

MEMORANDUM

August 10, 2005

TO: Vice Chief Administrative Patent Judge
Administrative Patent Judges

FROM: MICHAEL R. FLEMING
Chief Administrative Patent Judge

SUBJECTS: Standard Operating Procedure 1 (Revision 12)
Assignment of judges to merits panels, motions panels, and expanded panels

The attached document supersedes Board of Patent Appeals and Interferences' Standard Operating Procedure 1 (Revision 11) dated August 11, 2004, on the same subject matter. The significant changes in this revision include:

- updating the SOP to reflect our new organizational structure;
- updating the "Group Listings" from which expanded panels are to be selected to reflect the new organizational structure.

Attachment

Cc: Amalia Santiago
Chief Board Administrator

BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 1 (REVISION 12)

ASSIGNMENT OF JUDGES TO MERITS PANELS, MOTIONS PANELS, AND EXPANDED PANELS

The following applies to the assignment of judges to merits panels,¹ motions panels,² and expanded panels³ in *ex parte* appeals and interferences.⁴

Except as provided in section V.C. of this Standard Operating Procedure, assignments (designations under 35 U.S.C. § 6) of Administrative Patent Judges to panels of the Board of Patent Appeals and Interferences are made by the Chief Board Administrator, assisted by the Program and Resources Administrators, under the direction of the Chief Administrative Patent Judge (Chief Judge). The Director's authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. *See Manual of Patent Examining Procedure* § 1002.02(f) (8th ed., rev.2, May 2004).

This Standard Operating Procedure creates internal norms for the administration of the Board of Patent Appeals and Interferences (Board). It does not create any legally enforceable rights. The procedures described in this Standard Operating Procedure (SOP), as they pertain to determinations and comments made by the Chief Judge and any other Judge, are considered part of the deliberative process.

I. Administrative Divisions of the Board

A. The Chief Administrative Patent Judge (Chief Judge) and the Vice Chief Administrative Patent Judge (Vice Chief Judge) are *ex officio* members of all administrative divisions and may administer interferences or otherwise participate in rendering panel decisions.

B. The Administrative Patent Judges (judges) of the Board are assigned to one of five divisions. These divisions include the Biotechnology Division, the Chemical Division, the Electrical Division, the Mechanical Division and the Trial Division.

¹ Three-judge panels designated to decide *ex parte* appeals and enter final decisions in interferences.

² Three-judge panels designated to enter interlocutory orders where a panel is appropriate, including, e.g., requests for reconsideration of non-final decisions in interferences.

³ Panels consisting of more than three judges.

⁴ A merits or motions panel may include all judges (including any senior judge) assigned to the Trial Procedure Section of the Trial Division when an interference assigned to the Trial Procedure Section involves a significant procedural issue applicable to proceedings before the Trial Procedure Section and the Trial Procedure Section judges deem it appropriate to issue an opinion binding on the Trial Procedure Section.

II. Divisional responsibilities for *ex parte* appeals

A. In general, one judge from either the Chemical Division or the Biotechnology Division, and one judge from each of the Electrical Division and the Mechanical Division will be designated as the merits panel to decide *ex parte* design appeals.

B. In general, a merits panel to decide *ex parte* appeals originating in Technology Center 1600 will be selected from judges assigned to the Biotechnology Division.⁵

C. In general, a merits panel to decide *ex parte* appeals originating in Technology Center 1700 will be selected from judges assigned to the Chemical Division.

D. In general, a merits panel to decide *ex parte* appeals originating in Technology Centers 2100, 2600 and 2800 will be selected from judges assigned to the Electrical Division.

E. In general, a merits panel to decide *ex parte* appeals originating in Technology Centers 3600 and 3700 will be selected from judges assigned to the Mechanical Division.

F. Judges assigned to the Trial Division may be assigned to merits panels deciding *ex parte* appeals from time-to-time dependent on their technical backgrounds.

G. Concerning panel assignments of *ex parte* appeals involving judges of the Trial Division, the following will generally apply:

1. Judges assigned to the Trial Procedures Section generally will not be assigned as the second or third judge on any *ex parte* appeal.
2. Judges assigned to the Trial Procedures Section generally will not be assigned to *ex parte* oral hearings.
3. In general, a merits panel to decide re-examinations and *ex parte* re-issues will be selected from judges assigned to the Trial Merits Section.

III. Inter-Divisional Panels in Appropriate Cases

Where appropriate (based on the technology and/or legal issue involved), one judge from the Chemical Division or the Biotechnology Division, one judge from the Electrical Division, and one judge from the Mechanical Division may be designated as the merits panel to decide an *ex parte* appeal.

Where appropriate (based on the technology and/or legal issue involved), one or more judges from any of the Biotechnology, Chemical, Electrical or Mechanical Divisions may be designated as members of an interference panel.

⁵ In general, a merit panel to decide *ex parte* appeals originating in Technology Center 1600 involving chemistry of a non-pharmaceutical nature will generally be assigned to a merits panel of judges selected from the Chemical Division.

IV. Expanded Panels

From time to time it may be necessary to expand a merits or motions panel. The following applies to the use of expanded panels.

A. Reasons for expanding a panel include:

1. An issue of exceptional importance, such as where serious questions have been raised about the continuing viability of an apparently applicable prior precedential opinion of the Board.
2. Conflicting decisions by different panels of the Board.
3. A substantial difference of opinion among judges on a significant issue pending before the Board.
4. A written request from the Commissioner for Patents or the Commissioner's delegate identifying a particular appeal as one containing an issue of first impression, which written request shall become part of the administrative record. This request may be made in advance of decision by the Board or in connection with a request for rehearing.
5. A written request from the Commissioner for Patents or the Commissioner's delegate identifying a particular appeal as one presenting an issue governed by a prior decision of the Board,
 - a) representing that the Commissioner for Patents has determined that it would not be in the public interest to follow the prior decision, and
 - b) asking the Board to reconsider and overrule the prior decision,which written request shall become part of the administrative record. This request may be made in advance of decision by the Board or in connection with a request for rehearing.

B. Generally seven judges will be designated to decide cases in which an expanded panel is to be used. The Chief Judge will determine when an expanded panel is to be designated.

C. A judge, a merits panel, or a motions panel may suggest to the Chief Judge the need for the designation of an expanded panel. Likewise, the Patent Examining Operation, an applicant or patent owner in an *ex parte* appeal, or a party in an interference may suggest the need for an expanded panel.

D. When an expanded panel is designated (1) after a case initially has been assigned to a three-judge panel and (2) before a decision is entered by the merits panel, the judges initially designated shall be designated as part of the expanded panel.

E. When an expanded panel is designated (1) after entry of a decision by a merits panel and

(2) to consider a request for rehearing of the decision of the merits panel, the judges on the merits panel shall be designated as part of the expanded panel. The expanded panel shall decide the rehearing on its merits.

F. Generally, expanded panels will include the Chief Judge, the Vice Chief Judge, and five additional judges to be assigned by the Chief Judge. The selection of the five additional judges shall be based on the type of case from the "Group Listings" set out below. Generally, a Senior Judge is not participate in expanded panel decisions unless that Senior Judge was a member of an original three-member panel which has been expanded prior to decision or on rehearing; nevertheless assignment of a Senior Judge to an expanded panel shall be at the discretion of the Chief Judge.

G. When the Chief Judge is disqualified, recused, or otherwise unable to sit, judges shall be assigned by the Vice Chief Judge and the Vice Chief Judge shall preside.

H. When the Chief Judge and the Vice Chief Judge are disqualified, recused, or otherwise unable to sit, the judges shall be assigned by the Chief Board Administrator and the most senior judge shall preside.

I. In an appropriate circumstance, the Chief Judge may designate an expanded panel consisting of more or less than seven judges, including an expanded panel consisting of all judges, to decide a case.

J. Generally, "Group Listings" from which expanded panels are to be selected to the extent possible are as follows:

1. An interference with a significant issue of general applicability within the Trial Division:

- a) Chief Judge
- b) Vice Chief Judge
- c) Four judges from the Trial Division
- d) One judge from the Chemical Division, the Biotechnology Division, the Electrical Division, or the Mechanical Division.

2. An *ex parte* appeal with a significant issue of general applicability within all Divisions or a significant design issue:

- a) Chief Judge
- b) Vice Chief Judge
- c) One judge from the Chemical Division
- d) One judge from the Biotechnology Division
- e) One judge from the Electrical Division
- f) One judge from the Mechanical Division
- g) One judge from the Trial Division.

3. An *ex parte* appeal with a significant issue of general applicability within essentially only the Biotechnology Division:

- a) Chief Judge
- b) Vice Chief Judge
- c) Four judges from the Biotechnology Division or the Trial Division (having a biotechnology background).
- d) One judge from the Chemical Division, the Electrical Division, or the Mechanical Division

4. An *ex parte* appeal with a significant issue of general applicability within essentially only the Chemical Division:

- a) Chief Judge
- b) Vice Chief Judge
- c) Four judges from the Chemical Division or the Trial Division (having a chemical background).
- d) One judge from the Biotechnology Division, the Electrical Division, or the Mechanical Division

5. An *ex parte* appeal with an issue of general applicability essentially only within the Electrical Division:

- a) Chief Judge
- b) Vice Chief Judge
- c) Four judges from the Electrical Division or the Trial Division (having an electrical background)
- d) One judge from the Chemical Division, the Biotechnology Division, or the Mechanical Division.

6. An *ex parte* appeal with an issue of general applicability essentially only within the Mechanical Division:

- a) Chief Judge
- b) Vice Chief Judge
- c) Four judges from the Mechanical Division or the Trial Division (having a mechanical background)
- d) One judge from the Chemical Division, the Biotechnology Division, or the Electrical Division.

7. An expanded panel in an interference with a significant patentability issue will be designated in accordance with the guidelines for *ex parte* cases, except that an interference merits panel will be assigned and all judges on the interference merits panel will be designated on the expanded panel. After a decision is entered by the expanded panel on the patentability issue, the interference may, if appropriate, be

remanded to the interference three-judge merits panel for further proceedings not inconsistent and for entry of a judgment consistent with the decision of the expanded panel on the patentability issue.

K. All decisions by an expanded panel of 7 or more judges will be circulated to each judge of the Board *prior* to entry of the decision. Within two weeks, each judge *not* designated on the panel may comment on the decision. Comments shall be in writing (for purposes of this Standard Operating Procedure, comments “in writing” include comments transmitted by e-mail) and shall be presented to each member of the expanded panel, with a copy to the Chief Judge and Vice Chief Judge.

V. Assignment of Cases to Judges

A. A panel designation will be provided for each appeal and interference.

B. A judge assigned to handle an interference should arrange for a substitute judge to act on cases in the absence (i.e., leave, etc.) of the judge assigned to the interference.

C. Except where a party requests and agrees to entry of a *pro forma* adverse judgment under 37 CFR § 41.127(b), whenever a decision in an interference proceeding requires entry by a panel of judges, the judge to whom the interference is assigned shall request the Chief Board Administrator to assign a panel. In the instance of an interference proceeding assigned to one of the members of the Trial Procedure Section, no request to the Chief Board Administrator is ordinarily required.

D. The judges designated on a merits panel, motions panel, or expanded panel shall not be changed without authority of the Chief Judge or the Vice Chief Judge. When satisfied that there is good reason to change the panel already designated, the Chief Judge or Vice Chief Judge will approve a revised designation after making whatever changes are determined to be appropriate or will direct the Chief Board Administrator to enter a revised designation. From time to time, the Chief Judge may authorize other employees of the Board to alter the panel already designated.

E. A reasonable effort should be made to preserve the roles of judges assigned as the Number 1, Number 2, and Number 3 judges in *ex parte* appeals. However, when the judge assigned the role of Number 1 is of the opinion that it would be in the interest of efficient administration of the Board, the judge assigned the role of Number 1 is authorized to change the roles of judges assigned the roles of Number 2 and Number 3. An instance in which it would be appropriate to change the roles is when the judge assigned the role of Number 2 is on leave for more than a brief period of time. If, after conference with the other judges assigned to the appeal, the judge initially assigned the role of Number 1 is not part of the majority, one of the judges initially assigned the roles of Number 2 and Number 3 will author the majority opinion. Any member of a panel may request that the conference include all members of the panel.

