

MEMORANDUM

February 12, 2009

TO: Vice Chief Administrative Patent Judge
Administrative Patent Judges

FROM: MICHAEL R. FLEMING
Chief Administrative Patent Judge

SUBJECT: Standard Operating Procedure 1 (Revision 13)
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 12) dated August 10, 2005, on the same subject matter.

Attachment

BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 1 (REVISION 13)

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

The following applies to the assignment of Administrative Patent Judges (judges) to merits panels,¹ motions panels,² and expanded panels³ in appeals and interferences.

Except as provided in section IV.C. of this Standard Operating Procedure (SOP), assignments (designations under 35 U.S.C. § 6) of judges to panels of the Board of Patent Appeals and Interferences (Board) are made by the administrative personnel of the Board, 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 SOP creates internal norms for the administration of the Board. It does not create any legally enforceable rights. The procedures described in this 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 Judge and 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 judges of the Board are assigned to a division based on technical or legal discipline.

II. Designation of Merits Panels

- A. In general, the Chief Judge will designate judges as the merits panel to decide *ex parte* appeals based upon their legal and technical expertise.
- B. In general, the Chief Judge will designate judges as merits panels to decide *ex parte* and *inter partes* reexamination appeals.
- C. In general, the Chief Judge will designate a judge or judges, as appropriate, for all matters for interferences.

¹ Three-judge panels designated to decide 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.

III. 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, an odd number of 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 appeal, or a party in an interference may suggest the need for an expanded panel.

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

E. When an expanded panel is designated after entry of a decision by a merits panel but before consideration of a request for rehearing of the decision of the merits panel, the judges

on the merits panel shall, if available, 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, a Vice Chief Judge, and additional judges to be assigned by the Chief Judge. The selection of the additional judges shall be based on the technical or legal expertise of the judges.

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

H. When the Chief Judge and all Vice Chief Judges are disqualified, recused, or otherwise unable to sit, the judges shall be assigned by the Board's senior management staff and the most senior judge shall preside.

I. In an appropriate circumstance, the Chief Judge may designate an expanded panel consisting of any number of judges, including an expanded panel consisting of all judges, to decide a case.

J. The Chief Judge may require a decision by an expanded panel of seven (7) or more judges to 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 SOP, 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.

IV. 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 the case 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 have the lead Trial Division judge request an assignment of a panel.

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 senior management staff to enter a revised designation. From time to time, the Chief Judge may authorize Board administrative personnel 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. Another appropriate instance in which to change the roles is when 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.