

PATENT TRIAL AND APPEAL BOARD

STANDARD OPERATING PROCEDURE 1 (REVISION 17)

ASSIGNMENT OF JUDGES TO PANELS

This Standard Operating Procedure (“SOP”) describes the process by which administrative patent judges (“APJs” or “judges”) are assigned to panels in all jurisdictions of the Patent Trial and Appeal Board (“PTAB” or “Board”). As used in this SOP, the term “jurisdictions” refers to the Board’s authority over specific types of proceedings, such as appeals of adverse decisions of examiners upon applications for patents (including in reexamination and reissue proceedings) and America Invents Act (“AIA”) proceedings¹ (collectively, “cases”).

This SOP sets forth internal norms for the administration of the PTAB. It does not create any legally enforceable rights. The actions described in this SOP are part of the United States Patent and Trademark Office’s (“USPTO”) deliberative process.

I. Delegation of the Director’s Authority to Designate Panels

“Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.” 35 U.S.C. § 6(c). The Director has delegated to the Chief Judge the authority under 35 U.S.C. § 6(c) to designate panels.²

Statutory members of the Board may be paneled on cases in the ordinary course in accordance with this SOP. The Director will not be involved in directing or otherwise influencing the paneling or repaneling of any specific proceeding before the PTAB prior to the issuance of the panel decision. 37 C.F.R. § 43.3(d). When reviewing or rehearing an issued panel decision, the Director may repanel the

¹ AIA proceedings include *inter partes* reviews under 35 U.S.C. § 311; post-grant reviews under 35 U.S.C. § 321; and derivation proceedings under 35 U.S.C. § 135.

² Manual of Patent Examining Procedure § 1002.02(f).

proceeding in a manner consistent with Board paneling guidance, through an Order entered into the record. *Id.*

The Chief Judge has further delegated³ the designation of panels to at least one Board employee (“designee”). The designee(s) will follow the assignment guidelines provided below and as directed by PTAB leadership.⁴ The designee(s) is expected to use best efforts to panel cases with judges having appropriate jurisdictional designations, technology expertise, case management, no conflicts of interest, and other availability considerations. All actions taken to designate panels under this SOP shall be impartial, and no panel members shall be selected to influence an outcome.

II. Paneling Guidance

A. Assignment of panels: The designee(s) shall assign the three judges to serve on a panel as “APJ1,” “APJ2,” and “APJ3.” Panels shall not be expanded beyond three judges. Ordinarily, so long as APJ1 is in the majority, APJ1 will do a significant portion of the writing and case management for a case, in consultation with APJ2 and APJ3. Notwithstanding these provisions, any of the three judges assigned to a case may draft written work product in the case, including memoranda, concurrences, and dissents. All three judges will provide input on writing assignments, except in rare circumstances in which fewer than all three judges are available and in which there is no statutory requirement for a three-judge panel.

³ Notwithstanding the delegations, the Director and Chief Judge retain the authority to delegate panels consistent with the guidance in this SOP.

⁴ PTAB leadership comprises the Chief Judge, Deputy Chief Judge, Vice Chief Judges, and Senior Lead Judges (including those “acting” in these roles).

B. Avoidance of conflicts of interest and additional paneling instructions regarding financial interests:

1. Each judge is required to ensure that they comply with the Standards of Ethical Conduct for Employees of the Executive Branch at 5 C.F.R. part 2635 (“Ethics Rules”) in all cases. Each judge is highly encouraged to provide the designee(s) with a “do not panel” list that identifies financial interests and personal relationships that may preclude paneling them on a case for any reason, and to update that list whenever the judge becomes aware of new financial interests and/or personal relationships.
2. In determining whether a conflict of interest exists, the designee(s) use the judge’s “do not panel” list, which follows the guidance set forth in the Ethics Rules. Judges will consult with the Department of Commerce Ethics Law and Program Office, as necessary, to resolve any questions pertaining to conflicts of interest. A summary of “Ethics guidance” is posted on the USPTO website (www.uspto.gov/patents/ptab/ethics-guidance). In addition, the [“Guidance on Paneling of Cases” memorandum \(the “Paneling Memorandum”\)](#) identifies certain financial interests that may preclude paneling a judge on a case even if those financial interests do not rise to the level of conflicts of interest under Ethics Rules.
3. Providing the designee(s) with a “do not panel” list does not excuse judges from the obligation to independently perform conflict checks. Each judge is ultimately responsible for complying with conflict-of-interest rules and the guidance set forth in the Paneling Memorandum, and for informing the designee(s) if repaneling is needed for a particular case.
4. The designee(s) must not panel a judge on a case if any of the disclosed parties or real parties in interest are entities on a judge’s “do not panel” list.

C. Paneling by jurisdiction designation: By default, all judges work on appeals, subject to the needs of the Board. As described further below, some judges are paneled only on appeals, while other judges are also paneled on cases in other jurisdictions of the Board (e.g., reexamination appeals and/or AIA proceedings). Jurisdiction designations are made by PTAB leadership, accounting for, among other things, each judge's jurisdictions for which they attest to competency, the overall docket composition of the Board, and the needs of the Board. The designee(s) maintains current records of each judge's designated jurisdiction(s).

D. Periodic paneling:

1. For judges paneled only on appeals, the designee(s) will automatically assign appeals to a judge's docket on a regular, periodic basis, with the goal of maintaining a given judge's docket size at a target level. For judges who are not automatically paneled on appeals (e.g., because the judge is assigned to handle AIA proceedings), a judge can contact the designee(s) to request a certain number of appeals, up to a designated maximum. PTAB leadership designates the target level and maximum number of appeals that can be assigned to different groups of judges, according to the needs of the Board.
2. The designee(s) panel AIA proceedings on a regular, periodic basis. The designee(s) identifies statutory due dates of AIA proceedings based on the date a Notice of Filing Date Accorded ("NFDA") is mailed. AIA proceedings generally will have a projected decision on institution ("DI") statutory due date six months from the NFDA. A final written decision ("FWD") has a statutory due date twelve months from the date a DI is issued. In paneling AIA proceedings, the designee(s) account for these dates, as appropriate, as well as the dockets of the assigned judges and the needs of the Board, as set forth below.

E. Paneling by technology:

1. Each judge has a technology discipline designation in one or more of the following technology disciplines:

biotechnology/pharma, business methods, chemical, electrical, mechanical, and design. Based on their background, each judge shall provide the designee(s) with a primary technology discipline designation and, where appropriate, any additional technology discipline designation(s).

2. The designee(s) should ensure, to the maximum extent possible, that judges are paneled to match the technology discipline of the case to the technology discipline designations of the paneled judges by endeavoring, wherever possible, to panel to each case at least two judges having a technology discipline designation matching the technology discipline of the case.

F. Paneling by experience: The designee(s) will panel judges new to a particular jurisdiction (“new judges”) with judges having more experience in that jurisdiction. The designee(s) will not panel new judges on cases with other new judges absent approval from PTAB leadership.

G. Paneling related cases:

1. The designee(s) should assign appeals for which there was a prior appeal to the same panel that heard the prior appeal whenever feasible. When a large number of applications are related, additional factors should be considered in paneling appeals for such applications to ensure decision consistency.
2. For reexamination appeals, to facilitate the efficiency and consistency of results, the designee(s) should assign reexamination appeals challenging the same patent, or involving the same patent owner and involving related subject matter, to the same panel of judges whenever feasible. When a reexamination appeal is based on a patent that is/was also involved in an AIA proceeding, then the designee(s) should assign, whenever feasible, a judge from the panel in the related AIA proceeding to the reexamination appeal. Alternatively, when an AIA proceeding is based on a patent that is/was also involved in a reexamination appeal, then the designee(s) should

assign, whenever feasible, a judge from the panel in the related reexamination appeal to the AIA proceeding.

3. For AIA proceedings, to facilitate the efficiency and consistency of results, the designee(s) should assign families of AIA proceedings challenging the same patent, or involving the same patent owner and involving related subject matter, to the fewest total judges as is practicable in view of familiarity with the family and judge availability considerations, absent guidance from PTAB leadership.
 - a. When paneling new cases in the family, the designee(s) should, where appropriate, seek input from judges currently serving on existing cases in the family regarding judge availability.
 - b. If a family is large (e.g., four or more writing assignments in a month), the designee(s) should normally assign a panel with at least two judges who have the availability to author multiple decisions by the projected due dates of the new cases. A judge paneled as APJ1 on a case should normally be paneled as APJ2 or APJ3 on other cases in the family, whenever feasible.
 - c. A new case requesting joinder to an existing case challenging the same patent will normally be assigned to the same panel, absent guidance from PTAB leadership.
 - d. A new case not involving a request for joinder, but challenging a patent challenged in a previous case should normally be assigned to the same panel as the previous case whenever feasible, absent guidance from PTAB leadership. Otherwise, the panel should include at least one judge from the previous panel, if feasible.
 - e. The designee(s) should normally panel unrelated small families of cases and stand-alone cases to judges with availability remaining after paneling large families and cases related to existing cases.

- f. The designee(s) panel AIA proceedings in a manner that strives to ensure that all statutory deadlines are met.

H. Order of handling cases:

1. The designee(s) assign appeals to panels in order based on when the appeals are docketed by the PTAB (i.e., by appeal number). Judges are expected to decide appeals generally in the order the appeals are docketed by the PTAB.
2. The designee(s) panels pre-GATT cases (i.e., applications filed prior to June 8, 1995) immediately when received by the PTAB. Appeals for pre-GATT applications are prioritized based on the age of the application, rather than the appeal number.
3. The designee(s) prioritize the assignment of appeals that have been made special, either through a granted petition to make special of the underlying application, or any ongoing expedited patent appeal program. The designee(s) panels such prioritized appeals at a regular interval to help ensure that those appeals are spread across an appropriate number of judges, such that an individual judge has the capacity to decide the prioritized appeals in an expedited manner.
4. The designee(s) panels reexamination and reissue appeals to ensure such cases are decided with special dispatch.

- I. **Cases with hearings:** The designee(s) should normally panel cases with hearings with at least two judges having an official duty location in a USPTO office, but must, at minimum, panel each such case with at least one judge having an official duty location in a USPTO office, absent approval from PTAB leadership.

J. Balancing workload:

1. The designee(s) should assign to each judge a designated number of cases as APJ2 or APJ3 for each case the designee(s) assigns the judge as APJ1.

2. Unless the needs of the PTAB require otherwise, judges provide desired relative levels of AIA proceedings and appeal participation to the designee(s). Because some writing assignments in AIA proceedings have statutory due dates, before assigning an AIA proceeding to a judge, the designee(s) must check the existing assignments for that judge to ascertain that judge's availability.

K. Panel changes:

1. Generally, before a panel has appeared (e.g., in an order, decision, conference call, or hearing), a judge may request removal from a panel for any reason that the judge, in their sound judgment, determines to be reasonable. A judge also may be repaneled by the designee(s) to meet statutory deadlines or other needs of the PTAB.
2. For all proceedings in which the panel has appeared (e.g., in an order, decision, conference call, or hearing), panel changes generally are disfavored, except that panel changes to avoid conflicts of interest and/or to comply with the guidance set forth in the Paneling Memorandum are always permitted.
3. Any panel change shall be made by the designee(s). Reasons a panel may change are limited to:
 - a. RECUSAL—judges shall recuse themselves for the reasons set forth in section II.B.1–2 (referring to Ethics Rules).
 - b. CASE MANAGEMENT—judges may be reassigned for more efficient case management, to meet the PTAB's statutory deadlines, or to meet other jurisdictional needs of the PTAB.

- c. UNAVAILABILITY—judges may be unavailable for reasons that include: approved leave; the death or serious illness of the judge or the judge’s family member; a detail assignment within or outside the USPTO; workload changes; the retirement or permanent departure of the judge from the agency; reasons consistent with the Paneling Memorandum; or other reasons not captured by this SOP that are reasonable.
4. To request removal from a panel, the judge should contact the designee(s) and copy their supervisor. A supervisor’s approval generally is required for all panel change requests, except for requests to be removed for reasons set forth in section II.B.1–2 or to comply with the Paneling Memorandum guidance.
 5. A panel member may suggest a specific replacement judge when requesting the substitution of one or more judges who have indicated a need for a panel change. The designee(s) will ensure the guidance in this SOP has been met, but is/are not obligated to make the suggested panel replacement.
 6. If approved, and the panel has appeared, a Panel Change Order will be entered into the public record notifying the parties of the panel change. The Panel Change Order will identify the new panel and provide the reason for the panel change from the reasons enumerated above (i.e., recusal, case management, or unavailability).
 7. Panel members may reorder themselves as APJ1, APJ2, and APJ3 at the panel’s discretion at any time during a proceeding, without obtaining a supervisor’s approval. The panel will notify the designee(s), who will update the case assignment records.

L. Matters related to Director Review: The Director may delegate Director Review to a panel of the Board (“Delegated Rehearing Panel” or “DRP”). The Director will issue an order delegating review. When the Director delegates Director Review to a DRP, the designee(s) who assigns panels will assign three judges to serve on a DRP from the list of judges eligible to serve on a DRP (convened based on DRP-specific procedures provided elsewhere in public USPTO guidance), in a manner consistent with the rest of this SOP, as practical. The Board will prepare a DRP panel identification order, with the names of the assigned judges for the DRP, for issuance by PTAB leadership or the designated delegate.

M. Matters related to review of appeals decisions: For an appeal, the Director may convene an Appeals Review Panel (“ARP”) to rehear a Board decision or to consider a Board decision on remand from the U.S. Court of Appeals for the Federal Circuit. The members of the ARP are selected by the Director impartially and pursuant to ARP-specific procedures provided elsewhere in public USPTO guidance.