

PATENT TRIAL AND APPEAL BOARD

INTERNAL OPERATING PROCEDURE

Processing Procedures for *Ex Parte* Appeals

This Internal Operating Procedure (IOP) describes processes by which Administrative Patent Judges (“APJs” or “judges”) prepare and circulate opinions and other materials in *ex parte* appeal cases for paralegal review and for review by co-panelists. The IOP sets forth general guidelines for the judges and may serve as a resource for the onboarding of new judges.

The IOP formalizes current practices at the Patent Trial and Appeal Board (“PTAB” or “Board”). Some of the information in this IOP was contained in a former-version of Standard Operating Procedure 3 (Interim Revision 2), Board of Patent Appeals and Interferences (CJ Michael Fleming, March 30, 2010). This IOP maintains and reflects current procedures.

This IOP sets forth internal norms for the administration of the Board. It does not create any legally enforceable rights.

I. PROCEDURE FOR PANELED APPEALS

Paneling is generally carried out by the paneling staff according to Standard Operating Procedure 1 (SOP1).

A. Notification of Assignment

The judges on a panel may consult P-TACTS for a list of assigned cases.

Internal Operating Procedure Processing Procedure for *Ex Parte* Appeals

B. Recusals

Judges are expected to advise paneling staff in advance of any conflicts of interest. If a judge is nevertheless paneled on an appeal and wishes to request a recusal from the appeal, the judge will contact the Appeals Paneling staff. Once the panel has been changed in P-TACTS and on the electronic working file, the Appeals Paneling staff will notify the judge.

C. Unavailability

A judge should keep their technology cluster calendar updated so that the Appeals Paneling and Hearing Staff know when the judge will be on leave and will be unavailable for a future hearing date.

D. Postponement of Hearing

The Hearing staff will inform the panel if the hearing for an appeal has been postponed. If a heard appeal is being postponed, the assigned judge may inform the Appeals Paneling staff that they would like to keep the case. Otherwise when the case is rescheduled, it may go to a new panel for hearing scheduling efficiencies.

E. Change in Panel Order

A judge may email the Appeals Paneling staff with a cc: to their Lead Judge to request a change in the order of judges assigned to a panel. This is generally used to change the assigned author.

F. Related Appeals

If a panel becomes aware of a related appeal or appeals, and desires to keep the appeals with the same panel, a panel member should notify the Appeals Paneling staff.

Internal Operating Procedure
Processing Procedure for *Ex Parte* Appeals

G. Other Changes to Assignments

A judge should contact their Lead Judge regarding other paneling requests, e.g., if a member of their panel is or will be unavailable.

H. Conferencing by Judges and Three-Judge Conferencing Procedure

The judge designated as APJ1 according to SOP 1 is responsible for scheduling a conference with the other panel members. See generally SOP 1 for more guidance on panel assignments, designations, and changes.

The case conference shall be a three-judge conference. The panel members may attend the case conference via audio (phone) or video, with the three judges attending the same conference. In the rare circumstance where the unavailability of any one of the judges of the panel cannot be accommodated, the authoring judge (APJ1) may request a repanel to replace the unavailable judge (and conduct a 3-judge conference), or may conduct a separate conference with each panel member to account for the availability. The three-judge conferencing procedure is aimed at improving efficiency and quality in decision-making by including all three judges early in the decision-making process. This is intended to promote the exchange of ideas and collegiality, particularly in a distributed work force.¹

I. Draft Decision Processing

After conferencing the case with the panel members, the judge authoring the opinion composes a draft opinion to be submitted in P-TACTS to the paralegals for processing. See PTAB Style Guide (“Style Guide”) for standards governing the format and style of the draft opinion.

¹ This conferencing procedure may be subject to change by the Chief Judge if there is a change in the Board’s inventory, pendency, or other circumstance that would call for a different procedure.

Internal Operating Procedure Processing Procedure for *Ex Parte* Appeals

If a judge would like additional documents placed in the electronic working file for the circulation process, the judge may email the PTAB Appeals Admin Mailbox.

J. Draft Processing by the Paralegal Team

A paralegal reviews a draft decision submitted by the judge through P-TACTS. Paralegal review is required of all decisions, unless authorized by a lead judge for rare, exceptional circumstances.

K. Circulation of Draft Decision

The judge will receive a notification from P-TACTS when the draft decision has been reviewed by a paralegal and is ready for circulation. The authoring judge reviews the revised draft opinion, accepts or rejects changes suggested by paralegal review, and circulates the opinion. Judges should not reject changes suggested by paralegal review that are based on any mandatory requirements set forth in the Style Guide, such as the format requirements for the decision outcome table.

The co-paneled judges reviewing the draft opinion in circulation will typically insert any suggested changes into the opinion using track changes and may note whether the suggested change is discretionary with the authoring judge, or mandatory for obtaining their consent to join the opinion. The co-paneled judge will indicate whether they authorize the opinion for mailing in P-TACTS. Each panel member (judges) may at any time schedule further conferences to resolve outstanding issues.

In general, panels working on *ex parte* appeals must circulate decisions through P-TACTS. However, a judge may circulate a decision through email if there is some issue that prevents circulation through P-TACTS. Judges may also have email exchanges about a decision outside P-TACTS, such as an exchange of draft language, comments or suggestions

Internal Operating Procedure
Processing Procedure for *Ex Parte* Appeals

that require more active discussion, reconsideration of a decision prior to issuance, or discussions about writing separately in a concurrence or dissent. A judge may communicate by email about a draft decision in parallel with P-TACTS circulation of the draft decision. Unless there is a technical issue with P-TACTS, all approval of a decision for mailing should be completed in P-TACTS.

At any point prior to mailing, a judge can optionally resubmit an opinion for paralegal review. For example, a judge may wish to resubmit an opinion for paralegal review if there have been major changes to an opinion. Judges must resubmit for paralegal review if there is a concurrence or dissent that has not previously been submitted for paralegal review. When resubmitting a decision for paralegal review, the judge should create the assignment in P-TACTS as “Paralegal review for additional material” instead of “Paralegal review decision draft.”

Once the authoring judge receives authorization from all panel members, the authoring judge places the opinion in the Ready for Mailing folder and authorizes the opinion for mailing in P-TACTS.

L. New Evidence Cited in the Opinion

See Style Guide for guidance on the mailing of an opinion with new evidence not already of record.

II. REQUESTS FOR ERRATA OR VACATUR

If a judge would like to issue errata for a recently-mailed decision or vacate a decision that has recently mailed, the judge may email the PTAB Appeals Admin mailbox.

III. PROCEDURE FOR REQUESTS FOR REHEARING

A rehearing decision is treated similarly to a new case for purposes of circulation and processing.

Internal Operating Procedure
Processing Procedure for *Ex Parte* Appeals

IV. DRAFT OPINION PREPARATION BY THE AUTHORIZING JUDGE

A. Saving Draft Opinions to the H:\ and S:\ Drives

During the drafting of the opinion, the judge should save the document to a local folder on their C:\ drive that is regularly backed up (such as the Documents or Desktop folders or subfolders) or to their H:\ drive. When the draft is ready for processing by the paralegal team, the judge places a copy onto the S:\ drive. The naming and location conventions are as follows.

B. Document Filename Convention

The file is named using a two-letter code for the type of decision and the appeal number, and may be followed by the word “draft” or “circ” as explained herein. For example, a draft opinion for appeal number 2006-001234 in Word would be named “fd2006-001234 draft”. The appropriate two letter codes are:

- fd for final decisions
- rm for remands
- rh for rehearings
- dm for dismissals
- od for orders
- pt for petitions
- mc for miscellaneous communications

Decisions are identified generically as “xxnnnnn-nnnnnn.”

C. Designated Location for Drafts on the S:\ drive

The draft is placed on the S:\ drive at S:\Appeals Processing\Opinion Processing in the Draft Opinions subfolder of the judge’s folder. For instance, a draft written by Judge Jones is placed in S:\Appeals Processing\Opinion Processing\Jones\Draft Opinions. The draft put into the

Internal Operating Procedure
Processing Procedure for *Ex Parte* Appeals

draft folder by the judge and submitted for paralegal review should generally be a clean copy, i.e. there are generally no track changes that have not been accepted or rejected by the judge in the draft. A judge may optionally leave a comment for the paralegal, for the panel, or for themselves in the draft.

D. Naming and Location of Files for Circulation and Mailing

As above, when a judge creates a draft opinion, the judge provides a file name ending in “draft” in the judge’s Draft Opinions folder. When a paralegal completes their review, the paralegal changes the file name to end in “circ” instead of “draft” (e.g., “fd2006-001234 circ”). This file may now be referred to as the “circ” file. The authoring judge uses the “circ” file when the authoring judge circulates the opinion. The co-paneled judges make any suggested changes to the “circ” file in the same folder.

The authoring judge places the opinion in the Ready for Mailing folder (S:\Appeals Processing\Opinion Processing\Jones\Ready for Mailing), typically with a simple file name that omits “circ” (e.g., “fd2006-001234”) when it is authorized by all panel members and is ready for mailing.

V. REVIEW OF ORAL HEARING TRANSCRIPTS

After participating in an oral hearing for an *ex parte* appeal, the judges on the panel will receive an email from the Hearings Team asking them to review a transcript of the hearing. The APJ1 will typically review the transcript for completeness and correctness, and will send the transcript for mailing based on the directions received in the email with a copy to the other judges on the panel. Other judges on the panel may also provide additional corrections.

Users, Boalick, Scott
Digitally signed by Users,
Boalick, Scott
Date: 2023.07.17
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