

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Boardside Chat: NPRM and SOPs for PTAB Decision Circulation, Internal PTAB Review, and Remands

Melissa Haapala, Vice Chief Administrative Patent Judge

November 16, 2023



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov

Agenda

- I. Background
- II. Notice of Proposed Rulemaking
- III. Standard Operating Procedure 4
- IV. Standard Operating Procedure 3

I. Background

Background

The Patent Trial and Appeal Board (PTAB) is made up of administrative patent judges (APJs) and four statutory members:

- the USPTO Director,
- the USPTO Deputy Director,
- the USPTO Commissioner for Patents, and
- the USPTO Commissioner for Trademarks.



Background (*cont.*)

- In panels of at least three members, the PTAB hears and decides:
 - appeals of adverse decisions by examiners in applications for patents;
 - appeals of adverse decisions by examiners in reexamination proceedings; and
 - proceedings under the AIA, including inter partes reviews, post-grant reviews, and derivation proceedings.
- Under 35 U.S.C. 6(c), the Director designates the members of each panel.
- The Director has delegated that authority to the Chief Judge of the Board.
 - See PTAB Standard Operating Procedure 1 (SOP 1), Page 1, Assignment of Judges to Panels
<https://www.uspto.gov/sites/default/files/documents/SOP%201%20R15%20FINAL.pdf>



Notice of proposed rulemaking and Standard Operating Procedures

- On May 26, 2022, the USPTO issued an interim process for PTAB decision circulation and internal review.
- On July 20, 2022, the USPTO issued a request for comments ("RFC").
- On October 5, 2023, the USPTO issued:
 - a notice of proposed rulemaking ("NPRM") (published Oct. 6)
 - Standing Operating Procedure ("SOP") 4
 - an updated SOP 9, which is now renumbered SOP 3.



General rulemaking process

- A proposed rule (NPRM) lays out how we plan to address a specific problem and requests comment on our plan.
 - It consists of proposed regulatory text and a preamble.
- After a proposed rule is published in the *Federal Register* . . . we can proceed to a final rule or, if the comments warrant, we can develop a different rule and re-propose it.

Pre-Issuance Internal Circulation and Review of Decisions within PTAB

NPRM: Proposed provisions

Summary


The USPTO proposes regulations to govern pre-issuance circulation and review of decisions within PTAB to promote the efficient delivery of reliable intellectual property rights by promoting consistent, clear, and open decision-making processes at the PTAB

Notice of proposed rulemaking

- Comments in response to the NPRM are due **December 5, 2023**
- All comments must be submitted in writing through the Federal eRulemaking Portal

Submit a formal comment

<https://www.regulations.gov/search?filter=PTO-P-2023-0012>

 PROPOSED RULE
Pre-Issuance Internal Circulation and Review of Decisions within the Patent Trial and Appeal Board
PTO-P-2023-0012] RIN 0651-AD68 Rules Governing Pre-Issuance Internal Circulation and Review of Decisions... To submit comments via the portal, one should enter docket number **PTO-P-2023-0012** on the homepage and
Agency Patent and Trademark Office | Posted Oct 5, 2023 | ID PTO-P-2023-0012-0001
 Comments Due Dec 5, 2023

Displaying 1 - 1 of 1 results



Submit a formal comment (cont.)

<https://www.federalregister.gov/documents/2023/10/06/2023-22218/rules-governing-pre-issuance-internal-circulation-and-review-of-decisions-within-the-patent-trial>



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PR Proposed Rule

Rules Governing Pre-Issuance Internal Circulation and Review of Decisions Within the Patent Trial and Appeal Board

A Proposed Rule by the [Commerce Department](#) on 10/06/2023



This document has a comment period that ends in 33 days. (12/05/2023)

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Proposed provisions governing pre-issuance internal circulation and review

- The USPTO proposes to **add part 43**, which provides for new regulations governing the pre-issuance circulation and review of decisions within the PTAB.

Structure of Part 43

- Section 43.1: Policy
- Section 43.2: Definitions
- Section 43.3: Director involvement
- Section 43.4: PTAB management involvement
- Section 43.5: PTAB non-management involvement
- Section 43.6: Controlling legal authority

§ 43.1: Policy

- Section 43.1: Sets forth **procedures for the pre-issuance circulation** and review within the Patent Trial and Appeal Board of draft panel decisions rendered in proceedings pending under Parts 41 and 42 of this chapter and sets forth the controlling legal authority, policy, and guidance applicable to the decisions of the Board.
 - Part 41: Appeals and interferences
 - Part 42: Trial practice

§ 43.2: Definitions

- Section 43.2: Set forth definitions for terms used in Part 43.
 - Board
 - Decision
 - Director
 - Deputy Director
 - Commissioner for Patents and Commissioner for Trademarks
 - Issuance
 - Management Judge
 - Panel
 - Proceeding

§ 43.3: No pre-issuance **Director involvement** in panel decisions

- Section 43.3: Specifies that the Director of the USPTO and other statutory members of the Board (Deputy Director and Commissioners for Patents and Trademarks) are not involved in panel decisions prior to their issuance, either directly or indirectly.
 - **§ 43.3(a)** prohibits the Director, Deputy Director, Commissioner for Patents, and Commissioner for Trademarks from communicating, directly or indirectly, with any member of a panel regarding a decision, **prior to issuance** of that decision by the panel.
 - **§ 43.3(b)** provides that paragraph **(a) does not apply** to any proceeding in which the individual is a member of the panel and also specifies that when sitting as a member of a panel, the individual is a coequal member of the panel.

§ 43.3: No pre-issuance **Director involvement** in panel decisions (*cont.*)

- Section 43.3: Specifies that the Director of the USPTO and other statutory members of the Board (Deputy Director and Commissioners for Patents and Trademarks) are not involved in panel decisions prior to their issuance, either directly or indirectly.
 - **§ 43.3(c)** clarifies that nothing in § 43.3 shall prevent the Director or their delegate from communicating with a panel as to **resource needs or the procedural status** of any proceeding.
 - **§ 43.3(d)** specifically delegates to the Chief Administrative Patent Judge the Director's **power to designate and re-designate panels** of the Board under 35 U.S.C. 6(c).
 - Prohibits the Director from directing or otherwise influencing the paneling or repaneling of any proceeding **prior to issuance** of the panel decision.

§ 43.4: Limited pre-issuance **management involvement** in decisions

- Section 43.4: Governs involvement by Board management or Office employees outside the Board in the review and circulation of decisions prior to issuance.
 - § 43.4(a) prohibits any **Management Judge or employee of the Office external to the Board** from initiating communication, directly or through intermediaries, with any member of a panel regarding a decision, prior to issuance of that decision.
 - § 43.4(b) provides an **exception to paragraph (a)** in the event a member of the panel optionally requests input from a Management Judge prior to issuance of the decision.

§ 43.4: Limited pre-issuance **management involvement in decisions (cont.)**

- Section 43.4: Governs involvement by Board management or Office employees outside the Board in the review and circulation of decisions prior to issuance.
 - **§ 43.4(c)** specifies that it is within the **panel's sole discretion to adopt any edits, suggestions, or feedback** provided by a Management Judge in response to an optional request for input, and the panel has the final authority and responsibility for the content of a decision.

§ 43.4: Limited pre-issuance management involvement in decisions (*cont.*)

- Section 43.4: Governs involvement by Board management or Office employees outside the Board in the review and circulation of decisions prior to issuance.
 - **§ 43.4(d)** provides that **paragraph (a) does not apply** to a Management Judge who is a member of the panel and specifies that when sitting as a member of a panel, a Management Judge is a coequal member of the panel and exercises no review authority over the proceeding.
 - **§ 43.4(e)** clarifies that nothing in § 43.4 shall prevent a Management Judge from communicating with a panel as to **resource needs or the procedural status** of any proceeding.

§ 43.5: Review of decisions by **non-management judges**

- Section 43.5: Governs procedures for circulation of decisions to, and review of decisions by, a designated group of non-Management Judges (e.g., Circulation Judge Pool) if the Office sets forth procedures for such circulation.
 - **§ 43.5(a)** provides that **no Management Judge** shall participate in any such circulation and review procedures.
 - Reviewing Non-Management Judges **will not discuss substance** with a Management Judge prior to issuance unless the Management Judge is a member of the panel

§ 43.5: Review of decisions by non-management judges (cont.)

- Section 43.5: Governs procedures for circulation of decisions to, and review of decisions by, a designated group of non-Management Judges (e.g., Circulation Judge Pool) if the Office sets forth procedures for such circulation.
 - **§ 43.5(b)** specifies that **any edits, suggestions, or feedback** provided, following circulation and review to the designated group of non-Management Judges, **are optional** and in the sole discretion of a panel to accept.
 - **Panel has final authority** and responsibility for the content of a decision and determines whether and how to incorporate any feedback provided.

§ 43.6: Controlling legal authority; No unwritten or non-public binding policy or guidance

- Section 43.6: Provides that all decisions of the Board are expected to comport with all applicable statutes, regulations, binding case law, and written agency policy and guidance applicable to Board proceedings.
 - Specifies there is **no unwritten agency or Board policy or guidance** that is binding on any panel of the Board.
 - Requires that **all written policy or guidance binding on panels** of the Board shall be **made public**.

Submit a formal comment

<https://www.federalregister.gov/documents/2023/10/06/2023-22218/rules-governing-pre-issuance-internal-circulation-and-review-of-decisions-within-the-patent-trial>



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LEAP



- [Legal Experience and Advancement Program \(LEAP\)](#)
- Designed to:
 - Aid in development of the next generation of patent practitioners
 - Encourage a diverse group of advocates to develop their skills before the PTAB
- To qualify, a patent agent or attorney must have:
 - Three or fewer substantive oral arguments in any federal tribunal, including PTAB

Audience Questions

Procedure for Pre-Issuance Optional Decision Review and
Post-Issuance Decision Review

Standard Operating Procedure 4 (SOP4)

SOP4

- Replaces the interim process for PTAB decision circulation and internal PTAB review.
- Provides further details regarding the internal circulation process and the structure of the reviewing body of non-management judges (currently embodied by the Circulation Judge Pool).
- Provides details regarding post-issuance review.
- Note: some provisions in SOP4 overlap with proposed NPRM rules. These provisions set forth the current process while the proposed rules are pending.

SOP4: Circulation Judge Pool (CJP)

- CJP is a representative group of at least six non-management peer PTAB judges; open to any non-management PTAB judge.
- Any panel member, **at their sole discretion**, may choose to circulate a draft decision to CJP.
- For each reviewed decision, CJP may provide the panel with:
 - Potential conflicts or inconsistencies with relevant authority; and
 - Potential inconsistencies with other PTAB decisions and suggestions for improved readability and stylistic consistency.
- Each decision reviewed by CJP is typically reviewed by two CJP members.

SOP4: Circulation Judge Pool (*cont.*)

- CJP may have periodic meetings with PTAB Executive Management to discuss **issued** decisions that address a notable issue, issued decisions that potentially conflict with relevant authority, and general areas of potential policy clarification.
- PTAB Executive Management may discuss issues or issued decisions with the Director for (i) considering whether to issue new or updated policies or guidance; and (ii) considering *sua sponte* review of a decision.

SOP4: Optional pre-issuance consultation with PTAB management

- Any panel member, at their sole discretion, may optionally request input from a designated PTAB Management Pre-Issuance Review team.
 - Input may include information regarding potential conflicts or inconsistencies with relevant authority or other PTAB decisions.
 - PTAB Management review team may consult with senior management in another USPTO business unit (e.g., Solicitor’s Office) for input and may share input it receives with panel. If a panel member seeks such input, it may indicate that in its request for optional pre-issuance management review.
 - Adoption of any suggestions provided by PTAB management based on such consultation is **optional**.
- Unless consulted by a panel member, PTAB management does not make suggestions to the panel on any pre-issuance decisions, either directly or indirectly through CJP.
- As with CJP’s feedback, the **panel has final authority** and responsibility for the content of a decision, and determines whether and how to incorporate feedback from PTAB management.

SOP4: Post-issuance review

- A PTAB Post-Issuance Review team reviews issued PTAB decisions for consideration for *sua sponte* Director review or policy clarification.
- The Post-Issuance Review team may identify decisions that address an issue of first impression, appear inconsistent with relevant authority, or involve an area where policy clarification may be needed and flag decisions for PTAB Executive Management.
- PTAB Executive Management determines whether to raise decisions to the Director for further attention, such as *sua sponte* Director Review or other review or policy clarification mechanisms.

SOP4: Process and the USPTO Director

- The Director is not involved, pre-issuance, in directing or otherwise influencing any panel decisions.
- The Director is not involved in directing or otherwise influencing the paneling or repaneling of any specific proceeding before PTAB prior to issuance of the panel decision.
- When reviewing or rehearing an issued panel decision, the Director may direct the repaneling of the proceeding in a manner consistent with PTAB paneling guidance.



Procedure for Decisions Remanded from the Federal Circuit for
Further Proceedings

Standard Operating Procedure 3 (SOP3)

SOP3

- Updates the former PTAB Standard Operating Procedure 9 (SOP9) for decisions remanded from the Federal Circuit to remove the requirement for PTAB judges to discuss remanded cases with PTAB management.
- To remove the gap in numbering, SOP9 has been renumbered to SOP3.
- No other changes.

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Next Boardside Chat



- Thursday, January 18, 2024, at 12-1 pm ET
- Topic: AIA Trial Practice
 - Practice Tips from Judges and Lead Practitioners
- Register for and learn about upcoming Boardside Chats at:
- <https://www.uspto.gov/patents/ptab/ptab-boardside-chats>

