

## **PATENT TRIAL AND APPEAL BOARD**

### **STANDARD OPERATING PROCEDURE 2 (REVISION 10)**

#### **PRECEDENTIAL OPINION PANEL TO DECIDE ISSUES OF EXCEPTIONAL IMPORTANCE INVOLVING POLICY OR PROCEDURE**

#### **PUBLICATION OF DECISIONS AND DESIGNATION OR DE-DESIGNATION OF DECISIONS AS PRECEDENTIAL OR INFORMATIVE**

This Standard Operating Procedure (SOP) addresses the designation of a Precedential Opinion Panel in adjudications before the Patent Trial and Appeal Board (Board) to decide issues of exceptional importance (e.g., involving agency policy or procedure). The SOP sets forth the composition of the Precedential Opinion Panel, describes the mechanisms for invoking Precedential Opinion Panel review of a Board decision recently issued in a pending case, and explains the Precedential Opinion Panel review process. Unless otherwise designated, Precedential Opinion Panel decisions will set forth binding agency authority.

This SOP further addresses the publication of Board decisions and the review procedure for designating Board decisions, other than Precedential Opinion Panel decisions, as precedential or informative authority for the Board. The review procedure includes a process by which an Executive Judges Committee evaluates decisions nominated for precedential or informative designation. As part of this process, the Executive Judges Committee also may solicit and evaluate comments from all members of the Board to determine whether to recommend the nominated decision for designation as precedential or informative.

Finally, this SOP includes a procedure for de-designating precedential decisions and informative decisions.

No decision will be designated or de-designated as precedential or informative without the approval of the Director. This SOP does not limit the authority of the Director to designate or de-designate decisions as precedential or informative, or to convene a Precedential Opinion Panel to review a matter, in his or her sole discretion without regard to the procedures set forth herein. Nor does this SOP limit the Director's authority to issue, at any time and in any manner,

policy directives that are binding on any and all USPTO employees, including policy directives concerning the implementation of statutory provisions. *See, e.g.*, 35 U.S.C. §3(a)(2)(A); *see also, e.g.*, 35 U.S.C. §§ 3(a)(1), 2(b)(2)(A), 316(a), 326(a).

This SOP sets forth internal norms for the administration of PTAB. It does not create any legally-enforceable rights. The actions described in this SOP are part of the USPTO's deliberative process.

## I. PURPOSE

### A. Precedential Opinion Panel Review

The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (Director), who is a statutory member of the Board (35 U.S.C. § 6(a)), is “responsible for providing policy direction and management supervision for the Office” (35 U.S.C. § 3(a)(2)(A)), and has “the authority to govern the conduct of proceedings in the Office” (35 U.S.C. § 2(b)(2)(A)). The Director has an interest in creating binding norms for fair and efficient Board proceedings, and for establishing consistency across decision makers under the Leahy-Smith America Invents Act (35 U.S.C. §§ 311-329; Section 18 of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329 (2011)) and, to the extent applicable, for patent examination, for example, in *ex parte* appeals and reexamination appeals.

### B. Publication of Decisions and Designation of Decisions as Precedential or Informative

The Administrative Procedure Act requires that “[e]ach agency shall make available to the public . . . final opinions, including concurring and dissenting opinions, as well as orders, made in the adjudication of cases.” 5 U.S.C. § 552(a)(2)(A). Since August 1997, Board decisions have been made available to

the public through the electronic posting of most<sup>1</sup> final Board decisions (<http://e-foia.uspto.gov/Foia/PTABReadingRoom.jsp>; <https://ptab.uspto.gov>). A decision, as used in this SOP, refers to any Board decision, opinion, or order, or the rehearing decision of any Board decision, opinion, or order.

The Board enters thousands of decisions every year. Every decision other than a precedential decision by the Precedential Opinion Panel is, by default, a routine decision. A routine decision is binding in the case in which it is made, even if it is not designated as precedential or informative, but it is not otherwise binding authority. This SOP provides a mechanism for highlighting certain Board decisions by designating them as precedential or informative.

### C. Procedures for De-designation

This SOP also provides a procedure for de-designating decisions previously designated as precedential or informative when they should no longer be designated as such, for example, because they have been rendered obsolete by subsequent binding authority, are inconsistent with current policy, or are no longer relevant to Board jurisprudence. No decision will be de-designated without the approval of the Director.

## II. PRECEDENTIAL OPINION PANEL REVIEW FOR ESTABLISHING BINDING AGENCY AUTHORITY

### A. Criteria for Precedential Opinion Panel Review

The Precedential Opinion Panel generally will be used to establish binding agency authority concerning major policy or procedural issues, or other issues of exceptional importance in the limited situations where it is appropriate to create such binding agency authority through adjudication before the Board. For example, and among other things, the Precedential Opinion Panel may be used to

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<sup>1</sup> Electronic publication of most decisions depends on whether the underlying application is entitled to confidentiality. 35 U.S.C. § 122. Since November 2000, only a relatively small number of decisions remain confidential.

address constitutional questions; important issues regarding statutes, rules, and regulations; important issues regarding binding or precedential case law; or issues of broad applicability to the Board. The Precedential Opinion Panel also may be used to resolve conflicts between Board decisions, to promote certainty and consistency, or to rehear any case it determines warrants the Panel's attention.

#### B. Composition of the Precedential Opinion Panel

35 U.S.C. § 6(c) provides that proceedings at the Board "shall be heard by at least 3 members of the Patent Trial and Appeal Board [Board], who shall be designated by the Director." The Board is composed of the Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges. 35 U.S.C. § 6(a). The Board further includes a Chief Administrative Patent Judge ("Chief Judge"), a Deputy Chief Administrative Patent Judge ("Deputy Chief Judge"), and a number of Operational Vice Chief Administrative Patent Judges ("Operational Vice Chief Judges").

The Precedential Opinion Panel members are selected by the Director, and by default shall consist of the Director, the Commissioner for Patents, and the Chief Judge. The Director (or the Director's delegate) may determine that a panel of more than three members is appropriate in certain circumstances. The Director may also, in his or her discretion, replace the default members of the Panel with the Deputy Director, the Deputy Chief Judge, or an Operational Vice Chief Judge, in any case. The three primary members of the Precedential Opinion Panel may each decide to delegate their authority under certain circumstances. Decisions on delegation of authority will be made in the following order: (1) first the Director will decide whether to delegate his or her authority; (2) next, the Commissioner for Patents; and (3) finally, the Chief Judge. The authority of each of these three members of the Precedential Opinion Panel may be delegated to one of the following individuals, in the following order and based on availability: the Deputy Director; the Deputy Chief Judge; or an Operational Vice Chief Judge in order of seniority. No individual may receive the delegated authority of more than one member of the Precedential Opinion Panel. A Precedential Opinion Panel member's authority may be delegated for reasons including conflicts of interest

and availability or when the issues to be decided are directed to procedural aspects of practice before the Board.<sup>2</sup>

### C. Obtaining Precedential Opinion Panel Review

The Director may convene a Precedential Opinion Panel to review a decision in a case and determine whether to order sua sponte rehearing, in his or her sole discretion and without regard to the procedures set forth herein.

The Precedential Opinion Panel may also be recommended in the following ways:

1. Any party to a proceeding may recommend Precedential Opinion Panel review of a particular Board decision in that proceeding. Such a recommendation must be submitted by email to [Precedential\\_Opinion\\_Panel\\_Request@uspto.gov](mailto:Precedential_Opinion_Panel_Request@uspto.gov). The email must identify with particularity the reasons for recommending Precedential Opinion Panel review. The email must be accompanied by a request for rehearing filed with the Board, which must satisfy the requirements of 37 C.F.R. § 41.52(a) or 42.71(d), as applicable, including the due dates set forth therein. Counsel for all other parties must be included as recipients of the email. In addition, the email must contain at least one of the following statements of counsel at the beginning:

Based on my professional judgment, I believe the Board panel decision is contrary to the following decision(s) of the Supreme Court of the United States, the United States Court of Appeals for the Federal Circuit, or the precedent(s) of the Board: (cite specific decisions).

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<sup>2</sup> This SOP does not limit the authority of the Director to convene a Precedential Opinion Panel consisting of any Board members, including statutory members, at any time, to review any matter before the Board, in his or her sole discretion.

Based on my professional judgment, I believe the Board panel decision is contrary to the following constitutional provision, statute, or regulation: (cite specific provision, statute, or regulation).

Based on my professional judgment, I believe this case requires an answer to one or more precedent-setting questions of exceptional importance (set forth each question in a separate sentence).

/s/ [signature]

ATTORNEY OF RECORD FOR [list party/parties].

2. In addition to the Commissioner for Patents and the Chief Judge, any other member of the Board may recommend Precedential Opinion Panel review of a particular Board decision, provided that such recommendation complies with the due dates set forth 37 C.F.R. §§ 41.52(a) or 42.71(d). Such a recommendation must be submitted by email to [Precedential Opinion Panel Request@uspto.gov](mailto:Precedential_Opinion_Panel_Request@uspto.gov). The email must identify with particularity the reasons for suggesting Precedential Opinion Panel review.

There is no right to further review of a recommendation for Precedential Opinion Panel Review that is not granted.

#### D. Precedential Opinion Panel Review Process

A Screening Committee will review the recommendations for Precedential Opinion Panel review submitted under § II.C.1 and § II.C.2, above. The Screening Committee shall be comprised of the members of the Precedential Opinion Panel, or their designees, typically in equal numbers (for example, 3 designees of each of the Chief Judge, Commissioner for Patents, and Director). The designees must be USPTO employees with a legal degree, selected from the group of:

- PTAB Administrative Patent Judges;
- The Deputy Director;
- Individuals with a grade of SES or SL reporting directly or indirectly to the Commissioner for Patents, Deputy Commissioner for Patent Examination

Policy, Deputy Commissioner for Patent Operations, or Deputy Commissioner for Patent Quality; or

- Attorneys reporting directly or indirectly to the General Counsel or Solicitor.

The Screening Committee will forward its recommendations to the Director.

Where appropriate, the Director will convene a Precedential Opinion Panel to decide whether to grant rehearing and, if rehearing is granted, to render a decision on rehearing in the case.

In all instances in which Precedential Opinion Panel review is ordered, the Precedential Opinion Panel will enter an order notifying the parties and the public when the Precedential Opinion Panel has been designated and assigned to a particular Board case. The order will further identify the issues the Precedential Opinion Panel intends to resolve and the composition of the panel. The Precedential Opinion Panel may request additional briefing on identified issues, and, in appropriate circumstances, may further authorize the filing of amicus briefs. The Precedential Opinion Panel may order, at its discretion, an oral hearing. Once the case has been assigned to the Precedential Opinion Panel, the Precedential Opinion Panel will render a decision in the case resolving the identified issues.

The Precedential Opinion Panel will maintain authority over all issues in the case while the case is under Precedential Opinion Panel review. The Precedential Opinion Panel may, however, delegate authority back to the prior Board panel assigned to the case to handle routine interlocutory matters, conduct conference calls, or attend to other matters outside of the intended scope of the Precedential Opinion Panel review, among other things. If authority is so delegated, the prior Board panel assigned to the case will keep the Precedential Opinion Panel apprised of these matters and provide reasonable prior notice of any intended decision, but may handle matters so delegated without direction from the Precedential Opinion Panel.

If further proceedings in the case are warranted after the Precedential Opinion Panel decision is rendered, the prior Board panel assigned to the case typically will conduct those proceedings.

#### E. Effect of Precedential Opinion Panel Decision

Opinions of the Precedential Opinion Panel shall have the effect described in § III.D, below.

The Director may designate any decision by any panel, including the Precedential Opinion Panel, as precedential without regard to the procedures set forth herein. No decision may be designated as precedential without the Director's approval. Precedential decisions entered by the Precedential Opinion Panel shall be labeled "Precedential." Precedential decisions shall be posted to the Board's Precedential Decisions Web page<sup>3</sup> and may be sent to commercial reporters that routinely publish Board decisions.

The Precedential Opinion Panel may also choose to designate its decision as routine when, e.g., the decision in retrospect is no longer of precedent-setting importance. In its discretion, the Precedential Opinion Panel may alternatively choose to designate its decision as informative, for example when it meets the criteria for an informative decision described in § III.A, below.

Opinions of the Precedential Opinion Panel may be de-designated in accordance with the procedures set forth in § IV, below.

### III. DESIGNATING AN ISSUED DECISION AS PRECEDENTIAL OR INFORMATIVE

Every Board decision, other than a Precedential Opinion Panel decision, is a routine decision until it is designated as precedential or informative. A routine decision is binding in the case in which it is made, even if it is not designated as

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<sup>3</sup> <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions>



precedential or informative, but is not otherwise binding authority. The sections below set forth a procedure for nomination, review, and designation of issued decisions (other than decisions entered by the Precedential Opinion Panel) as precedential or informative.

#### A. Nominating Process for Precedential or Informative Designation

Any person, including for example Board members and other USPTO employees and members of the public, may nominate a routine decision of the Board for designation as precedential or informative. An informative decision may similarly be nominated for precedential designation.

Nominations for precedential or informative designation must set forth with particularity the reasons for the requested designation. Persons nominating such a decision must also identify any other Board decisions of which they are aware that may be in conflict with the nominated decision. Nominations should be submitted by email to [PTAB\\_Decision\\_Nomination@uspto.gov](mailto:PTAB_Decision_Nomination@uspto.gov).

Nominated decisions may be considered for precedential designation for generally the same reasons described in § II.A, above. For example and among other things: constitutional questions; important issues regarding statutes, rules, and regulations; important issues regarding binding or precedential case law; or issues of broad applicability to the Board. The precedential designation may also be used to resolve conflicts between Board decisions and to promote certainty and consistency among Board decisions.

Nominated decisions may be considered for informative designation for reasons including, for example: (1) providing Board norms on recurring issues; (2) providing guidance on issues of first impression to the Board; (3) providing guidance on Board rules and practices; and (4) providing guidance on issues that may develop through analysis of recurring issues in many cases (e.g., factors to consider on institution decisions).

The Screening Committee as defined in § II.D, above, will review the nominated decisions and make recommendations as to which cases should be

further reviewed for designation as precedential or informative. This further review is performed by an Executive Judges Committee.

## B. Executive Judges Committee

The Executive Judges Committee will provide a recommendation to the Director on whether or not to designate a decision, or a portion thereof, as precedential or informative.

### 1. Composition of the Executive Judges Committee

The Executive Judges Committee consists of five members, and includes the Chief Judge, the Deputy Chief Judge and the Operational Vice Chief Judges, in order of seniority and based on availability.

### 2. Executive Judges Committee Review Process

As part of its evaluation, the Executive Judges Committee may solicit and review comments from members of the Board. To that end, the Executive Judges Committee may present the nominated decision to all members of the Board for comment during a Board review period. During the Board review period, which typically will be five business days, any member of the Board may submit written comments to the Executive Judges Committee regarding whether the decision should be designated as precedential or informative. The Executive Judges Committee may share the comments with all members of the Board. After the expiration of the Board review period, the Executive Judges Committee will compile and evaluate the received comments, and shall determine by majority vote of the Executive Judges Committee whether or not to recommend the decision for designation as precedential or informative.

## C. Designating a Decision as Precedential or Informative

The Executive Judges Committee shall submit its designation recommendation to the Director, with an explanation for the recommendation. The Director may consult with others, including, for example, the members of the

Precedential Opinion Panel and members of the Office of the General Counsel. No decision or portion thereof may be designated as precedential or informative pursuant to these procedures without the Director's approval. If the Director determines that the decision or portion thereof should be designated as precedential or informative, the Director will notify the Chief Judge.<sup>4</sup>

The decision to be designated will then be published or otherwise disseminated following notice and opportunity for written objection afforded by 37 C.F.R. § 1.14, in those instances in which the decision would not otherwise be open to public inspection because a patent application is preserved in confidence pursuant to 35 U.S.C. § 122(a).

Decisions, or portions thereof, designated as precedential or informative shall be labeled "Precedential" or "Informative," respectively, and include the date on which the decision is so designated. If a portion of a decision is designated as precedential or informative, an indication of that portion shall be included in the label. Precedential and informative decisions shall be posted electronically on the Board's Precedential and Informative Decisions Web page and may be sent to commercial reporters that routinely publish Board decisions.

#### D. Effect of Precedential or Informative Designation

A precedential decision is binding Board authority in subsequent matters involving similar facts or issues.

Informative decisions set forth Board norms that should be followed in most cases, absent justification, although an informative decision is not binding authority on the Board.

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<sup>4</sup> This SOP does not limit the authority of the Director to designate or de-designate an issued decision or portion thereof as precedential or informative at any time, in his or her sole discretion.

A decision previously designated as precedential or informative under a prior version of SOP 2 (and not previously de-designated) shall remain precedential or informative unless de-designated under § IV of this SOP.

#### IV. DE-DESIGNATING A PRECEDENTIAL OR INFORMATIVE DECISION

Any person, including for example Board members and other USPTO employees and members of the public, may suggest that a Board decision designated as “Precedential” or “Informative” should no longer be designated as such, for example because it has been rendered obsolete by subsequent binding authority, is inconsistent with current policy, or is no longer relevant to Board jurisprudence. Nominations for de-designation should be submitted by email to [PTAB\\_Decision\\_Nomination@uspto.gov](mailto:PTAB_Decision_Nomination@uspto.gov).

If the Director determines that the particular Board decision should no longer be designated as such, the subject Board decision will be de-designated. The Chief Judge will notify the Board that the decision has been de-designated. The decision will be removed from the Board’s Precedential and Informative Decisions Web page and the public will be notified that the decision has been de-designated.