that's my recollection of what

1 and those were the ones that caused the major
2 trauma on the board because that impacted a lot of
3 the Judge's feeling of judicial independence.

4 And it's very true. And unfortunately,
5 at that point, our acting well, our the
6 undersecretary at that point and then the acting
7 undersecretary, Joe Natale, there wasn't explicit
8 guidance on that issue other than some briefs that
9 we had put together on this issue to go up to the
10 Fed circuit. So sorry, that was a long answer,
11 but I hope that --

12 Q No, I appreciate it. And do you know
13 whether during that process where Smith was
14 expanding and then changing in order to sort of
15 get this result, was that disclosed to the parties
16 during that process or did it, was it just issued
17 with a panel names, and that's who they thought
18 made a decision?

19 A Yes. I don't have any personal
20 knowledge of that whatsoever. I've never spoken
21 to James about it, and I've never spoken to the
22 panel members about that. But again, I highly

1 doubt that that was disclosed to the parties.

2 That's just not something the PTAB did until we
3 changed SOP1.

4 Q Okay. And with regard to SOP1, I know
5 there's a number of sort of considerations that
6 you would consider in determining whether to
7 expand a panel or exercise your authority to
8 expand the panel. And we talked about consistency
9 and exceptional importance. And those were
10 factors that guided you in expanding the Nike
11 panel, is that right?

12 A Yes.

13 Q Okay. And you'd also talked about how
14 important it was for the parties to be aware of
15 who was on the panel. Initially so that they
16 would know who made the decision, that there was
17 transparency, that things weren't being done
18 behind their backs. I think that's what you
19 testified to, right?

20 A Well, I think what I testified to was
21 that I was glad to see the transparency put into
22 place into the new SOP1. And again, those

1 considerations that we used for the old SOP were
2 essentially incorporated into the new one, when we
3 formed this thing called the Precedential Opinion
4 Panel, the POP. And so it was consistency, it was
5 exceptional importance. Notice to the parties
6 that all was incorporated in SOP1 when it was --
7 when that was revised eventually. So, you know,
8 again, but I think there was, I'm not sure I think
9 I heard you say I think it's you know,
10 transparency is very important. This director
11 review process post Arthrex is, we're trying to
12 make that as transparent as possible.

13 But again, at the time when we were all
14 doing this, there was no sense that this needed to
15 be done. And in fact, you know, we would change
16 judges. As I said, there were many situations
17 where I think it was unfortunate, frankly, a panel
18 would be constituted, for instance, and then at
19 the next conference call, there would be a
20 different panel, of different panellists there.
21 And that could be because of -- we had that
22 because of retirement, illness. I remember

1 somebody's husband got a new job which conflicted
2 her out of her responsibilities. And so we just
3 handled that in the normal course of panelling.
4 We picked somebody new to come on, that sort of
5 thing, but it was never really notified to the
6 parties until there was that sort of final
7 decision that went out.

8 Q And why --

9 A And we also, if I might, sorry Judge,
10 just -- one of the other dynamics that was going
11 on here, too, is that unfortunately, my judges
12 were being hounded a lot by the public and they
13 were being criticized because of their lack of
14 skill sets. And so one of the -- there was the
15 sensitivity of publishing the resumes of the
16 judges. We were asked on multiple FOIA requests
17 for the judges. There's a judges book that people
18 put together, and they wanted everybody's resume.
19 And then they were using that information as
20 fodder to criticize the use of the judges. So
21 there was that dynamic, too, going on at the same
22 time that we wanted to protect the judges from

1 these outside attacks and let them do their job.

2 So that was also going on at the same time.

3 Q Okay. With regard to the original SOP
4 before it was revised and the idea that this
5 wouldn't be something done frequently, the
6 expansion of panels. Why not? What difference
7 does it make? Why was there, you know, clear
8 guidance in your SOP to say we're not going to do
9 this all the time?

10 A I think mainly because well one reason
11 was because of resources, right, we wanted --
12 three judge panels consume a lot of resources as
13 it is to have five, six, seven judge panels would
14 be even more work. And we were underwater when it
15 came to the workload. We just did not have a lot
16 of resources, you know. In fact, we were it was
17 suggested over and over again and it still is that
18 we change the panel after institution before the
19 trial so that you get a fresh set of eyes. Well,
20 that's essentially an expansion of the panel from
21 three to six, if you will, only in the different
22 phases of the trial. But I mean, it's an

1 interesting question you ask. I mean, I think
2 because the way the USPTO operates, right,
3 everything comes from the director on down and
4 then the examiner. Essentially one person gets to
5 decide whether you get this monopoly on a patent.
6 Right. And of course, that person is supervised
7 by a Supervisory Patent Examiner, and there are
8 Directors and all the way up the chain. But
9 ultimately, that's all.

10 You know, once you become an examiner
11 with some -- with your essentially your signatory
12 authority, you get to decide those big issues.
13 And I think that was still the mentality and it
14 still is to get to allow these three judge panels
15 to decide those cases and be as independent as
16 they possibly can. And again, independent in my
17 mind was always based on the technology. If we
18 can get to the technology, look at the prior art,
19 look at the claim construction, we're home free.
20 That's what we were hired to do. It was
21 unfortunate a little bit that, you know, the way
22 the rules are written and the way the statute is

1 written, frankly, we're hamstrung by that, of
2 course. But procedural issues are, you know,
3 instead of we have 60 pages on a brief and instead
4 of 60 pages of argument based on technology, we'll
5 get 45 pages based on the procedural issues that
6 we have now.

7 And I think that's an unfortunate way to
8 go. It's happened, but that's why these
9 procedural issues have just sort of swamped the
10 board in terms of its time. So that's why it was
11 important to try to put clear procedural lines in
12 place so that they could do their job more easily.
13 And it was just clear for everybody.

14 Q Okay. And I know with regard to the
15 reasons for expanding in Nike with the exceptional
16 importance and consistency concerns, why wouldn't
17 that be appropriate to disclose to the parties in
18 advance so that they know, while they're pleading
19 their case, that the PTO has identified their case
20 as containing issues of exceptional importance and
21 consistency with the way the process works. It
22 seems to me if the PTO really is concerned about

1 transparency. The justifications for expanding
2 the panel should be disclosed to the parties so
3 that they understand this, the ramifications of
4 their case.

5 A Right. And I think, oh, I totally hear
6 you, Judge. And I think one of the one of the
7 things that you struggle with is and, you know, in
8 the government just as well as I do, that
9 sometimes things work, move very, very quickly,
10 and sometimes things move very, very slowly.
11 Right. And I think in this situation here, we had
12 a situation where there were so many moving parts,
13 not just on personnel, but on (phonetic) federal
14 circuit cases. Then we have a new director coming
15 in to decide orders and things like that in
16 different policy that if you set something back in
17 a year ago is of exceptional importance. That
18 might not be the case six months from now or a
19 year from now, and things particularly in a very
20 volatile environment that we were working under.

21 So that's why I think it's -- because I
22 look at I have very intimate knowledge now of the

1 director review process and of the POP Screening
2 Committee that has implemented the new SOP1. And
3 it's difficult to identify issues of importance
4 because what might be important to, frankly, one
5 side of the business unit, the patents group,
6 might not be decided. It might be said no to by
7 our solicitor's office because they feel that
8 issue is already up before the Fed's circuit and
9 we shouldn't be, let them decide at first. Let's
10 just wait.

11 Let them decide it. It might not be
12 ideal for the parties or for us, but let's just
13 keep it on our docket and then it gets decided.
14 So that, I think, is why there is a reluctance to
15 announce too quickly and too early what is an
16 issue of exceptional importance.

17 And we see a lot of POP requests that
18 use that exact same language. This is an issue of
19 exceptional importance and it's like, well, maybe,
20 but it might just be of exceptional importance to
21 you because it's your patent. And so that's, it's
22 a fine line there. And again, at the stroke of a

1 pen, the Director can issue guidance. And I mean,
2 I think the best example of that was we were
3 trying to get a precedential opinion together to
4 get this issue of applicant admitted prior art
5 resolved once and for all. This is literally six
6 years ago and we couldn't find a good case and we
7 couldn't get traction anywhere.

8 And finally, when Andre came on board,
9 it wasn't super high on his list, but he issued a
10 memo that said, This is how we're going to be
11 handling, applicant admitted prior art. It took a
12 while to get that together, but it was literally a
13 five year process. So that's why, you know,
14 there's a number of different considerations, not
15 just to expand the panel and let everybody know
16 and let the cards fall as they may. And again, I
17 think one of the nice things about SOP one as
18 revised now is that the concerns about expanded
19 panels are considerably less. And because the
20 director and the Commissioner for Patents are on
21 the POP panel. There's an avenue for them to
22 really get these things raised in a proper way.

1 So, you know, I think that's I really am very
2 happy about how that process has evolved. But it
3 was very much in flux. Very much in flux.

4 Q And I could see that things changed.
5 And I can appreciate the idea of seeing a new, a
6 whole new area of process that you guys had to
7 sort of adapt to. One of the things that I'm
8 struggling with in this case is the concept of due
9 process. And from your testimony, I'm trying to
10 understand in your world what due process means
11 for these litigants. So my understanding based on
12 the sort of essence of your understanding of due
13 process as it relates to the AIA and what
14 litigants are entitled to is the only due process
15 of right they have is a decision by the Director.
16 Is that right? Is that your understanding of due
17 process?

18 A Well, yes, that's a good question. And
19 I hope I didn't give you -- I know I was I didn't
20 try to be evasive to Mr. Kappers' questions on due
21 process, because I know that's kind of a crucial
22 thing for for Michael's position. Obviously, it's

1 not that we don't care about due process. That's
2 not the case at all. But, you know, it's an
3 interesting situation, though. I remember where
4 we've had many discussions where we have said, I
5 don't think this I've certainly never sent an
6 email on this, but we certainly had a lot of
7 discussions that said, give the parties as much
8 due process as possible.

9 It doesn't do us any harm. And one of
10 the best examples was in Aqua Products, for
11 instance, the case that was dealing with the exact
12 same issue when that came back on remand, the
13 panel, including Mr. Arpin, Jim Arpin, was on the
14 case. They didn't want to give him extra briefing
15 on this issue. And we had said, just give them
16 five pages of a brief. We want to make sure that
17 they have had an opportunity to tell us their take
18 on Aqua Products. It doesn't hurt us. You're
19 going to read five pages. That's all there is.
20 So I just want to make sure that I'm not sure if
21 I'm answering your question correctly, but I just
22 wanted to clarify some of my comments on due

1 process.

2 It's not that it's not important, but it
3 certainly is. There's a lot of variations of due
4 process that are raised that, frankly, the Fed
5 circuit has said either Rule 36 didn't said we
6 don't want to -- we don't care about it, or that
7 they have essentially said that there wasn't due
8 process. And frankly, you know, one of the things
9 that we did was puts things in the trial practice
10 guide, like give the patent owner a sur-reply. It
11 is the institution stage so that he does have a
12 chance to respond to the petitioner so that it
13 didn't seem so one sided. So it due process has
14 been important to us and those are the changes I
15 think we've been making. And they're incremental
16 some are more than others.

17 But I think certainly there's going to
18 be and there are due process challenges made post
19 Arthrex because almost every single appeal post
20 Arthrex raised the due process issue that the
21 Acting Commissioner was the commissioner for
22 patents who's acting as the Undersecretary, still

1 doesn't have the directorial control over the
2 board that the Supreme Court said. So we're
3 dealing with those due process issues on a daily
4 basis, frankly, with all of these cases. And now
5 that Kathi Vidal is the new Undersecretary, we're
6 getting we just filed a brief this past week where
7 all of the people who had their director review
8 petitions decided underneath the acting director
9 have renewed their petition in front of the Fed
10 circuit. So due process is front and center for
11 us, Judge.

12 Q But under the law, I just want to know
13 your understanding of what you think parties are
14 entitled to under the law. Under the law, the
15 only thing they're entitled to is the decision by
16 the Director. Correct? I mean, the Director can
17 go in and change whatever he wants. The Director
18 could say, I'm not giving you any opportunity to
19 respond. I'm not going to give you an opportunity
20 to brief this issue. I'm going to issue a
21 decision based on what I see here. I mean,
22 technically, under the law, that's your

1 understanding of their due process rights.

2 A I would agree with you. And I would
3 point out specifically under the institution
4 phase, for instance, right, under the institution
5 phase, the Director really has the authority.
6 Now, he's delegated that to decide the institution
7 to the board. But there were many discussions out
8 there in order to frankly, after the SAS came,
9 case came down, there was so much more work we had
10 to do, so much more work.

11 And one of the things that we really
12 have been trying to do was say, do we want to go
13 to a single line institution decision? And that
14 would have been exactly what you were talking
15 about. No discussion, no briefing. Just the
16 director himself says this case, this one is
17 instituted, this one is not instituted. Go to
18 trial. That's exactly right. So and that
19 scenario that you're talking about, I think, is
20 very -- you know, a lot of the arguments come out
21 of that because it's the institution decision,
22 which is really the purview of the director.

1 Q Okay. And back when sort of all this
2 Nike when the Nike issue occurred and sort of
3 prior to the expansion, the panel who had been
4 designated in that case had made a decision. And
5 they essentially, I guess, through your process,
6 have to run that by the ARC first. And then in
7 this case, the ARC looked at it and said, okay,
8 here's our added suggestions, I guess. And then
9 they also said, we suggest that you send this to
10 the Chief and Deputy.

11 Because you have I think they said
12 because you have a concurrence opinion or
13 something. And I'm always sort of concerned about
14 the language that it seems that is. Terms of art
15 for you the term suggestion when they say we
16 suggest that you do this, does that mean that the
17 panel could have just kind of mailed this thing
18 out after getting the ARCs edits?

19 A It's happened before, Judge. I'm pretty
20 sure that decisions have mailed that on
21 retrospect. Probably should have gone through the
22 ARC review process. Now I'm pretty sure that there

1 were changes that were made when I was there in
2 terms of ARC. We tried to identify specific
3 issues that we wanted to have consistency on.

4 So before I think and I'm not sure if
5 Nike was under this old regime or not, it might
6 have been where every single case had this
7 quote-unquote suggestion, if you will, if there
8 was a concurrence or a dissent. But now I mean, I
9 think that's still probably the case. But you're
10 right. I mean, there is this notion I mean, that
11 was the process that was set up and it was set up
12 specifically. So to essentially deal with these
13 to avoid the need for expansion, if you will.
14 And, you know, and frankly, to get out in front of
15 the issue, because we issue opinions that affect,
16 you know, severe property and monetary rights out
17 there.

18 And it's always important for us as an
19 agency to make sure that when a decision is coming
20 out that is going to have press, we want to make
21 sure that the director is aware of it so that he
22 doesn't get blindsided by a question so that he's,

1 you know, he knows what's going on in his agency,
2 essentially. So that was another purpose for it.
3 It wasn't necessarily to, you know, to change the
4 opinion or to wordsmith it to death. And, of
5 course, you know, we always encouraged everybody,
6 all the judges, to be on the ARC Committee, but a
7 lot of them didn't want to be. And I would have
8 hoped that they would just because then they get a
9 they see how the sausage is made, if you will, at
10 that point. But that was another reason for the
11 ARC.

12 Q So if Judge Arpin and Judge Fitzpatrick
13 and the other panel member can follow, it is if
14 they would have just issued that decision after
15 they got the edits from the arc, would they have
16 been in trouble?

17 A In trouble. It probably you know, it
18 wouldn't have been something that I mean, it
19 probably would have been technically
20 insubordination, right? They're not I don't think
21 the judges have the right to send a pin. Again,
22 I'm sorry that the details on the intimate

1 operation of when it gets mailed and who sees it.
2 I was looking at it from a much higher standpoint.
3 And so only the issues that rose to that up
4 through the ranks did I get averse to.

5 But I think there would have been
6 definitely an issue with the judges. I'm not
7 saying they would have been in trouble, but it's
8 just, you know, the PTAB management requested that
9 these decisions all go through ARC. That's just
10 the way --essentially every single air decision
11 had to go through ARC. That was the mandate that
12 I inherited from my predecessors and it was just
13 maintained throughout that entire process.

14 Q Okay. Yes, I understand that the sort
15 of ARC piece, but I guess the question that I have
16 is when the ARC suggests that the panel does
17 something, whether there's a requirement that the
18 panel do that, is that a Directive from the ARC or
19 is that a suggestion from.

20 A It's a suggestion, yes. Frequently, if
21 I remember correctly, there would be things like
22 there was -- there would be like one or two

1 sentences in the opinion that just were just
2 unnecessary to the holding or a unnecessary to the
3 decision. And it just raised something that was
4 -- that somebody could grab on to and use and cite
5 back against us later saying, well, PTAB has
6 already decided this issue this way. And so there
7 would be a suggestion back saying, you guys don't
8 really need this sentence. Consider taking it
9 out.

10 And I said they would or they would edit
11 it, that sort of thing. But yeah, that was --
12 that's typically how it went. And we did have I
13 remember there was certainly on the -- we had a
14 one of the very big issues that we were dealing
15 with throughout the summer and fall of 2017 was
16 the multiple petitions issue. How many petitions
17 could a petitioner or file against a single
18 patent?

19 And so we had put out a case that was
20 informative and then made precedential. And in
21 that situation, there was this there were
22 essentially seven factors that were being

1 considered. And I remember one of the discussion
2 points was when you put point one and two beneath
3 three through seven, because one and two are
4 really of a different ilk. And so it was that
5 sort of a suggestion to the panel. And they went
6 back and decided on it, and it was fine for them
7 to do that. So they did it, but sometimes you'd
8 get pushed back and say, No, I want to include
9 that in there.

10 Q Okay. The statutory requirement that
11 you mentioned, I guess you guys have a year once
12 the case has gone to trial am I understanding
13 that. Right or is that on a remand from the
14 federal circuit?

15 A Yes. There's essentially two clocks.
16 One is in the institution phase. And then what
17 you're referring to is the trial phase. So once
18 the case, once the trial is instituted, so in an
19 IPR that a reasonable likelihood to prevail that
20 the claims at least one or more claims are on
21 patentable has been found. That starts the one
22 year clock and that's a statutory requirement that

1 does have an exception that the Chief can
2 (phonetic) that for another six months. And
3 again, we did that when Apple products came down
4 because that was a major, major sea change coming
5 down from the federal circuit in a lot of ways.

6 And we had to adapt quickly. So there
7 we used our six month extension on remand. That
8 clock no longer exists. However, we wanted to try
9 to get the decisions out quickly. Initially, the
10 recommendation from the board had been that there
11 would be no time limits on remand, and I actually
12 put in place an SOP. I encourage them to do it,
13 to have a goal of a six month time frame in order
14 to do the remands. And again, that was assuming
15 it would be going to the same panel and it would
16 be a fairly limited remand. Obviously we can see
17 that sometimes the remands coming back from the
18 federal circuit are very involved.

19 Q And I guess that's one of my questions
20 is we sort of have similar deadlines sometimes,
21 and it is a reflection on us a lot of times as the
22 adjudicating judge if things are delayed. And so I

1 guess my question to you is, what does the office
2 do? What is management do when you have a panel
3 like this that's saying, hey, this is going to go
4 up to the federal circuit and reflect poorly on us
5 just based on this delay that's occurred? That is
6 no, you know, it doesn't have anything to do with
7 us. This is kind of behind the scenes. What --
8 is there anything that the management does to make
9 it clear to the federal circuit that the
10 adjudicating judges weren't responsible for the
11 delay?

12 A I don't think so. I don't think that
13 there's anything that they affirmatively do that
14 might come up in oral argument. For instance, I
15 know that when I've listened to oral arguments,
16 there might have been a question of, you know,
17 typically because of the delay, a very important
18 issue might not come up. Let's say this is a
19 great example. It just came up a year ago when
20 the original case was decided back in 2013, for
21 instance. Well, that's a whole nother world from
22 2013.

1 So it might come up in oral argument, in
2 which case you would look at the procedural
3 history and that could be explained by the
4 Solicitor's Office. But I think another example
5 of that and this unfortunately happens a lot, is
6 on the patent side of the house, you have a number
7 of patents that don't get issued promptly, that
8 sit in certain examiners dockets. And because
9 it's an ugly case, for instance, or it's difficult
10 or there's a lot of prior art, it takes a long,
11 long time for that to get resolved.

12 And so one of the ways that we have done
13 it on the management side, at least on the patent
14 side now, is to tie our goals, which implicates
15 not only whether we meet them, but it's also our
16 bonus structure, whether the if you don't meet
17 those pendency goals and you have these outliers,
18 then you're able to that really sort of hits you
19 in the pocketbook, if you will. But even on PTAB,
20 we had X Party appeals. We had a number of folks
21 that a number of the judges, they had a lot of
22 really, really old cases. They were sitting on

1 them for two, three years. And frankly, at that
2 point, they might not have even known who their
3 judges were.

4 That was another thing. Those were
5 completely none of those X Party appeals judges
6 were disclosed to the parties. And so in order to
7 get rid of that, we put in a goal that the judges
8 had to work on their oldest case first, you know,
9 and move forward that way. And that's the way we
10 got rid of the oldest cases. Those, you know,
11 those real dog cases that sit out there and we
12 allowed for transfer. That was another thing we
13 did is we allowed that the judges, if it was a
14 difficult case or it was something that just
15 wasn't moving, let one of your colleagues handle
16 it.

17 Q Okay. This kind of leads to my next
18 question with regard to the identity of the panel.
19 So you'd originally testified that that it was
20 important for the parties to know the identity of
21 the panel. So that I guess just for transparency
22 purposes and to know that something wasn't going

1 on behind their back. And but in this case, when
2 you expanded drafts were prepared, even a majority
3 decision draft under your name was prepared. That
4 sort of during that process, there was no sort of
5 reason to notify the parties. Is that accurate?

6 A Yes. Throughout the entire process we
7 were operating under the existing SOP1 rules that,
8 you know, that I had inherited. But you know, a
9 number of the board members that I or the
10 executive that I had in my committee --mon my
11 committee were particular Judge Bullock. He'd
12 been on the board since, you know, the early 2000,
13 pre AIA, that sort of thing. And that's just --
14 that's how it operated. And so and I know that
15 may or may not be particularly satisfying, but it
16 was certainly not viewed as being there was any
17 due process violations or that it would affect the
18 outcome of any decision or that ultimately that
19 the parties were going to be harmed in any way.
20 You know what?

21 You know, again, I have to say, I mean,
22 you know, when you say I was concerned about the

1 transparency, I am concerned about the
2 transparency, but and I'm glad it resolved the way
3 it did, but there was no guarantee that that's how
4 it was going to be resolved, because a number of
5 the options we had still, you know, essentially,
6 you know, keep the process exactly the way it is
7 or even tighten it up even more or as you
8 suggested earlier, use it more, use it to expand
9 panels on a regular basis. And fortunately, I
10 think we got rid of a lot of those panels. But,
11 you know, again, there was nothing in my mind that
12 was nefarious or concealing about the identity of
13 the panels for any improper purposes. That's what
14 we did. Unfortunately, the timing of this thing
15 got dragged out at infinitum and it was just not
16 good. But I do not think that the parties were
17 harmed in any way.

18 Q But I guess my question really is, why
19 not just disclose it when you have panel judges
20 saying, hey, let's disclose this, you know, it
21 can't hurt anything, why not just disclose it?
22 And that solves two problems because now the

1 parties are notified. So there's clearly nothing
2 going on behind the scenes where you're hiding it
3 from them. And the panel that is sitting on the
4 case can say, look, now, you know, why implicitly
5 why this thing's been delayed. But why didn't you
6 just do that at the time?

7 A Yes. So remember that the way this was
8 floating through, we had an Obama appointee,
9 Michelle Lee, as our commissioner, and then she
10 was held over into the Trump administration. And
11 then we had Joe Natale as acting, and then we had
12 Andre Yonkou ultimately as our confirmed. So that
13 essentially is our universe. Now, this would have
14 been essentially a policy change, right? And so
15 we wanted to bring this.

16 Q Why would it be a policy change?

17 A We call them the front office or the
18 10th floor. They would have the front office, the
19 undersecretary and her team or his team would have
20 wanted to know about these sorts of changes
21 because this would have been something that would
22 have been noticed.

1 Q You know, so when you're talking
2 changes, you're talking about the changes of
3 notifying a party that there's a different judge?

4 A Yes. So I didn't feel like I could just
5 unilaterally say to Michael and to Jim, yes, let's
6 absolutely do this. I would have raised it to the
7 undersecretary and his senior advisors, his or her
8 senior advisors. Then we would have discussed it.
9 There would have been ramifications to it. And
10 one of the ramifications, I think, that was
11 problematic was, well, we have to announce it for
12 everybody and nobody, you know, for all of the
13 cases. And there was also an administrative piece
14 to it.

15 What happens? Do you have to announce
16 every single time somebody had an ethics conflict
17 arise or somebody got -- we've had one of the
18 judges got sick. You know, maybe we didn't have
19 to disclose the illness, of course, for
20 confidentiality reasons, of course. But, you
21 know, it was it was all of those sorts of it seems
22 so easy just to say, well, just send him a note

1 and just do it. But, you know, within the
2 agencies, you have to go up level, by level, by
3 level. And this would have been something that
4 they would have wanted to know all the way to the
5 top. And they would have wanted to know, well,
6 how is this going to impact everybody? And one of
7 the biggest problems that was arising in this time
8 period, remember, from June?

9 Q Yeah, but I, understand why you're
10 saying, but it wouldn't have, it wouldn't really
11 have expanded much because you hardly ever
12 expanded panels. And the idea that, hey, you
13 know, having to notify parties of changes in their
14 panel was already being done and in fact, it
15 wasn't done in Nike.

16 They notified the panel when Judge
17 Fitzpatrick had been removed and another judge had
18 been placed on the panel. It went out under this
19 same policy that you're talking about. So I don't
20 understand this idea that somehow this was a big
21 change in policy when parties have been notified
22 prior to the final decisions being issued that the

1 composition had changed, whether had it changed
2 through an expansion or whether it had to change
3 because a judge had been removed from a panel for
4 sickness or in Judge Fitzpatrick's. Situation
5 because management decided that. So I don't
6 understand what you're saying, it doesn't resonate
7 with me. It doesn't seem to make sense.

8 A Well, I don't know when, you know,
9 again, the timing of when the decision went out
10 and the SOP1 being revised and I don't know when
11 the Nike folks were identified or notified of the
12 change in panel. Again, you know, I think I don't
13 know if they were contemporaneous in time. I can
14 understand that because that was the that was the
15 movement. After two years of working through many
16 directors and again with Joe Natale as acting, he
17 didn't want to make any decisions that would upset
18 the new director.

19 So there was a lot of stuff that was put
20 on hold before -- until February of 2018 when the
21 new director came into place. So I could
22 understand why, Michael, why that would have done.

1 I don't know if it was before the new final
2 decision or not, must have been fairly close in
3 time. But that's because SOP1 was, you know,
4 after two years was moving in that direction. And
5 so I can easily see why that happened. So and
6 again, that was a single case, but I don't think
7 we did that. I don't recall ever doing that in
8 other cases.

9 Q Okay. I guess my last question is, it
10 seems as though Judge Arpin and Judge Fitzpatrick
11 were essentially making the same argument about
12 expanded panels. Is that -- was that your
13 understanding that they shared the same concern?

14 A I don't, that's -- I'm not sure, you
15 know, because, again, a lot of this stuff coming
16 through would be filtered, if you will, through my
17 management team up to me and saying like this has
18 been raised. So but I will say, I mean, Michael
19 and Jim were very much simpatico on a number of
20 these issues. I think you guys were on the same
21 side of the same party joinder issue, you know,
22 and so I would not be surprised if they held the

1 same viewpoints. They're both very, very smart
2 judges and they have a lot of opinions on a lot of
3 things. And that's actually good for the board,
4 right. In order to raise some of these issues.
5 That's absolutely good. But once it's decided and
6 this is the policy moving forward, we need
7 everybody to get on board and move forward.

8 JUDGE NIEDRICK: Okay. Thank you, Mr.
9 Horrigan, any follow up?

10 REDIRECT EXAMINATION

11 BY MR. HERRIGAN:

12 Q Yes, just one matter. I'd like to clear
13 up a little bit. If you could go back to tab 7,
14 page 656, please.

15 A Okay. Hold on. Okay.

16 Q I asked you about that first sentence
17 about that May conference, you recall that. And
18 you said that was not your understanding of what
19 happened, right?

20 A That's not my memory of it at all. No.

21 Q Okay. Do you recall whether the subject
22 of panel expansion and Mr. Fitzpatrick's position

1 was discussed during the course of that
2 conference?

3 A I think it probably was, you know, You
4 know, there's this line down there about he asks,
5 will you please provide me that opinion? You
6 know, again, everything is done verbally at the
7 patent office and there was no opinion to share.
8 But that had been the opinion of the Office of
9 General Law since the decision was made back in
10 the mid nineties. So I don't doubt that panel
11 expansion came up because that was part of his, if
12 I'm not mistaken, that was part of the new part to
13 his concurrence at that point.

14 Q Okay. Now having had this roll around
15 in the back of your head for a couple of hours
16 now, did you ever say that the decision on remand
17 will not go out so long as he continues to discuss
18 panel expansion in his concurring opinion?

19 A I don't recall saying that at all. I
20 really don't. I'm sorry. I just don't.

21 MR. HARRIGAN: Thank you. Nothing
22 further.

1 JUDGE NIEDRICK: Okay. Mr. Kappers, any
2 follow up?

3 MR. KAPPERS: No follow up. Thanks.

4 JUDGE NIEDRICK: Okay, great. Thank you
5 very much, Judge Ruschke, I really appreciate your
6 patience this third day for you, I know. Please
7 don't discuss your testimony with anyone. If you
8 have any questions, please contact Mr. Horrigan.

9 THE WITNESS: Well, I hope I was
10 helpful, Judge.

11 JUDGE NIEDRICK: Yes, thank you. And
12 you can go ahead and hit leave meeting or I'll
13 remove you either way.

14 THE WITNESS: Okay. Thank you. All
15 right.

16 JUDGE NIEDRICK: Thank you. Okay.
17 Great. All right. So, why don't we go ahead and
18 take a lunch break now? How much time is a half
19 hour enough for everyone? Or would you like 45
20 minutes? Any feelings one way or the other.

21 MR. HARRIGAN: Thirty minutes is okay.

22 JUDGE NIEDRICK: Thirty minutes is

1 enough.

2 MR. HERRIGAN: Okay. So you asked me to
3 raise Janet Gongola after that testimony
4 concluded. Do you want to do that when we get
5 back?

6 JUDGE NIEDRICK: Yes, when we get back.
7 I just wanted to review my notes on it. I had
8 some notes, so I wanted to just refresh my memory
9 on it before I hear it. Okay, so in any event
10 we'll come back. It is 1:12 right now. Let's
11 come back at 1:45. Miss Dawson, if we go off the
12 record.

13 (Recess)

14 JUDGE NIEDRICK: And we're continuing
15 with the Fitzpatrick appeal. Before we move on to
16 the Government's next witness, Judge Fink. Mr.
17 Herrigan, you discussed and mentioned it last the
18 last hearing date we had, I think the day before
19 that you perhaps wanted to call Janet about a
20 witness. Could you please provide a proffer for
21 that request?

22 MR. HERRIGAN: Sure. One of the

1 allegations here is that Mr. Kauffman told the
2 appellant that Miss Gongola had told him that Mr.
3 Yonkou had wanted Mr. Fitzpatrick fired. We only
4 learned that on the Monday before the hearing
5 started. The name Janet Gongola. That is when I
6 was made aware of that name. Actually, I learned
7 it at the start of the hearing. So when I was
8 made aware of that name, I contacted her and she
9 testified or she told me that that none of that
10 was true. She never said that to Mr. Kauffman and
11 Mr. Yonkou said that to her. And she I've learned
12 that recently. She she's available and willing to
13 testify this afternoon, and it should not take
14 very long.

15 JUDGE NIEDRICK: Okay. Great. And Mr.
16 Abramic, I think you indicated, or Mr. Kappers,
17 that you guys had an objection to calling Ms.
18 Gongola or Judge Gongola.

19 MR. KAPPERS: Yes, we do. We do object.
20 The agency is trying to change its witness list in
21 the middle of a hearing, and it needs a good
22 reason to do that. And there's just not a good

1 reason here. They served in interrogatory on
2 Judge Fitzpatrick, I believe, in May 20, 21. I'm
3 happy to share the interrogatory with you, or I
4 can just read it. But essentially asks Judge
5 Fitzpatrick to identify the individual he named in
6 his complaint to the OSCE as to who conveyed the
7 message from Director Yonkou.

8 We responded Philip Kauffmann. So that
9 was in July 2021, and the agency had plenty of
10 time, ten months, to figure out what to do with
11 that information. For example, they control Judge
12 Kauffman. He's an APJ at the agency that could
13 have asked him much sooner than Monday before the
14 hearing.

15 MR. ABRAMIC: When Mr. Horrigan asked
16 him and he wouldn't provide an answer, he could
17 have deposed Mr. Kauffman, put him under oath.
18 They could have come to you and asked for help to
19 get the answer from Judge Kauffman, and they did
20 none of that. They could have subpoenaed or
21 brought Director Iyankoo (phonetic), they did none
22 of that. We had a prehearing conference before

1 this occurred, and in no uncertain terms, we told
2 you why we were calling Judge Kauffman and that
3 was to provide the name of the individual at the
4 agency that conveyed the threat from Director
5 Iyankoo, and so our position at this late stage,
6 it is prejudicial to my client to have a new
7 witness come in, when the agencies had 10 months
8 to figure out how to do an appeal like this.

9 JUDGE NIEDRICK: Mr. Horrigan, would you
10 like to respond?

11 MR. HARRIGAN: Well, that could all be
12 prejudicial if, in fact, Ms. Gongola is going to
13 prove that one of our witnesses testified falsely,
14 and that hardly is a reason not to let the witness
15 on. But, as I mentioned, Mr. Kauffman himself
16 testified that he refused to tell me the identity
17 of the witness. All right, it wasn't until the
18 day of the hearing that I learned the name of Ms.
19 Gongola. And, again this would be a very simple
20 matter to clear up, very quickly. There is no
21 reason on earth not to do it.

22 JUDGE NIEDRICK: Okay, I'm overruling

1 the appellant's objection and I'm going to permit
2 Ms. Gongola, or Judge Gongola to testify with
3 regard to the limited scope as described here.

4 Mr. Horrigan, when would she be available?

5 MR. HARRIGAN: She said she's available
6 this afternoon. Obviously, I need to contact her
7 to tell her to stand by --

8 JUDGE NIEDRICK: Sure.

9 MR. HARRIGAN: Maybe when we get done
10 with Mr. Fink, I could take a little break and
11 send her an email.

12 JUDGE NIEDRICK: Okay, that sounds good.
13 All right, anything else before we proceed to
14 Judge Fink? Nope. Okay, I'm going to go ahead and
15 admit. Hi, Judge Fink, this is Administrative
16 Judge Andrew Niedrick, can you hear me?

17 THE WITNESS: Yes. Hi judge.

18 JUDGE NIEDRICK: Hi, how are you?

19 THE WITNESS: Good.

20 JUDGE NIEDRICK: Good, thanks for
21 standing by. We are just going to jump right in
22 here. Let me just tell you who you are seeing on

1 your screen there. Mr. Kappers, Mr. Abramic, and
2 Mr. Suarez are attorneys for Judge Fitzpatrick,
3 and then William Horrigan, I think you know him,
4 he's an attorney for the agency, and then, there's
5 Ms. Dawson, there's Shaundra Morrell, she is the
6 court reporter and the other two black screens
7 that you see, are her back up reporters for the
8 hearing. Okay?

9 THE WITNESS: Okay, very good.

10 JUDGE NIEDRICK: Great. Okay, do you
11 have any objection to swearing an oath? Please
12 raise you right hand.

13 Whereupon,

14 WILLIAM FINK

15 was called as a witness and, having been first
16 duly sworn, was examined and testified as follows:

17 JUDGE NIEDRICK: Can you please spell
18 and state your first and last name for Ms. Dawson?

19 THE WITNESS: First name William. Last
20 name Fink. F-I-N-K.

21 JUDGE NIEDRICK: Thank you, and if there
22 is an objection during the testimony, please hold

1 your testimony and I'll rule on the objection, and
2 then instruct you on how to proceed, okay?

3 THE WITNESS: Yes.

4 JUDGE NIEDRICK: Okay, Mr. Horrigan,
5 your witness.

6 DIRECT EXAMINATION

7 BY MR. HERRIGAN:

8 Q Thank you, all right, Mr. Fink by whom
9 are you current employed?

10 A A law firm named Melvane (phonetic).

11 Q You were previously with the US. Patent
12 and Trademark Office?

13 A Right.

14 Q Okay, when did you work for the US PTO?

15 A I worked for the USPTO from June 2014
16 until last -- end of last April 2021.

17 Q Okay, and what positions did you hold?

18 A Okay, I held the position of APJ,
19 Administrative Patent Judge, Lead Administrative
20 Judge and Vice-Chief Administrative Patent Judge.

21 Q And, how long were you a Vice-Chief
22 Judge?

1 A I believe from December 2017, until the
2 I left the PTO, so 3 years and 5 or 6 months.

3 Q And, how much experience do you have in
4 the field of intellectual property? How many
5 years?

6 A Well, post law school, post law school I
7 have over years. I had some experience with
8 intellectual property before law school at my
9 company that I worked for. So, well over 20 years
10 of experience.

11 Q Do you recall becoming involved in a
12 grievance brought by the appellant Michael
13 Fitzpatrick in 2018?

14 A Yes.

15 Q How did you become involved with that?

16 A I was asked by my boss to get involved
17 in this.

18 Q Do you know why you were selected?

19 A I believe that they needed someone of a
20 certain rank to handle the grievance.

21 Q At the time you were selected, what
22 experience did you have supervising APJ's?

1 A I had had probably a year and a half of
2 experience as a lead judge, and then Vice-Chief
3 Judge, by that period of time.

4 Q What experience had you had at this
5 point with AIA cases.

6 A Probably about 4 years -- 3 or 4 years
7 of experience.

8 Q So, had you served on panels?

9 A Yes.

10 Q Did you know how they worked?

11 A Yes.

12 Q So, at the time you were assigned to
13 respond to the grievance, did you know the
14 appellant?

15 A No, I didn't.

16 Q Okay, so how were you first made aware
17 of the grievance?

18 A My boss, who was then Deputy Chief Scott
19 Boalick -- now the Chief, I believe he told me
20 that I would be getting this grievance to handle.
21 That he nominated me to address the grievance.

22 Q Okay, and so let me ask you to open up

1 tab 6, and then go to page 452.

2 A Yes.

3 Q What do you understand that to be?

4 A So, this the grievance procedure that I
5 was given, by way of instruction.

6 Q Okay, and what role did this procedure
7 here play in how you conducted your adjudication
8 of the grievance.

9 A Well, I read through this, and I
10 familiarize myself with what I needed to do, and I
11 used this as a guide for how to address the
12 grievance.

13 Q What did you understand your job to be
14 in deciding this grievance?

15 A To respond to -- so, Mr. Fitzpatrick had
16 a written grievance, I believe it was styled as a
17 normal grievance at that point, I read --I was to
18 read and respond to the grievance.

19 Q Were you provided any documentation when
20 you started your review of the grievance?

21 A Besides the grievance itself, I believe
22 there were a number of exhibits, that Judge

1 Fitzpatrick provided.

2 Q Okay, and we are in tab 6 - so, let's go
3 to page 68, please. Do you recognize this as part
4 of the package you were provided?

5 A Yes, this appears to be the grievance
6 memo.

7 Q And, did you review that document?

8 A Yes.

9 Q Did you consider the appellant's
10 arguments in your deliberation?

11 A Yes.

12 Q Now, have you had an opportunity to
13 scroll through pages 75 through 344 of tab 6?

14 A 75 Through 344.

15 Q But, they are exhibits to Fitzpatrick's
16 appeal -- grievance correct?

17 A Yes. Yes, I think that is right.

18 Q And, so that documentation that follows
19 the grievance is the documentation you were
20 provided, correct?

21 A Right.

22 Q Did you consider those documents in your

1 deliberations?

2 A Yes.

3 Q Did you interview witnesses as part of
4 your deliberation on the grievance?

5 A Yes.

6 Q Who did you witness -- interview, sorry.

7 A I listed them in the grievance, or in my
8 response to the grievance, I believe they would
9 have been Vice Chiefs Tierney, Weidenfeller, Lead
10 Judges Mitchell and Paulraj, and I don't recall if
11 there were any others offhand.

12 Q How did you identify those people to
13 talk to?

14 A Well, the grievance was addressed to Mr.
15 Fitzpatrick's lead judge was Susan Mitchell, or is
16 Susan Mitchell, and then her supervisor who is
17 Vice Chief Weidenfeller, so I started with them.
18 And, asked about the facts that were in the
19 grievance, that's how I began identifying who to
20 talk to.

21 Q Right, did you speak with the appellant?

22 A No.

1 Q Why not?

2 A I think there were sufficient facts in
3 the record, I recall those in a very compressed
4 time frame as well. Because I promised to get
5 this response to him within a week. So, I -- as I
6 recall, I felt like I had the facts that I needed
7 to support the conclusions that I drew.

8 Q Did you gather additional documents in
9 addition to what Mr. Fitzpatrick provided?

10 A Yes, so, I asked for some of the
11 witnesses to give me additional facts, and then I
12 asked them to provide whatever supporting
13 documents they had.

14 Q And, did you include the documents that
15 you considered in your report?

16 A Yes.

17 Q All right, so let's turn to page 4 of
18 tab 6.

19 A Yes.

20 Q Is this your decision?

21 A That looks like my decision, yes.

22 Q Okay, how did you go -- structure this

1 report?

2 A Well, I believe that, I believe that I
3 went through item by item in the grievance, and
4 then responded in the same order to each of the --
5 to each of the requests that were made in the
6 grievance.

7 Q All right, if we scroll down to page 5,
8 we see a section marked A?

9 A Yes.

10 Q What does that signify?

11 A The one that says IPR 2018 00019?

12 Q Correct.

13 A So, that refers to a case involving Mr.
14 Fitzpatrick and lead judge Paulraj, and I believe
15 it was part of the basis for the feedback that
16 Vice Chief Weidenfeller gave to Mr. Fitzpatrick.

17 Q What did you understand the issue to be
18 in this matter?

19 A The issue in this case -- do you mind if
20 I --

21 Q Not at all -- please.

22 A -- skim this paragraph?

1 Q Please.

2 A Yes, okay. Can you repeat the question?

3 Q Sure, what was the issue, here?

4 A The issue here was the manner in which
5 this case was conferenced -- so, Mr. Fitzpatrick
6 was -- was the lead APJ or what you call the APJ 1
7 on this case, and was providing a draft or
8 providing a conference. So, the panel conference
9 -- the case fairly close to the deadline and Mr.
10 Fitzpatrick provided a resolution of a case that
11 Mr. Paulraj thought was not what they had talked
12 about, or not what he thought was going to be
13 delayed. That it would be decided which would be
14 on the merits and that Mr. Fitzpatrick said,
15 that's fine -- he would be willing to step aside
16 and let the other two judges decide the case on
17 the merits, and he would write separately, and Mr.
18 Paulraj said that there wasn't enough time to do
19 that because -- writing a full decision on the
20 merits, and I think that that it was a number of
21 days before the deadline. Writing a full decision
22 on the merits would take normally you know a lot

1 more time, especially if you are stepping into it
2 cold and unexpected.

3 Q How did you come about this information?

4 A I asked Mr. Paulraj to tell me about
5 this case. And, he explained it to me, and he
6 provided some emails I believe.

7 Q So, let's turn then to tab 32, and go to
8 page 83.

9 A 83?

10 Q Yes. Yes. Do you recall this is the
11 institution decision that was the subject of your
12 inquiry?

13 A Yes, that appears correct.

14 Q And, let's go then to page 93. And,
15 what do you understand this to be?

16 A Page 93. So, this would be page 6 of
17 the decision?

18 Q It's Mr. Paulraj's dissent. It's the
19 first page of Mr. Paulraj's dissent --

20 A So, what page of the --

21 Q Tab 32, page 93.

22 A Could you give me the PDF page number?

1 Q That is the PDF page number it's page
2 93. So, on the bottom right-hand corner, you'll
3 see 93 of 357.

4 A I'm sorry I was in the wrong document --
5 93.

6 Q Happens all the time.

7 A Okay, so this is Mr. Paulraj's dissent
8 correct?

9 Q And, then let's slide down to page 94,
10 and let's look at that footnote.

11 A Footnote 1, yes.

12 Q And, what does the final sentence there
13 mean to you?

14 A The final sentence, I would welcome the
15 opportunity for the panel to further consider this
16 issue and a request for rehearing. Yes, so, he
17 was inviting the party that was -- that party that
18 was losing in this decision, to ask for a
19 rehearing so that they could reconsider on a --
20 and have time to reconsider it.

21 Q It -- with someone with your experience
22 what does that mean to you?

1 A I don't think -- I have ever seen an
2 invitation for a rehearing request being made in
3 an opinion.

4 Q All right, so --

5 A It's kind of unprecedented.

6 Q Okay, you testified you've been an APJ
7 and you've been on panels, that you are familiar
8 with how they work, right?

9 A Yes.

10 Q So, you mentioned the deadlines, why
11 don't you flesh that out just a little bit for us.

12 A So, the deadlines so all of these kind
13 of decision -- decisions to institute, are on a
14 statutory deadline of 3 months from the last --
15 from the patent preliminary response, or the date
16 which it was waived -- for -- or not filed. And,
17 the board had -- still has a very good track
18 record of never missing this deadline and had a
19 number of mechanisms in place to try to make sure
20 that they didn't miss a deadline, and so I recall
21 this decision, and this was the issue that Mr.
22 Paulraj has brought up was that the way in which

1 this case was decided was not what he viewed as
2 what the panel wanted to decide and but that there
3 was not time to for the panel to form a different
4 majority with Mr. Fitzpatrick with the dissent and
5 write a full opinion on the merits. So, that was
6 how this came up, this footnote.

7 Q How if at all did you experience factor
8 into your consideration of this matter?

9 A Well, my experience as a APJ and as in
10 various roles, my experience you know it forms how
11 I felt this situation seemed to me to be a little
12 bit - well, not a little bit, but you know, it was
13 effecting -- kind of pushing, you know, the panel
14 and the direction that, at least some of the
15 judges -- at least one of the judges, felt
16 uncomfortable in doing, and not really giving
17 enough time for that judge to do anything
18 differently. So, you know that's the -- that's
19 how I react to this.

20 Q And, so what conclusion did you reach on
21 this manner?

22 A That this was a little bit embarrassing

1 for the board to have that happen. And, I -- my
2 conclusion was that it wasn't - it, you know, part
3 of, you know, part of the judges job is, you know,
4 the relationships with colleagues, the
5 interactions with colleagues, and I felt like this
6 was kind of an aggressive -- kind of an aggressive
7 position to take on a case, and force the
8 colleagues to take. You know, we operate on a
9 certain level of trying to come to consensus on
10 these things so, it was pushing the judges in the
11 direction they didn't feel comfortable in doing,
12 and then having to essentially invite a request
13 for rehearing.

14 Q So, then let's look at the second item
15 which we can see at tab 6, page 6. So, why don't
16 you explain what item b there, concerns?

17 A Okay, so this relates to 4 cases.
18 Again, decision to institute and in this case, the
19 panel instituted review and analyzed the arguments
20 in the patent, and in the response, and so
21 addressed -- they addressed -- in addressing the
22 arguments, addressed more than one claim, which

1 would be the minimum that needs to be addressed in
2 instituting review. So, Mr. Fitzpatrick wanted
3 to author a concurrence that said essentially
4 that, what is quoted here which is -- I don't see
5 a need to analyze the remaining claims.

6 Q How did you go about looking into this
7 particular item?

8 A So, this one came with a number of
9 emails that Vice Chief Weidenfeller provided to me
10 and, you know, I talked to Vice Chief Weidenfeller
11 about this, and I think, where this went was --
12 this actually progressed all the way to the
13 statutory deadline, which we rarely if ever --
14 which we try to avoid in most cases. Deciding a
15 case on the statutory deadline, and in so doing, I
16 think as I recall, Vice Chief Weidenfeller had to
17 mail the decision without the concurrence, and
18 then Mr. Fitzpatrick asked for the order in an
19 email to expunge the decisions and replace them
20 with new decisions with his concurrence involved.

21 Q In your write up, you referred to SAS.
22 What is your understanding of what that is?

1 A That was a Supreme Court decision that
2 decided that we had a rule that allowed
3 institutions, on fewer than all claims, and fewer
4 than all grounds, kind of complicated, but, that's
5 the jist of it. So, that -- the rule was contrary
6 to the statute and the statute was an all or
7 nothing determination of it's institution -- was
8 an all or nothing determination and once you had
9 one claim, you could decide to institute or not
10 institute -- once you had one claim that was
11 sufficient to institute. So, that was a statutory
12 floor, if you will for institution. We had a
13 number of meetings in -- right after SAS came down
14 from the Supreme Court, when we had to meet with
15 the director several times and talk about how we
16 were going to implement the SAS decision, and
17 whether or not we would, as an agency, adopt a
18 policy of addressing additional claims in the
19 situation - decision, if the patent owner asked
20 for it. If the patent owner had challenged the
21 basis for institution on additional claims. So, we
22 would -- the decision was to take the SAS

1 decision, but do more than it -- more than the
2 minimum that it required.

3 Q Who's decision?

4 A This was Director Ianku. He was the
5 Director under Secretary of Commerce for
6 intellectual Property and Director of the Patent
7 and Trademark Office.

8 Q Did the director explain himself, why he
9 wanted to do that?

10 A Yes.

11 Q What did he tell you?

12 A He said that I want to provide parties
13 as much information as they ask for, and I want I
14 think -- it's important to -- if we if the patent
15 owner in an institution decision -- makes a number
16 of arguments, that we should address their
17 arguments. They've asked us to address their
18 arguments, and he felt quite strongly that on this
19 issue, that we should be fulsome as we could be in
20 our decisions.

21 Q Now we can see from page 6, that you
22 referred to both exhibits P and Q. So, I'm going

1 to first take you to P and, you go down to page
2 14.

3 A Okay, this in --

4 Q -- still in tab 6.

5 A Tab 6 - 14?

6 Q Right, so you see exhibit P, correct?

7 A Yes, yes, I have.

8 Q And, then you can scroll down to 15.

9 A Yes.

10 Q And, so this is an email exchange right?

11 A Yes.

12 Q What do you find significant about this
13 exchange?

14 A So, this exchange was -- so this was
15 where Vice Chief Weidenfeller down about 4 emails
16 down, had told the panel to email the decision
17 about the concurrence, and then Mr. Fitzpatrick
18 responded, don't mail this decision without my
19 concurrence, and then again to the same group,
20 they need to be expunged and new decisions replace
21 them. What was significant here was -- that Mr.
22 Fitzpatrick ordering his second line supervisor to

1 mail the decision with his concurrence.

2 Q Why do you find that to be significant?

3 A Well, the as I think I expressed in the
4 -- Yes, that appears correct. As I expect most
5 government or executive agencies -- and the -- to
6 tell your supervisor to do something different
7 than what your supervisor decides, is the correct
8 course of action is essentially trying to
9 countermand, you know, an order that the
10 supervisor gave, and yet the supervisor made a
11 decision in this case.

12 Q And, is there something about the USPTO
13 that requires the supervisors do not get to tell
14 employees how to respond?

15 A No.

16 Q Okay, so, to what extent do you think
17 the word insubordinate applies to this situation?

18 A Well, telling your boss and ordering
19 your boss to do something different than what
20 would -- your boss did is insubordinate.

21 Q At page 19 of tab 6, we will see exhibit

22 Q -- do you have that?

1 A Nineteen?

2 Q Correct -- and you slide down to page
3 20.

4 A Yes.

5 Q And do you see another email?

6 A Yes.

7 Q And, so what do you make of this?

8 A So, this was the same situation, the
9 same day, ordering -- well purporting to order,
10 this long list of recipients to expunge exhibits,
11 and replace them with expunged the decisions, and
12 replace them with new decisions with Mr.
13 Fitzpatrick's decision -- his concurrence.

14 Q All right, then, let's go back to your
15 decision -- which is at page 6, and why don't you
16 just summarize for the administrative judge, what
17 you concluded with respect to this item?

18 A So, this where I said -- I concluded
19 that this was insubordinate -- you know,
20 attempting to countermand second level supervisor,
21 or even a first level supervisor, is the
22 definition of insubordinate and provides support

1 for the feedback regarding stakeholder
2 interactions and discretion and judgement.

3 Q And, we see that you included a footnote
4 here -- why don't you explain to us why you did
5 that. Footnote 1, I am referring to.

6 A Yes, I'm looking at that. Yes, so, this
7 was the same day there was a training given in
8 which we had provided a guidance -- we were
9 providing the guidance that we were getting from
10 the Director, and it included there was some Q &
11 A, in this, and during the Q & A with Mr.
12 Fitzpatrick, he blasted out a note to everyone --
13 200 and something employees, that I think, was
14 attempting to undermine what - we -- explaining
15 and the contours of the guidance, we were getting
16 from the director on this -- on this issue about
17 how to implement the Supreme Court's decision on
18 SAS.

19 Q We see in your footnote that you
20 reference exhibit R, so let's go there which is at
21 page 24 of this same exhibit -- same tab 6 and
22 then we'll scroll down to 5 --

1 A Okay.

2 Q What do we see at the mid-section down.
3 What is that?

4 A So, this is - this is -- it looks like
5 the chat, so this is the chat between Phil
6 Kauffman and a number of people it looks like.

7 Q And --

8 A And, what am I looking at exactly, sorry
9 --

10 Q -- well, let's go down to page 26 --

11 A Okay.

12 Q Just above the middle, you see from
13 Michael Fitzpatrick to everyone -- you see that?

14 A Yes. Yes.

15 Q Is that what you are just referring to?

16 A Yes.

17 Q Okay, and what's wrong with this?

18 A Well, I mean, I think it was intended to
19 embarrass management. As I recall, there was a
20 set up question from someone that said something
21 like, you know, can you analyze one claim and I
22 think the answer is nuanced -- it depends on what

1 issues the patent owner had raised, and I think --
2 and I think Vice Chief Weidenfeller was giving the
3 training, and then Mr. Fitzpatrick responded in
4 this way, that I wanted to file concurring
5 opinions, and I was removed from panels. I think
6 that that was, you know, trying to air essentially
7 -- airing this, you know, this whole issue in
8 front of 200 and something colleagues. You know,
9 it was an attempt to embarrass Vice Chief
10 Weidenfeller.

11 Q Turning back to your decision on page 7
12 of tab 6, okay, you address at the top, you
13 addressed Mr. Fitzpatrick's point about the SAS
14 issues, right?

15 A Yes.

16 Q Okay, and then you have a footnote too -
17 so, let's slide down to that, what is going on in
18 footnote 2?

19 A Yes, oh, this is the point that I was
20 just making a minute ago -- which was -- which was
21 this Supreme Court requires this is the minimum
22 that needs to be analyzed, according to the

1 Supreme Court, and then, but this doesn't support
2 their willingness to follow the director's
3 guidance. You know, the content of the decisions
4 is a policy matter as well as a legal matter. So,
5 this was exactly what I was talking about when I
6 said the director had instructed us to continue
7 the policy of analyzing disputed issues, even if
8 some of those disputed issues did not need to be
9 analyzed at the time of the institution decision.

10 Q With respect to this matter be -- what
11 was your conclusion?

12 A Well, I thought that Vice Chief
13 Weidenfeller actions is not mailing the
14 concurrence, was reasonable in view of the policy
15 director -- the policy head of the agency making a
16 determination, that we would give more fulsome
17 decisions, and I so I thought it was reasonable to
18 mail the decision without the concurrence.

19 Q What was your view -- go ahead.

20 A There is no requirement that there's 3
21 judges in an institution decision, I would add,
22 so, mailing a 2-judge decision is not -- there's

1 nothing wrong with that, in this case.

2 Q Did you form an opinion on whether it
3 was appropriate for Mr. Weidenfeller to have
4 brought this up with Mr. Fitzpatrick during
5 counseling.

6 A Yes.

7 Q What's your opinion on that?

8 A So, I think you know what Vice Chief
9 Weidenfeller, the feedback that he gave I think
10 was supported by these events.

11 Q And, what do you understand on this
12 particular item, that the appellant did that was
13 worthy of being counseling for?

14 A I think it was -- I think it was
15 bordering on being insubordinate was the -- was
16 what was the issue here.

17 Q We are on page 7 of tab 6, and we see
18 towards the bottom the third item C?

19 A Yes.

20 Q Can you give us a synopsis of what you
21 understood the issue to be here?

22 A If I could just skim this --

1 Q Sure.

2 A Okay, Okay, I'm sorry what's your
3 question?

4 Q Give us a synopsis of what you
5 understand the issue to be here?

6 A So, I think this was an issue -- was a
7 case -- I think this was the Knight vs Adidas
8 case, if I recall, and this was a case in which
9 Mr. Fitzpatrick altered a concurrence and had put
10 confidential information into the concurrence, and
11 then, I believe, he was instructed to remove the
12 confidential information under the existing --
13 under the policies, and then Mr. Fitzpatrick
14 responded with an email to the Chief Judge and to
15 Deputy Chief Boalick saying that he would make
16 edits if they would mail the decision promptly.

17 Q We'll get to that -- I'm sorry. What do
18 you understand confidential information to be?

19 A So, confidential is -- I would consider
20 it to be deliberative process like predecisional
21 and deliberative process information. So, I would
22 say that, you know, we frequently get FIA

1 requests, and I often had to deal with the general
2 counsel's office on FOIA requests, and if it could
3 be redacted under a predecision or deliberative
4 process exception to FOIA, that's confidential.
5 So, it we wouldn't put that stuff into public
6 facing decisions.

7 Q We can see here that you refer to
8 exhibit E & F, so let's do this let's go this --
9 we are in tab 6, let's go to page 101.

10 A Yes.

11 Q So, these are actually numbered by the
12 appellant and you see that exhibit e is at the
13 bottom of the page.

14 A Yes.

15 Q What did you understand this to be?

16 A This was the email from Lead Judge
17 Mitchell to Judge Fitzpatrick about the
18 confidential information that we just talked about
19 in the grievance response.

20 Q So, we see that Ms. Mitchell makes
21 reference to highlights on pages 6-9 -- do you see
22 that?

1 A Yes.

2 Q And, I will let you know that we have
3 all been over this many times, so I'll try and
4 move you through this. What is your understanding
5 of why Ms. Mitchell is writing to him?

6 A So, Vice Chief Weidenfeller had
7 instructed -- had instructed lead Judge Mitchell
8 to have Mr. Fitzpatrick redact or excise certain
9 information from his decision.

10 Q And, so let's go then to page 141, and
11 if you scroll through it to 143, do you understand
12 what those yellow highlights are?

13 A Let me find the page -- 43 -- yes.

14 Q Okay. And, when you were looking at
15 this matter way back then -- did you go through
16 this?

17 A Yes.

18 Q Did you form an opinion on whether the
19 information highlighted here, was in fact,
20 confidential?

21 A Yes, if I could just refresh my memory,
22 quickly?

1 Q Of course, of course.

2 A Yes, this was about the panel expansion.

3 So, this was about a panel expansion that the
4 decision to expand the panel, and then eventually
5 unexpand the panel. So, this was confidential
6 information. I mean this would have been
7 predecisional and deliberative process, kind of
8 information. It's the internal, you know,
9 workings, you know, of the board.

10 Q And, what is your opinions on whether
11 Ms. Mitchell was correct in asking the appellate
12 to remove this information?

13 A Yes, this, I think was correct to ask
14 him to remove that.

15 Q So, let's look at Tab T, which starts at
16 page 51, I believe.

17 A Fifty-one?

18 Q Yes, of tab 6.

19 A Okay.

20 Q So, we see exhibit T, and let's go down
21 to page 52.

22 A Yes.

1 Q You've seen this email before?

2 A Yes.

3 Q We have, as well, so let me just refer
4 you to the underlying section -- what do you make
5 of that?

6 A So, this was the -- yes, this was the --
7 I will do -- take the content out of my concurring
8 opinion if it will facilitate prompt mailing of
9 the decision.

10 Q And, what is your opinion on that?

11 A Well, I don't think the decision was
12 under a deadline, so I don't think there was any
13 basis to make acceptance of instruction to
14 management conditional on management facilitating
15 a prompt mailing of the decision.

16 Q This was on a remand -- so it wasn't --
17 there was no deadline in this case. All right,
18 so. And, then let me ask you to turn briefly to
19 tab 7, page 656.

20 A Yes.

21 Q And, once you are there, I'll ask you to
22 look at the second paragraph -- give your

1 continued --

2 A Yes. Right.

3 Q What is your opinion on that?

4 MR. ABRAMIC: Objection, your honor
5 foundation.

6 JUDGE NIEDRICK: Overruled, please
7 answer.

8 BY MR. HERRIGAN:

9 A This was insubordinate, I mean, this was
10 telling the chief judge that he's not moving fast
11 enough, and that he took the edits out because he
12 didn't agree with them.

13 Q So, looking back at your decision tab 6,
14 page 7-8?

15 A Tab 6, page 7 --

16 Q Seven into 8. Why don't you explain to
17 the administrative judge your conclusion to item
18 C.

19 A Yes, my conclusion was this was another
20 example of support for Vice Chief Weidenfeller
21 counseling on discretion and judgement. Again,
22 with some level of insubordination and to

1 management.

2 Q Did you discuss this items with Mr.
3 Weidenfeller?

4 A Yes. I did.

5 Q Do you recall what he explained was his
6 concern here?

7 A His concern was having confidential
8 information in the decision -- is that -- in the
9 underlying decision. So, that was the basis for
10 the instruction to take the confidential
11 information out.

12 Q Did Mr. Weidenfeller bring this to your
13 attention? I guess that should be the first
14 question?

15 A Yes.

16 Q What did you understand was the reason
17 that he brought it to your attention?

18 A He -- I has asked him for -- I had asked
19 him for examples to support his feedback to Mr.
20 Fitzpatrick and this, and the action that he took
21 in taking him off his preferred docket. And, the
22 feedback being that this stakeholder interactions

1 were lacking in recent times. So, that -- I asked
2 him for the examples of that.

3 Q Did he explain to you why he thought
4 this was an example?

5 A Yes. So, this was an example, I mean I
6 think them you know, in particular the agreeing to
7 take the information out, and not been -- if an
8 expedited -- the decision process, and then
9 putting it back in, and I think was, you know, an
10 attempt to undermine the chief judge and I think
11 that was his concern.

12 Q Right, and then let's go down to item D,
13 which is on page 8 of tab 6, see that?

14 A Yes.

15 Q And, what do you understand this issue
16 concerned?

17 A This issue concerned another example --
18 another occasion, on which in a draft concurrence
19 Mr. Fitzpatrick had put confidential information
20 into the decision.

21 Q And, how did you become aware of this
22 matter?

1 A Vice Chief Weidenfeller told me about
2 this particular situation.

3 Q Did you have occasion to speak with Vice
4 Chief Tierney?

5 A Yes, so I talked to Vice Chief Tierney,
6 and asked for a -- his -- for him to explain this
7 situation to me and he did, and he provided the
8 email as I recall.

9 Q What was your understanding of his
10 involvement in this matter?

11 A So, he was -- he was his boss or his
12 bosses boss, had instructed him to tell Mr.
13 Fitzpatrick to take this information out of the
14 decision. I think originally his -- Mr.
15 Fitzpatrick's immediate supervisor, Lead Judge
16 Mitchell was, you know, was close to doing that -
17 but, I think it must have escalated to Vice Chief
18 Tierney.

19 Q So --

20 A He was the person who delivered that
21 instruction on the call.

22 Q Okay, you referred to exhibits U and V.

1 Let's look at those -- we can start at page 55, of
2 tab 6.

3 A Yes.

4 Q Did you review this email as part of
5 your review?

6 A Yes.

7 Q Okay, and what did you make of this?

8 A So, this was Mike Tierney's had made a
9 record of the call with Mr. Fitzpatrick.

10 Q Okay, and in your review what role did
11 this play in the decision you made?

12 A Well, so, this was an example of putting
13 confidential information into a decision, and it's
14 that paragraph -- that's under the first
15 sub-bullet, putting confidential information into
16 a decision and then refusing to take it out. I
17 guess -- causing it to be escalated to Vice Chief
18 Tierney.

19 Q And, I think we see exhibit V at page
20 48.

21 A Yes.

22 Q Have you had an opportunity to review

1 this very long email?

2 A I'm just getting to this email. Yes, I
3 recall reading this email.

4 Q And, how did that factor into your
5 assessment of this item?

6 A Well, this seemed, again, I think this
7 seemed to be an example of Mr. Fitzpatrick trying
8 to embarrass Vice Chief Tienry in this case,
9 another the Chief Judge and so, I thought it was
10 just -- I did think it another -- I agreed with
11 Vice Chief Weidenfeller -- it's another example of
12 discretion issue and insubordination.

13 Q Then, let's look back at the end of your
14 decision, which is on the top of page 8 and tab 6,
15 and going into page 9.

16 A I'm sorry - so, the top of page --

17 Q I'm sorry the bottom of page 8 going
18 into page 9.

19 A So, the heading conclusion?

20 Q Correct. So, just for the
21 administrative judge, what was the conclusion that
22 you reached after you looked into this matter?

1 A So, my conclusion was that these
2 examples were very examples of stakeholder
3 interactions that were -- were highly unusual and
4 supported a conduct action that Vice Chief
5 Weidenfeller -- the feedback, the counseling and
6 the decision to take Mr. Fitzpatrick off of his
7 preferred docket.

8 Q In your opinion, did the information
9 available to you support Mr. Weidenfeller's action
10 for removing the appellant from AIA cases?

11 A Yes.

12 Q Why?

13 A Well, I think the difficulty here is
14 that these cases are all timing. These are all
15 very heavily timing dependent. So, we are on
16 these strict deadlines that we take really heroic
17 -- go to heroic lengths not to violate, and I
18 believe to date, in almost 10 years we still
19 haven't blown one of these deadlines -- thousands
20 of cases. And, I think that these -- the decision
21 to take him off these cases and provide feedback,
22 I think were tailored to the fact, that these were

1 particular -- these were causing particular
2 difficulties with management, requiring constant
3 intervention or frequent intervention, I should
4 say, and creating, you know, articulate
5 emergencies.

6 Q Okay. What steps did Scott Boalick take
7 to voice your decisions when were involved in your
8 investigation of the grievance?

9 A Nothing at all.

10 Q To what extent where your findings
11 influenced by what you thought Mr. Boalick's
12 desired outcome might me?

13 A Not at all.

14 Q Did Mr. Weidenfeller make any effort to
15 influence your decision?

16 A No.

17 Q Did what extent were your findings to
18 appease Mr. Weidenfeller?

19 A I didn't do anything to appease Mr.
20 Weidenfeller.

21 Q All right, and let me ask you to look at
22 page 73, tab 6. And, do you see the heading,

1 grievances?

2 A Yes.

3 Q Okay, and we see on second paragraph,
4 undocumented performance appraisal, correct?

5 A Yes.

6 Q Having reviewed the matter in detail,
7 what is your opinion on whether the interaction
8 between Mr. Weidenfeller and the appellate,
9 constituted an undocumented performance appraisal?

10 A I think, I mean, I think it was a -- it
11 was feedback is what it was, and it was
12 counseling. Feedback about conduct -- it wasn't a
13 performance appraisal in the sense, that there is
14 no -- it wasn't part of a performance evaluation
15 process.

16 Q Okay, let me take you back briefly to
17 the SAS matter that we talked about, do you recall
18 that?

19 A Yes.

20 Q Are you aware that decision later went
21 out wherein, where not all the items were
22 addressed in the decision - institution decision.

1 Is that something you are aware of?

2 A Yes.

3 Q And, are you how does that influence
4 that you told us about what Mr. Fitzpatrick did in
5 that instance?

6 A There were times when it was
7 appropriate. The guidance that we give is that
8 there were times when it was appropriate to do
9 what Mr. Fitzpatrick wanted to do, if that was the
10 arguments that were presented. And, there were
11 times when it would have been -- it was
12 inconsistent with the director's policy to provide
13 fulsome responses to all arguments that patent
14 holder raises, and their response, and so -- so
15 the decision to do one versus the other, it was
16 consistent with what the agency wanted. But, the
17 issue with Mr. Weidenfeller was the constantly
18 pushing back on and essentially telling management
19 you weren't going to do that -- or he wasn't going
20 to do something, or made it conditional. So, that
21 was the part, that I was asked to look at. Just
22 the stakeholder interactions.

1 Q All right, thank you, nothing further.

2 JUDGE NIEDRICK: Thank you very much,

3 Mr. Horrigan, Mr. Kappers?

4 CROSS-EXAMINATION

5 BY MR. KAPPERS:

6 Q Hi, Judge Fink, this is Robert Kappers
7 here on behalf of the appellant.

8 A Hi.

9 Q If you could turn to tab 6 at page 4.

10 A Yes.

11 Q Okay, and so this is your decision on
12 Judge Fitzpatrick's informal grievance.

13 A Yes.

14 Q And, I know we talked about this -- this
15 concerns a call that occurred on May 30, 2018. Is
16 that right?

17 A Yes.

18 Q Okay, were you involved in making the
19 decision to move Judge Fitzpatrick from this AIA
20 docket?

21 A No.

22 Q And, you weren't initially assigned to

1 Judge Fitzpatrick's formal grievance, were you?

2 A I was not.

3 Q When were you first assigned?

4 A I recall it was approximately a week
5 before about a week earlier.

6 Q Okay.

7 A I'm sorry, about a week earlier than the
8 date on this thing. I remember having to turn it
9 around in a very tight timeframe.

10 Q Okay, mid-September 2018, is that fair?

11 A I think it was about a week earlier.

12 Q Okay, let's turn to page 5 of tab 6, and
13 talk about the IPR 2018 00019.

14 A Yes.

15 Q And, so this event concerned Judge
16 Fitzpatrick sending to Judge Paulraj a draft
17 decision too late, is that right?

18 A Well, it was late -- it wasn't
19 necessarily too late of itself, it was late and it
20 was in a way that was inconsistent with how the
21 panel thought the case was going to be decided.

22 Q Okay, let me ask you this, as an APJ - I

1 -- how many days should you shoot to send the
2 other APJs on the panel your draft decision?

3 A I recall there is exact guidance in the
4 performance documents, I frankly don't like having
5 these things hang over my head, so, as an APJ I
6 try to give some weeks, approximately a month's
7 notice to circulate a draft before the decision.

8 Q As an APJ, I -- have you ever missed
9 that informal -- that internal guidance deadline?

10 A I don't think so. I don't think so.

11 Q As an APJ II or III have you ever
12 received a draft decision from an APJ I, that
13 missed the internal deadline?

14 A I don't recall any specific cases.

15 Q Do you know if the PTAB tracks the
16 number of APJs that miss that internal deadline?

17 A There are, I believe, they do, actually.
18 I believe they do.

19 Q Okay, when determining or deciding Judge
20 Fitzpatrick's information grievance, did you ask
21 for that data to determine how frequent this
22 actually occurs?

1 A So, I think you are asking me if they
2 track it -- I think at the time, I don't recall
3 that they tracked it. I think it was something we
4 may have implemented later because, just to --
5 because I think that that was something that, you
6 know, it did happen occasionally, so I think it
7 was something that we were asked about, and we got
8 data on, but I don't think it was something that
9 was available at that time -- that data.

10 Q Okay --

11 A -- so, no I didn't ask about that.

12 Q Okay, thank you. And, you said it
13 happened occasionally. When it happened, how many
14 of the APJs that missed that deadline were given
15 oral counseling as a result?

16 A There would usually be a phone call to
17 find out what the problem was. The peers of the
18 judge would complain, because it would put them
19 into a difficult tight timeframe that wasn't
20 necessarily -- made it difficult for them to
21 organize their work. So, there would typically be
22 a phone call made, especially if it happened more

1 than once. Or at least, to find out what
2 happened.

3 Q Okay, and how many of those APJs were
4 punished as a result?

5 A I'm aware that, from time to time, that
6 if the deadlines were being -- were not being met,
7 that the judge would be counseled and in some
8 occasions, taken off of the deadline cases.

9 Q Okay, and what percentage of the cases
10 where an APJ, and this is the internal deadline,
11 were they taken off of cases?

12 A I don't know. I would say it's at the
13 infrequent end of the spectrum that that would be
14 the -- often the result is efforts the APJs make
15 more significant efforts, to comply with the
16 deadlines.

17 Q All right, you said you spoke to Judge
18 Weidenfeller and Judge Mitchell before, deciding
19 this informal grievance, did you ask them whether
20 they spoke to Judge Fitzpatrick about this IPR
21 2018-2019 event, to get his side of the story?

22 A Yes, it looks like a typo there. It's

1 2019 not 2009. I just realized. I don't recall
2 -- I don't recall - well, I'm sorry the question
3 was whether or not they told me -- that they told
4 Mr. Fitzpatrick about this particular case and the
5 deadline issue?

6 Q My first question is, do you know
7 whether or not, whether Judge Weidenfeller or
8 Judge Mitchell spoke to Judge Fitzpatrick about
9 this event and got his side of the story?

10 A I don't recall.

11 Q Did you speak to Judge Fitzpatrick to
12 get his side of the story about this IPR.

13 A I didn't talk to Mr. Fitzpatrick in
14 deciding this grievance.

15 Q All right, let's talk about this second
16 IPR which is the SAS issue.

17 A Yes.

18 Q And, you say, looks like in the second
19 sentence that VCJ Weidenfeller asked the panel if
20 it could mail the majority opinion as a 2-judge
21 decision. And, then you conclude the paragraph
22 with -- you rejected this offer. Is that right?

1 A Yes, I see, it's the end of the first
2 paragraph you are pointing me to, right?

3 Q Unless -- and you -- thank you Judge
4 Fink, and you cite exhibit P, so let's turn to
5 exhibit P which is tab 6, we'll start at page 16.

6 A Yes.

7 Q Okay, and let's look at the middle email
8 on May 12, 2018. It's from PTAB management
9 review, but you see that Scott Weidenfeller, signs
10 that email?

11 A Yes, I see it.

12 Q He asked, would the panel be amendable
13 to 2 judge DI's in these cases written only by you
14 and Thiel (phonetic). Did I read that right?

15 A Yes.

16 Q Okay. Now, the question is to the panel
17 -- says would the panel be amendable at the time,
18 was Judge Fitzpatrick on the panel?

19 A Yes.

20 Q And, who's the first judge to respond to
21 Judge Weidenfeller's questions?

22 A Mr. Fitzpatrick.

1 Q All right, can you read his response?

2 A Scott, I want to keep my opinion.

3 Q Now, I would call this an answer to a
4 question, but is this what you said was rejecting
5 an offer?

6 A No, no.

7 Q That's not what --

8 A -- no.

9 Q -- what you referred to as rejecting the
10 offer?

11 A Oh, in my grievance response, the thing
12 that you just told me. Well, he is rejecting the
13 offer to mailing a 2- judge decision.

14 Q But, he's on the panel, right?

15 A Yes. He's on the panel.

16 Q All right, now you mentioned
17 insubordination -- I think you used the word
18 countermand, so lets turn to page 15 of tab 6, and
19 lets start at the bottom.

20 A Did you say 15?

21 Q Yes, page 15 of tab 6.

22 A Okay. Yes.

1 Q Let's start at the bottom with another
2 Scott W, email.

3 A Yes.

4 Q All right, he says please mail the
5 decision without the concurrence.

6 A Yes.

7 Q All right, okay, and that's at 6:36 p.m.
8 is that right?

9 A Yes.

10 Q All right, so after an hour Judge
11 Weidenfeller sends this email --

12 A Yes.

13 Q -- and then, when did Judge Fitzpatrick
14 respond?

15 A The next morning it looks like.

16 Q Yes, what time?

17 A 5:19 a.m.

18 Q Okay, so, at 5:19 a.m. in the morning --
19 the next morning, Judge Fitzpatrick responds to
20 Judge Weidenfeller, and you refer to this as
21 countermanding, is that right?

22 A Yes.

1 Q Doesn't it seem like Judge Fitzpatrick
2 wakes up, maybe he looks at his iPhone and he sees
3 an email, and he thinks to himself, I don't know
4 if Scott Weidenfeller saw my answer?

5 A No, I don't think that is reasonable.

6 Q Did you ask Judge Fitzpatrick if that
7 was what he was thinking when he sent the email at
8 5:19 the next morning?

9 A No.

10 Q Okay, did anybody respond to this 5:19
11 email before Judge Fitzpatrick sent another email
12 at 8:13?

13 A I think - no, not that I know of.

14 Q In that 8/13 email, what you call the
15 second instance of countermanding -- is that
16 right?

17 A Yes.

18 Q All right, and after that second
19 instance of countermanding, Judge Weidenfeller
20 responds to Judge Fitzpatrick, is that fair?

21 A Yes.

22 Q And, that's where he says, that in very

1 clear terms, "Michael you were removed from the
2 panels in these case, because you refused to join
3 the majority opinion that did exactly what the
4 Director of SAS guidance informed the panel they
5 should do in situations faced by the panel." Did
6 I read that right?

7 A Yes, it looks --

8 Q Okay, now -- all right, now this SAS
9 guidance was this written guidance or oral
10 guidance?

11 A It was delivered orally, and I believe
12 it was on training materials that were provided.

13 Q Okay, what exactly did it say?

14 A It said that panels should respond to
15 the arguments -- I don't have the training in
16 front of me, so I don't remember what exactly --
17 what was written down on the training. But, the
18 oral guidance was that we're not going to do one
19 claim, because a lot of judges were thinking that
20 -- oh, wow, this will be a lot easier, I only have
21 to do one claim now. And, they had asked that
22 question specifically and we said no, that's not

1 the -- that is not the correct approach, if more
2 arguments are raised.

3 Q All right, let's turn back to your
4 decision, which is tab 6, we'll go to page 6.

5 A Yes.

6 Q I want to have you review that footnote
7 1 again -- we'll you talk about a comment in a web
8 chat box.

9 A Yes.

10 Q Okay, and the comment that you say that
11 you quote from Judge Fitzpatrick was, "I was
12 removed from 4 panels today, because I wanted to
13 file concurring opinions to the VI saying in light
14 of SAS, only one claim needs to be analyzed." Is
15 that right?

16 A Yes.

17 Q -- and you cite, it that R?

18 A Yes.

19 Q All right, let's go to exhibit R, tab 6,
20 and it's on page 26.

21 A Okay.

22 Q And, you looked at this earlier, so

1 let's go to the middle where Judge Fitzpatrick,
2 makes his comment, okay.

3 A Yes, from Michael Fitzpatrick to
4 everyone, right?

5 Q Exactly. Now you left out a portion of
6 this comment, didn't you?

7 A I didn't pull the whole comment in the
8 flip note, that is correct.

9 Q Okay, will you read the rest of the
10 comment for us.

11 A What - so, in response, so, I think that
12 I just put the first sentence in -- refresh my
13 memory there --

14 Q Yes, you did, can you read the rest of
15 the comment?

16 A In response to a question someone just
17 said that one claim, one ground, is not
18 prohibited, my question is not prohibited -- my
19 question is how can I do it without being taken
20 off a panel?

21 Q Okay. So, this is a training before,
22 how many APJ's were at this training?

1 A Well, there were over 200 -- over 200 of
2 them -- judges and probably some patent attorneys,
3 as well.

4 Q And, I think you said at this training,
5 this is where management was providing guidance on
6 SAS given by the director, is that right?

7 A Yes.

8 Q Okay. And, Judge Fitzpatrick here is
9 saying that someone at this training and is doing
10 exactly what he wants her to do in his opinions,
11 is that right?

12 A Can you repeat that question?

13 Q What Judge Fitzpatrick is saying is that
14 someone at the training event told everybody that
15 200 APJ's, that it was not prohibited to do what
16 he wanted to do in his recurring opinions, where
17 he was removed from the panel. Is that right?

18 A No, that's not right, the answer to this
19 specific question -- this specific question --
20 about whether or not it is prohibited. It is not
21 prohibited in all cases. What we were trying to
22 explain to the judges, and we had done several

1 times at that point, was that if additional
2 arguments were raised by the party, that we would
3 respond to the additional arguments, even if it
4 meant responding or analyzing more than one claim.
5 And, so, that was what we were explaining at that
6 time.

7 Q Okay, and I - so, I guess, that would be
8 those are the additional arguments raised by a
9 patent owner that would come in the form a patent
10 owner preliminary response, is that right?

11 A Correct.

12 Q And, so am I right to understand that
13 one instance where its actually okay to just
14 analyze one claim, one ground, is where the patent
15 owners preliminary response, only raises -- only
16 addresses one claim on the ground, for example, is
17 that right?

18 A Yes.

19 Q Now, if the patent owner responds --
20 addresses more than one claim, and more than one
21 ground, and the institution decision only
22 addresses one claim and one ground, is it your

1 testimony that that would be contrary to the
2 director's guidance?

3 A Yes.

4 Q Would it surprise you, Judge Fink, that
5 there are also post SAS institution decisions that
6 analyze one claim, one ground where a patent
7 owners preliminary response analyses more than
8 just one claim, one ground?

9 A It would surprise me if they came after
10 we delivered the guidance that -- that's not what
11 the director wanted. I believe -- I recall at
12 that time in the first couple of weeks that this
13 was -- doing -- on that there were some instances
14 of that happening, and I think some of them were
15 even just to comply with the deadlines. It would
16 surprise me that once we delivered the guidance
17 several times, that that would keep going on, yes.

18 Q Okay, well if we look at Judge
19 Fitzpatrick's question in this WebEx chat, can't
20 you see why Judge Fitzpatrick sitting at this
21 training might be confused about the director's
22 SAS guidance?

1 A No.

2 Q All right, look to the bottom of page 6
3 on tab 6.

4 A Yes.

5 Q There's a comment from Mitchell
6 Weatherly (phonetic) to everyone. And, he says
7 what is the director's legal authority for telling
8 panels how to decide these issues in a final
9 written decision. And, so my question for you
10 Judge Fink, did Mitchell Weatherly exercise a lack
11 of discretion when asking that question in the
12 WebEx chat?

13 A Probably.

14 Q All right, turn the page to page 27 of
15 Tab 6.

16 A Yes.

17 Q And, let's look at Jacklyn Harlow's
18 (phonetic) private message.

19 A Yes.

20 Q Okay, and she says, "What is the
21 recourse for a panel member who's instructed to
22 follow a "policy of the director" that they are

1 not allowed to identify a decision." How is that
2 panel member to maintain their professional
3 integrity when they are told to sign their name to
4 something they think is incorrect, that they are
5 not allowed to explain -- that they've been told
6 to follow a policy.

7 A Yes.

8 Q Do you understand --

9 A Yes.

10 Q Okay -- do you understand Judge Harlow's
11 concern that she is raising here.

12 A Yes, that concern was raised by several
13 people.

14 Q Okay, if she were to ask you that
15 question, what would your response be?

16 A I believe what we instructed judges was
17 -- is that they felt they were deciding things in
18 a way, that they didn't agree with, but were doing
19 so to follow a policy. we told them to just say,
20 I'm deciding this in accordance with office
21 policy", and leave it at that.

22 Q All right, if you could turn to page 20

1 of tab 6, Judge Fink.

2 A Yes.

3 Q Okay, and you looked at this email
4 earlier on direct with Mr. Horrigan, right?

5 A Yes.

6 Q The subject of the emails AIA hotlist?

7 A Yes.

8 Q Can you explain to me what the AIA
9 hotlist is?

10 A Yes, so, it was a list that was
11 generated by the PTAB staff of decisions that were
12 due the next day -- the statutory deadline was the
13 next day, and had not been mailed yet, and needed
14 to be mailed. And, so, and it was -- to the
15 judges who were on the panel, and then various
16 management staff were on that list. I'm sorry on
17 the two on the CC.

18 Q And, did judges other than Fitzpatrick,
19 in this instance, reply all on this AIA hotlist?

20 A Do you mean like, as a matter of course?

21 Q Does it -- let me just -- no, not as a
22 matter of course -- has it occurred where judges

1 have replied all to this AIA hotlist when they are
2 included?

3 A Yes, it happens.

4 Q Let's turn back to page 5 of tab 6, and
5 let's just go back to the Judge Paulraj IPR issue,
6 okay?

7 A Yes.

8 Q Did you talk to the other copanelists on
9 that IPR about this development?

10 A No, I didn't think I did.

11 Q Okay.

12 A I listed everyone I talked to on the
13 grievance, so, no they aren't there - no, I didn't
14 talk to them. I'm sorry -- I didn't mean to
15 interrupt.

16 Q Did you -- okay - so, you don't know one
17 way or the other, if a copanelist actually agreed
18 with Judge Fitzpatrick's view of how to proceed in
19 this IPR?

20 A Well, they weren't on his opinion, I
21 guess, so to me, that means they didn't agree with
22 what he was writing.

1 Q All right, if you could turn to page 5
2 of your decision, that's, you know, I'm sorry it's
3 page 5 of tab 6 and in the middle -- you make a
4 note that all of these events took place within a
5 10-month period between July 31, 2017 and May
6 30, 2018. Do you see that?

7 A Yes, I do.

8 Q When deciding Judge Fitzpatrick's formal
9 grievance, did you review his written performance
10 appraisals?

11 A I believe he reported -- I accepted his
12 representation and I think it was in his grievance
13 memo that he had been given previously -- been
14 given good performance appraisals.

15 Q Did you review those performance
16 appraisals?

17 A No, I took his word for it.

18 Q Okay, and so, that would include the
19 October 2017 fiscal year end performance appraisal
20 and the April 2018 mid- year performance
21 appraisal, is that right?

22 A Yes.

1 Q -- and both of those appraisals occurred
2 in between the 10-month period, that you describe
3 here in your formal brief, is that right?

4 A Yes. Yes.

5 Q How often does PTAB management give an
6 APJ that receives positive performance reviews, an
7 oral informal counselor?

8 A Well, it happens. It's -- I think when
9 we see a normally -- when we see a pattern or
10 something that strikes us as being an outside -- a
11 one off, I would call it - then, we have to
12 intervene as managers and provide feedback --and
13 it does happen.

14 Q And, how often do APJs that get positive
15 performance reviews get punished?

16 A I mean that happens too. It's not very
17 often, and I don't really think of it as
18 punishment. I think of it as work -- on this other
19 part of the document -- that still needs to be
20 done until you know, you can kind of come to grips
21 with what management is requiring, in terms of the
22 decision making.

1 Q Do you know if Judge Fitzpatrick wanted
2 to be ex parte reexamination appeals?

3 A I don't think he did because his
4 grievance asked to have his old docket back.

5 Q So, you still don't -- you don't view
6 his removal from AIA cases to a position where he
7 did not want to be as punishment?

8 A No, I think it was -- I think we viewed
9 it as -- if you can -- if you can get along with
10 your peers and management, that my understanding
11 was -- is that, you would have your docket back.
12 That was what was asked of him.

13 Q All right, one last thing if you could
14 turn to tab 7, page 656.

15 A Yes.

16 Q Mr. Horrigan then showed you this email
17 on direct, do you remember that?

18 A Yes.

19 Q You didn't identify this email in your
20 formal -- in your decision on Judge Fitzpatrick's
21 formal grievance did you?

22 JUDGE NIEDRICK: Can you give the cite

1 for that Mr. Kappers, I'm sorry.

2 MR. KAPPERS: Tab 7 at 656.

3 JUDGE NIEDRICK: Thank you.

4 THE WITNESS: Your question was -- did
5 -- was this email cited by me, I don't think it
6 was. I don't think I saw this email.

7 BY MR. KAPPERS:

8 Q Well, okay, but was the first time you
9 saw this email at the hearing today?

10 A Yes, I think it was.

11 Q Okay, and, do you know whether Judge
12 Weidenfeller -- when he spoke to Judge Fitzpatrick
13 on May 31 -- raised this particular email with
14 him?

15 A No. I don't know.

16 Q I have nothing further.

17 JUDGE NIEDRICK: And, I don't think I
18 really have anything. Any follow up Mr. Horrigan?

19 MR. HARRIGAN: None.

20 JUDGE NIEDRICK: Okay, Thank you very
21 much. Judge Fink, I really appreciate you coming
22 and testifying today. Please don't discuss your

1 testimony with anyone, if you have any questions,
2 please contact Mr. Horrigan, okay?

3 THE WITNESS: Very well, thank you
4 Judge.

5 JUDGE NIEDRICK: And, you can go ahead
6 and hit mute and if you can't find it, I'll leave.

7 THE WITNESS: I'll find it, I'll hit it
8 for you.

9 JUDGE NIEDRICK: Okay, thank you. Okay,
10 were you able to get a hold of Judge Gongola?

11 MR. HERRIGAN: Yes, I was.

12 JUDGE NIEDRICK: Okay, and when do you
13 want to call her? I see - Judge Paulja is in the
14 waiting room.

15 MR. HERRIGAN: I intended to call her
16 last.

17 JUDGE NIEDRICK: Okay, okay. Do you
18 guys need a short break or should we just push
19 forward with Judge Paulja? Anybody?

20 MR. HERRIGAN: Can we do 5 minutes, your
21 honor?

22 JUDGE NIEDRICK: Yes, okay. Let's go

1 off the record. It is now 3:20 let's come back at
2 3:25.

3 (Recess)

4 JUDGE NIEDRICK: Okay, and I'm just
5 admitting Judge Paulraj. Judge Paulraj can you
6 hear me, this is Administrative Judge Andrew
7 Niedrick?

8 THE WITNESS: Yes, I can hear you judge.

9 JUDGE NIEDRICK: Okay, great. And just
10 to kind of let you know who is on the video
11 conference here. Mr. Suarez, Mr. Kappers, and
12 Mr. Abramic - actually Mr. Abramic is on a call
13 right now, but Mr. Kappers and Mr. Suarez are
14 representing Judge Fitzpatrick in his appeal and
15 William Horrigan, I'm sure you know, is the
16 agency's attorney in this case. And, then Ms.
17 Dawson is our court reporter, and she has a couple
18 of other -- you can see that blackout square, they
19 are her backup for her recordings. Okay.

20 THE WITNESS: All right, great.

21 JUDGE NIEDRICK: Okay, do you have any
22 objection to swearing an oath?

1 THE WITNESS: I do not.

2 Whereupon,

3 CHRISTOPHER PAULRAJ

4 was called as a witness and, having been first
5 duly sworn, was examined and testified as follows:

6 JUDGE NIEDRICK: Great, and can you
7 please spell and state your first and last name
8 for the record?

9 THE WITNESS: It is Christopher
10 C-H-R-I-S-T-O-P-H- E-R PAULRAJ P-A-U-L-R-A-J.

11 JUDGE NIEDRICK: Great, thank you, and
12 if there is an objection while you are testifying,
13 please speak your answer. I'll rule on the
14 objection and instruct John how to proceed, okay?

15 THE WITNESS: Yes.

16 JUDGE NIEDRICK: Okay, Mr. Horrigan,
17 your witness?

18 DIRECT EXAMINATION

19 BY MR. HORRIGAN:

20 Q Thank you, what is your current position
21 sir?

22 A I'm an administrative patent judge with

1 the patent trial and appeal board.

2 Q And, you've also been a lead
3 Administrative Patent Judge is that correct?

4 A That is correct.

5 Q And, for what periods have you been an
6 APJ?

7 A Overall, I started with the board in
8 April 2014, so if you want to count the time where
9 I was a lead APOJ, I've been in either an APJ
10 position or lead APJ position, since 2014 and
11 continued with that in that position.

12 Q And, then, how many of those years were
13 you involved in AIA cases?

14 A I would say pretty early on, since I
15 joined the board, since I think my first day -- my
16 case may have been docketed to me around 2015.

17 Q Do you have any estimate of how many AI
18 cases you have handled in that time period?

19 A I would say hundreds, either as APJ I
20 which is alternating judge position or another
21 judge on the panel.

22 Q All right, so let me ask you to turn to

1 tab 32, page 83.

2 A Let me just pull it up. I'm there.

3 Q Okay, and what do you recognize this as?

4 A This is a decision from 2018 -- it's a
5 decision denying institution on which I was a
6 panel, and I wrote a dissenting opinion, and Judge
7 Fitzpatrick and Judge Jen Yang (phonetic) were on
8 the panel with me.

9 Q Now, we've had a bunch of testimony
10 about APJ I, II and III. In this case who was APJ
11 I?

12 A Judge Fitzpatrick was.

13 Q And, what was your role on this case?

14 A I don't know if I recall -- I don't
15 think we often distinguished between APJ II and
16 III in AII cases, especially. But, I was an APJ
17 II or III. I was in another case on that case.

18 Q And, so what are the responsibilities of
19 APJ I when they are assigned to a case like this?

20 A I mean APJ I -- their primary
21 responsibility is to present the case to the other
22 2 judges, they are often the ones that pick up the

1 case file. First, and they'll have primary
2 authoring responsibility of the case, and they'll
3 circulate a decision, of course APJ II and III,
4 will have input and, as example with this case, or
5 maybe dissents or concurrences to an APJ II or
6 III.

7 Q Let me refer you to -- I'm sorry --

8 A I'm sorry --

9 Q I'm sorry -- anything else --

10 A That's it.

11 Q That's okay. All right, so let me refer
12 you know to Tab 5, page 68.

13 A Okay.

14 Q And, using this to put the timeframe in
15 mind, what happened with this particular case?

16 A I'm still pulling it up -- give me a
17 second.

18 Q Sure.

19 A You said Tab 5, page 68?

20 Q Correct.

21 A All right, and your question again?

22 Q Okay, so, we see that on April 11th a

1 decision is ready for your review. Is that what
2 is going on here?

3 A Yes, well, the page that I see on page
4 68 the decision was sent for paralegal processing.
5 I believe there was other correspondence where
6 Judge Fitzpatrick sent a copy of the decision, or
7 link to the decision, for panel review as well.

8 Q Yes, but, do you recall this was in
9 April 11, 2018 -- do you recall that timeframe?
10 Okay.

11 A I do.

12 Q Okay, you mentioned APJ I takes the
13 lead, correct?

14 A That's correct.

15 Q And, at some point there's a conference,
16 is that right?

17 A Yes.

18 Q What's the purpose of the conference?

19 A The purpose of the conference is to come
20 to some kind of consensus as a panel about how to
21 generally go forward with the case, besides --

22 Q Is that what happened in this case?

1 A Generally, that's my recollection.

2 Q Okay, do you recall that conference?

3 A I do, yes, it took place earlier that
4 week.

5 Q What is your recollection for how that
6 conference went?

7 A So, my recollection it's always been,
8 about more than 4 years at this point, my
9 recollection was that it was somewhat of an
10 unusual conference because Judge Fitzpatrick had
11 presented the issues in a manner that, at least,
12 my impression for myself, as well as my impression
13 of Judge Yang, had thought at the time, was that
14 he wanted to decide the case under somewhat an
15 unusual procedural posture.

16 Q As opposed to what?

17 A As opposed to our regular run of the
18 mill bread and butter approach which is -- we
19 offer -- refer to the -- deciding a case on the
20 merits -- which is, at least the way I use that
21 term is, to decide it on a primary issue we decide
22 and the institution decision, and IPR is the

1 decider as to whether or not a petitioner has
2 shown a reasonable likelihood of prevailing with
3 respect to, at least one claim, and on that we
4 decide whether our petitioner has shown a good
5 case. I'm not using legal terminology here. A
6 good case to go forward on the patentability
7 charges that are presented.

8 Q And, in this conference, Mr. Fitzpatrick
9 presented a different approach? Is that right?

10 A Well, my recollection was that Judge
11 Fitzpatrick had initially proposed denying
12 institution on the basis of real party and
13 interest. Which is a basis which we have denied
14 institution at the board, but it doesn't happen
15 often, and I know there were a lot of concerns
16 about using real party as an interest -- as a
17 basis to deny institution, especially when -- if
18 we were to deny the merits, we would have ended up
19 reaching the same conclusion, real party and
20 interest was perhaps more controversial basis, and
21 now it continues to be there -- has been board
22 precedent, and federal precedent addressing real

1 party and interest issues since this time.

2 Q Now, do you recall these 4 years later,
3 when this decision had to get out?

4 A Yes, I do. Just based on my review, of
5 the files here -- the -- and the email itself,
6 shows as April 18, 2018, so I think that may have
7 been the statutory deadline for this decision to
8 get out.

9 Q And, so the conference that you held,
10 was that timely that you had?

11 A So, when you say timely -- we at the
12 board to have a goal -- it's not necessarily a
13 strict -- when I say strict, it's not -- it's an
14 aspirational goal, I would say. I would try to
15 circulate a decision to the panel at least 12 days
16 before it needs to be mailed. And, we often
17 strive to mail a decision at least one business
18 day before the statutory deadline. So, just from
19 the timing here, and the dates that I could put
20 together, it doesn't look like a decision was
21 either conferenced or circulated 12 business days
22 before the deadline.

1 Q So, coming out of the conference, what
2 were you expecting to happen next?

3 A Well, my recollection was that we
4 discussed the issues. I mentioned real party
5 issues as one basis to deny institution, and
6 ultimately my recollection was that night Jen,
7 Judge Yang, nor I, were on board with that
8 approach, so Judge Fitzpatrick had proposed
9 another alternative approach, again I would say,
10 it was somewhat unusual from my experience at the
11 board at that time. Which was an interpretation
12 of the rules that would have led to that. Judge
13 Fitzpatrick said, you know, it was his view that
14 petitioner had not met the requirements for filing
15 a petition, or that the requirements for proposing
16 a claim construction and an accountability
17 analysis, so that was what Judge Fitzpatrick had
18 proposed at the end of the conference earlier that
19 week on April 9, and my recollection was that we
20 were going to see how it was going to write up.
21 And, Judge Fitzpatrick was going to circulate a
22 decision, which he did, April 11, laying out his

1 reasoning.

2 Q Okay, and so did you review it on April
3 11?

4 A I reviewed it as soon as possible either
5 April 11, or shortly after, I see that from the
6 email correspondence. Here, he circulated it 5:14
7 p.m. so past my normal business hours.

8 JUDGE NIEDRICK: Judge Paulraj, what are
9 you looking at? You need to stay on the documents
10 that the questions that referred you to. Please
11 don't --

12 THE WITNESS: I'm sorry.

13 JUDGE NIEDRICK: -- move to other
14 documents. Okay --

15 THE WITNESS: Okay.

16 JUDGE NIEDRICK: -- you need to stay
17 with, right now, we are on page 68 of tab 5, so
18 please go back to that and please don't scroll
19 around, unless you are asked to.

20 THE WITNESS: Yes, judge, sorry. So, I
21 was at page of tab 5 references to an email that
22 Judge Fitzpatrick had circulated to our

1 interference file section, April 11, 5:10 p.m.,
2 where I was copied and Judge Jen Yang, was copied.
3 But, just for completeness sake, from my own
4 recollection, I know as part of the same email
5 chain there was a follow up email which Judge
6 Fitzpatrick had sent an email specifically to
7 Judge Yang and myself, usually a separate copy for
8 a panel review, and that's when I started -- when
9 I had access to a decision that I could review.

10 BY MR. HERRIGAN:

11 Q And, why don't we just scroll up to the
12 bottom of page 67, is that what you are referring
13 to?

14 A Yes.

15 Q Okay, And, then let's across up to the
16 top of page 67.

17 A Okay.

18 Q So, what's happening here.

19 A So, it appears that between Wednesday
20 5:14 p.m. and Friday April 13, 2:12 p.m., I had
21 reviewed the decision, and I had signed off on the
22 decision for ARC, which is our AIA Review

1 Committee. Which is another procedural
2 requirement that, especially for certain times of
3 decision, such as an institutional decision, the
4 court judges need to send to ARC for their review,
5 so I signed off on ARC, but I had some concerns as
6 laid out in this email, and in my voice mail that
7 is referenced in this email.

8 Q Okay, with respect to that voice mail
9 can we go to tab 1, page 24.

10 A Yes.

11 Q And, on the second half of that page you
12 will see what Mr. Fitzpatrick had described IDs
13 that voice mail. You see that?

14 A I'm getting there right now. I see it,
15 yes.

16 Q Does that look like an accurate summary
17 of what happened?

18 A Again, having it having been 4 years, I
19 don't have any reason to question whether it
20 factored or not. It seems like it is consistent
21 with what I had said in the email that we saw
22 earlier.

1 Q And, on this Friday, before this opinion
2 is due out -- what is your concern about this
3 matter if anything?

4 A So, at this point I had actually gotten
5 to see the analysis that Judge Fitzpatrick had put
6 down in his draft petition. I know we had
7 discussed the approach earlier that week on that
8 Monday April 9 but having had a chance to review
9 the analysis, I had some serious concerns. I knew
10 that there was a deadline coming up, but for that
11 reason, I signed off on ARC. Normally the
12 practice would be for panel to be fully on board
13 with the decision before it goes onto to ARC, but,
14 under the circumstances, I signed off on our ARC
15 review and then I said, I need to take a look at
16 it, and whether or not I'll have to write a
17 dissent. I need to take a look at it in a little
18 more detail, I was trying to see if I should do a
19 little more research on my own, just generally
20 thinking about the approach, that Judge
21 Fitzpatrick made on his -- in his opinion and so,
22 that's what I did. I ended up thinking about it

1 more over the weekend.

2 Q And, then let's go to tab 5, page 65.

3 Do you see an email from you, correct?

4 A Yes.

5 Q So, you spent the weekend writing this
6 dissent up?

7 A I did.

8 Q And, on tab 32, page 93, please.

9 A I'm sorry, what was the cite for that?

10 Q Tab 32, page 93.

11 A I'm there.

12 Q All right, and can you summarize for the
13 administrative judge, what the essence of your
14 dissent was?

15 A So, it is a fairly short dissent, but
16 the essence of the -- is I didn't agree with the
17 interpretation of the rules that Judge Fitzpatrick
18 had laid out, in the majority opinion. I thought
19 it was highly unusual especially given my
20 experience as a panel litigator, for the majority
21 to take a position that a petitioner could not at
22 least, under the rules as interpreted by the

1 majority, provide an unpatentable analysis under
2 an alternative approach. You know, before I
3 joined the board, I was a panel litigator, so I
4 was coming from a panel litigation background. My
5 experience was that patent defendants, at least in
6 courts, and before the ITC where I practiced,
7 often, present their invalidity arguments under
8 alternative approaches, and they often condition
9 their arguments under the premise that, if you are
10 going to adopt the patent holders interpretation,
11 that the claims are maybe on board that they are
12 covered by the prior ARC, and that's the basis for
13 our invalidity contentions. And, my view was that
14 given that board was serving as, let's say an
15 alternative forum where invalidity arguments that
16 could have been presented in disaccord of ITC,
17 were going to be presented to the board. In my
18 view it made sense for us to take a similar
19 approach in terms of our interpretation of the
20 rules. So, I laid that out in this dissent.

21 Q And, then, let's scroll down to page 94
22 looking a footnote 1 at the bottom.

1 A Yes, I see it.

2 Q Why did you include that footnote?

3 A There are a few things in this footnote,
4 but, so, the first thing -- the first sentences,
5 talk about the fact that my view wasn't -- that we
6 shouldn't have necessarily granted institution,
7 you know, we could have denied institution, if we
8 had actually considered the merits. Say, we
9 actually ended up constructing the claims in a
10 certain way that would have led us to conclude
11 that petitioner did not meet its burdens under
12 that particular construction. However, as I said
13 in the second to last sentence there, the
14 majorities approach forecloses the analysis all
15 together. And, I did say something here that I
16 did consider at the time, and I still continue to
17 consider, highly unusual for a footnote in a board
18 decision, I noted that I'd welcome the opportunity
19 for the panel to further consider this issue and
20 the request for rehearing, and I did that because
21 of the fact that my view was that I didn't believe
22 that the panel had enough opportunity, especially

1 myself and Judge and Jen Yang, to full consider
2 this, given the short turnaround that we were
3 asked to try this case -- short time frame in
4 which we were asked to turn this case around.

5 Q Okay, you had many, many cases in the
6 past, correct?

7 A I have, yes.

8 Q Have you been in a situation where an
9 APJ has had a conference late and given you a copy
10 late?

11 A I have.

12 Q Have you done that yourself?

13 A I have.

14 Q Okay, so what -- what about this
15 situation if anything, did you find to be
16 concerning?

17 A So, it wasn't necessarily the lateness
18 per say as you alluded to -- it happens, judges at
19 the board are very busy and given the other,
20 perhaps statutory deadlines or pressing matters
21 decisions, can be circulated late closer to the
22 statutory deadline, but what I thought was very

1 unusual here, was we were asked as a panel,
2 especially ALJ II and II, to decide this case on a
3 really unheard of approach, in my view. It was
4 highly unusual, it was the first time I had seen
5 the rules considered in such a manner, and I felt
6 that there just was not enough time for a proper
7 deliberation of this issue under the
8 circumstances.

9 Q Thank you, nothing further.

10 JUDGE NIEDRICK: Okay, Mr. Suarez, I
11 take it you are going to do the cross here.

12 MR. SUAREZ: Yes, I will your honor.

13 JUDGE NIEDRICK: Okay, you can go ahead,
14 thank you.

15 CROSS-EXAMINATION

16 BY MR. SUAREZ:

17 Q Thank you your honor. Good afternoon.
18 Mr. Paulraj, how are you?

19 A Good, how are you?

20 Q You testified on direct that you served
21 on many panels of the PTAB presiding over
22 interparty reviews, correct?

1 A Yes.

2 Q And, typically 3 APJs are designated to
3 a panel, right?

4 A Yes.

5 Q And, why is it 3 judges?

6 A That's a statutory requirement.

7 Q And, aside from the statutory
8 requirement, are there reasons why it is useful to
9 have 3 judges instead of 2 or 1 judge?

10 A I don't have -- I'm not sure I fully
11 understand the question. You mean, as a policy
12 matter?

13 Q As a policy matter, as a practical
14 matter based on your extensive experience as a
15 judge. Is there equality in having 3 judges on a
16 panel?

17 A I find it useful, yes -- to have 3 judge
18 son a panel.

19 Q Sorry --

20 A It's part of the - honestly, it's one of
21 the reasons I really like this job for me, to be
22 able to deliberate these complex issues with

1 colleagues, that I consider to be some of the best
2 and brightest in the profession.

3 Q You think that collegiality and
4 discussion that occurs amongst the judges is a
5 asset for the board?

6 A I do.

7 Q Now, in an IPR, the panel decides
8 whether or not claims of an issued patent are
9 patentable or not patentable, correct?

10 A That is some of the issues that we
11 decide, yes.

12 Q And, there is an institution phase of
13 the proceeding, correct?

14 A An institution phase, yes.

15 Q And, that's before the institution
16 decision, right?

17 A Yes.

18 Q And, then after the institution phase,
19 there is a trial phase or a merits phase, of the
20 proceedings, correct?

21 A Yes.

22 Q And, everything that occurs after

1 institution is in the trial phase of the merits
2 phase, correct?

3 A What do you mean everything that occurs
4 in the proceedings?

5 Q So, everything that occurs. So, after
6 institution you've entered the trial phase or the
7 merits phase correct?

8 A Yes, assuming we institute, yes.

9 Q Right, and so after that point in time,
10 after the panel institute all deliberations are in
11 the merits phase or the trial phase, correct?

12 A When you say merits phase, I'm a little
13 turned off by that terminology but, yes, we
14 referred in the statute and in our rules -- I
15 think define a trial as a period of policy
16 institution, yes.

17 Q Okay, now -- the designated panel at
18 institution is the panel that ultimately decides
19 the APR, is that correct?

20 A That's definitely the case.

21 Q Okay, when is that not the case?

22 A In case there's a panel change, for some

1 reason, if the judge does part of the institution
2 decision is unavailable for any variety of
3 reasons, post institution.

4 Q Okay, and under current PTAB practice,
5 if there is a panel change or a panel change order
6 is issued correct?

7 A Yes.

8 Q And, that is done pursuant to SOP1,
9 revision 15, correct?

10 A I don't have that SOP in front of me,
11 but I'll take your word for it, if that is the
12 particular SOP/revision you are talking about.

13 Q The current SOP requires panel change
14 orders to issue, at that time the change of the
15 panel, right?

16 A I believe that there is an SOP that
17 requires a panel change order to issue.

18 Q In -- on direct you talked about the
19 Holijek (phonetic) IPR correct?

20 A If that's the case I was asked about on
21 direct. I don't have the exact -- party name,
22 but, I often times I think about these cases in

1 terms of the numbers, rather than a particular
2 party name.

3 Q I understand, in the case you spoke of
4 on direct, the panel did change, correct?

5 A At some point the panel changes, yes.

6 Q And at some point, that panel changed to
7 move Judge Fitzpatrick and replaced him with
8 another judge, correct?

9 A That's correct.

10 Q And, that judge was Judge Kaiser
11 (phonetic), right?

12 A That's correct.

13 Q I believe you said this in direct, you
14 said an IPR resembles civil litigation in many
15 respects, right?

16 A In some respect.

17 Q In based on your prior experience as a
18 district court litigator sounds like that's part
19 of the allure for you and working on AIA trials,
20 is that fair?

21 A It is not so an allure, AIA trials are,
22 I would say, it's a hybrid between a patent office

1 proceeding and has certain aspects of litigation
2 -- and me coming from the litigation background,
3 where I've litigated before the district courts,
4 as well as, the International Mid Commission, I
5 was able to use that skill set and knowledge basis
6 in my current job, yes.

7 Q Now, based on your experience presiding
8 over PTAB panels, you've presided over oral
9 arguments in the PTAB correct?

10 A Yes.

11 Q And, during arguments you expected the
12 attorneys arguing their case to you to tell the
13 truth to you and the other panel members?

14 A Yes.

15 Q And, the attorneys practicing for the
16 PTAB owe a duty of candor?

17 A Yes.

18 Q Are they subject to rules of
19 professional conduct that also impose a duty of
20 candor?

21 A Yes.

22 Q If, during oral argument, and the

1 attorney gave you a false answer, you would want
2 the attorney to come back and correct everything,
3 correct?

4 A That would be my expectation, yes.

5 Q And, you would agree that an attorney
6 has a legal obligation to correct a false
7 statement made before a judicial tribunal, right?

8 A I'm sorry, say that again?

9 Q You would agree that it's reasonable to
10 agree that an attorney has legal obligation, or at
11 least a professional obligation, to correct a
12 false statement made before a judicial tribunal,
13 correct?

14 A I can't talk about every single judicial
15 tribunal, but at least before the PTAB, I think it
16 depends on the false statement, and it depends on
17 the material on the false statement. But, I'd
18 like to think that the attorneys before that have
19 come before me have had a high level of ethics
20 instilled in them, and then they never have to
21 worry about a material false statement that rises
22 to the concerns you alluded to.

1 Q Okay, on direct you spoke about the 12
2 business days, sort of rule of thumb, to submit
3 PTAB decisions to the panel, is that right?

4 A So, it is more than a rule of thumb,
5 it's in our documents -- it's in our performance
6 documents.

7 Q On direct, you characterized it as a
8 goal, right?

9 A Yes, I would say that is probably a more
10 accurate characterization of that.

11 Q Okay, so, it is not a mandatory
12 directive, right?

13 A No, it's not mandatory, per say. It's
14 not, so when you say mandatory, it's not an
15 absolute requirement, in my experience.

16 Q Okay, so, would you say it's advisory
17 then?

18 A It is a little more than advisory, it's
19 again a goal that we should strive for, so as
20 judges and that we try to strive for, in most
21 cases. If there is a reason why, I couldn't
22 circulate it within that 12-business day period, I

1 try to alert the panel or anyone else involved,
2 you know, this decision may be a little late, I
3 guess later than expected.

4 Q Okay, and I believe you said, "it
5 happens in terms of judge's missing the 12-day
6 sort of guidance, or informal understanding, is
7 that right?

8 A Yes. And, I would say again, I wouldn't
9 necessarily characterize it as an informal
10 understanding, it's documented, so it's more than
11 an informal understanding.

12 Q Okay, and so how often does that happen,
13 in your experience?

14 A I couldn't give you a particular
15 percentage, I know it has happened before.

16 Q Does it happen more than 30 percent of
17 the time?

18 A It may -- say unless I can go and look
19 back at every single case, and come up with a
20 formulation or a tabulation, I can't even start
21 with the percentage, I'm sorry.

22 Q Okay, how about more than 10 percent?

1 A It's hard for me to say -- establish --

2 Q You were appointed lead judge in

3 December 2017, correct?

4 A Yes, that's right.

5 Q And, so have you been a lead judge ever

6 since that time?

7 A Well, I recently rotated off being a

8 lead judge, earlier this year.

9 Q Okay, and what is your role now?

10 A Back to being an administrative patent

11 judge.

12 Q I see.

13 A I hate to say normally today, but to

14 maybe distinguish it as, you know I was a lead

15 judge where supervisors and I no longer have that.

16 Q And, so you were a lead patent judge for

17 approximately 5 years, correct?

18 A December 2017 to say March 2022 -- is I

19 think a little less than 5 years.

20 Q Four or 5 years?

21 A Four or 5 years, yes.

22 Q Okay, and so in that time you had a

1 window into more panels in terms of the timeliness
2 of decisions. Is that fair?

3 A I think that's fair.

4 Q Okay, and would it surprise -- you're
5 familiar with other lead administrative patent
6 judges?

7 A I am.

8 Q And, if another lead administrative
9 patent judge estimated that, at around a quarter
10 of the decisions are late pursuant to that 12-day
11 rule, would that surprise you?

12 A It wouldn't necessarily surprise me, but
13 again, there may be that lead judges own
14 experience either as a supervisory -- I apologize.
15 That's my home phone number - so, let me see if I
16 can turn it off.

17 JUDGE NIEDRICK: Sounds like it stopped,
18 we don't hear it anymore.

19 THE WITNESS: All right, apologies about
20 that.

21 JUDGE NIEDRICK: Yes.

22 THE WITNESS: Do you need to hear the

1 answer again, court reporter?

2 Could you ask the question again, I lost
3 my train of thought.

4 MR. SUAREZ: I did as well. Can you
5 read back my question, I believe the phone
6 happened after my question was asked.

7 JUDGE NIEDRICK: I think it was
8 something to the effect of -- okay, here we go.

9 (The reporter read the record as
10 requested.)

11 MR. SUAREZ: Oh, you know what -- that
12 jogs my memory. So, if another, so you are
13 familiar with Administrative Patent Judge
14 Mitchell, correct?

15 THE WITNESS: Are you talking about
16 Susan Mitchell -- Lead judge?

17 BY MR. SUAREZ:

18 Q She's a leader judge -- she's a lead
19 judge, right.

20 A Yes, that's right.

21 Q Okay, and so, if she had testified at
22 this hearing around a quarter of the decision were

1 delivered late relative to that 12-day, that we've
2 been discussing, would that surprise you?

3 A It wouldn't have.

4 Q So, from your experience a pretty
5 significant percentage then of these decisions
6 from APJ, at least the drafts that come to the
7 panel, after this 12 days, right?

8 A Yes, I would consider a 25 percent of a
9 -- if that is an accurate assessment, to be a
10 significant percentage, yes.

11 Q Now and -- you had agreed with my prior
12 question that the 12-day rule was not a directive,
13 right?

14 A I agree it is not a directive.

15 Q Okay, so, and then my question is, when
16 is an APJ -- is a policy from the director viewed
17 in your eyes as the directive that you necessarily
18 must follow in all cases. When is that the case?

19 A When you say -- can you repeat that
20 question?

21 Q Let me rephrase it, perhaps it was
22 inartful. What does the director need to do in

1 terms of oral statement, writing or anything else,
2 that tells you as an APJ that what they have
3 issued is a directive and necessarily binding on
4 you as an APJ?

5 A So, I think I understand the question.
6 And, in terms of the director's policy
7 pronouncements, that can come to us in a variety
8 of ways. The -- and these are often policy
9 pronouncements on perhaps how the director views a
10 law, interprets our rules, or views, you know,
11 certain statutory issues, etc. So, one example is
12 the 2019 patent eligibility guidance that the
13 director had issued. That was initially I want
14 say, that was in the form of a guidance or a memo
15 that laid forth the director's approach to
16 deciding one on one cases, and in fact, it got
17 published in the federal register and then later
18 incorporated into our manual of patent examination
19 policy NVP (phonetic). So, that is one way for
20 the director to set forth the director's policy.
21 Another way, is to -- through presential
22 decisions, either presidential decision designated

1 from within, decisions that originated from the
2 board or decisions that came out of our
3 presidential opinion panel at the top, as it was
4 called, and more recently after the supreme
5 court's author rights (phonetic) decision,
6 director initiated review decision, director
7 decision directly coming from that process. So,
8 those are some examples, but, I don't know it --
9 that would necessarily be comprehensive in terms
10 of other methods, by which the director made --
11 pronounce or issued policy pronouncements.

12 Q Okay, does the director, does the
13 director have to put something in writing for it
14 to be binding on you based on your experience as
15 an APJ?

16 A Does the director have to put something
17 in writing in order for it to be binding on me
18 based on my experience as an APJ? At least based
19 on my experience as an APJ, my own experience, the
20 only time I've felt compelled to say -- if that is
21 the right word -- by any director policy is based
22 on written statements. I haven't had the director

1 directly calling me to tell me that this the
2 policy that should be followed in any particular
3 case, or any particular issues for several cases.

4 Q So, do you think it would be
5 appropriate, for example, call you and tell you
6 that you need to change your decision in a
7 particular --

8 MR. HARRIGAN: Objection, we're well
9 outside the scope of direct.

10 JUDGE NIEDRICK: Sustained. Yes, we are
11 well beyond the scope of direct.

12 MR. SUAREZ: I'll move on that's no
13 problem. So, let's talk about Hologic Life
14 Sciences (phonetic) that we talked about on
15 direct. So, let's go to tab 6, page 88, please?

16 THE WITNESS: Let me open that up.

17 BY MR. SUAREZ:

18 Q Okay, tab 6, page 88 --

19 A I'm sorry -- it's still loading up -- my
20 computer has been slow today all day. Apologies
21 for that. Page 88, you said?

22 Q So, page 88-99, that is the April 18,

1 2018 decision you looked at on direct denying
2 institution, correct?

3 A That's correct.

4 Q And, the panel was Judge Fitzpatrick,
5 yourself, and Jen Yang, right?

6 A That's correct.

7 Q Now, you had testified on direct that
8 before Judge Fitzpatrick issued his opinion or
9 circulated his draft opinions, you had had a
10 conference call with Judge Fitzpatrick and Judge
11 Yang, right?

12 A That's correct.

13 Q And, that you had -- the panel did not
14 agree with an approach to a decision that would
15 deny institution based on real party and interest,
16 right?

17 A That's my recollection.

18 Q But, Judge Yang proposed an alternative
19 route that Judge Fitzpatrick agreed with, correct?

20 A I'm not sure that was my recollection
21 --I think the alternative route as laid out in
22 this decision denying institution was based on

1 this interpretation of our rules, and I believe
2 that was also that -- Judge Fitzpatrick had
3 proposed. I don't think it was initiated or
4 originated from Judge Yang.

5 Q Okay, as you sit here today, you're not
6 100 percent sure about that?

7 A I'm probably -- I'm fairly certain that
8 that is not something that Judge Yang proposed on
9 her own initiative.

10 Q Okay, now you referenced this
11 alternative means and decision, and you went into
12 a little bit on direct, but let's just for clarity
13 go to page 95 and 96 of the majority opinion.

14 A Okay.

15 Q And, the issue that is discussed on page
16 95 and 96 relates to a regulatory provision
17 37CFR42.104B, correct?

18 A Yes.

19 Q And, the panel majority's view was that
20 it was inappropriate for petitioner to base their
21 unpatentability arguments on the patent owners
22 construction in a district court case, right?

1 A That's the way I interpreted the
2 majority opinion.

3 Q They felt, the panel majority felt, that
4 the petitioner needed to advance it's own
5 sincerely held view of the construction and use
6 that as the basis of patentability, right?

7 A I don't recall the using the phrase
8 sincerely held, I do recall something to the
9 effect that what petitioner considered to be
10 "correct construction" so, to the extent that is
11 sincerely held, is in the decision I don't recall
12 that type of phraseology.

13 Q Understood. But, you would agree that
14 the dispute between the majority and yourself was
15 over which claim construction could be used as the
16 basis on arguing on patentability.

17 A Yes, that was the dispute. That was the
18 difference of opinion between myself, and the
19 majority option.

20 Q And, judge Yang and Judge Fitzpatrick
21 believe that this regulation precluded the
22 approach that petitioner was taking, therefore,

1 requiring deniable institution and you disagreed
2 with that, right?

3 A I don't want to speak for what Judge
4 Yang and Judge Fitzpatrick believe, I can see that
5 that is what is in the majority opinion, but you
6 know, it the majority opinion is what it says.

7 Q Understood, so let's look at now page
8 98-99 of tab 6. This is another copy of the
9 dissent you issued with the April 18, 2018 opinion
10 in Hologic Vienzo (phonetic), right?

11 A Yes.

12 Q And, this is memorializing your view
13 that you disagreed on this question of whether
14 37CFR52.104B barred the petition, right?

15 A Yes.

16 Q And, you wrote this decision over the
17 course of a weekend after you made the judgement
18 that you were not going to agree with the
19 majority's approach, right?

20 A Yes.

21 Q Now, you testified on direct that not
22 all IPR institution decisions necessarily reach

1 these merits, right?

2 A Yes.

3 Q That IPR's can be denied on various
4 procedural grounds, right?

5 A Yes.

6 Q And, one of the basis you testified on
7 direct was a petition can be denied based on
8 failure to name real parties and interest,
9 correct?

10 A Yes.

11 Q And, that was again the approach that
12 Judge Fitzpatrick initially floated, but the panel
13 didn't agree with, right?

14 A That's correct.

15 Q And, another basis for denying a
16 petition on purely procedural grounds would be
17 under the one-year bar provision of 35 USC315B,
18 correct?

19 A You know when you say purely procedural,
20 I think that's a good way to characterize, but
21 yes, I would consider a time bar issue to be more
22 of a procedural denial rather than on the merits.

1 Q Right, and so a denial based on
2 35USC315B would not engage the patentability
3 merits, or to say that that petition is too late,
4 correct?

5 A Yes.

6 Q And, there are other reasons why
7 petitions can be denied without reaching the
8 patentability merits, correct?

9 A Correct.

10 Q And, what are some of those other
11 reasons?

12 A So, again, there are some considerations
13 to the merits in these types of denials, but we
14 often consider under our 325D juris prudence,
15 whether or not the arguments were previously
16 presented to the office -- same arguments in
17 evidence. So, we have a presidential board
18 decision of Advanced Bionics (phonetic) that takes
19 into consideration certain factors and other
20 presidential board decisions is Becton Dickinson,
21 that also gives some factors to that analysis.
22 So, to the extent that we deny an institution on

1 the basis of 325D, I would characterize that, as a
2 procedural denial, although to be fair, there is
3 consideration of the merits in that analysis.

4 Q Understood, now you said you said you
5 joined the PTAB in 2014, is that right?

6 A Yes.

7 Q Okay, so would it be fair to say since
8 the time you joined the PTAB in 2014, that there
9 has been additional procedural basis, that have
10 kind of developed in the law, to deny petitions
11 apart from the merits?

12 A Yes, that's a fair characterization.

13 Q And, so it wouldn't be unreasonable then
14 for a member of a panel to suggest a potentially
15 new basis to deny a petition based on a procedural
16 argument, right?

17 A You said it wouldn't be unusual?

18 Q It would be unreasonable?

19 A Unreasonable -- I -- again I'm not sure
20 I would characterize as reasonable or unreasonable
21 -- I think it would -- it's happened. It doesn't
22 happen often, certainly it depends on what the

1 proposal is.

2 Q Okay, but you don't have anything
3 against APJs raising procedural arguments as the
4 potential basis for denying a petition apart from
5 the merits, right?

6 A No, I don't have anything, per say,
7 against that. I think those types of proposals
8 need further deliberation, especially if it's
9 proposals that hadn't been previously considered,
10 or it's an interpretation of our rules and that
11 happened -- fully deliberated previously.

12 Q Understood. Now going back to your
13 dissent. Your dissent again, it espoused the view
14 that your interpretation of 37CFR42.104B was the
15 correct one, right?

16 A I wrote a dissent espousing my view that
17 I did not agree with how the majority interpreted
18 that rule, and I laid out what I thought was
19 appropriate interpretation of our rules.

20 Q And, as an APJ, you had a right to file
21 a dissent based on your understanding of the law,
22 correct?

1 A Yes, I would say as an APJ, I was within
2 the scope of my job responsibilities to express a
3 dissenting opinion or a concurring option.

4 JUDGE NIEDRICK: While we're asking, can
5 you just hold on one second? I think we lost the
6 backup. Ms. Dawson, it looks like the one of the
7 lines dropped off. Okay, do you need to call back
8 in? Okay, we can just hold on one sec. Okay,
9 there it is. Okay, I'm going to admit the --
10 okay, you should be good to go. I'm sorry.
11 Please continue, Mr. Suarez.

12 MR. SUAREZ: Yes. So, why did you
13 believe it was important to file this dissent in
14 Hologic case?

15 THE WITNESS: I believe it was important
16 enough that I, in good conscience, could not sign
17 on to the majority's opinion, you know, and the
18 majority opinions' interpretation of our rules.
19 So, I expressed my dissenting opinion, dissenting
20 view.

21 Q Why is it important for the public to
22 have knowledge of your dissenting view?

1 A I don't have necessarily an opinion on
2 why it was important for the public. Certainly,
3 you know, it -- for me, the dissenting opinion was
4 a way to express my view, whether it was to other
5 members of the board, to the majority, to the
6 parties, or to the general members of our
7 stakeholder community. I thought it was a good
8 approach to express my view of how I would
9 interpret the rules.

10 Q Do you think it would be appropriate for
11 a Vice Chief judge to tell you that you cannot
12 send out this dissenting opinion?

13 A I personally would think that that would
14 be problematic.

15 Q Why would that be problematic?

16 A It depends on the dissenting opinion. I
17 think there's some, you know, so, you know, even
18 within the confines of our leeway to write a
19 dissenting opinion, I think there's certain things
20 that we should keep in mind. At least, in my
21 view. I think we should try to strive to maintain
22 a professional tone -- demeanor. Certainly, I

1 would never write a dissenting opinion where I
2 take an approach where I would consider to be
3 unprofessional. So, I even when I disagree on
4 policy issues or legal issues, I try to maintain a
5 professional tone. So, that's one example where
6 if a dissenting opinion or concurring opinion
7 crosses a line in terms of professionalism, that
8 maybe where senior -- core leadership may
9 intervene.

10 Q But your opinion is that if concurrence
11 or dissent is written in a professional,
12 respectful manner, that that concurrence or
13 dissent should issue?

14 A Generally.

15 Q Okay, now, with this dissent here, you
16 hope to persuade Judge Fitzpatrick and the other
17 judge in the panel, Judge Yang, that your view of
18 the law was correct, right?

19 A In part, yes.

20 Q And that's partially why you wrote
21 footnote that Mr. Horrigan pointed you to on
22 direct, right?

1 A Yes.

2 Q You're hoping that with more time, you
3 know, to consider it maybe Judge Yang or
4 Fitzpatrick would change their views on redirect,
5 right?

6 A Yeah, I thought with more time, maybe a
7 fuller record the parties -- or the in this case a
8 losing party -- had filed a request for rehearing,
9 we could have had more time to deliberate as a
10 panel rather than just less than the one week that
11 we had to fully consider the issue as a panel.

12 Q And the litigants in this case,
13 ultimately, they accepted your invitation to
14 pursue rehearing, correct?

15 A That's correct.

16 Q And so, in your view, ultimately lost
17 again on rehearing, right?

18 A I think that's a fact. It's not my
19 view. I think the request for rehearing was, I
20 believe, denied. So, the decision denying
21 institution stood at the end of the day.

22 Q Okay, so let's talk about that. So, I'm

1 going to point you to tab thirty-three and page
2 four two four. Let me know when you're there.

3 A Sorry, you said tab thirty-three page
4 four two four?

5 Q Yes.

6 A All right, just loading up. Yes, I'm
7 sorry. My son is practicing piano. If you don't
8 mind, let me just tell him to pause real quick.
9 Yes. Yes, I apologize for that.

10 Q It sounds pretty good.

11 A Thank you. All right.

12 Q Okay, so just to reorient you just Judge
13 Paulraj, we're at page four two four of tab
14 thirty-three. Are you there?

15 A Yes, I'm there.

16 Q Okay. And so, this is another decision
17 in Hologic versus Enzo Life Sciences, right?

18 A Yes.

19 Q And this one is dated November 28, 2018,
20 right?

21 A That's right.

22 Q And this is a decision denying the

1 request for rehearing. Is that right?

2 A That's right.

3 Q Okay. So, this has not been admitted.

4 So, just for this ministerial point, if you go
5 from page 424, all the way through 435, that is
6 the opinion denying the request for rehearing,
7 inclusive of a dissent that you wrote in denial of
8 rehearing decision, right?

9 A That's right.

10 Q Okay. So, I'd like to move that this
11 exhibit, which is labeled exhibit O, tab
12 thirty-three, page 424 to 435 be admitted to
13 evidence.

14 JUDGE NIEDRICK: Any objections, Mr.
15 Horrigan?

16 MR. HARRIGAN: No.

17 JUDGE NIEDRICK: Okay, that's admitted
18 without objection.

19 MR. SUAREZ: Okay, so now, I'm going
20 back to the dates now this decision issued
21 November 28th, 2018. So, that was approximately
22 seven months after the initial decision denying

1 institution, correct?

2 THE WITNESS: That's correct.

3 Q And this decision came out after May 30
4 of 2018, right?

5 A Yes, November 28th is after May 30th,
6 yes.

7 Q And you're aware that Judge Fitzpatrick
8 was removed from NAA panels as of May 30, 2018.

9 A I don't have the exact date in front of
10 me, but I recall that was around the time period,
11 yes.

12 Q And Judge Fitzpatrick was replaced by
13 Judge Kaiser, right?

14 A That appears to be the case.

15 Q And Judge Kaiser is the one who wrote
16 the decision on rehearing, correct?

17 A Yes.

18 Q And Judge Yang is still on the panel,
19 right?

20 A Yes.

21 Q And Judge Kaiser and Judge Yang comprise
22 the majority in this opinion, right?

1 A Yes.

2 Q Okay. And this opinion on we're
3 hearing, it maintained denial of the petition,
4 based on the failure to meet the requirements of
5 37 CFR 42.104B, correct?

6 A That appears to be the case.

7 Q And so, I assume, in the time between
8 the issuance of the original decision and the
9 intervening seven months, you tried to persuade
10 Judge Yang and then eventually Judge Kaiser, of
11 your view, correct?

12 A Yes, we had further deliberations in the
13 intervening time period. Yes.

14 Q And despite those deliberations, a new
15 judge came in and agreed with Judge Fitzpatrick,
16 right?

17 A Yes.

18 Q And Judge Yang --

19 A If I could qualify that statement, you
20 know, I don't know -- the ultimate outcome, it
21 appears that Judge Kaiser agreed with Judge
22 Fitzpatrick. I don't know if I can say that Judge

1 Kaiser agreed with every reasoning in Judge
2 Fitzpatrick's original decision.

3 Q Understood, but Judge Kaiser could have
4 decided to join your initial view and ask the, you
5 know, and decide to consider the merits of the
6 patentability issues in assessing rehearing,
7 right?

8 A He could, yes.

9 Q But that didn't happen.

10 A That didn't happen.

11 Q And Judge Yang, in the intervening seven
12 months, never flipped her vote either, right?

13 A No.

14 Q Now let's look at your dissent. Your
15 dissent is on page 434.

16 MR. HARRIGAN: I'm going to object.
17 Both on relevance and the fact that we're outside
18 the scope of the direct. The merits of this case
19 are not the issue here. It's the chain of events
20 that happened earlier in the year. This has
21 nothing to do with that.

22 MR. SUAREZ: Your Honor, I can respond.

1 The whole basis was the alleged timeliness of
2 this, and Mr. -- Judge Paulraj needed more time.
3 This establishes that over seven months, he barely
4 changed his opinion, didn't need more time to
5 write. So, it's very relevant to this pretextual
6 basis for saying he was, you know, committing
7 malfeasance as a judge.

8 JUDGE NIEDRICK: The objection
9 sustained, so please move on. I don't think it's
10 relevant.

11 Q Now, going back to the issue of timing
12 of the original decision that came out in April
13 18, 2018, you did agree on direct that Judge
14 Fitzpatrick gave you his draft decision in advance
15 of the deadline, right?

16 A I did agree that he gave a draft pending
17 in advance to the deadline. Yes.

18 Q And you were able to lodge your
19 disagreement in that initial dissent, right?

20 A In a limited capacity, yes.

21 JUDGE NIEDRICK: I want to just make
22 sure. So, when you're saying in advance of the

1 deadline, you're talking about the statutory
2 deadline, not the twelfth day?

3 THE WITNESS: That's correct.

4 JUDGE NIEDRICK: Okay. Thank you.

5 MR. SUAREZ: And going back to that
6 April 11th timeframe that you were asked about and
7 direct, you said you received Judge Fitzpatrick's
8 opinion. And then you read it, right?

9 THE WITNESS: I did.

10 Q Okay. And then, you said that you were
11 sort of reconsidering whether you're going to
12 agree with this approach after you after you read
13 it. You said something like you're going to see
14 how it writes or something, right?

15 A Yeah, that's typically my approach.
16 Oftentimes, we agree upon during a conference, a
17 general approach, but the analysis, and the
18 reasoning really doesn't come together. At least,
19 I won't. I often don't fully see the full nature
20 of the analysis until I see in writing. And
21 that's what I was waiting for.

22 Q Understood. Okay. And so, now after

1 you receive the opinion, you left -- the draft
2 opinion -- you left Judge Fitzpatrick a voicemail,
3 right?

4 A That's correct.

5 Q Okay, so let's go to tab 676. This is a
6 this is a message from you to Judge Fitzpatrick
7 indicating a voice message, correct?

8 A I'm sorry, could you say the tab and
9 page number again?

10 Q Yeah, tab six, page seventy-six.

11 A Yes, I see the email. That included a
12 voice message attachment. Yes.

13 Q Okay. And the voice message attachment
14 is dated April 13, 2018, at 2:04 p.m., correct?

15 A That looks like it, yes.

16 Q For the record, that voicemail is
17 embedded in this record exhibit, and I'm going to
18 go ahead and play it. Okay, do you recognize that
19 as your voicemail?

20 A I could not hear anything from it.

21 JUDGE NIEDRICK: Nothing played on our
22 end.

1 MR. SUAREZ: Oh, that says something.
2 Okay. I'll try to turn the volume up a little
3 bit.

4 JUDGE NIEDRICK: We're not hearing
5 anything at all right now. I don't know if it's
6 playing or not.

7 MR. SUAREZ: You're not hearing me talk
8 even?

9 JUDGE NIEDRICK: Yeah, we can hear you
10 talk. We just don't hear anything else.

11 MR. SUAREZ: I'll try to press play
12 again. It was coming out of my speaker, so that's
13 very odd. And I could hear it in my office. So,
14 I don't know why that wasn't picking up. Let me
15 play it again.

16 JUDGE NIEDRICK: Still not getting
17 anything?

18 MR. SUAREZ: Hey Robert, could you maybe
19 play it? It might be a technical issue on my end.

20 MR. KAPPERS: What is the tab number?

21 MR. SUAREZ: It's tab six, page
22 seventy-six.

1 VOICEMAIL: Hey, Michael, it's Chris
2 Paulraj. I'm looking at your decision and I'm
3 having second thoughts, frankly, about the
4 approach we've taken. I'm going to send an email.
5 It's actually kind of a decision for ARC. But I'm
6 going to take a look at it again over the weekend
7 and see whether we need to take a different
8 approach or whether we need to do something in
9 terms of a dissent or something. So, let me think
10 about it a little more. But I'm going to send an
11 email and briefly kind of explain my thought
12 process here. But I do need logoff for the rest
13 of the afternoon. And I may not be able to log
14 back on until Sunday evening. So, hopefully we
15 can kind of come to a resolution early next week,
16 given the deadline by next Wednesday.

17 MR. SUAREZ: Thanks, Robert. Judge
18 Paulraj, do you recognize that as the voicemail
19 you left on April 13th?

20 THE WITNESS: Yes, I do.

21 MR. SUAREZ: So, you mentioned in that
22 voicemail that you were having second thoughts

1 about the approach, quote, we've taken in the
2 draft opinion, right?

3 A Yes, that's the words I used. Yes.

4 Q So, you didn't say in the voicemail it
5 was just Judge Fitzpatrick, right?

6 A Yeah, at that point, I considered the
7 decision to still be when I say we, I used the
8 word we to be a panel decision, as I had not
9 launched a separate dissenting opinion at that
10 point.

11 Q You noted in the voicemail that you were
12 considering a dissent and that you were thinking
13 about it a little more, right?

14 A That's correct.

15 Q And you didn't say anything in your
16 voicemail about the timing on which Judge Bill
17 Fitzpatrick circulated his draft opinion, right?

18 A I think I alluded to it by the fact that
19 we did have a deadline coming up. And I needed to
20 -- we needed to sign off on our given -- upcoming
21 deadline. So, I didn't know that I was cognizant
22 of the time for sure.

1 Q You didn't say anything in the voicemail
2 about being frustrated that Judge Fitzpatrick sent
3 the opinion too late or anything like that, right?

4 A No, I did not express any frustration to
5 that effect.

6 Q You didn't like admonished him or
7 criticize him for that, right?

8 A Nor would it have been my place my place
9 to do so. I didn't.

10 Q And in fact, as we sit here today,
11 you've never directly expressed any concerns with
12 Judge Fitzpatrick over the timing of the draft he
13 circulated in this case, right?

14 A That's correct.

15 Q And you didn't raise any concerns with
16 PTAB (phonetic) Management over the timing of
17 Judge Fitzpatrick's decision for circulation of
18 his draft before the decision was released on
19 April 18, 2018, right?

20 A That's correct.

21 Q In fact, you never raised the concern
22 about timing to PTAB Management on your own

1 initiative, right?

2 A That's correct.

3 Q And you've never sent an email or made a
4 phone call to management of your own initiative,
5 expressing concerns about the timing of Judge
6 Fitzpatrick's draft, right?

7 A That's correct to the best of my
8 recollection.

9 Q So ultimately, this decision or this
10 issue about the timing of Judge Fitzpatrick's
11 draft -- you provided that the PTAB Management
12 because PTAB Management asked you about that,
13 right?

14 A I sent PTAB Management -- I recall
15 specifically how my conversation with former BCJ
16 at the time, BCJ Fink -- Tim Fink -- who had
17 inquired about the dissent I wrote and the
18 footnote. And I expressed some concern at that
19 point.

20 Q Okay, so, when did Judge Fink reach out
21 to you about the Hologic case?

22 A I recall it was around the September

1 time period. Later that year. September 2018, or
2 so.

3 Q Did you -- and so, what did Judge Fink
4 ask you to solicit that information?

5 A I certainly recall the conversation
6 because I thought it was unusual at the time. But
7 he essentially asked me about the circumstances
8 surrounding the dissent. And the timing, at which
9 point I did express my concern that I thought the
10 decision was circulated among too close to the
11 deadline, especially given the unusual issue that
12 was presented. And my view was that the panel
13 needed more deliberation -- more time for
14 deliberation in order to really kind of address
15 this issue of first impression. At least what I
16 thought was an issue of first impression.

17 Q Now, you used unusual, it sounded like a
18 couple of different ways in your answers. I just
19 want to make sure I understand. You said it was
20 unusual that Judge Fink was asking you about this,
21 right?

22 A Yeah, I've never had a conversation with

1 the BCJ on a particular case in that manner prior
2 to that.

3 Q Okay so, what about Judge Fink reaching
4 out to you about this made an unusual interview?

5 A I mean, I was a lead Judge at the time.
6 So, I certainly knew that there were certainly
7 some personnel issues surrounding Judge
8 Fitzpatrick that were happening. I didn't know
9 all the details because I was not in the direct
10 chain of command. But I put two and two together
11 that Judge Fink, at the time, was asking about
12 this in relation to any personnel issues that
13 maybe had happened already or were about to be
14 taken into effect.

15 Q Got it. But prior to September 2018,
16 you never raised concerns with PTAB Management,
17 including Judge Fink about this Hologic decision,
18 right?

19 A I don't recall raising any formal
20 concerns with PTAB Management, no. I don't recall
21 doing that.

22 Q Now, you just stated that you were aware

1 of Judge Fitzpatrick's personnel issues. When did
2 you become aware of those issues?

3 A Sometime prior to that time period, and
4 so, between, I would say April when this decision
5 went out, and September 2018.

6 Q Okay, do you recall how you became
7 aware?

8 A Just generally, I don't think it was
9 through any formal communication. Probably just
10 discussions with other lead Judges or maybe as a
11 lesson in -- maybe through the rumor mill, but
12 that said, I had heard or concerns. There were
13 certain things, including Judge Fitzpatrick being
14 taken off AIA cases that were happening around
15 that time.

16 Q Okay. Did you ever talk about this
17 Hologic case with Vice Chief Judge Weidenfeller?

18 A Not to my recollection.

19 Q So, it'd be fair to say that the manner
20 in which you discussed this issue with Judge Fink,
21 this wouldn't have been the normal protocol for
22 you to report concerns about your APJ Colleagues.

1 A Yeah, certainly was not the normal
2 practice I would take. No.

3 Q Have you ever, on your own initiative,
4 expressed concerns about your APJ Colleagues?

5 A Yes.

6 Q Okay. In what context have you done
7 that?

8 A Well, we do have opportunities to
9 provide feedback as part of our peer review
10 process, our other end of the year review
11 performance processes, to give feedback about our
12 colleagues. So, that's one way I've given both
13 positive and negative feedback about my
14 colleagues. That said, you know, under
15 exceptional circumstances, I may call -- although
16 I would say I can't recall any specific situation
17 where this has happened -- the APJ's Lead Judge
18 and say, you know, this happened, and under the
19 circumstances, you just may want to keep an eye on
20 that if that's a repeated issue.

21 Q Got it. So, the type of feedback you're
22 talking about or raising concerns, those are the

1 types of concerns that would go into the formal
2 PAP process, right?

3 A Yes, correct.

4 Q And so to the extent there that you've
5 raised criticisms, you would agree that those
6 criticisms need to go into the formal PAP
7 evaluation?

8 A I don't know have a full opinion on
9 whether or not -- when you say formal PAP process,
10 there is the end of the year process. There is
11 also a mid-year review process. But there's also
12 -- as a Lead Judge, I know this -- there's also
13 continued performance evaluations. As a Lead
14 Judge, my job was to make sure that judges
15 continue to perform not just at the point of the
16 mid-year review or at the end of the year review
17 process, but throughout the year.

18 Q Now, you mentioned the formal annual
19 reviews, and then the mid-year reviews. Have you
20 ever delivered a performance improvement plan to
21 an APJ as Lead Judge?

22 MR. HARRIGAN: Objection. We are

1 getting way outside the scope, and we are getting
2 in irrelevant territory.

3 JUDGE NIEDRICK: Yeah, I think I have
4 enough here, Mr. Suarez. So, you need to move on.

5 MR. SUAREZ: I only have a couple more
6 questions. So, we'll wrap it up. Now, is the
7 punishment that Judge Fitzpatrick received --
8 being removed from AIA trials -- is that common at
9 the PTAB from your experience?

10 THE WITNESS: So, when you say
11 punishment, I don't have a comment on whether or
12 not being removed from AIA trials is punishment.
13 But in terms of whether that is common, my
14 understanding is it isn't common. It's only
15 happened, to my knowledge, maybe two times if
16 that.

17 Q Is that two inclusive of Judge
18 Fitzpatrick?

19 A Yes.

20 Q Okay, so, what was the other time you're
21 aware of where someone was removed from AIA
22 trials?

1 A There was one other judge that I am
2 aware of that was removed from AIA trials. At
3 least for a period of time.

4 Q Do you know what the basis was in that
5 situation?

6 A I'd be speculating. I don't know the
7 exact basis.

8 Q Okay, I have nothing further.

9 JUDGE NIEDRICK: Okay. Mr. Horrigan,
10 any follow up?

11 MR. HARRIGAN: No, thanks.

12 JUDGE NIEDRICK: Okay. Thank you very
13 much, Judge Paulraj. I really appreciate your
14 testimony today. Please don't discuss it with
15 anyone. If you have any questions, please contact
16 Mr. Horrigan. Okay?

17 THE WITNESS: All right. Thank you
18 Judge.

19 JUDGE NIEDRICK: And Judge Paulraj, f
20 you just look at the bottom there, there's a leave
21 button. If you hit that, it will take you out.

22 THE WITNESS: Excellent. All right,

1 thank you.

2 JUDGE NIEDRICK: Thank you. Okay. And
3 it looks like we have Judge Tierney in the waiting
4 room right now. So, do you all want to take a
5 short break before we come back to Judge Tierney?

6 MR. HERRIGAN: Just one point, the way
7 things are going, I don't know how that you want
8 to go tonight, but I need to give Judge Gongola
9 some guidance.

10 JUDGE NIEDRICK: Okay. I mean, I prefer
11 to try and finish tonight. Based on the estimates
12 that you all gave the last time, it seems as
13 though Judge Tierney shouldn't be more than I
14 would think an hour, two hours max. And then it
15 sounds like Judge Gongola is going to be very
16 short, I would assume. Again, the scope that I've
17 approved her for is just very limited. So, I
18 guess I'd ask Mr. Kappers, Mr. Suarez, is Judge
19 Fitzpatrick -- are you planning on having him
20 testify at the end?

21 MR. KAPPERS: Yes.

22 JUDGE NIEDRICK: Okay. Any idea how

1 long that would take based on what you know now?

2 MR. KAPPERS: An hour or so.

3 JUDGE NIEDRICK: I'd like to try and
4 push through everything instead of moving on to
5 another day. So, let's -- if you could let Judge
6 Gongola know -- unless you want to take her first,
7 Mr. Horrigan. It's up to you, you know, since you
8 might be very short, and have her testify for a
9 few minutes and then go with Judge Tierney. It's
10 up to you.

11 MR. HERRIGAN: Okay, I will let me send
12 them both an email whilst we're on break, and I'll
13 see.

14 JUDGE NIEDRICK: Okay. Is five minutes
15 long enough for everyone? Does anybody need
16 longer?

17 MR. HERRIGAN: I can get emails out in
18 five minutes, but I'm not sure about getting them
19 back in five minutes, so --

20 JUDGE NIEDRICK: Okay. All right.
21 Great. Let's come back in five minutes. And
22 we're going to continue with the agency's case.

1 We're going to hear from rebuttal witness, Janet
2 Gongola. And it looks like Judge Gongola was
3 admitted here. Judge Gongola, can you hear me?
4 This is Administrative Judge Andrew Niedrick. If
5 you look on the bottom left-hand corner, there's a
6 little microphone. If you hover over that, press
7 it. It should clear your mic. If you're trying
8 to talk, we can't hear yet. And there's a video
9 screen there. Oh, there we go. Now we can see.
10 Now right next to the video screen, there should
11 be a little button that looks like a microphone.
12 If you hover over that, hit it. That's going to
13 unmute you. Yeah, we still can't hear you. There
14 should be a -- down at the bottom of your screen,
15 unless yours is configured differently, on the
16 bottom left-hand corner, there should be a
17 microphone. Do you see that? Give me the thumbs
18 up if you see it. Looks like she froze. You may
19 want to email her, Mr. Horrigan. Ask her to log
20 off and then we'll try back. I'm going to go
21 ahead and remove her. Hopefully she'll -- she's
22 back. Judge Gongola, can you hear me? This is

1 Administrative Judge Andrew Niedrick. Can you
2 hear me?

3 THE WITNESS: Good afternoon, Your
4 Honor. Can you -- yes, I hear you. Are you able
5 to hear me?

6 JUDGE NIEDRICK: Yes, we can hear you
7 fine. If you can hover over that video button and
8 get your video back on -- by your microphone,
9 there. Do you see it?

10 THE WITNESS: There we go.

11 JUDGE NIEDRICK: Perfect.

12 THE WITNESS: I think I think I'm
13 connected properly now, both visually and audibly.

14 JUDGE NIEDRICK: Yes, we can hear you
15 and see you. It sounds like there might be a
16 little issue. I don't know if you have a stable
17 Internet there, but we'll find out soon enough.
18 So, can you --

19 THE WITNESS: I'm terribly sorry.

20 JUDGE NIEDRICK: Oh, it's okay. Okay,
21 so, hopefully this isn't going to take long. I
22 appreciate you sort of, joining us on short

1 notice. Do you have any objection -- let me just
2 tell you who's on the screen first. Mr. Abramic,
3 Mr. Suarez, and Mr. Kappers are attorneys for
4 Judge Fitzpatrick. And Mr. Horrigan, I know
5 you're familiar with. He's the attorney for the
6 agency. And then we have Shandra Dawson. She's
7 the court reporter. The other two screens that
8 you see that are dark, are Ms. Dawson's backups.
9 Okay?

10 THE WITNESS: Thank you.

11 JUDGE NIEDRICK: Sure. Do you have any
12 objection to swearing an oath?

13 THE WITNESS: I do not.

14 JUDGE NIEDRICK: Okay, can you please
15 raise your right hand? Do you solemnly swear the
16 testimony you're about to give is the truth, the
17 whole truth, and nothing but the truth so help you
18 God?

19 THE WITNESS: I do.

20 Whereupon,

21 JANET GONGOLA

22 was called as a witness and, having been first

1 duly sworn, was examined and testified as follows:

2 JUDGE NIEDRICK: Great. If you can
3 state and spell your first and last names for the
4 record.

5 THE WITNESS: Janet. J-a-n-e-t.
6 Gongola. G-o-n-g-o-l-a.

7 JUDGE NIEDRICK: Great, thank you. And
8 if there's an objection, while you're testifying,
9 just please hold your answer and I'll rule on the
10 objection, and then instruct you on how to
11 proceed. Okay?

12 THE WITNESS: Yes, thank you.

13 JUDGE NIEDRICK: Okay. Mr. Horrigan,
14 your witness.

15 DIRECT EXAMINATION

16 BY MR. HORRIGAN:

17 Q Thank you. And thank you for joining
18 us. We appreciate it. What is your current
19 position with USPTO?

20 A I'm a Vice Chief Judge for strategy at
21 the Patent Trial and Appeal Board.

22 Q And how long have you been a Vice Chief

1 Judge?

2 A Five and a half years.

3 Q And as a part of -- as a Vice Chief
4 Judge, you're part of a management team. Is that
5 right?

6 A Yes.

7 Q And on occasion, the management team
8 meets with a Director of the USPTO. Is that
9 right?

10 A Yes.

11 Q Okay, now, if I could put you back into
12 2018, do you recall being involved in such
13 meetings with Andre Dionkou (phonetic)?

14 A Yes, however, there were management
15 meetings in 2018 around that time. I did not
16 attend all of those meetings.

17 Q Sure. Do you recall in any of these
18 meetings where Andre Dionkou (phonetic) expressed
19 anything along the lines of a desire for USPTO
20 management to terminate Michael Fitzpatrick?

21 JUDGE NIEDRICK: Looks like we have a
22 connection issue. Okay, looks like she's

1 rejoining. Judge Gongola, can you hear us? Judge
2 Gongola, are you there? Is there any objection --
3 I'm sorry, can you hear us, Judge Gongola? If you
4 can, can you turn your video off? Just hover over
5 and hit stop video. Sometimes that helps us get
6 audio. Can you hear?

7 THE WITNESS: The meeting dropped one
8 moment. Can you hear me? My video dropped.

9 JUDGE NIEDRICK: Yeah, I can hear you.
10 Is there any objection to her testifying? I'm
11 sorry. Hang on one second Judge Gongola, we just
12 have a really bad connection. And I have a
13 feeling that might be your internet stability
14 there. Is there an objection to her testifying
15 just by calling in on the telephone?

16 MR. HERRIGAN: No, I don't need to see
17 the witness if we can get better audio.

18 JUDGE NIEDRICK: Okay. Yeah. So, if
19 you can get the -- does she had the information,
20 Mr. Herrigan, to call in?

21 MR. HERRIGAN: I sent her the last
22 notice that you put out. But there's no phone

1 number there.

2 JUDGE NIEDRICK: Okay. Do you -- I'm
3 sorry. You don't have it handy. Do you have it
4 handy, Ms. Dawson? I know you just called in.
5 Can you just give that information to Mr.
6 Horrigan, and maybe he can email it to Judge
7 Gongola.

8 THE WITNESS: Can you hear me? Are you
9 able to hear me?

10 JUDGE NIEDRICK: Yes, we can hear you
11 now. Can you hear us? This is Judge Niedrick.

12 COURT REPORTER: The one tap mobile?

13 JUDGE NIEDRICK: Yes.

14 COURT REPORTER: Can you hear me, Mr.
15 Horrigan?

16 MR. HARRIGAN: I can, yes.

17 COURT REPORTER: Have her call
18 669-254-5252. Do you have the meeting ID and the
19 passcode?

20 MR. HARRIGAN: Yes.

21 COURT REPORTER: Or she can call
22 646-828-7676 either of those two numbers,

1 depending on her location. And she can tap in the
2 meeting ID and passcode, and we can get her
3 through the audio.

4 MR. HERRIGAN: Okay, let me try that
5 first one first.

6 JUDGE NIEDRICK: I'm going to go ahead
7 and remove her at this point, so she can try and
8 call in. If you can hear us, Judge Gongola, Mr.
9 Herrigan is going to email us some information.
10 If you could use that information to call in just
11 on your phone. And we'll just have your testimony
12 by phone.

13 MR. HERRIGAN: All right, she's calling
14 now.

15 JUDGE NIEDRICK: Okay, great. Thank
16 you, Ms. Dawson.

17 COURT REPORTER: You're welcome.

18 JUDGE NIEDRICK: There she is. Can you
19 hear us, Judge Gongola?

20 THE WITNESS: Good afternoon.

21 JUDGE NIEDRICK: Okay, that's good.

22 Good afternoon. Can you hear me okay? This is

1 Administrative Judge Niedrick.

2 THE WITNESS: Yes. I can hear you fine.

3 Thank you.

4 JUDGE NIEDRICK: Okay, I think I think
5 we're good to go here. So, you're just going to
6 testify by phone, okay? So, I know sometimes it's
7 hard to know who's asking you a question. So,
8 I'll try and identify ourselves before we ask it
9 first. It's going to be Mr. Horrigan for a while,
10 okay?

11 THE WITNESS: Yes, thank you.

12 JUDGE NIEDRICK: Okay. Just please
13 remember that you're still under oath. And he's
14 going to try and pick up where you left off.
15 Okay, Mr. Horrigan.

16 THE WITNESS: Yes, thank you.

17 BY MR. HERRIGAN:

18 Q All right. So, we had been talking
19 about these management team meetings with the
20 Director, correct?

21 A Yes.

22 Q And then, we referred back to the 2018

1 timeframe and talked about Andre Dionkou. Do you
2 call that?

3 A Yes.

4 Q Okay. And so, the question was whether
5 in any of these meetings, which you attended,
6 Andre Dionkou, said anything along the lines of a
7 desire for USPTO management to terminate Michael
8 Fitzpatrick?

9 A No. I was not in a meeting where that
10 statement was made from Andre.

11 Q Okay, now are you aware of Philip
12 Kaufman (phonetic)?

13 A Yes.

14 Q Who do you understand him to be?

15 A Phil Kaufman is an APJ, who works at the
16 Patent Trial and Appeal Board. Phil is in my
17 direct chain of command. He reports to me. I'm
18 his supervisor.

19 Q Did you ever tell Mr. Kaufman that Mr.
20 Dionkou had expressed a desire to terminate Mr.
21 Fitzpatrick?

22 A No. I did not tell.

1 Q All right. What level of confidence do
2 you have that you did not tell Mr. Kaufman that?

3 A I'm one hundred percent confident I was
4 not part of any conversation with the Director
5 about Michael Fitzpatrick. That's that I could
6 have ever have related. That's a pretty serious
7 statement. I would have remembered if something
8 like that transpired, and I relayed it to Mr.
9 Kaufman.

10 Q Thank you, nothing further.

11 JUDGE NIEDRICK: Who wants to do the
12 cross?

13 MR. ABRAMIC: I will, Your Honor.

14 JUDGE NIEDRICK: Okay, thanks. This is
15 John Abramic. He is one of the attorneys for
16 Judge Fitzpatrick, okay?

17 CROSS-EXAMINATION

18 BY MR. ABRAMIC:

19 Q Good afternoon, Judge Gongola. Thank
20 you for being here this afternoon. I will try to
21 be very brief. Can you hear me okay?

22 A Yes, sir.

1 Q You mentioned Judge Phil Kaufman. You
2 know Judge Kaufman. Is that right?

3 A Yes, sir.

4 Q Do you know him to be a person of high
5 integrity?

6 A Yes.

7 Q Do you know him to be an honest person?

8 A Yes.

9 Q Do you know him to be someone who would
10 testify truthfully, if under oath?

11 A Yes, I believe he would.

12 Q Okay. And so, when you were just
13 answering questions for Mr. Horrigan, you stated
14 that you never had a conversation with the
15 Director about Judge Fitzpatrick. Is that
16 correct?

17 A That is correct.

18 Q Okay, so I want to change it a little
19 bit. And it's -- I don't -- I'm not asking you
20 about whether or not you ever had a conversation
21 with the Director. Did you ever inform Judge
22 Kaufman that you had heard anything about anybody

1 having knowledge of terminating Judge Fitzpatrick
2 or punishing Judge Fitzpatrick?

3 A No, I did not. I don't make it a
4 practice to talk about personnel matters involving
5 one employee with another employee, meaning
6 Michael Fitzpatrick with Phil Kaufman. That's not
7 my practice. I don't think that's professional,
8 or appropriate, or acceptable to do. So, I do not
9 do that.

10 Q Okay. And so, the -- if Judge Kaufman
11 were to have testified under oath, that you had a
12 conversation with him about Judge Fitzpatrick and
13 the possibility that he would be terminated or
14 punished, do you believe that Phil Kaufman would
15 be lying?

16 A I don't want to call anyone a liar. I
17 don't like to use those terms to describe people.
18 I suspect maybe Mr. Kaufman is misremembering or
19 maybe confused, something. So, as an honest
20 person -- so, I don't think he would intentionally
21 lie under oath. I think he has the best of
22 intentions. I just don't think maybe he remembers

1 correctly, or he understood correctly.

2 Q I have nothing further, Your Honor.

3 JUDGE NIEDRICK: Okay, Mr. Horrigan, any
4 other questions?

5 MR. HARRIGAN: No, thank you.

6 JUDGE NIEDRICK: Thank you very much,
7 Judge Gongola. I appreciate your hanging out in
8 the hearing for us today. Please don't discuss
9 your testimony with anyone. If you have any
10 questions, please contact Mr. Horrigan, okay?

11 THE WITNESS: Yes, Your Honor. Thank
12 you.

13 JUDGE NIEDRICK: Thank you. You can go
14 ahead and hang up now.

15 THE WITNESS: Goodbye.

16 JUDGE NIEDRICK: Goodbye. Okay. All
17 right, you guys. We're right on cue there. So,
18 hopefully that's going to follow through with
19 Judge Tierney as well. Okay, Mr. Horrigan, you
20 all set for Judge Tierney?

21 MR. HARRIGAN: I am.

22 JUDGE NIEDRICK: I'm going to go ahead

1 and get him. Hi, Judge Tierney. This is
2 Administrative Judge Andrew Niedrick. How are
3 you? Good. Can you please unmute yourself from
4 the left hand? There you go. Okay. Okay, great.
5 We can hear you. Thank you for your patience. I
6 know it's been a long haul waiting, and then
7 getting prepared the last time around and not
8 going. So, I appreciate your efforts there. I
9 want to make sure we're getting your audio. Can
10 you just say something?

11 THE WITNESS: Yeah, can you hear me now?

12 JUDGE NIEDRICK: Yes, that's good.
13 Perfect. Okay. We're going to have your
14 testimony. Mr. Horrigan is going to ask you some
15 questions on direct. And then, we have some cross
16 examination by either John Abramic, Christopher
17 Suarez or Robert Kappers, as you can see them in
18 your video windows. They are attorneys for Judge
19 Fitzpatrick. The other person you see there is
20 Ms. Dawson. It says Shaundra Morale (phonetic).
21 She is our court reporter. And the other two
22 blank squares is her backup for the recording.

1 THE WITNESS: Okay.

2 COURT REPORTER: This is the court
3 reporter. There's a lot of feedback and static.
4 I don't know if anyone else was catching it.

5 JUDGE NIEDRICK: I hear a little bit I
6 don't hear a lot. Now I don't hear anything.

7 COURT REPORTER: It sounds like a
8 vacuum. Or traffic.

9 JUDGE NIEDRICK: I don't hear it. Let
10 me make sure it's not coming from my -- I'm going
11 to mute myself. I don't know if that if it
12 stopped, but I don't have any noise here in my
13 office. Is it still going, Ms. Dawson?

14 COURT REPORTER: No, it stopped for now.
15 It's stopped for now. Okay, let's continue.

16 JUDGE NIEDRICK: All right, let's give
17 it a try. Okay, Judge Tierney, do you have any
18 objection to swearing an oath?

19 THE WITNESS: No, I don't.

20 JUDGE NIEDRICK: Okay, can you please
21 raise your right hand? Do you solemnly swear that
22 the testimony you're about to give is the truth,

1 the whole truth, and nothing but the truth so help
2 you God?

3 THE WITNESS: Yes.

4 JUDGE NIEDRICK: Can you say that again?

5 THE WITNESS: Yes.

6 JUDGE NIEDRICK: Okay. Thank you.

7 THE WITNESS: I think I need to get
8 closer.

9 Whereupon,

10 MICHAEL TIERNEY

11 was called as a witness and, having been first
12 duly sworn, was examined and testified as follows:

13 JUDGE NIEDRICK: Yeah, there you go.

14 That's better. Can you please state and spell
15 your first and last names for the record?

16 THE WITNESS: My first name is Michael.

17 M-i-c-h-a-e-l. My last name is Tierney.

18 T-i-e-r-n-e-y.

19 JUDGE NIEDRICK: Great. Thank you. And
20 if there's an objection while you're testifying,
21 please hold your answer. I'll rule on the
22 objection and instruct you on how to proceed,

1 okay?

2 THE WITNESS: Okay.

3 JUDGE NIEDRICK: Okay. Great. Mr.
4 Horrigan, your witness.

5 DIRECT EXAMINATION

6 BY MR. HERRIGAN:

7 Q Thank you. How long have you been with
8 USPTO?

9 A I've done two stents, so, I'm in my
10 second stent. I think if I added them up
11 together, it's around twenty-six and a half years.

12 Q Okay, and what roles have you held here?

13 A I started off in 1992, as a patent
14 examiner. I then left the agency and went to a
15 law firm, and came back though, in the early
16 2000s. I was Administrative Patent Judge
17 somewhere around -- I'd have to look up the exact
18 date, but I believe it was around 2011. I became
19 the Lead Administrative Patent Judge. And then I
20 became a Vice Chief Administrative Patent Judge in
21 December of 2016.

22 Q Okay, so, let me then ask you to bring

1 up tab seven, page ninety-six.

2 A Tab seven, page ninety-six.

3 Q Do you have an opinion in Fresenius
4 (phonetic) versus Hospira (phonetic)?

5 A Yes.

6 Q Could you recall getting involved with
7 this matter back in the 2017 timeframe?

8 A I don't think I gave an opinion. Oh,
9 wait.

10 Q Let me get take you down to page
11 ninety-nine of that. And do you see that laid out
12 information?

13 A This is the one.

14 Q Okay, why don't you tell us what you see
15 here?

16 A Okay, this is a decision that was a
17 draft decision. It had a paragraph in there that
18 contained confidential information that had not
19 been released to the public. Judge Fitzpatrick
20 was wanting to issue the decision with the
21 confidential information.

22 Q Okay. And how did you become involved

1 in this?

2 A I was asked as part of the Management
3 Team to -- we'd had several conversations in
4 general regarding this matter. And I was the one
5 who ended up getting asked to reach out to Judge
6 Fitzpatrick and ask him to remove the confidential
7 information from the decision.

8 COURT REPORTER: Mr. Tierney, I'll just
9 ask you -- this is the court reporter, Mr.
10 Tierney. I will have to ask you to speak about
11 two octaves louder.

12 THE WITNESS: I will try to raise my
13 voice, as long as I'm not shouting at anybody.

14 COURT REPORTER: No, not at all.

15 BY MR. HARRIGAN:

16 Q Okay, so, looking at this language here,
17 did you review that before you contacted Mr.
18 Fitzpatrick?

19 A Yes, I did.

20 Q And do you agree with the ARC, here,
21 that this is not public information?

22 A Yes.

1 Q Why?

2 A The information was internal as to
3 whether there was a vote to make a decision
4 precedent or not. We had not released the fact
5 that this had been made and how they're voting did
6 come out. And this is something that the agency
7 was contemplating -- do we want to make
8 precedential? Typically, there were various ways
9 we made precedent. And it varied at times with
10 how we would do it. At that point in time, there
11 was a vote. And what you did is you made a vote,
12 you then went to the Director and had a
13 recommendation. The Director could accept the
14 recommendation or not. So, as we see here, there
15 had been a vote. There had been a recommendation,
16 and the Director was still contemplating on
17 whether or not to make not necessarily that
18 decision, but some of the principles of that
19 decision precedential and binding on the board.

20 Q Now, did you agree with ARC, here, that
21 this was in fact confidential information?

22 A Yes.

1 Q And what was the harm be to the USPTO in
2 having this information out in a decision?

3 A The Director speaks with one voice,
4 essentially. He has a policy, and this would
5 contravene the policy that the Director was
6 attempting to issue. So, rather than going out
7 with, you know, the Director having a decision out
8 there that criticizes this policy, based upon
9 internal deliberations, we were not going to go
10 out and have the systems convince you with that
11 information. For example, if you were to have the
12 Director say, I'm thinking about this decision, I
13 could go either way. We don't want a decision on
14 later where somebody says, well, when they made it
15 precedent, even the Director realized that they
16 could go a different way and wasn't sure which way
17 to go. We don't want that internal deliberation
18 made public.

19 Q Why didn't you just simply take it out?

20 A We asked Judge Fitzpatrick -- ARC had
21 asked him, at first, to take it out. It's a
22 typical process for consistency reasons. So, this

1 is an unusual opinion. And usually we don't see
2 confidential information being put into a decision
3 that's to be issued.

4 Q But again, why not just simply take it
5 out rather than a tussle back and forth with Mr.
6 Fitzpatrick?

7 A We work with the judges. It's a
8 collegial atmosphere, and we did not want to order
9 him. We just wanted to reason with him and
10 explain that maybe he didn't recognize it was
11 confidential. And we wanted to impress upon him
12 this is something that is confidential, does sit
13 with the Director's deliberations as to what
14 should be made precedential.

15 Q All right, then let me ask you to turn
16 to page 102. Do you see at the top there, an
17 email from Mr. Fitzpatrick?

18 A Yes.

19 Q Did you become aware of that email?

20 A Yes, I was aware of the email at the
21 time I was contacting him.

22 Q And what is your opinion on with what

1 Mr. Fitzpatrick is saying here?

2 A I believe Mr. Fitzpatrick is saying that
3 he is entitled to determine what should or should
4 not be confidential and what should and should not
5 be agency policy.

6 Q Okay, and what's your own personal view
7 as a Vice Chief Judge about what he's saying?

8 A I disagree with what he's saying. Even
9 if he believes the public's entitled to know it's
10 not his decision. It's the Director's decision as
11 to what the policy should be, and how the agency
12 should go about making something precedential.

13 Q All right, so then let me ask you to
14 turn to tab six, page fifty-six.

15 A Page fifty-six, tab six.

16 Q And we see an email from you, correct?

17 A Yes.

18 Q And dated September 1, 2017?

19 A Correct.

20 Q Why don't you summarize for the
21 Administrative Judge what's going on here?

22 A Okay, a little bit of background. So,

1 we have something called the AIA review. It's
2 typically, colleagues that review decisions,
3 especially for consistency purposes, and they give
4 suggestions. Sometimes when things -- suggestions
5 are -- need to be more than suggestions, for
6 example, somebody's trying to release something
7 confidential -- and that is a rarity -- or
8 someone's violated -- trying to violate policy, we
9 want to have maybe a talk with them as part of
10 their performance plan. Give them a heads up that
11 this is something that is violating what they're
12 supposed to be doing. So here, we've already had
13 the ARC panel reach out. We'd already actually
14 had a prior attempt to discuss the matter with Mr.
15 Fitzpatrick. And so, this was basically in
16 another try where -- this was the one where we had
17 to have a meeting where I had to call, and I had a
18 relay a direct order that if you did not take this
19 confidential information out of the decision,
20 there would be potential sanctioned consequences
21 -- disciplinary matters, that would arise.

22 Q Why were you sending this email to Scott

1 Boalick?

2 A Judge Boalick was my supervisor at the
3 time at ARC. I am still a Vice Chief. And Scott
4 Boalick was the Deputy Chief. So, I was reporting
5 to him and relaying that I had to give
6 information. That yes, this is the authority I've
7 been given. And it also laid out the possible
8 disciplinary issues that could arise should he
9 persist and release this information.

10 Q Okay, and so let me first ask you to
11 address the second black bullet that we see on
12 page fifty-six. What is the message you're trying
13 to get across to Mr. Fitzpatrick?

14 A Basically, again, as I'm trying to
15 convey here, the paragraph in particular,
16 contained confidential information, cannot be
17 disclosed to the public, and that it's contrary to
18 his performance plan to basically be releasing
19 confidential information to the public.

20 Q And why don't you elaborate on that last
21 point for us a little bit? We see that the second
22 dark bullet, the first white bullet, and then the

1 first square thing. So, why don't you elaborate
2 what you mean by that?

3 A Okay. So, we have a lot of things that
4 the board, as most agencies do, that are
5 confidential deliberations -- discussion,
6 basically pre-decisional information all going
7 around brainstorming issues. And especially when
8 it comes to Director trying to set a policy.
9 There may be many different stakeholder views
10 expressed. And the Director may lead toward one
11 view, based on a conversation, may change the view
12 another day. And this is just part of that
13 deliberative process. Now, if we start releasing
14 all the information that goes into the
15 deliberation, just call it non-confidential, then
16 all of a sudden, you're like, okay, you're no
17 longer speaking with clarity and consistency.
18 You're speaking with no one's going to be able to
19 understand this final guidance, because it's going
20 back and forth, back and forth. And it's become
21 as clear as mud. We have all this that's come out
22 from the Director, and from the board.

1 Q And in this bullet we're looking at, you
2 make a reference to the performance appraisal
3 plan. What's the connection?

4 A So, an employee has their duties
5 basically outlined, and how they're going to be
6 rated set forth in a performance appraisal plan --
7 PAP for short. The PAP identifies what the judge
8 is supposed to follow, and how they're going to
9 get rated. For example, we have a production
10 requirement. We also have -- now we have a
11 professionalism requirement that's on that. You
12 can see here as part of the performance plan, it
13 was clear the judge has to recognize the need for
14 confidentiality. That's -- we are the officers of
15 the Executive Branch.

16 Q Okay, and then below that, that next
17 white bullet, explained that point.

18 A So, an individual judge doesn't have the
19 authority to act on behalf of the agency to
20 determine that something that is confidential
21 should be released to the public. They can raise
22 that issue and go through the management chain,

1 but it's not ultimately their decision.

2 Q Okay, and then did you in fact, direct,
3 as we see in the next bullet, direct the appellant
4 to remove that language?

5 A Yes, I did.

6 Q Okay. And then the final bullet, were
7 the consequences. Did you discuss the
8 consequences with Mr. Fitzpatrick about not
9 removing it?

10 A Yes, I related the consequences as you
11 can see in this email.

12 Q Okay, so, the second white bullet, what
13 do you mean by adjusting your case assignments?

14 A By adjusting a case assignment means if
15 he could get back to me, that it was understood.
16 If there was any doubt, he could ask for
17 clarification during this call we had. We would
18 remove him from AIA was one avenue proposed. We
19 could also give it the special projects. For
20 example, we could give him working with the Corps
21 on appeal process to improve how they handled the
22 court. So, by case assignments, we had the

1 option, and we would look into removal from AIA,
2 removal from all cases.

3 Q Now, from your perspective, why was
4 removing him from AIA cases an appropriate
5 response to the concern that you're raising here.

6 A So, this is not the first interaction
7 we've had -- I or others at the management team
8 have had with Michael Fitzpatrick -- Judge
9 Fitzpatrick. Judge Fitzpatrick had -- if you
10 agreed with him, everything would be fine. If you
11 did not agree with him though, he would dig in,
12 and basically, try to hook back at you, or however
13 you want to term it, and be difficult. And over
14 time, that became more and more apparent. For
15 example, we've had several conversations as a
16 management team or ARC, letting the judge know,
17 this is confidential information. It wasn't a
18 surprise. And to get to the point of a direct
19 order just shows you how far things have gone on
20 what we considered this routine matter. Normally,
21 if you tell somebody that it's confidential, it
22 would have been moved on, but here, not with Judge

1 Fitzpatrick. He digs in his heels and disagrees.
2 He will, instead of going through other
3 appropriate paths, he's just like, I'm right.
4 This is what it will be. Do as I say.

5 Q And what's the connection to AIA cases?

6 A AIA cases what we found is that in AIA,
7 Michael has certain views which may or may not be
8 correct. When he's correct and we all agree,
9 there's no problem. But if he disagrees, he
10 again, feels the need to espouse his views, but
11 maybe not follow the guidance that's given the
12 policy directives, as he wants to push the
13 envelope constantly, as to here's what I should be
14 able to do. I'm going to do it. And over time,
15 again, this is just an example here, we had the
16 ARC meeting with him. We had -- I know, there was
17 another call we had where we wanted to discuss the
18 matter, and he declined to discuss it because his
19 third and fourth level supervisors weren't in the
20 meeting. The second, I believe even the first
21 level and a couple second levels were there -- he
22 just would not be easy -- raise it up higher and

1 higher to hear the message. It wasn't that his
2 thoughts hadn't been conveyed to the management
3 team. We arranged that. But at what point do you
4 just basically say, enough is enough? It was AIA,
5 for some reason, he felt that he was right, and he
6 needed to announce it. Whereas in ex parte, I
7 haven't seen that issue come up. I'm not aware of
8 that issue. But I was aware actually of
9 interferences, and in AIA it seemed like somehow
10 because of these interferences were the reason for
11 the escalation that was occurring.

12 Q All right, why don't you describe the
13 tone of this conversation that you had with Mr.
14 Fitzpatrick?

15 A It's difficult. If you're an observer,
16 the tone would be -- I guess you could call it
17 cold, but civil. If you're on the receiving end
18 of it, I was -- I gave him the direct order. And
19 then I got quite a few questions. And question
20 after question after question. I was being,
21 essentially, cross-examined with my direct order.
22 I think there's a subsequent email where he

1 memorialized the conference call that we had. You
2 can see from the tone of the email, it's similar
3 to what we had during the conference call. He was
4 very unhappy. And he was making it very clear
5 that he disagreed, that he did not think it was
6 correct. And that he had numerous questions that
7 he needed answered, so that he could then decide
8 whether or not he needed to comply.

9 Q All right now, this email that you sent
10 to Mr. Boalick is dated September 1, 2017. Is
11 that the same date that you had the conversation
12 with Mr. Fitzpatrick?

13 A That's my recollection. Yes.

14 Q All right. Then let's turn to tab six,
15 page fifty- nine.

16 A All right, I'm on page fifty-nine.

17 Q Okay, and so this is the following
18 Tuesday, correct?

19 A Yes.

20 Q And who are the people that are being
21 copied on this email?

22 A That would appear -- I think he has his

1 panelist. I think he has -- he has some members
2 of his first level league. He has members of ARC,
3 the AIA Review Committee. He also has myself,
4 another Vice Chief at the time, who is now Deputy
5 Chief. He had the Deputy Chief Scott Boalick.
6 And the email was sent to the Chief Judge at the
7 time, David Ruschke.

8 Q And what did you understand of the point
9 that Mr. Fitzpatrick was trying to make this
10 email?

11 A That he was very unhappy and he
12 disagreed with what he'd been told. And he -- I
13 have to scroll through the exact -- I think if we
14 can move it -- I think he says what we're doing is
15 unlawful, somewhere if I recall correctly. He
16 wanted the FOIA officer to come down and talk to
17 him. I think he needed his third and fourth level
18 supervisor, if not more, to actually convey the
19 message instead of having the second level give
20 the to direct order. He needs it from a higher
21 authority than the second level supervisor in
22 combination with his first.

1 Q Alright and let me ask you to scroll
2 down to page sixty. And towards the bottom, and
3 there's an although I'm complying. Do you see
4 that?

5 A Yes.

6 Q And what did you make of that?

7 A I make of it that he genuinely disagrees
8 and doesn't want to comply, but he's only doing it
9 under I guess, in his mind -- I would use the
10 word, he feels coerced. But that's -- I'll let
11 him speak with his own words.

12 Q Okay, and then continuing down into page
13 sixty-two. In the middle of the page, we see us a
14 paragraph that begins on August 14th. Do you
15 recall that?

16 A Yes, that's it.

17 Q And did in fact, a meeting take place on
18 August 14th?

19 A Yes.

20 Q And what -- Mr. Fitzpatrick says he
21 declined to discuss it. What does that mean?

22 A As it says in the paragraph, and my

1 recollection, is near the end of the meeting, I
2 wanted to discuss the matter. The matter being
3 removal of the paragraph that will contain a
4 confidential information. As he points out in his
5 own email, he declined to discuss it, because his
6 third and fourth levels supervisors were not
7 present at the meeting.

8 Q And as a PTAB Manager, what was your
9 take on this statement?

10 A I was somewhat shocked that we had to
11 bring in a third and fourth supervisor to relay
12 the information before it's actually accepted.

13 Q What was your understanding of the scope
14 of your authority when you were conveying this
15 information to Mr. Fitzpatrick?

16 A I am -- was at the time -- a member of
17 the Senior Executive Service. I'm a member of the
18 PTAB Executive Team. And I'd been asked to relate
19 the Executive Team's views, which I did. Finally,
20 I tried to do it at this meeting, but he was not
21 willing to discuss it with me.

22 Q Okay, and then if I could ask you to go

1 down to page sixty-three. And let's look at the
2 first two sentences. So, I think you touched on
3 this, but Mr. Fitzpatrick was doing what here?

4 A Yeah, it's -- I mean, if you take it
5 literally, he basically wants the President to
6 come down and sit with him and have a chat with
7 him. I would be a little more kind in my
8 interpretation. I believe he wants at least the
9 third and fourth level supervisors. I'm not sure
10 if he wants the Director here to come down and
11 actually have a chat with him.

12 Q Right. And, and then the first full
13 paragraph on this page sixty-three -- what do you
14 understand that to be?

15 A That I need to provide -- or that the
16 Board, Executive Team, or the Director, or even
17 the President has to provide a memorandum in
18 writing regarding the confidentiality issues or
19 the FOIA issues. It actually was pointed out by
20 ARC though. It was a comment. So, I don't know
21 if he actually had that information. It was -- I
22 didn't understand why he needed anything more. Or

1 what clarity he was seeking. We could have had a
2 calm discussion. I guess he just feels like he
3 doesn't have to follow the direct order unless
4 it's in writing, and from his third or fourth, or
5 higher-level supervisor.

6 Q Okay, so this event -- this event that
7 you got involved in, what did you make of Mr.
8 Fitzpatrick's involvement?

9 A I found him very difficult to work with.
10 Again, if you agree with him, things are fine.
11 But when you disagree with him, and he doesn't
12 want to comply, I find him difficult to work with.
13 And you go round and round and round. And I think
14 this is an example of it -- of what occurs when
15 you disagree.

16 Q Okay, would you agree that you have more
17 experience with personnel matters than the typical
18 Vice Chief Judge?

19 A Yes.

20 Q Why is that?

21 A Various reasons, one of which I have
22 been in the agency a little bit longer than the

1 other Vice Chiefs. I have been a -- I have been a
2 member of the Management Team as a whole by being
3 a Lead Judge for over a decade. I also tend to be
4 -- I think I'm the second longest Vice Chief of
5 the Board. I also manage, in my division -- the
6 division I'm associated with -- division three for
7 the Board. I also have a section, which is
8 directed to patent attorneys who are members of
9 COPA and union members. And we have a number of
10 issues, employee issues that arise there. So, I
11 frequently have dealt with employee issues over
12 the years.

13 Q Prior to involvement in the matter, we
14 just discussed, were APJ's taken off AIA cases?

15 A There were some quality issues, but
16 beyond quality, I'm trying to remember if there's
17 anyone who had a conduct issue. I don't remember
18 anyone with a conduct issue that would have had
19 this situation. Again, I don't want to be --
20 there were a couple of quality issues where we did
21 recommend to put some judges off, but as to
22 conduct, I don't recall anyone who was taken off.

1 Q Okay, since 2017, when this took place,
2 are you aware of any other APJ who was removed
3 from AIA cases?

4 A There's one judge -- I didn't get
5 specifics. I'd rather not to go into names if you
6 need names, but I defer to you and the judge.
7 There is an individual who we felt -- I would call
8 it a quality issue. They'd been asked to be put
9 on. They were temporarily given an opportunity to
10 do AIA. They did not interact well with the two
11 panel members we had. There are a lot of quality
12 issues. That judge felt that they were doing just
13 fine. We thought it was a quality issue and no
14 longer put them on. There was one other judge,
15 though, that had a decision where they were told,
16 basically, you need to have the following
17 decision. If you're going to go out and criticize
18 into sub policy, we can no longer put you on the
19 AIA. We actually gave a choice to the judge. If
20 you're willing to follow a sub policy and not
21 criticize it, you can stay on AIA cases. If
22 you're going to be on AIA cases and start

1 criticizing the Director's policies, then we're
2 not going to be paneled with you. That judge
3 decided to not be on AIA cases at that time.

4 Q Did you personally have any involvement
5 in Mr. Fitzpatrick being taken off AIA cases in
6 2018?

7 A I was not the deciding official. I
8 would have met with Tim Fink and conferred with
9 him because this was, I believe, an issue that you
10 had asked me about, as he was looking at the
11 second -- what to do with at a later thing that
12 occurred with Mr. Fitzpatrick.

13 Q But as to the decision itself in May of
14 2018, did you have any involvement in that?

15 A No, I was not the deciding official.
16 So, beyond being consulted as to when it occurred
17 and situations like this, it wasn't my decision.
18 It was, I believe, Judge Fink's.

19 Q Great, thank you. No further questions.

20 JUDGE NIEDRICK: Thank you, Judge
21 Tierney. Who's going to do the cross? Mr.
22 Abramic?

1 MR. ABRAMIC: Yes, sir.

2 JUDGE NIEDRICK: Okay, great. You can
3 go ahead.

4 CROSS-EXAMINATION

5 BY MR. ABRAMIC:

6 Q Good afternoon, Judge Tierney. I'm
7 going to try to be brief. Thank you for being
8 here. Can you go to tab six, page fifty-six? It
9 was one of the documents that you were talking
10 about.

11 A On page fifty-six now.

12 Q Okay. And is it correct that this
13 incident with the presenting of IPR occurred in
14 September of 2017?

15 A I'm not sure I follow the question.
16 What do you mean by occurred? Do you mean that
17 they actually had a panel or hearing? Or you're
18 actually saying they were deciding the case?

19 Q No, where you had this incident with
20 Judge Fitzpatrick, where you ordered him to remove
21 confidential material. That incident happened in
22 September of 2017. September 1st. Do you see

1 that?

2 A The call I had -- the second call I had
3 -- the one where I give him a direct order -- the
4 direct order call occurred on September 1st.

5 Q Okay. And then he ultimately agreed to
6 remove the material after you gave him that direct
7 order, right?

8 A It wasn't clear if he agreed until the
9 following week.

10 Q Okay, so the following week, he agreed
11 to remove the material, right? So, that would
12 still be September of 2017, right?

13 A That's correct.

14 Q Okay. And so, you're aware -- Mr.
15 Horrigan just brought up the issue of Mr.
16 Fitzpatrick being taken off AIA cases. And that
17 occurred at the end of May of 2018. You just said
18 you were not involved in that decision. Is that
19 right?

20 A Again, I just want to clarify what I
21 said was consulted by, I believe it was Judge
22 Fink, as to the matter here, and other

1 interactions with him, but I was not actually the
2 assigned official on that matter -- whether to
3 take him off or what consequences there would be
4 for the conduct issue that occurred.

5 Q Okay, so just to be clear, our
6 understanding is Judge Fink responded to Mr.
7 Fitzpatrick's informal grievance. And Judge Fink
8 has testified that he spoke to you in connection
9 with responding to that. Is that what you're
10 talking about?

11 A Yes.

12 Q Okay. And that was September, I believe
13 it was September of 2018. I'm talking about May
14 of 2018, when Mr. Fitzpatrick was actually
15 removed, and it's our understanding that it was
16 Judge Weidenfeller, who was involved in that
17 decision. Does that refresh your recollection?

18 A Yeah, it wasn't clear what you were
19 referring to. So, now I understand you're talking
20 about taking him off and not the actual grievance
21 that was decided.

22 Q Okay. And so, you were not involved in

1 Judge Weidenfeller's decision to take him off AIA
2 cases in May of 2018. Is that correct?

3 A Other than providing input? No.

4 Q What do you mean by other than providing
5 input?

6 A Well, your question seems to presuppose
7 that I had no interactions with Judge
8 Weidenfeller. But yet, we had -- Judge
9 Weidenfeller was well aware of the incident here,
10 and other difficulties we've had. So, in that
11 sense, I had discussions with Judge Weidenfeller.
12 As to the ultimate decision, no.

13 Q So, when was Judge Weidenfeller aware of
14 this incident from September of 2017?

15 A When it occurred.

16 Q When it occurred. Okay, so, he was
17 aware of it prior to September, I'm sorry, May of
18 2018 when he removed Judge Fitzpatrick from AIA
19 trials?

20 A That stands to reason.

21 Q Okay, do you recall having a discussion
22 with Judge Weidenfeller in May of 2018, about

1 Judge Fitzpatrick, and this particular case --
2 this incident from 2017?

3 A I don't recall a conversation in May of
4 2018 with Judge Weidenfeller specific to this.

5 Q Okay. And so, would you also agree that
6 from September of 2017, up until the end of May
7 2018, that Judge Fitzpatrick would have received
8 at least two formal performance appraisals -- his
9 year end in 2017, and his mid- year in 2018?

10 A Under normal circumstances, yes. I
11 don't recall seeing them pass, but he should have
12 been issued a performance. He should have been
13 issued his rating in October and then following,
14 he should have been issued one in April.

15 Q Would it surprise you to learn that
16 those performance appraisals were uniformly
17 positive?

18 A Knowing his Lead Judge, no, I'm not
19 surprised.

20 Q I'm sorry. What did you say?

21 A I said, knowing his Lead Judge, I am not
22 surprised.

1 Q Okay, so, are you suggesting that his
2 performance appraisals were inaccurate?

3 A I'm saying I did not rate him.

4 Q Okay, and so, after this incident
5 happened in September of 2017, his Lead Judge was
6 who? Judge Mitchell?

7 A My understanding, in September of 2017,
8 it was Judge Mitchell.

9 Q And were you her superior?

10 A No.

11 Q Okay. Did you have any input on
12 Performance Appraisal processes?

13 A So, how we designed the PAP, I can go
14 ahead and provide input, and we also do outreach
15 of all judges. This is how we designed our PAP
16 plan.

17 COURT REPORTER: I'm sorry, could you
18 repeat your answer, Mr. Tierney? Could you repeat
19 your answer?

20 THE WITNESS: When we're developing a
21 performance appraisal plan, we tend, although it's
22 not required, to seek input from other judges --

1 from all judges. We tend to go out and ask for
2 input on how the PAP plan should be designed. But
3 it's not required though, and I can't guarantee it
4 happened every time we develop a PAP plan.

5 BY MR. ABRAMIC:

6 Q Do you think Judge Mitchell is a good
7 supervisor?

8 A I think Judge Mitchell is a very nice
9 supervisor.

10 Q What about Mr. -- I'm sorry, Judge
11 Weidenfeller? Do you think he's a good
12 supervisor?

13 A I think Judge Weidenfeller is a good
14 supervisor.

15 Q Would it surprise you to learn that
16 Judge Weidenfeller signed a positive performance
17 appraisal after this incident -- performance
18 appraisal for Judge Fitzpatrick?

19 A It would not surprise me.

20 Q Okay, after this incident in September
21 2017, did you go to any Management judges and
22 indicate that this incident should reflect poorly

1 Judge Fitzpatrick's performance appraisal?

2 A We would have had a discussion in the
3 October rating period. But generally, we tried to
4 move beyond things and not just escalate. If
5 there was a matter of a try to basically let
6 bygones be bygones, and move on, and avoid
7 potentially escalating a matter and making
8 something even worse.

9 Q Okay, but I want you to answer my
10 question. Did you during those deliberations tell
11 other supervisors that this incident should cause
12 a negative reflection on Judge Fitzpatrick's
13 performance appraisal?

14 A So, I'll be clear, at the time this
15 occurred, we were having executive meetings and we
16 had them every week. I made my views very clear
17 that I was frustrated with Judge Fitzpatrick and
18 the way he was interacting with the agency. And I
19 felt there should be repercussions based upon his
20 failure to follow guidance and have us basically
21 go to the point of getting a third and fourth
22 supervisor for direct orders to be given. So, I

1 made my views clear. And matter of fact, we also
2 had number of just general discussions where it
3 was clear that many of our ARC meetings, or
4 actually it was ARC meetings, it became clear and
5 that every other meeting, it seemed we had
6 Fitzpatrick's name come up. So, it was pretty
7 evident that Mr. Fitzpatrick views were causing
8 concerns as he was not necessarily wanting to
9 follow agency policy.

10 Q Okay, so if it was evident, I'd be able
11 to go into his performance appraisals and find
12 statements like this guy doesn't follow guidance.
13 This guy is tough to work with. It's evident,
14 right?

15 A Not necessarily.

16 Q Okay. Let's go back to tab six at page
17 fifty-six. Same page we were just looking at. I
18 want to talk -- thank you. Thank you. I want to
19 talk about this notion of confidentiality. You
20 were explaining that Judge Fitzpatrick had
21 confidential information in his opinion. And
22 then, if you look on the email here, there's a sub

1 bullet that says may threatened confidentiality of
2 the deliberative process. Do you see that?

3 A I see the sub bullet.

4 Q Okay. So, what I -- I have questions
5 about confidentiality versus deliberative process.
6 There's a term that has been used in this hearing
7 -- deliberative process privilege. Are you
8 familiar with that term?

9 A Please explain what you're using it as,
10 if you have a specific example, so I can
11 understand.

12 Q Well, I'd like to know if you are aware
13 of the term deliberative process privilege.

14 A Are you referring to FOIA?

15 Q I'm referring to a legal protection
16 against disclosure for deliberative processes of
17 judges' agencies.

18 A And what I'm referring to in the email
19 is FOIA. That he's trying to basically give
20 information of a deliberative nature out to the
21 public. And this is not something we give via
22 FOIA.

1 Q Okay, and it's your understanding that
2 that concern is a concern of confidentiality, and
3 not necessarily a concern of deliberative process
4 privilege?

5 A Oh, geez. I'm not following the
6 question. Can you rephrase it?

7 Q I'm just trying I understand that
8 there's a difference between the two. You said
9 that there's confidential information that we
10 don't want any opinion. And so, it sounds to me
11 like what you're telling me is, look, my concern
12 was that there's confidential information in the
13 opinion. And that was your only concern?

14 A Well, it's twofold. There's
15 confidential information. And apologies for not
16 being articulate with this as to what I wanted to
17 convey. And maybe I verbally conveyed at the
18 time. I'd have to go back and try and reflect,
19 but deliberative process -- there's a -- we don't
20 as an agency through FOIA, give information out
21 that is deliberative process information. So,
22 right here, confidentiality, deliberative process,

1 I may mix the two.

2 Q Okay, so, I'm not trying to be
3 difficult. I'm trying to understand if those are
4 two distinct concepts or if there's kind of a
5 Venn, you know, if they overlap. Like is some
6 deliberative process information confidential and
7 some confidential information is deliberative
8 process? Or is deliberative process under a big
9 umbrella of confidentiality?

10 A Let's step back. If you're in the
11 agency and you receive business confidential
12 information, that would not necessarily be
13 deliberative information. So, there are two
14 separate, but they do overlap with time. So, in a
15 Venn diagram, they would be overlapping but not
16 necessarily coextend.

17 Q Okay, understood. Now where in that
18 Venn diagram does Mr. Fitzpatrick's paragraph that
19 you wanted to remove fall? Under both?

20 A My impression and what I was trying to
21 convey to my supervisor, and what we had agreed
22 upon was it was both.

1 Q Okay, now let's talk about
2 confidentiality. Forget about deliberative
3 process for a minute. Are you aware of any
4 written document or guidance that explains the
5 agency's position on what is and what is not
6 confidential information?

7 A I'd have to go look. I know there are
8 certain things that we identify as confidential.
9 I don't know if we got together and spelled out
10 what the actual definition of confidential is.

11 Q Okay, so, same question for deliberative
12 process. Are you aware of any written guidance
13 that explains the contours of what is and what is
14 not deliberative process?

15 A I believe our General Law Office --
16 Office of General law with a FOIA office, which
17 I've interacted with, would have such information.

18 Q You think they would have such
19 information?

20 A We have -- yes because they're
21 constantly having to respond to FOIA requests, and
22 then explain what the deliberative process nature

1 of a document is. So, there would be
2 documentation. I may have it on my computer, but
3 off top my head, I know when I have a question, I
4 go to the General Law Office.

5 Q Okay, so, the agency would be able to
6 produce that documentation.

7 A The agency would be able to explain to
8 you what deliberative process is for purposes of
9 FOIA.

10 Q Okay, so, on the subject of deliberative
11 processes, I'm looking at the at the email here --
12 and I'm looking at the portion that was the
13 offending paragraph -- which you say is covered by
14 deliberative process. So, what you're saying is
15 that -- what we're reading here, is covered under
16 the agency's deliberative process. So, it can't
17 be disclosed outside of the agency, right?

18 A When you say we're reading here, what
19 are you referring to, please?

20 Q Yeah, I'm trying to do without looking
21 at the opinion itself. But if you look at the
22 email, at page fifty- six -- tab six, page

1 fifty-six, you see the paragraph that starts with
2 subsequently, the majority opinion.

3 A I'm at fifty-six, the full paragraph
4 that starts with subsequently.

5 Q So, that's just a recitation of the
6 paragraph that was in Mr. Fitzpatrick's opinion,
7 right? That was the information you wanted him to
8 remove from his opinion, right?

9 A Yes.

10 Q Okay. And so, that's the information
11 that you are saying is covered by the deliberative
12 process privilege, right?

13 A It would -- we would deny a FOIA request
14 keeping this information is what I'm saying.

15 Q Okay, so, that information and that
16 protection is the agency's protection. So, the
17 public is not entitled to know that information,
18 right?

19 A I mean, I'm not an expert at the scene.
20 The Director could waive it and make it public
21 should he choose to do so, but that's different
22 than a judge to turn on their own. But then

1 they're going to go ahead and give deliberative
2 information.

3 Q Okay. Do you know why I'm able to look
4 at it right now?

5 A At this speaking hearing? It's been
6 produced. That's my assumption. You tell me.

7 Q Okay, I have no further questions.

8 JUDGE NIEDRICK: Thank you, Mr. Abramic.
9 Judge Tierney, I just have a couple -- with regard
10 to the email that you sent on September 1, just
11 sort of summarizing what you discussed with Judge
12 Fitzpatrick, Judge Mitchell was on the call with
13 you when you have that conference. And did you
14 also -- I'm just wondering why Judge Weidenfeller
15 is not CC'd on this. Is there a reason for that?
16 Was he no longer supervising the appellant as a
17 second level? I can't -- I don't recall from what
18 I've heard so far.

19 THE WITNESS: I can't recall why I
20 didn't just CC him also. I was basically letting
21 my supervisor know that the information had been
22 conveyed and letting the first level supervisor

1 know because she was on the call. And she had
2 wanted to be informed.

3 JUDGE NIEDRICK: Okay, have you ever
4 received in the past, and all your years of
5 supervising, an email like the response that you
6 receive from Judge Fitzpatrick on September 5th
7 after this?

8 THE WITNESS: No, Your Honor.

9 JUDGE NIEDRICK: I don't think I have
10 anything else. Any follow up, Mr. Horrigan?

11 MR. HERRIGAN: No, thank you.

12 JUDGE NIEDRICK: Okay. Any questions
13 from my question Mr. Abramic?

14 MR. ABRAMIC: No, Your Honor.

15 JUDGE NIEDRICK: Okay. Great. Thank
16 you very much, Judge Tierney. Thanks a lot for
17 your patience. I know you waited a long time.
18 And actually, you beat the estimate, which is
19 really good for the way this hearing's going. So,
20 thanks a lot. Please don't discuss your testimony
21 with anyone. If you have any questions, please
22 contact Mr. Horrigan, okay?

1 THE WITNESS: Thank you, Your Honor.

2 JUDGE NIEDRICK: Thank you. And if you
3 can just go ahead and hit the leave button at the
4 bottom, that'll take you out of the meeting.

5 THE WITNESS: Thank you.

6 JUDGE NIEDRICK: Thank you. Goodnight.
7 Okay, great. All right. So, I think at this
8 stage, all we have left, unless I'm forgetting
9 someone, is just Judge Fitzpatrick. Is that
10 correct?

11 MR. ABRAMIC: That is correct, Your
12 Honor. We do need, in order to make the audio
13 work, we need to get him set up in another room.
14 So, could we take five minutes? I've been picking
15 up the pace. I'll be fast with him.

16 JUDGE NIEDRICK: Okay, great. Thanks.
17 Okay. We'll come back that -- is five minutes
18 long enough or to somebody needs longer? Okay,
19 great. So, let's come back on at 6:11 p.m. We
20 can go off the record, Ms. Dawson.

21 (Recess)

22 COURT REPORTER: We are back on the

1 record at 6:12 p.m.

2 JUDGE NIEDRICK: Thank you very much.

3 And we're continuing with the hearing. And we're
4 going to hear from Judge Fitzpatrick now. He's
5 going to be the last witness. And Mr. Abramic,
6 you can go ahead with your examination.

7 Whereupon,

8 MICHAEL FITZPATRICK

9 was recalled as a witness and, having been
10 previously duly sworn, was examined and testified
11 further as follows:

12 REDIRECT EXAMINATION

13 BY MR. ABRAMIC:

14 Q Thank you, Your Honor. Judge
15 Fitzpatrick I want to go -- I'm hearing a lot of
16 feedback. Are you all hearing feedback?

17 COURT REPORTER: Yes.

18 THE WITNESS: All right, is this better?

19 COURT REPORTER: Yes.

20 BY MR. ABRAMIC:

21 Q Now Judge Fitzpatrick, I want to start
22 with the May 30th call -- May 30, 2018 -- that Mr.

1 Weidenfeller called an oral counseling. Do you
2 recall that phone call?

3 A Yes.

4 Q I want to go to tab six at page twelve.
5 Do you have that document?

6 A I do.

7 Q And you recall this is the document that
8 is Mr. Weidenfeller's note for the call?

9 A Yes.

10 Q I want to talk about the bullet that
11 says you showed a lack of judgment as to when to
12 compromise. Do you see that one?

13 A Yes.

14 Q And then there's the two sub bullets
15 that refer to failure to follow SAS template, and
16 that you saw no need to follow the Director's
17 guidance. Do you recall what those two sub
18 bullets were about?

19 A Yes, they were about my SAS concurrence
20 where I wanted to follow the Supreme Court
21 decision in SAS -- and institute -- after doing a
22 single claim analysis and then instituting based

1 on that.

2 Q And was that -- that was the Riot Games
3 IPR, right?

4 A It was, although, well, it absolutely
5 was. But Judge Weidenfeller, during his
6 testimony, he injected another case, Fujifilm.

7 Q Okay, let's talk about the Riot Games
8 IPRs first. Do you recall Mr. Weidenfeller's
9 testimony last week, where he said that your
10 conduct in the Riot Games cases was insubordinate
11 to him?

12 A I remember him testifying about that.
13 Yes.

14 Q Okay. I want to talk about that. But
15 can you first tell me whether Judge Weidenfeller
16 ever said on the May 30th call that you had been
17 insubordinate to him?

18 A No, he said that it was inconsistent
19 with SAS guidance. And he said it was an example
20 of a failure to compromise.

21 Q Okay, let's go to tab six at 246 through
22 249.

1 A I'm sorry, 246. Okay, I'm there.

2 Q Do you do you recall this document?

3 A Yes, it's an email string.

4 Q And is this about the Riot Games
5 Institution decisions?

6 A It is.

7 Q Okay, when Judge Weidenfeller was saying
8 that this was an example of you being
9 insubordinate to him, do you agree with him?

10 A I do not.

11 Q Okay, can you explain what's going on in
12 these emails? Let's start at tab six at 249.

13 A Okay, which did want the bottom email?
14 Or which email do you want to start with?

15 Q Let's start with the email from Carl
16 Eastham at 5:06 p.m. What's going on there?

17 A Okay, this is the Riot Games' four
18 related cases. And we have decisions to institute
19 ready. They include concurring opinions by me,
20 which was welcomed by my copanelists, which is
21 Judge Eastham and Judge Dang. And Carl is trying
22 to get management to sign off so we can issue the

1 decisions. And it had been six days since kind of
2 the last time he reminded them and so he's
3 reminding them.

4 Q Okay, so, what happens next?

5 A That was Wednesday. And then I got to
6 -- may I flip to the next page, the next email?
7 You can see the body of the email, but it's May
8 12th. Okay. Scott Weidenfeller's response on
9 behalf of management, and he says, he asked if the
10 panel is amenable to issuing two judge decisions
11 on institution with only Judge Dang. And Judge
12 Eastham -- meaning without my opinion.

13 Q Okay, and why is it significant that he
14 asked the panel, in your view?

15 A Because he wants to know. He's asking
16 us if we're amenable to this. My response was,
17 no, I'm not. I wasn't amenable to it.

18 Q And are you referring to your email of
19 May 14th at 9:30 a.m. on page 248?

20 A Yes, that's where I let him know that.
21 Yes.

22 Q Okay, were you countermanding an order

1 by sending that email?

2 A No. In the first instance, I did not
3 perceive there to be any order. He was asking the
4 panel if were amenable to a certain course of
5 action. I'm on the panel. So, I gave my answer.
6 My answer was that I was not amenable.

7 Q So, what happened next?

8 A Then, Judge Eastham replies on behalf of
9 -- on his own behalf, and on the behalf of Judge
10 Dang, apparently. And he says, Thuy (phonetic)
11 and I -- that's Judge Dang's first name - Thuy
12 (phonetic) and I are fine either way, Scott, i.e.
13 With or without concurrence.

14 Q And then what happens?

15 A Well, nothing during the rest of the
16 day. During the rest of the normal business
17 hours. Then, as you can see, there's another
18 email it's at 6:36 p.m. This was after I'd signed
19 off for the day. And Scott Weidenfeller writes,
20 please mail this decision without the concurrence.
21 I apologize for the delay.

22 Q And then what happened after that?

1 A I wake up the next morning and sign in
2 and I see this email. And it looks -- I don't see
3 any response to his, you know, he asked whether
4 the panel was amenable to this course of action.
5 And I had responded that I was not. He never
6 replied to that. And so, I see his email as a
7 mistake -- that he sees Judge Eastham's response.
8 And that's perhaps all he sees. And so, he's
9 going with that. And that's going to be a
10 mistake. And so, I write an email quite early in
11 the morning, letting them know that the decision
12 should not go out without my concurrence.

13 Q Were you attempting to countermand an
14 order with that email?

15 A No. Again, in my mind, the last thing
16 that Judge Weidenfeller indicated to me was that
17 he wanted my input as to whether or not I was
18 amenable to being -- to having my opinion stripped
19 from these decisions. And that was the last thing
20 I know. There was never any closure on that. So,
21 I was just trying to make sure that these
22 decisions do not go out mistakenly without my

1 opinion.

2 Q Moving up to Mr. Weidenfeller's email at
3 10:06 a.m., what is this? And this is on page
4 247.

5 A Okay. This is Judge Weidenfeller
6 removing me from the cases. And this is the first
7 clear indication that he's, you know, exercising
8 management authority to exclude my opinions.

9 Q Can you go to tab six at twenty to
10 twenty-three?

11 A Sure, yeah.

12 Q Okay. You've seen this document before.
13 What is this email?

14 A This is that same morning. And so,
15 after I sent out that email -- it at very early in
16 the morning -- nobody responded to me. And the
17 next thing that I, you know, the next significant
18 thing that happened was I discovered that the
19 decisions then did go out with just two -- with
20 just Judge Dang and Judge Eastham, and without my
21 opinion. And so, I'm replying to this AIA hotlist
22 email letting them know that. So, what's going on

1 with these AIA house emails, they're trying to
2 make sure nothing slips through the cracks. That
3 we always meet our statutory deadlines. And so,
4 whenever a case is approaching the statutory
5 deadline, it goes on this AIA hotlist and someone,
6 you know, on staff, will send out an email to
7 everybody that has any involvement with any of the
8 cases that are on the list and says, hey, these
9 are in danger of going past the deadline, what's
10 going on? And I'm letting them know that despite
11 the fact that Judge Eastham said decisions were
12 mailed this morning, and we're now like, we're now
13 in the clear, I'm letting them know we're not
14 really actually in the clear because those
15 decisions went out mistakenly, because they don't
16 have my opinion.

17 Q Okay, so tab six at twenty, that email
18 distribution list -- that's not a distribution of
19 folks that you decided to direct your message to?

20 A No, no, that's who -- I replied all,
21 which is what every -- which is what happens.
22 Everyone replies on this. And the reason is so

1 that anyone who needs to know, knows that this
2 case has been resolved, or that this case has not
3 been resolved, so that they can do something about
4 it.

5 Q Okay, can you go to tab seven at 907?
6 And this one you might have to pull up on your
7 screen.

8 A Yes, I see. It's very small.

9 Q Can you explain what this document is?

10 A Yeah, this is what I was just referring
11 to. The judge -- this is an email from Judge
12 Eastham to the same group in response to Ms.
13 Torres' email, you know, that these four cases --
14 these four Riot Games cases -- are on the AIA
15 hotlist, and wondering, you know, are they going
16 to get resolved. Are they going to go out. And
17 judge Eastham is letting her know that they did,
18 and so, he says, good morning. The four DIs --
19 IPR 2018 dash 00129 through 132 mailed today.
20 Thanks, Carl. And he sent it to the same group
21 that I sent my email to.

22 Q On or around the time of these emails,

1 did Judge Weidenfeller or anyone in PTAB
2 Management say or email to you that you had
3 countermanded or attempted to countermand Judge
4 Weidenfeller's authority?

5 A No. He said that my opinion was
6 inconsistent with the SAS guidance. And that was
7 it. He didn't say anything about countermanding.

8 Q When is the first time you were accused
9 by anyone of attempting to countermand Mr.
10 Weidenfeller's authority?

11 A It was in late September. And it was in
12 -- it was from Judge Fink -- was the person who
13 first said, you know, asserted that I had
14 countermanded or attempted to countermand Judge
15 Weidenfeller. That was in his denial of my
16 informal grievance.

17 Q You just mentioned that Judge
18 Weidenfeller said that your Riot Games concurring
19 opinion was against SAS guidance. What do you
20 think of that?

21 A Oh. And I've been referring to SAS --
22 when I have, it's the same case -- SAS. It's

1 wrong. I don't believe there's -- I've never been
2 given any guidance for which my opinion was
3 inconsistent with.

4 Q Did Judge Weidenfeller ever identify the
5 guidance that your opinion allegedly contradicted?

6 A No. And I specifically sought
7 clarification about what was the basis for his
8 assertion that it was inconsistent with guidance.
9 He never identified any guidance to me.

10 Q Do you believe that you were alone in
11 your view that no guidance precluded single claim
12 institution decisions?

13 A I was not alone.

14 Q How do you know that?

15 A Because numerous decisions went out that
16 did exactly what I wanted to do in my concurring
17 opinion.

18 Q Can we go to tab six at page
19 twenty-four?

20 A Looking at (inaudible) exhibit R?

21 Q Yeah, we've seen this document during
22 some of the testimony today. If you go down to

1 page twenty-five, there's an email from Lee
2 Stipena (phonetic). Do you see that?

3 A I do.

4 Q What's in this email?

5 A So, this is -- we would have had a
6 meeting, I guess, that day, because this says, for
7 today's meeting. So, on May 16th, we must have
8 had a meeting. And typically, our meetings are,
9 you know, we're spread out across the country.
10 So, I'm WebEx. And WebEx has this chat function
11 where you can ask questions. And it looks like
12 management -- maybe Lee Stipena (phonetic) was
13 involved with the meeting. So, he had all the
14 questions. I'm not sure why he would have had
15 them. But he apparently did. And looks like
16 management asked him to forward them to him -- the
17 questions that the judges had during the meeting
18 that they typed up.

19 Q If you go to page twenty-six of the
20 document, you see that there's a question from
21 Michael Fitzpatrick to everyone. Do you see that
22 it? It started with I was removed from four

1 panels. Do you see that?

2 A I do.

3 Q Do you recall Judge Fink's testimony
4 today, where he said that by asking this question,
5 you were trying to embarrass Judge Weidenfeller?

6 A I do recall him saying that.

7 Q Do you agree with him?

8 A I do not.

9 Q Why not?

10 A This email, so, this was a very
11 frustrating thing for me to have gone through --
12 to have just at my opinions taken away in those
13 Riot Games' cases. And then I'm seeing other
14 judges do exactly what I'm proposing to do -- what
15 I was proposing to do in my concurring opinions.
16 And I get vague, you know, management officials
17 vaguely telling me that what I wanted to do was
18 inconsistent with guidance, but they never
19 identify the guidance. They never -- there's
20 nothing even close to a satisfactory explanation
21 for how my concurrent opinions would be
22 inconsistent with the guidance. And so, this

1 meeting, I think -- I know, during this meeting,
2 SAS was discussed. And so, I'm trying to get
3 management to explain to me the contours of
4 whatever guidance there is on SAS. So, it was
5 frustrating here, for me to hear that. Like, me
6 trying to educate myself on all these mixed
7 messages from management, that that itself is, I
8 think -- maybe he said it was countermanding or
9 undermining, I don't know, or embarrassing. I
10 can't remember what he said. But all I'm trying
11 to do is try to figure out what it is exactly that
12 -- what are our marching orders from management?
13 It was never clear to me.

14 Q A little bit ago, you mentioned the
15 Fujifilm case. Do you recall Judge Weidenfeller's
16 testimony, where he said that you allegedly failed
17 to follow SAS guidance in the Fujifilm case?

18 A I do.

19 Q Okay. And were you on the panel in the
20 Fujifilm case?

21 A I was. I was with Jeff Smith and
22 Patrick Bouche (phonetic).

1 Q Did Judge Weidenfeller mention the
2 Fujifilm case to you during the May 30, 2018,
3 telephone call?

4 A He did not.

5 Q Was the order at issue in the Fujifilm
6 case a decision on institution?

7 A No, it was not. It was related to SAS.
8 But it was not an institution decision. So, it
9 was a case -- Fujifilm was a case that we had
10 already instituted. And we did a partial
11 institution. And then, SAS came down and said,
12 PTAB, you're not allowed to do partial
13 institutions. So, we had all these proceedings we
14 had to fix so to speak. We either had to go back
15 and uninstitute them -- deny it -- or we had to
16 add in everything. So, it was just because it was
17 a binary thing. SAS told us we had to do it. And
18 all that order was, that we wanted to issue, was
19 just -- it was going to -- my memory is, it was
20 going to quote the relevant, you know, the most
21 relevant hold part of SAS, and point out that this
22 was partially instituted IPR. And then ask the

1 parties, do they want to file a motion in view of
2 SAS? That was it. It wasn't ruling definitively
3 on anything. It was just telling them, hey, if
4 you if you want to file a motion, you need to let
5 us know.

6 Q And did you have a concurring or
7 dissenting opinion with that case?

8 A It was not. It was unanimous.

9 Q Okay, can we go to tab seven at 925
10 through 927. Okay, what is this document?

11 A This is this is that order. This is the
12 draft order that never went out. So, it's
13 unanimous. Judge Smith, Judge Bouche, and me -- I
14 was the author -- and yeah, starting in the second
15 paragraph, I explained that we instituted on three
16 of six grounds raising the petition. Subsequently
17 Supreme Court held the following. I won't read it
18 all. But, you know, said, you're not allowed to
19 do partial institutions. And then, our order was
20 the following -- according -- or would have been
21 the following. Accordingly, it is ordered that if
22 either party seeks to file a motion in view of SAS

1 Institute, each request, within one week of this
2 order, a conference call to seek authorization for
3 filing the motion.

4 Q Did anyone ever identify any guidance
5 that this order did not comply with?

6 A No.

7 Q Can we go to tab six at fifty-six
8 through fifty- seven? Do you recall that Judge
9 Tierney just talked about this document and the
10 Fresenius IPR?

11 A I do.

12 Q And you recall Judge Weidenfeller
13 testifying that you wanted to include alleged
14 confidential information in an opinion in this
15 IPR?

16 A I believe so.

17 Q Did Judge Weidenfeller mention this IPR
18 to you during his May 20, 2018, telephone
19 performance appraisal?

20 A He did not.

21 Q And Judge Tierney instructed you to
22 remove this alleged confidential information from

1 your opinion, is that right?

2 A That is right.

3 Q And did you comply with that directive?

4 A I did.

5 Q Looking at the bottom of page fifty-six
6 of tab seven -- I'm sorry -- it's six. Do you see
7 the sentence where it says, if you fail to follow
8 my direction, the consequences may include?

9 A Yes.

10 Q And then, on page fifty-seven, what
11 what's on that page?

12 A These are the list of -- the
13 non-exhaustive list of punishments.

14 Q And do you see where it says adjusting
15 your case assignments?

16 A Yep, I do.

17 Q What did you take that to mean?

18 A I took that to mean I will be removed
19 from AIA cases and reassigned to ex parte appeals.

20 Q And how would you view that transfer?

21 A As punishment.

22 Q I going to switch gears and talk a

1 little bit about due process. Do you recall the
2 testimony of Judges Mitchell and Boalick, where
3 they acknowledged that it would not comport with
4 due process for the Director to tell a judge to
5 change his or her decision on a substantive issue
6 of patentability?

7 A I do.

8 Q What's your recollection as to what
9 Judges Mitchell and Boalick said about where to
10 draw that line -- on whether Director interference
11 in an APJ decision comports with due process or
12 not?

13 A I recall both of them having a lot of
14 difficulty articulating where that line would be.
15 And I remember -- I think Judge Mitchell referred
16 to a penumbra, and also described I think, bread
17 and butter issues, and maybe we were allowed to be
18 judicially independent on them, but not other
19 issues.

20 Q And so, the bread and butter thing you
21 mentioned, is that there's been a lot of talk in
22 this hearing about substantive patentability

1 issues versus procedural issues. Do you recall
2 that?

3 A I do.

4 Q And so, do you agree with the notion
5 that Director interference on substantive issues
6 of patentability might interfere with due process
7 rights, but a director can interfere however much
8 they want with procedural issues?

9 MR. HARRIGAN: Objection. Leading.

10 JUDGE NIEDRICK: Overruled, please
11 continue.

12 THE WITNESS: Was that the end of the
13 question? And was it do I recall that?

14 BY MR. ABRAMIC:

15 Q Yeah. Do you agree with the notion that
16 that's where the dividing line is -- procedural
17 versus substantive patentability?

18 A I don't. I would say probably for two
19 reasons. I mean, I don't even know where that
20 line would be. I don't know how you would
21 separate those two. Even if you could, I probably
22 wouldn't agree.

1 Q Why not?

2 A Procedure can be everything in these
3 cases. Whether we institute or not, that right
4 there -- if we don't institute, that's a win for
5 the patent owner. If the procedure is on, like, a
6 motion to amend, that decides whether or not --
7 and that was what that issue at Nike -- it was a
8 motion to amend. And so, denying that motion to
9 amend based on a procedural reason versus a
10 substantive reason doesn't matter. You're still
11 taking away or depriving the patent owner of
12 property rights. You're depriving them of those
13 substantive claims.

14 Q Can we go to tab seven at 656? Okay, do
15 you recall that this is the email where you
16 memorialize the telephone call with the Nike panel
17 on May 7th?

18 A Yes.

19 Q And do you recall Judge Ruschke's
20 testimony today that his recollection of the phone
21 call was that his concern about your opinion was
22 not that you discussed panel expansion, but that

1 your opinions still contained alleged confidential
2 information?

3 A I recall that testimony. Yes.

4 Q Is that your recollection of the call?

5 A No. It doesn't -- his recollection
6 doesn't make sense.

7 Q Why not?

8 A At the time, I had already -- sorry,
9 this is on May 10th, and I'm memorializing a May
10 7th call. At the time of May 7th, the conflict --
11 the allegedly confidential information had already
12 been removed from my opinion for seventeen days.
13 Okay, I removed it on April 19th, or April 20th.
14 Definitely by April 20th. I removed it. And I
15 would also add that the -- pointing out that in
16 the second paragraph, I'm saying given your
17 continued refusal to allow the decision to enter,
18 I have removed the edits to my concurring opinion
19 that management via Vice Chief Judge Weidenfeller
20 had sought. I never desired those edits. I
21 agreed to them on the now unfulfilled condition
22 that the decision will be timely entered. So, I

1 think Chief Judge Ruschke's saying he wouldn't let
2 it go out because the confidential information was
3 still in there. I'm telling you that's not the
4 case. I did take it out. Judge Weidenfeller
5 acknowledge that I took it out. And if that was
6 truly the reason, all Ruschke had to do was
7 respond to this email and say, you misunderstood
8 me. And I would have said, okay, I'll take it
9 back out again. Let's mail this thing.

10 Q No further questions.

11 JUDGE NIEDRICK: Thank you. Mr.
12 Horrigan?

13 MR. HARRIGAN: Nothing, thanks.

14 JUDGE NIEDRICK: Okay. I don't think I
15 have anything either. Hang on one second. I
16 guess I'm just going to circle back to the email
17 that you responded to Judge Tierney with -- the
18 email at tab six, page fifty-nine. It starts at
19 fifty-nine. It's a lengthy email. And I just
20 kind of want to understand, although I don't know
21 if this is particularly relevant. I just want to
22 understand, sort of, your motivation for sending

1 that. If you can go there. It's -- let me make
2 sure I got the right citation. Actually, you're
3 going to start at fifty-nine. That's the one you
4 sent on September 5th. Do you see that?

5 THE WITNESS: Yes.

6 JUDGE NIEDRICK: Can you just sort of
7 explained to me what the purpose was? It does
8 seem sort of over the top to me. And I just want
9 to understand your motivation.

10 THE WITNESS: Gotcha. Definitely. So,
11 this whole process that led to the order for me to
12 take out the confidential information -- which I
13 immediately complied with -- that process was, in
14 my view, I was in this gray area of, it was, guess
15 whether I'm ordering you to do this or not. So,
16 ARC, we've heard conflicting testimony about what
17 -- I think we have heard conflicting testimony --
18 I definitely have heard conflicting things about
19 whether ARC is always merely suggestive, or
20 whether you should follow it. In this case, they
21 asked me to remove the confidential information.
22 They labeled it as confidential, and they redlined

1 it out. And I asked for -- there was another
2 email that was shown to Tierney where I had
3 written that I would remove it if there's a legal
4 requirement to do so. Could someone please
5 explain that to me? And thereafter, I received
6 many phone calls -- people trying to get me to
7 remove it. Every one of those people told me they
8 were not ordering me to do it. And that they were
9 calling me on behalf of someone else that they
10 refuse to identify. Ultimately, Judge Tierney
11 called me on September 1st and read me that
12 script. And he wouldn't provide it to me, which I
13 thought was odd. So, that is why I memorialized
14 it. Everything else, kind of before that, was
15 done off the books. You know, I would get these
16 phone calls urging me to do this. And I would --
17 I was never given anything definitive about the
18 reasons why I should remove it. And ultimately, I
19 was ordered verbally to remove it. And there was
20 no record of that. And so, I wanted to
21 memorialize it.

22 JUDGE NIEDRICK: Thank you. I think

1 that's all I have. So, at this point, I think
2 that concludes all the evidentiary testimony and
3 documentation for the case. Just want to confirm
4 that with everybody. Is that right? Mr.
5 Abramic?

6 MR. ABRAMIC: Yes, Your Honor.

7 JUDGE NIEDRICK: Okay. Mr. Horrigan?

8 MR. HERRIGAN: That's correct.

9 JUDGE NIEDRICK: Okay. So, I'm going to
10 order closing briefs in this case. I understand
11 the background -- you can see, sort of, my
12 understanding from the jurisdictional order, sort
13 of the -- I understand sort of the context. So, I
14 want you to try and focus more on, sort of, the
15 meat of the merits of this case in your closing
16 briefs. I think I have a fairly good
17 understanding of the two disclosures and whether
18 there's a reasonable belief there. So, do what
19 you want with that, but I don't think a whole lot
20 is necessary. I think the real focus here is
21 going to be, sort of, the clear and convincing
22 side of the case, which is the agency's burden. I

1 think there's a lot of evidence, sort of,
2 discussing and describing, sort of, what
3 transpired and the reasons that the agency
4 provided for taking the actions. So, if you
5 could, you know, focus on that, I think that would
6 be very helpful to me. I want to limit it to
7 twenty-five pages or less. And again, I think if
8 you hit on those things, it shouldn't be a problem
9 to fit in. I know we've had a lot of information
10 introduced. But so, it's twenty-five pages or
11 less. I'll, sort of, turn it over to you now, and
12 see how much time you think you might need in
13 order to do that. Mr. Abramic -- let me ask first
14 -- Ms. Dawson, how long do you think it would take
15 for them to get transcripts?

16 JUDGE NIEDRICK: Okay, so, assuming that
17 you don't get trapped -- can transcripts for ten
18 days or two weeks, how much time do you think
19 you'd need to put together the closing briefs?
20 Mr. Abramic?

21 MR. ABRAMIC: So, I would suggest maybe
22 thirty days from getting the transcripts. That's

1 just a ballpark.

2 JUDGE NIEDRICK: Okay. What about you,
3 Mr. Horrigan?

4 MR. HERRIGAN: Okay. I had a question
5 though. When will the recordings be made
6 available so that we can order transcripts?

7 JUDGE NIEDRICK: The recordings, I
8 think, have already been sent to us from the first
9 two days. The recording, I imagine, will be sent
10 -- usually they come in about a week to us -- for
11 us. So, I think they could probably get started
12 -- unless I'm mistaken, Ms. Dawson -- on the
13 transcripts for the first two days.

14 MR. HERRIGAN: Oh, I'm sorry. I guess I
15 misunderstood. Are we going to see transcripts
16 from this?

17 JUDGE NIEDRICK: Well, you can order
18 transcripts. The Board does not provide
19 transcripts.

20 MR. HERRIGAN: Right. So, we have a
21 court reporting service. We'd like to take the
22 recordings and have them transcribed. That's what

1 I'm trying to get to.

2 JUDGE NIEDRICK: I understand. Okay,
3 yes. So, they will be posted -- the recordings
4 from the first two days, were probably recorded --
5 be posted later this week -- tomorrow or Thursday.
6 I think they came in. I saw my office manager
7 earlier, and she said that she has them. So, if
8 they haven't already been uploaded, then I'll make
9 sure they get uploaded immediately. And then Ms.
10 Dawson, how long before the next recording gets
11 sent over to us? Do you know? Okay. Usually, I
12 haven't seen it gone longer than a week. So, I
13 think at the very outside edge. Right. So, given
14 that -- so, assuming that you don't get what you
15 need to send it off until another week, Mr.

16 Horrigan, how much time do you think you'd need?

17 MR. HORRIGAN: Well, so, as we already
18 pointed out, it would be ten days to get the
19 transcript from them. Thirty days sounds fine to
20 me. I'm just saying the there's another hurdle
21 here.

22 JUDGE NIEDRICK: Why don't we do -- why

1 don't I do forty-five days for closing briefs?

2 Does that work for everybody? Mr. Abramic, yeah?

3 MR. ABRAMIC: Yep.

4 JUDGE NIEDRICK: Okay. And again, it's
5 limited to twenty-five pages or less. I'm going
6 to dismiss the case without prejudice for forty
7 days, so that I can get a new clock on this. So,
8 that I can write the decision because the case is
9 old -- older, and we have the same types of
10 guidelines that I think you all have. So, I'm
11 going to dismiss the case without prejudice
12 probably tomorrow, you'll see it. You don't have
13 to do anything. It'll be automatically refiled on
14 the 40th day. And then at that point, you can go
15 ahead and submit what you need to submit, okay?
16 And other than that, does anybody have anything
17 before we go off the record? Mr. Horrigan?

18 MR. HERRIGAN: I do not believe so. I'm
19 just trying to calculate the days here. I start a
20 leave period on the 11th of July. It sounds like
21 we're going to get to it sounds like the
22 forty-five days will run before then. But I'm

1 trying to run the numbers right now.

2 JUDGE NIEDRICK: Yeah, no, take your
3 time. Let's figure it out.

4 MR. HERRIGAN: Maybe the eighth of July.

5 JUDGE NIEDRICK: We can take a date
6 certain. That's fine. Take a look at your
7 calendars. Does July 8th work for you if we had
8 them do July 8th? Or do you want to pick a
9 different date? I mean, this is not --

10 MR. HERRIGAN: It is forty-five days.

11 JUDGE NIEDRICK: Okay. And that's what
12 you want? July 8th?

13 MR. HERRIGAN: Yeah, that'd be good.
14 But that my next question is, is there going to be
15 a reply?

16 JUDGE NIEDRICK: No reply.

17 MR. HERRIGAN: Good.

18 JUDGE NIEDRICK: Okay. So, July 8th.
19 Anything else, Mr. Herrigan?

20 MR. HERRIGAN: No, thank you.

21 JUDGE NIEDRICK: Mr. Abramic? Mr.
22 Kappers? Mr. Suarez, anything?

1 MR. SUAREZ: No.

2 JUDGE NIEDRICK: Okay, great. You guys
3 have all been really, really good. I really
4 appreciate sort of everybody's collegiality and
5 working with everything. It was very --
6 considering the complexity of the case and what
7 was going on, I really appreciate your
8 professionalism. So, with that, thank you very
9 much. Thank you very much, Ms. Dawson. Do you
10 need them to stay on for a little bit to get any
11 information? Okay, great. Thank you, too.
12 You've been fantastic. I really appreciate it.
13 All right, everybody have a good night. Thank
14 you.

15 (Whereupon, the HEARING was
16 adjourned.)

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1 CERTIFICATE OF NOTARY PUBLIC

2 I, Carleton J. Anderson, III do hereby
3 certify that the forgoing electronic file when
4 originally transmitted was reduced to text at my
5 direction; that said transcript is a true record
6 of the proceedings therein referenced; that I am
7 neither counsel for, related to, nor employed by
8 any of the parties to the action in which these
9 proceedings were taken; and, furthermore, that I
10 am neither a relative or employee of any attorney
11 or counsel employed by the parties hereto, nor
12 financially or otherwise interested in the outcome
13 of this action.

14 /s/Carleton J. Anderson, III

15
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18 Commonwealth of Virginia
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2 Please note any errors and the
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4 change or correction should have a reason. It may
5 be a general reason, such as "To correct
6 stenographic error," or "To clarify the record,"
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8 completed the sheet, signed and dated it, return
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11 errata sheets among the parties.

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