

The ITC's Administrative Law Judges and Their Ground Rules

IPO Advanced ITC Litigation Class

by

Scott J. Pivnick, Alston & Bird LLP

April 25, 2014

Administrative Law Judges



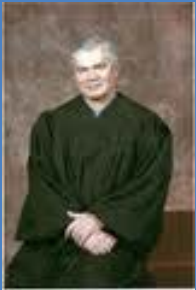
Charles E. Bullock

- Chief ALJ
- Former EPA ALJ
- Longest tenured ALJ (Almost 12 years)



Thomas B. Pender

- Former Social Security ALJ
- 2.5 years experience



Theodore R. Essex

- Former Medicare ALJ
- 6.5 years experience



David P. Shaw

- Former Social Security ALJ
- 2.5 years experience



Edward J. Gildea

- Former Social Security ALJ
- 5 years experience

Coming
Soon

Sandra (Dee) Lord

- Former Social Security ALJ
- Appointed October 2013

ALJ Ground Rules

- Each Judge has their own Ground Rules which are akin to a District Court's local rules.
- Ground Rules can either greatly reduce, or greatly increase the cost of an Investigation.
- Ground Rules are gospel and you ignore them at your peril
- Each Judge has their own idiosyncrasies.

Mandatory Disclosures

- ALJ Pender (7) requires significant mandatory disclosures, including priority dates, products within the scope of the NOI, domestic industry contentions, and infringement contentions at various points of the schedule.
- ALJ Pender (7.2.2) also requires significant source code production related to the products that fall within the scope of the NOI, as well as DI contentions (7.3).
- ALJs Lord (5), Shaw (2), Bullock (5), and Gildea (4) have similar mandatory disclosures for priority dates and prior art. ALJ Shaw (6.d) also requires disclosures on accused products and DI products.

Discovery: Disputes

- ALJs Pender (9.2), Essex (4.1.1), Bullock (4.1.1), Lord (4.1.1), and Gildea (3.1.1) all require the parties to engage in a Discovery Committee. This committee is composed of the lead counsel from each party, and the Staff if it is a party. These committees meet every other week to solve any pending discovery disputes.
- ALJ Shaw does not require the use of a Discovery Committee, and does not provide any additional guidance for the resolution of discovery disputes. Does say (1.1) parties should make “intensive” efforts to resolve differences.

Discovery: Disputes

- In the event discovery disputes can't be resolved in Discovery Committee, ALJs Essex (3.5) and Pender (5.4.2) provide for informal resolution of discovery disputes.
- Allows for informal letter outlining the discovery dispute followed by a call with ALJ within a day or two.
- Disputes often resolved on the call but if not, Judge will then allow parties to brief the issue by formal motion.

Discovery: Privilege Logs

- ALJs Bullock (4.9.1), Essex (4.9.1), Pender (9.11.1), Gildea (3.9.1) , and Lord (4.9.1) have specific requirements for what information must be included in a privilege log.
- ALJs Bullock (4.9.2), Essex (4.9.2), Pender (9.11.2), and Lord (4.9.2) recognize that the parties can agree to NOT exchange privilege logs. If they do, however, the ALJ will not consider any motions involving privileged documents.

Discovery: Depositions

- In addition to the requirements of Commission Rule 210.28(c), ALJs Gildea (3.4.1), Shaw (1.b), Pender (9.5), Lord (4.4.1), and Essex (4.4.1) require that each deposing party give the deponent at least 10 days notice for depositions in the United States, or at least 15 days for international depositions.
- ALJ Bullock has no such requirement.
- ALJ Gildea (3.4.1.1) has special titling and filing requirements for any deposition notice of a party in Japan.

Markman Briefs and Hearings

- ALJs Bullock (5A), Essex (5A), Gildea (1.15), and Lord (5A) will hold a *Markman* hearing if they consider it useful.
- ALJ Pender's (4.3) Procedural Schedule lists a *Markman* hearing in each case, though the *Markman* hearing is optional.
- ALJ Shaw (6.c) has never held a *Markman* Hearing.
- ALJ Gildea (1.15) has a 150 page limit on *Markman* briefs, with a 100 page limit on response *Markman* briefs.

Number of Patents and Claims

- ALJ Shaw (6) requires that for investigations that involve more than 4 utility patents or 32 utility patent claims, complainant must file a bi-weekly declaration detailing efforts to reduce the number of patents and claims at issue.

Mediation

- All ALJs require the parties to engage in at least two settlement conferences as listed on the procedural schedule.
- ALJs Bullock (7) and Lord (7) require additional attendance at a one-day mediation program, as structured by the Revised Users' Manual for Commission Mediation Program.
- The Commission's Mediation Program is optional for all other ALJs.

Witness Statements

- ALJs Bullock (9.3), Essex (9.4.1), Pender (14.3), Shaw (8.a), and Lord (9.3), require the use of witness statements for all direct witness testimony, with the exception of adverse or third party witnesses.
- ALJ Gildea (8.3.1) rarely allows any witness statements, and greatly prefers live testimony.
- ALJ Shaw has recently modified his Ground Rules (8) to require that all direct witnesses be deposed prior to the submission of their witness statement. *See, Certain Standard Cell Libraries, 337-TA-906, Order No. 6: Issuance of Amended Ground Rules (U.S.I.T.C. March 5, 2014).* No other ALJ has this requirement.

High Priority Objections

- ALJs Bullock (8.3), Gildea (8.6.10), Essex (8.2), Pender (13), Shaw (9.e), and Lord (8.3), allow parties to designate up to 10 High Priority Objections to documents or evidence that will be resolved prior to trial. Other objections are reserved for trial.

Closing Arguments

- Judge Essex (10.2) typically does not allow opening or closing arguments but parties can request one or both and will be allowed at discretion of Judge.
- ALJs Bullock (10.1), Lord (10.1), and Pender (14.6.1) allow brief opening statements but normally do not schedule closing arguments (10.2; 14.6.2).
- ALJ Gildea (9.2) does not require opening or closing but can do opening if requested. Parties must request closing arguments which are granted at ALJ's discretion.
- ALJ Shaw (8.f) allows opening but does not address closing arguments in his Ground Rules.

Questions?

Scott J. Pivnick
Scott.Pivnick@alston.com
Alston & Bird LLP
950 F Street, N.W.
Washington, D.C.
(202) 239-3300

Thank You For Your Attendance!