

PATENT TRIAL AND APPEAL BOARD

STANDARD OPERATING PROCEDURE 1 (REVISION 14)

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

The following applies to the assignment of Administrative Patent Judges (judges) to merits panels,¹ interlocutory panels,² and expanded panels³ in appeals, interferences, and AIA Reviews.⁴

¹ Merits panels, consisting of no less than three judges, designated to decide appeals, enter decisions on requests for rehearing of appeals decisions, enter final judgments and final decisions on substantive and responsive motions in interferences, and enter final written decisions in a derivation proceeding, an *inter partes* review, a post-grant review, or a transitional covered business method review (collectively, AIA Reviews). Merits panels may also include panels consisting of less than three judges designated to enter declarations in interferences, decisions on institution in AIA Reviews, and requests for rehearing of decisions on institution in AIA Reviews.

² Judge or judges designated to enter interlocutory orders in interferences and AIA Reviews, including, e.g., decisions on requests for reconsideration of non-final decisions in interferences, decisions on requests for authorization to file motions in interferences and AIA Reviews, decisions on miscellaneous motions authorized and filed in interferences, and decisions on motions authorized and filed in AIA Reviews.

³ Expanded panels consisting of the merits panel or interlocutory panel judge(s) and one or more additionally designated judges.

⁴ The term AIA Review includes a derivation proceeding under 35 U.S.C. § 135; an *inter partes* review under Chapter 31 of title 35, United States Code; a post-grant review under Chapter 32 of title 35, United States Code; and a transitional covered business method patent review under section 18 of the Leahy-Smith America Invents Act. An AIA Review proceeds in two phases—in the first phase, the Board determines whether to institute a review, and in the second phase, the Board conducts the trial and issues a final decision. *See In re Cuozzo*, 778 F.3d, 1271, 1276 (Fed. Cir. 2015); *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375-76 (Fed. Cir. 2014).

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 Patent Trial and Appeal Board (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) (9th ed., March 2014). The Director's authority to institute a trial has been delegated to the Board. *See* 37 C.F.R. § 42.4 (2012); 37 C.F.R. § 42.408 (2012).

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, Deputy Chief Administrative Patent Judge (Deputy Chief Judge) and Vice Chief Administrative Patent Judges (Vice Chief Judges) are members of all administrative divisions and may administer appeals, interferences, and AIA Reviews, or otherwise participate in rendering panel decisions.

II. Designation of Merits and Interlocutory Panels

A. In general, the Chief Judge will designate judges as the merits panel to decide *ex parte* appeals.

B. In general, the Chief Judge will designate judges as the 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.

D. In general, the Chief Judge will designate a judge or judges, as appropriate, for all matters for AIA Reviews.

III. Expanded Panels

An expanded panel is not favored and ordinarily will not be used. From time to time, however, it may be necessary to expand a merits or interlocutory panel. The following applies to the use of expanded panels.

A. Reasons for expanding a panel include:

1. The proceeding or AIA Review involves an issue of exceptional importance, such as where serious questions have been raised about the continuing viability of an apparently applicable precedential decision of the Board, or a panel of the Board renders a decision that conflicts with a precedential decision of the Board or an authoritative decision of the Board's reviewing courts.
2. Consideration by an expanded panel is necessary to secure and maintain uniformity of the Board's decisions, such as where different panels of the Board render conflicting decisions on issues of statutory interpretation or rule interpretation, or a substantial difference of opinion among judges exists on issues of statutory interpretation or rule interpretation.
3. A written request from the Commissioner for Patents or the Commissioner's delegate identifying a particular matter before the Board 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.
4. A written request from the Commissioner for Patents or the Commissioner's delegate identifying a particular matter before the Board 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 an interlocutory panel may suggest to the Chief Judge, Deputy Chief Judge, and/or Vice Chief Judges the need for the designation of an expanded panel. Likewise, the Patent Examining Operation, an applicant or patent owner in an *ex parte* appeal, a party in an *inter partes* reexamination appeal, a party in an interference, or a party in a AIA Review may suggest the need for an expanded panel.

D. When a judge, a merits panel, or an interlocutory panel (1) suggests an expanded panel or (2) receives a suggestion for an expanded panel, the judge, merits panel, or interlocutory panel shall notify the Chief Judge, Deputy Chief Judge, and the Vice Chief Judges of the suggestion, in writing (for purposes of this SOP, a notification “in writing” includes a notification transmitted by e-mail). The written notification shall identify the reason for the suggestion, as well as which, if any, of the factors set forth in Section III.A. apply.

E. When an expanded panel is designated (1) after a case initially has been assigned to a merits or interlocutory panel and (2) before a decision is entered by the panel, the judges initially designated shall be designated, if available, as part of the expanded panel.

F. When an expanded panel is designated (1) after entry of a decision by a merits or interlocutory panel and (2) to consider a request for rehearing of the decision of the panel, the judges on the initial panel shall, if available, be designated as part of the expanded panel. The expanded panel shall decide the rehearing on its merits.

G. Expanded panels will include 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.

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

IV. Assignment of Judges

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

B. A judge assigned to administer 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 § 1.662(a), whenever a decision in an interference requires entry by a panel of judges, the judge to whom the interference is assigned shall have the Deputy Chief Judge or a Vice Chief Judge request an assignment of a panel. The Deputy Chief Judge or Vice Chief Judge may delegate the assignment of a panel to a Lead Judge.

D. The judges designated on a merits panel, interlocutory panel, or expanded panel shall not be changed without authority of the Chief Judge, Deputy Chief Judge, or a Vice Chief Judge. When satisfied that there is good reason to change the panel already designated, the Chief Judge, Deputy Chief Judge, or a 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. For merits panels in *ex parte* appeals, the Chief Judge may authorize a Lead Judge to change a designated merits panel for good reason.