

BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 2 (REVISION 7)

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 a large number of 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, published applications, 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://des.uspto.gov/Foia/BPAIReadingRoom.jsp>

- D. A diminishing fraction of applications before the Board are entitled to confidentiality under 35 U.S.C. § 122(a) as a result of publication under 35 U.S.C. § 122(b) or by other means. Most 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.

- E. 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 binding precedent 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 binding precedent.
- F. 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.
- G. Any opinion made available to the public that (1) does not expressly indicate that the opinion is binding precedent of the Board or (2) is not identified as binding precedent on the Board's Precedential opinion website – <http://www.uspto.gov/web/offices/dcom/bpai/prec.htm> – shall be deemed to be nonprecedential.

II. Categories Of Board Opinions

There shall be three categories of Board opinions:

1. Precedential opinions
2. Informative opinions
3. Routine opinions.

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.
- 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 – Informative or Routine – 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 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 opinion of a prior panel of the Board may only be overturned by an opinion 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 Section 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. Precedential opinions will be posted at:
<http://www.uspto.gov/web/offices/dcom/bpai/prec.htm>.
- 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 effect 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 (Fed. Cir. 1988); *UMC Elecs. Co. v. United States*, 816 F.2d 647, 652 n.6 (errata) (Fed. Cir. 1987), *cert. denied*, 108 S.Ct. 748 (1988); *South Corp. v. United States*, 690 F.2d 1368, 1370 (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.
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- 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. Informative Opinions

Informative opinions are not binding, but illustrate norms of Board decision-making for the public, the patent examining corps, and future Board panels. Informative opinions may explain best practices, address recurring problems, identify developing areas of the law, exemplify types of decisions under-represented in commercial case reporting services, or report cases of public interest. The Chief Judge will determine which opinions should be designated as Informative. Informative opinions will be sent to commercial case reporting services, circulated within the Board, and sent to the Commissioner for Patents. Informative opinions will also be posted at:

http://www.uspto.gov/web/offices/dcom/bpai/informative_opinions.html.

VIII. Routine Opinions

Given the large number of opinions and orders produced each year at the Board, most opinions and orders will be Routine, and will not be designated as Precedential or Informative. The Board will not send such opinions and orders to commercial case reporting services. All opinions in support of a final decision will be posted at:

<http://des.uspto.gov/Foia/BPAIReadingRoom.jsp>

unless the opinion is subject to confidentiality protections under 35 U.S.C. § 122(a) or secrecy under 35 U.S.C. § 181. Routine opinions that are cited by a party or that are publicly available may be cited for whatever persuasive value they may have but, as a general matter, Routine opinions should be cited sparingly.