

MEMORANDUM

August 10, 2005

TO: Vice Chief Administrative Patent Judge
Administrative Patent Judges

FROM: MICHAEL R. FLEMING
Chief Administrative Patent Judge

SUBJECTS: Standard Operating Procedure 2 (Revision 6)
Publication of opinions and binding precedent

The attached document supersedes Board of Patent Appeals and Interferences' Standard Operating Procedure 2 (Revision 5) dated August 11, 2004, on the same subject matter. The significant changes in this revision include:

- updating the SOP to reflect our new organizational structure;
- improving the readability of section VI Procedures For Adoption Of Binding Precedent
- allowing each judge a vote to determine whether an opinion is adopted as precedential.

Attachment

Cc: Amalia Santiago Chief Board Administrator

BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 2 (REVISION 6)

PUBLICATION OF OPINIONS AND BINDING PRECEDENT

The following applies to the publication of opinions and adoption of binding precedent of the Board of Patent Appeals and Interferences (Board). This Standard Operating Procedure (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 made by the Director, the Chief Administrative Patent Judge (Chief Judge) and any other Administrative Patent Judge (judge), are considered part of the deliberative process.

I. Background

- A. The Board annually issues roughly 3500 opinions in appeals, interferences and other proceedings. These opinions are written primarily for the benefit of the parties to the proceedings. Most opinions do not add significantly to the body of law.
- B. In the past, Board opinions have been officially published in the Official Gazette and the Decisions of the Commissioner of Patents, and other publications. Opinions have also been published in paper and electronic form by commercial organizations.
- C. Beginning in late 1997, opinions in support of final decisions of the Board of Patent Appeals and Interferences appearing in issued patents, reissue applications, reexamination proceedings and interference proceedings open to the public have been disseminated by way of the Board's Internet web page. The Internet address for these opinions is:

<http://www.uspto.gov/web/offices/dcom/bpai/bpai.htm>

- D. Opinions of the Trial Division have likewise been disseminated by way of links to the Board's web page. The Internet address for Trial Division opinions is:

<http://www.uspto.gov/web/offices/dcom/bpai/its.htm>

- E. Ultimately, the publication provisions of 35 U.S.C. § 122(b) are expected to result in publication of 80% of all patent applications. Because Board opinions on appeal in applications published pursuant to 35 U.S.C. § 122(b) will be disseminated by way of the Board's Internet web page, it is expected that 80% or more of all Board opinions will be published by the USPTO on the Board's Internet web page. It is likely that some of these opinions, as well as opinions not otherwise subject to publication by the USPTO, will also be published by commercial reporters.
- F. The availability of these opinions on the Board's Internet web page or from other

sources does not alter the fact that a Board opinion is precedential only if the opinion has been made precedential pursuant to the provisions of this or earlier versions of SOP 2. Public policy favors widespread publication of opinions, even if the opinions are not considered precedential.

- G. Nothing in this SOP should be construed as requiring a member of the public to seek permission under this SOP to submit any nonprecedential opinion of the Board in its possession to any commercial or other entity for publication. Any opinion made available to the public that does not expressly indicate that the opinion is binding precedent of the Board or is not identified as binding precedent in the Appendix to this SOP shall be deemed to be nonprecedential.

II. Categories Of Board Opinions

There shall be two categories of Board opinions:

1. Precedential opinions
2. Nonprecedential opinions.¹

III. Criteria For Identifying Candidates To Be Made Precedential

- A. The Board's policy shall be to limit opinions which are candidates for being made precedential to those meeting one or more of the following criteria:
 1. The case is a test case whose decision may help expedite resolution of other pending appeals or applications.
 2. An issue is treated whose resolution may help expedite Board consideration of other cases or provide needed guidance to examiners or applicants pending court resolution.
 3. A new rule of law is established.
 4. An existing rule of law is criticized, clarified, altered or modified.
 5. An existing rule of law is applied to facts significantly different from those to which that rule has previously been applied.
 6. An actual or apparent conflict in or with past holdings of this Board is created, resolved, or continued.
 7. A legal issue of substantial public interest, which the Board has not treated recently, is resolved.
 8. A significantly new factual situation, likely to be of interest to a wide spectrum of persons other than the party (or parties) to a case is set forth.
 9. A new interpretation of a Supreme Court decision, a decision of the Court of Appeals for the Federal Circuit, or of a statute, is set forth.

¹ This category includes opinions of a merits or motions panel composed of all members of the Trial Procedures Section of the Trial Division when an interference assigned to the Trial Prodecures Section involves a significant procedural issue applicable to proceedings before the Trial Procedures Section and the Trial Procedures Section judges deem it appropriate to issue an opinion binding on the Trial Procedures Section.

- B. The purpose of a precedential opinion is to create a consistent line of authority as to a holding that is to be followed in future Board decisions.
- C. Disposition by nonprecedential opinion does not mean that the case is considered unimportant, but only that a precedential opinion would not add significantly to the body of law.
- D. The Director, the Patents Operation acting through a Commissioner or Assistant Commissioner, the appellant, a third party member of the public, or any judge may request in writing that an opinion be made precedential, by forwarding that request, along with accompanying reasons, to the Chief Judge. Typically, this request should be received within 60 days after the opinion is issued. The request and subsequent response shall be filed separately from the official record.

IV. Procedures For Adoption Of Binding Precedent

- A. Any opinion of the Board satisfying one or more of the criteria identified in section III above may be adopted as precedential, either at the time of its entry or subsequent to entry, provided that the following steps are followed.
 - 1. A majority of the merits panel that is entering or has entered the opinion agrees that the opinion should be precedential.
 - 2. If the Chief Judge considers the opinion an appropriate candidate for being made precedential, the Chief Judge will circulate the opinion under consideration for designation as precedential to all of the judges.
 - 3. Within a time set in the notice circulating the opinion (typically two weeks from the date of the notice), each judge shall vote "agree" or "disagree" (without further written comment or written discussion) on whether that judge agrees that the opinion should be made precedential. Barring extended unavailability (as in the case of serious illness), each judge has an obligation to vote "agree" or "disagree." If a judge does not communicate a vote within the time set, then the judge's vote will be normally considered to be in agreement that the opinion be made precedential.
 - 4. If the Chief Judge considers that a sufficient majority of those voting agree that the opinion should be made precedential, the opinion (along with the numerical results of the vote) will be forwarded to the Director, or the General Counsel acting by delegation on the Director's behalf, for review. If the Chief Judge does not consider that a sufficient majority of those voting agree that the opinion should be made precedential, the opinion will not be forwarded for review.
 - 5. If the Director, or the General Counsel acting by delegation on the Director's behalf, agrees that the opinion should be made precedential, the Director or General Counsel will notify the Chief Judge of that determination.
 - 6. The opinion is then published or otherwise disseminated following notice and opportunity for written objection afforded by 37 CFR § 1.14, in those instances in which the opinion would not otherwise be open to public inspection.

- B. Opinions entered by expanded panels do not automatically become precedential, but instead are subject to the procedures of this SOP. However, a prior precedential decision of a prior panel of the Board may only be overturned by decision of an expanded panel that itself has been made precedential or pursuant to an event set forth in Section VI D. The authoring judge for any decision by an expanded panel shall call the Chief Judge's attention to the opinion prior to entry of the opinion so that consideration of whether the opinion shall be made precedential can occur in advance of entry.
- C. The Chief Judge will determine if the opinion is an appropriate candidate to be made precedential. If the Chief Judge is convinced that the opinion ought not to be made precedential (e.g., because the Chief Judge believes the opinion does not meet the criteria of Part III above), the Chief Judge is under no obligation to consult other judges.
- D. Where a written request for a precedential opinion has been received, the Chief Judge shall prepare an order indicating that the opinion has, or has not, been adopted as precedent of the Board under the procedures of this Standard Operating Procedure.
- E. The opinion will become precedential upon being published or otherwise disseminated.
- F. Clearance for publication, if needed under the rules, will be obtained by the Chief Judge.

V. Scope Of Director's And Chief Judge's Review

- A. The Director of the United States Patent and Trademark Office (USPTO) is both a statutory member of the Board (35 U.S.C. § 6(a)) and the official charged by statute with providing policy direction for the USPTO (35 U.S.C. § 3(a)(2)). The determination of which decisions or opinions shall have binding precedential affect on the USPTO generally is within the province of the Director's statutory policy role.
- B. Review by the Director, or the General Counsel acting by delegation on the Director's behalf, is not for the purpose of reviewing or affecting the outcome of any given appeal, but strictly for determining whether the given opinion is to be made precedential.
- C. Neither review by the Chief Judge, nor consultation with judges not assigned to the merits panel, is for the purpose of reviewing or affecting the outcome of any given appeal, but strictly for determining whether the given opinion is to be made precedential.

VI. Precedent Binding Upon The Board

- A. The following are considered precedent binding upon the Board:

1. An opinion of the Supreme Court.
 2. An *en banc* decision of the Court of Appeals for the Federal Circuit.
 3. A decision of the Court of Appeals for the Federal Circuit, or its predecessors, the Court of Customs and Patent Appeals (CCPA) and the Court of Claims, which the Court of Appeals for the Federal Circuit considers binding precedent. *See Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 765, 9 USPQ2d 1417, 1423 (Fed. Cir. 1988); *UMC Elecs. Co. v. United States*, 816 F.2d 647, 652 n.6, 2 USPQ2d 1465, 1468 n.6 (errata) (Fed. Cir. 1987), *cert. denied*, 108 S.Ct. 748 (1988); *South Corp. v. United States*, 690 F.2d 1368, 1370, 215 USPQ 657, 658 (Fed. Cir. 1982) (*en banc*).
 4. An opinion of the Board made precedential by the procedures contained in this or earlier versions of SOP 2.
- B. Judges encountering conflicts in the decisions of the Court of Appeals for the Federal Circuit, the CCPA, and/or the Court of Claims should call the conflict to the attention of the Chief Judge.
- C. All other opinions of the Board that are published or otherwise disseminated are not considered binding precedent of the Board.
- D. All judges, including the Chief Judge, are bound by a published or otherwise disseminated precedential opinion of the Board unless the decision supported by the opinion is (1) modified by the Court of Appeals for the Federal Circuit, (2) inconsistent with a decision of the Supreme Court or the Court of Appeals for the Federal Circuit, (3) overruled by a subsequent expanded panel, or (4) overturned by statute.

VII. Nonprecedential Opinions

- A. When authoring an opinion, a panel or a single judge may determine that the opinion may be published in a commercial reporter or not published in a commercial reporter. (Decisions on appeal in applications open to the public under the provisions of 35 U.S.C. § 122(b) will be published on the Board's Internet Web page without regard to the panel's or individual judge's determination.) The fact that a panel or judge determines that an opinion may be published in a commercial reporter does not mean that it must be published; it means only that the authoring panel or judge has no objection to its being published in a commercial reporter.
- B. When the panel or the judge has no objection to publication of the opinion in a commercial reporter, the opinion should contain the appropriate one of the following headings on the first page:

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

The opinion in support of the decision being entered today

is binding precedent of the Trial Procedure Section of the Board of Patent Appeals and Interferences. The opinion is otherwise *not* binding precedent of the Board.

- C. These headings will typically be used in situations where, although the opinion does not add significantly to the body of law, the opinion may nevertheless be helpful to more than just the parties involved, and where the opinion recounts the facts of the case and the legal authorities relied upon in a way that permits a full understanding of the issues and the board's determination by recourse to the opinion alone.
- D. When a panel does not consider publication of the opinion in a commercial reporter warranted, the opinion should contain the following heading on the first page:

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

- E. Any panel or judge seeking to have a non-precedential opinion published shall forward the opinion to the Chief Judge. Clearance, if needed under the rules, will be obtained by the Chief Judge consonant with 37 CFR § 1.14. After clearance required by the rules is obtained, or when clearance is not needed, the opinion will be published or otherwise disseminated.
- F. A non-precedential opinion that is published or otherwise disseminated is not binding on other judges and/or panels.

Appendix: Opinions Approved as Binding Precedent of The Board of Patent Appeals and Interferences pursuant to Standard Operating Procedure 2 which have not been modified or reversed by the Federal Circuit:

Reitz v. Inoue, 39 USPQ2d 1838 (Bd. Pat. App. & Int. 1995)
Ex parte Bhide, 42 USPQ2d 1441 (Bd. Pat. App. & Int. 1996)
Ex parte Lemoine, 46 USPQ2d 1420 (Bd. Pat. App. & Int. 1994)
Basmadjian v. Landry, 54 USPQ2d 1617 (Bd. Pat. App. & Int. 1997)
Ex parte Yamaguchi, 61 USPQ2d 1043 (Bd. Pat. App. & Int. 2001)
Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003)