

Michael  
Fleming

Digitally signed by Michael  
Fleming  
DN: cn=Michael Fleming,  
o=US, ou=Board of Patent  
Appeals and Interferences,  
ou=Chief Administrative  
Patent Judge  
Date: 2009.06.18 09:01:08  
+04'00'

**Confidential - Internal Use and Distribution at the Board Only**

**BOARD OF PATENT APPEALS AND INTERFERENCES**

**STANDARD OPERATING PROCEDURE 3 (Revision 1)**

**PROCESSING PROCEDURES FOR EX PARTE APPEALS<sup>1</sup>**

The following applies to the processing and handling of papers in electronic form during the ex parte appeal process including ex parte appeals in reexamination and reissue applications.<sup>2</sup> Processing of ex parte appeals is divided into three phases: pre-appeal processing, undocketed appeal processing, and docketed appeal processing. Pre-appeal processing covers activities occurring before formal jurisdiction of the case passes to the Board. Undocketed appeal processing covers activities occurring from the time formal jurisdiction is conferred (mailing of docketing notice to the applicant) to the time the appeal is docketed to a panel of Administrative Patent Judges (Judges). Docketed appeal processing covers activities occurring during the Judge's decision making process and beyond.

This Standard Operating Procedure creates internal norms for the administration of the Board of Patent Appeals and Interferences (Board). It does not create any legally enforceable rights. The procedures described in this Standard Operating Procedure (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. Pre-appeal Processing of New Appeals**

While formal jurisdiction of the appeal does not pass from the Technology Center (TC) to the Board until a docketing notice is mailed to the applicant, the Board is required to perform various actions prior to the mailing of the docketing notice. These actions occur within the pre-appeal processing phase of case processing. Pre-

---

<sup>1</sup> This SOP does not apply procedures for inter partes reexamination proceedings. See SOP 5 and 6 for guidance on processing procedures for appeals in these types of proceedings.

<sup>2</sup> While this SOP references Appeals Division support staff for processing appeals, the processing of ex parte appeals in reexamination proceedings and reissue applications is performed by analogous Trial Division support staff.

appeal processing encompasses the steps of identifying cases appearing to include appeals under 35 U.S.C. § 134 for decision by the Board and review of those cases to determine if they are ready for decision. Processing of papers such as the notice of appeal, appeal brief, reply brief and request for extension of time to file the brief and reply brief are processed by the TCs. When such papers are addressed to the Board, the appropriate TC is contacted so it may handle the paper. Standards for pre-appeal processing at the Board are set forth below.

#### *A. Assignment of Pre-appeal Processing Duties*

The Chief Review Administrator (CRA) oversees the pre-appeal processing of cases. Normally, personnel within the Office of the Deputy Chief Appeal Administrator (OCRA) serve as reviewing team members. Other personnel may be designated as reviewing team members for processing overflow work. In all cases, the following procedures must be followed.

#### *B. Case Intake Procedures*

The CRA assigns cases to a reviewing team member. Cases are assigned from the BPAI.Inbox of eDAN and/or by tracking cases using PALM 123 (Examiner's Answer to Appeal Brief Mailed) and PALM 133 (Reply Brief Noted by Examiner) status reports.

#### *C. Actions Performed by Reviewing Team Member*

##### 1. Informal Review

There are two tiers of review: (1) an informal review, which is performed by the CRA prior to the assignment to an OCRA team member or an overflow team member, and prior to placing the case in PALM 132 Status (Appeal Case Awaiting Docketing (APWD)); and (2) a formal in-depth review performed after the case is placed in PALM 132 status. The informal review is conducted to identify applications that are not properly in appeal status or have errors easily correctable by Technology Center (TC) support staff. If such errors are found, the TC support staff is informed (messed in eDAN) and the case is not placed in PALM 132 status.

Examples of Informalities:

- Cases that should not be in appeal status. For example:

- o A Request for Continued Examination (RCE) that has not been processed
  - o Application has been abandoned
  - o Case messaged to the BPAI Inbox in error
  - o Case wrongly placed in PALM appeal status
  - o Time for response to the Examiner's Answer (or Supplemental Examiner's Answer) has not expired.
- Minor informalities that can be corrected by Technology Center (TC) support staff. For example:
    - o Status of entry of an amendment or other paper is unclear
    - o Fees have not been charged or have been improperly charged

## 2. Place the case into Appeal Waiting Docketing Status (PALM 132)

If the case is properly in appeal status and no minor informalities are found, the CRA performs a PALM 132 transaction to place the case into 132 (APWD) status. If a problem occurs and the PALM transaction cannot be completed, the CRA must correct the case before further processing.

Once the CRA completes the PALM 132 transaction, the CRA enters the application into the Adjudicated Case Tracking System (ACTS). In ACTS, the CRA then assigns a paralegal to ACTS Stage 1.

The case is ready for formal review by a paralegal.

## 3. Formal Review

The assigned paralegal conducts a formal review of the papers in the case to determine if the case is ready for assignment of an appeal number.

### a) Formality Problem Identified

*(1) Preparation of Order Returning Undocketed Appeal to the Examiner*

If a formality issue requiring examiner and/or appellant action is identified, the undocketed case must be returned to the examiner for correction. Some of the problems that require a return of the case include:

- Information Disclosure Statements (IDSs) not considered by the Examiner
- Reply Briefs not considered by the Examiner
- Affidavits and/or Declarations not considered by the Examiner
- Examiner's Answer not signed by Appeal Conferees
- Supplemental Examiner's Answer not signed by TC Director or designee
- New Grounds of Rejection in Examiner's Answer not signed by TC Director or designee
- Missing sections in the Appeal Brief or Examiner's Answer
- Examiner relies upon an abstract or non-translated foreign reference
- New declarations and/or amendments filed with or after the Appeal Brief
- Substantial differences between the claims in the Claim Appendix and the claims on appeal. If the case is otherwise ready for an appeal number except for the presence of minor errors in the claims appendix, the errors are noted and the case proceeds to undocketed appeals processing by the appropriate discipline team. The message to the discipline team must include a description of the minor errors.

### *(2) Review and Signing of Order*

The reviewing paralegal prepares a proposed Order Returning Undocketed Appeal that describes the problem(s) requiring correction. The proposed Order is prepared in Microsoft Word and placed in the folder: S:\Pre-Appeals Processing\Draft Returns (Draft Returns Folder)

The CRA monitors the Draft Returns Folder and reviews all Orders Returning Undocketed Appeals.

If the Order is ready to be signed, the electronic copy of the Order in the Draft Returns Folder is moved to the folder: S:\Pre-Appeals Processing>Returns ready for mailing (Returns Ready for Mailing Folder), and a copy is signed by the CRA. Once the Order is signed, it is delivered to the authoring paralegal. The paralegal performs the following steps:

- Prints and mails the Order to the applicant
- Sends a copy for scanning into the electronic file (IFW)
- Enters all pertinent data into ACTS and PALM (149 status)
- Messages the application back to the appropriate TC Special Processing Box

b) No Formality Problem Identified

If no errors are identified, the application is ready for processing by the discipline team for decision on appeal. The reviewing paralegal then performs the following steps:

- Enters any special status as an annotation to the appeal brief in the Table of Contents (TOC) window of the IFW (eDAN). The annotation must indicate the nature of the special status. Some examples of special status include rehearing, reissue, reexam, petition, and specially handled issues, e.g. rejection under 35 USC § 101.
- Enters any related appeal information in the appeal brief annotation.
- Enters Master Discipline Docket, Heard/On Brief designation, Technology Center, and special status information into the Pre-Appeal Bibliographic Data page in ACTS.
- Assigns the application to the Supervisory Paralegal of the appropriate discipline team in ACTS pre-appeal.
- Messages the Supervisory Paralegal of the appropriate discipline team.

*D. Oversight by CRA*

Once the application is in PALM 132 status, the BPAI has 30 days to process the case. It is the responsibility of the CRA to insure that each case is processed as expeditiously as possible while in 132 status. The CRA will monitor cases to make sure that no case exceeds the 30 day processing time.

## II. Undocketed Appeal Processing for New Appeals

Undocketed Appeal Processing encompasses promoting those cases ready for decision on appeal to appeal status and performing the steps required to bring the appeal before the Administrative Patent Judge panel (Judge panel) for its decision (docketing to the Judge).

### *A. Undocketed Appeal Intake*

#### 1. Supervisory Paralegal Appeal Intake Procedure

The Supervisory Paralegal of the appropriate discipline team checks the IFW for messaged cases and assigns the cases to the appropriate team member for processing. The Supervisory Paralegal also tracks the status of completion of the assigned tasks and reviews the quality of work completed by the team members. Evidence of high quality work and timeliness are tracked as well as errors in processing.

#### 2. Discipline Team Member Appeal Processing Procedure

Incoming cases in PALM 132 status are subject to the 30 day processing window monitored by the CRA. Once a case is assigned for processing, the Discipline Team Member must process the case as expeditiously as possible to minimize the time the case is in 132 status. The employee should discuss with his/her supervisor workload issues that may impact the timely processing of cases in PALM 132 status.

The Discipline Team Member performs the following tasks:

- Performs PALM 124 transaction to assign the application an appeal number.
- Promotes the application in ACTS to an appeal case.
- Verifies/enters the following data in ACTS:

- o Application number
- o Appeal number
- o Discipline
- o Technology Center (TC)
- o Whether On Brief or Hearing case (OB/H)Master discipline docket
- o Special type (if appropriate)
- o Enter TC designation 3620, 3680 or 3690 for cases coming from art units 3620+, 3680+ or 3690+, i.e., business method cases
- Prepares a Docketing Notice
  - o Mail copy to applicant
  - o Send a copy for scanning into the electronic file (IFW)
  - o Provide a stamped mailed paper copy to the designated member of Administrative Officer (AO) staff
- Prepares the electronic working file (eWF)

### 3. Preparation of Electronic Working File (eWF)

For each appeal case, the Discipline Team Member prepares an electronic working file (eWF). The eWF provides an internal working file for use by Judges and other Board personnel that can be reviewed and marked up during the appeal decision process. The eWF is stored on the Board's shared drive (S:\ drive) in designated folders.

#### a) Documents included in the eWF

PTOZone is used to initially download documents into the eWF. PTOZone automatically arranges the papers in chronological order with a bookmark outline listing the most recent document at the top. The downloaded order of documents and bookmarks are retained. The following documents are placed into the eWF from PTOZone:

- Request for Oral Hearing (if any)
- Reply Brief Noted
- All Reply Briefs filed after the Examiner's Answer
- All Supplemental Examiner's Answers filed after the Examiner's Answer
- Examiner's Answers filed after the last Office Action
- Appeal Briefs filed after the last Office Action

- Any Orders (Returns or Remands) prepared by the Board
- Any response to the Orders
- Last Office Action
- Most recent Drawings (if any)
- Substitute Specification (if any)
- Original Specification
- Original Abstract
- Original Claims
- Bibliographic Data Sheet
- Foreign References and/or Non-patent literature relied upon in the rejections on appeal (rejections included or referenced in the Answer)
- Translations of relied upon foreign references.

#### b) Additional Bookmarks

Each document placed into the eWF must be accompanied by a bookmark. The bookmarks automatically created upon downloading documents from PTOZone are retained. Add the following additional bookmarks:

##### 1. Brief bookmarks

Bookmark the following sections of the Brief (bookmark name is same as the section name and is indented under the Brief bookmark):

- Table of Contents of the Brief (if any)
- Real Party In Interest
- Grounds of Rejection to be Reviewed on Appeal
- Argument
- All Appendices including
  - o Claims Appendix
  - o Related Proceedings Appendix
  - o Evidence Appendix

##### 2. Answer bookmarks

Bookmark the following sections of the Answer (bookmark name is the same as the section name and is indented under the



Answer bookmark):

- Evidence Relied Upon
- Grounds of Rejection
- New Grounds of Rejection (if any are present)

c) Additional Papers

The following documents are further added to the beginning of the eWF in the following order and a bookmark for each created:

- PALM Application Number Information Page. Bookmark name: "Palm information"
- IFW Table of Contents. Bookmark name: "IFW Table of Contents." Inserted from either eDAN or Madras such that it includes the annotations section.
- Docketing Notice. Bookmark name: "Docketing Notice."

The following documents are placed at the end of the eWF:

- All U.S. Patents relied upon in the appealed rejections. Bookmarked by last name of the first inventor. The bookmarks are indented under the bookmark created within the Answer to the "Evidence Relied Upon."
- Prior decisions (if not already included in appellant's Related Proceedings Appendix). Bookmarked under the "Related Proceedings Appendix."

Once the eWF is created, the note tool of Adobe Acrobat is used to annotate the top left corner of the Docketing Notice with the creation date of the eWF by entering the date the docketing notice was created in mm/dd/yy format. Example: "eWF created on 00/00/06."

An example bookmark outline follows:

- Panel Assignment
- Palm Information
- IFW Table of Contents
- Docketing Notice
- 2006-07-13 Reply Brief Noted - BPAI
- 2006-04-21 Reply Brief Filed
- 2006-04-21 Request for Oral Hearing
- 2006-04-07 Examiner's Answer to Appeal Brief
  - Evidence Relied Upon
    - Fortune et al.
    - Breed et al.
  - Grounds of Rejection
    - New Ground of Rejection
- 2006-01-30 Appeal Brief Filed
  - Brief TOC
  - Real Party In Interest
  - Grounds of Rejection to be Reviewed on Appeal
  - Arguments
  - Claims Appendix
  - Related Proceedings Appendix
  - Evidence Appendix
- 2005-03-09 Final Rejection
- 2004-11-03 Bibliographic Data Sheet
- 2003-12-11 Specification
- 2003-12-11 Abstract
- 2003-12-11 Claims
- 2003-12-11 Drawings

## c) Storage of the eWF

### 1. Filename

The eWF is assigned a filename wfnnnn-nnnnnn.pdf wherein wf stands for working file and nnnn-nnnnnn is the appeal number. Additional information can be included in parentheses.

Example: wf2006-001234.pdf  
wf2006-001234 (related 06-1334).pdf

## 2. Storage location

The team member saves the eWF file on his/her H:\ drive and also saves the eWF on the S:\ drive at S:\Appeals Processing\Working Files\Unassigned Cases\ in a designated subfolder according to its hearing status and, if an on brief case, further according to its master discipline docket.

For example, a working file created for appeal 2009-001234 on an application from TC 1600 in which the hearing was waived would be saved as:

S:\Appeals Processing\Unassigned Cases\On Brief  
Biotech\wf2009-001234.pdf.

### *B. Panel Assignment*

The Chief Appeals Administrator (CAA) monitors the S:\Appeals Processing\Working Files\Unassigned Cases folders and coordinates with the Chief Judge in making panel assignments. See SOP 1 for procedures governing the assignment of judges to panels. Related cases are, if possible, assigned to the same panel.

## 1. Panel Assignment in Hearing Cases

### a) CAA Panel Assignment

The CAA assigns panels to a group of hearing cases to be heard in a hearing session. The CAA enters the panel data into ACIS. Once panels are assigned, the CAA sends an email to the AO (Administrative Officer) with a list of the appeal numbers and panel members of the group of cases to be heard in the hearing session.

### b) AO Sets Hearing

The AO sets the hearing date, time, and hearing room for the hearing session. AO staff then performs the following tasks for each case to be heard in the session:

- Enters the hearing data into ACTS
- Assigns the case to Judge1 in ACTS
- Enters the panel assignment into an eWF Assignment Sheet
- Inserts the eWF Assignment Sheet into the eWF
- Drafts and mails the hearing notice to the appellant
- Converts the hearing notice to PDF and inserts the notice at the end of the eWF and creates a Hearing Notice bookmark.
- Relocates the eWF to the S:\Appeals Processing\Working Files\Assigned to Judge folder.

AO staff also record hearing confirmations and waivers in ACTS, and convert these papers into PDF, and insert the papers into the eWF, when such papers are received. In addition, the AO staff will send the waivers and confirmations to be scanned. Note that once a case is designated as “Heard” in ACTS, the “Heard” status remains in the databases even if the hearing is waived.

The AO team handles all requests for rescheduling hearings, telephonic hearings, and video hearings. The AO will grant, deny or modify appellant’s request. Once the order dealing with appellant’s request has been mailed, the AO staff will enter the data into ACTS. After the data is entered into ACTS, a member of the AO staff will convert the document to PDF, insert the PDF document into the eWF, and bookmark it.

The AO is also responsible for ensuring that the proceedings of oral hearings are recorded and transcribed. Upon receipt of the transcribed record of proceedings, the AO emails an electronic version to the Appeals Manager to process for correction of typographical and clerical errors and authentication by Judge1 or their designee and for approval by the Vice Chief Administrative Patent Judge (Vice-Chief Judge). It should be noted that this process is separate and distinct from the processing of Board decisions.

The Microsoft Word formatting of Record of Proceedings is generally the same

as outlined in SOP 4 for appeal decisions. Initial codes and settings in Microsoft Word are as follows:

- a. Justification – LEFT
- b. Widow-Orphan Protection – ON
- c. Font – Times New Roman 14
- d. Line spacing – 1.5
- e. Margins – 1.25 inch on each side, 1.0 inch on top and bottom
- f. Footnote, headers, and footers – same size font as text on page, single-spaced.
  
- g. Page numbers are located at the bottom, center, of each page except for the first page (no page numbering on the first page).
  
- h. Line numbering is turned on. Line numbers are located in the left margin. The settings start at 1 from AUTO count by 1, and restart each page.

Upon receipt of the electronic version of the transcript by the Appeals Manager, the following procedures are followed:

- A copy of the electronic file is placed into the S:\Oral Hearings\Record of Proceedings folder. The file is renamed ropnnnn-nnnnnn where nnnn-nnnnnn is the assigned appeal number.
  
- The Appeals Manager sends an electronic copy to Judge1 for review and correction of the transcript.
  - Judge1 reviews and corrects typographical and clerical errors in the electronic copy using the Track Changes feature of Microsoft Word for any revisions, and adds a certificate of authentication attesting to the completeness and correctness of the transcript.
  
  - Judge1 sends the authenticated electronic copy to the Appeals Manager.
  
  - The Appeals Manager sends the authenticated electronic copy to the Vice-Chief Judge for approval.
  
  - The Vice-Chief Judge reviews the authenticated electronic copy, including any corrections made by Judge1, and, upon approval, advises the Appeals Manager.

- The Appeals Manager accepts the corrections approved by the Vice-Chief Judge and sends a printed copy of the authenticated transcript to appellant and the original for scanning into the official record.

## 2. Panel Assignment in On Brief Cases

The panel assignment procedure is simplified for on brief cases because scheduling of a hearing is not required. Panel assignment is made by considering the master discipline docket and assigning related cases to the same panel where appropriate.

Once the panel assignment is made the CAA or a Discipline Team member performs the following tasks:

- Enters the panel assignment into ACTS and assigns the appeal to Judge1
- Enters the panel assignment into an eWF Assignment Sheet
- Inserts the eWF Assignment Sheet into the eWF
- Relocates the eWF to the S:\Appeals Processing\Working Files\Assigned to Judge folder.

## 3. Panel Changes

Whenever a panel change, authorized in accordance with SOP 1 § V, is made, the Supervisory Paralegal:

- updates ACTS to reflect the new panel designation.
- updates the eWF Assignment Sheet by striking through the replaced panel member(s) using the Adobe Acrobat cross-out tool and listing the new panel member(s) and date of the change using the text box tool.
- sends an email to Judge1 indicating that the panel has been changed and listing the old and new panel designations.

## 4. Assignment to Patent Attorney

Supervisory Judges assign cases to Patent Attorneys (PAs) reporting to them by emailing the Discipline Team Supervisory Paralegal. The Supervisory

Paralegal:

- updates ACTS to reflect assignment to the PA.

### III. Docketed Appeal Processing

Docketed appeal processing encompasses the handling of appeals from the time they are docketed to the Judge panel to the time a decision is mailed.

#### *A. Notification of Docketing*

Docketing of cases to the Judge occurs upon entry of the panel information in ACTS. The Judge may get a list of assigned cases from ACTS.

#### *B. Conferencing by Judges*

Judge1 is responsible for scheduling a conference with at least one other panel member. See SOP 1 § V for more guidance on panel assignments and panel changes. Conferences can be held in any manner that facilitates the understanding of the issues on appeal and allows effective decision-making. Methods of conferencing include teleconferencing as well as in-person meetings. The eWF is designed to facilitate teleconferencing.

#### *C. Draft Decision Processing*

After conferencing the case with the appropriate panel member(s), the Judge authoring the majority opinion composes a draft opinion to be submitted to the discipline team for processing. See SOP 4 for standards governing the format and style of the draft opinion.

##### 1. Use of Approved Software

Judges must prepare and submit draft opinions in an approved version of Microsoft Word. Other methods of preparing draft opinions require

specific approval by the Chief Judge.

## 2. Saving Draft Opinions to the C:\ and S:\ Drives

During the drafting of the opinion, the Judge should save the document to his/her local C:\ drive. When the draft is ready for processing by the discipline team, the Judge places a copy onto the S:\ drive. The naming and location conventions are as follows:

### a) Document Filename Convention

The file is named using a two letter code for the type of decision, the appeal number followed by the word "draft" and giving the file the proper extension. For example, a draft opinion for appeal number 2006-001234 in Word would be named "fd2006-001234 draft.doc". 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.

As referenced below, decisions are identified generically as "xxnnnnn-nnnnnn."

### b) 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 Judges 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 draft folder by the Judge must be a clean copy, i.e. there are no track changes that have not been accepted or rejected by the Judge in the draft.



### 3. Submission to the Discipline Team

Once the Judge has composed an initial draft opinion, the Judge notifies the appropriate discipline team that the draft is ready for further processing.

#### a) Email Notification – Draft for Discipline Team Processing

For drafts in electronic form, notification is by email to the appropriate team mailbox. The email must include:

- Subject line – “[filename] draft Judge1/Judge2/Judge3.” Example: fd2006-001234 draft Jones/Smith/Doe
- Include Application Serial Number in the body of the email.
- Include any change of order between Judge2 and Judge3 in the body of the email.
- Include any special directions in the body of the email.
- The email should be sent to the mailbox of the appropriate team:
  1. BPAI Biotech Team
  2. BPAI Chemical Team
  3. BPAI Communications Electrical Team
  4. BPAI Computer Team
  5. BPAI Mechanical Team
  6. BPAI Business Methods Team

#### b) Dictation

Drafts composed by dictation are forwarded to the discipline team

by hand carrying to a designated shelf.

#### *D. Draft Processing by the Discipline Team*

The Supervisory Paralegal monitors the discipline team inbox and assigns drafts to a Discipline Team Member for processing. The email sent by the Judge is forwarded to the assigned team member with a cc to the Judge. "case assigned" is added to the subject line of the email. For example, for appeal fd2006-001234 the subject line reads: fd2006-001234 draft Jones/Smith/Doe – case assigned.

#### 4. Drafts Assigned to the Paralegal

Once the draft is assigned to a paralegal, the paralegal will perform the following duties:

- If the draft received from the Judge is not a clean copy, the Paralegal is not to work on that draft. A clean copy is a copy that does not have any track changes that have not been accepted or rejected by the Judge who submits the draft.
- Locate the draft on the S:\ drive
- Revise the draft so that it is in conformance with the standards of SOP 4, Style and Format, and Section 508 of the U.S. Rehabilitation Act such that the opinion is in final form before review by the Judge panel.
  - o The "track changes" function of Word is used to highlight edits.
  - o If an explanation is needed for a change, the team member inserts a comment in the appropriate location of the document using the commenting feature of Word.
- Save the revised draft to the local C:\ drive.
- Save the revised draft to the S:\ drive changing "draft" to "circ". Example: fd2006-1234 circ.doc.
- Email the lead paralegal for paralegal review. The subject line of the email reads: "xxnnnn-nnnnnn circ Judge1/Judge2/Judge3". Example fd2006-001234 circ Jones/Smith/Doe.
- The lead paralegal reviews the revised draft prepared by the legal tech. Once the revised draft is ready for Judge review, the lead

paralegal forwards the email to the legal tech with any changes and corrections made.

- The legal tech will then email the Judge with a cc to the Supervisory Paralegal of the discipline team.
- Quality Review – the Supervisory Paralegal notes the quality of work of the legal tech and paralegal.

#### *E. Circulation of Draft Opinion*

### 6. Initial Judge Review

After receiving the “xxnnnn-nnnnnn circ Judge1/Judge2/Judge3” email, the authoring Judge:

- accesses the “xxnnnn-nnnnnn circ. doc” document from the S:\Appeals Processing\Opinion Processing\Judge1name\ Draft Opinions folder,
- reviews the revised draft opinion, and
- accepts or rejects the changes made by the discipline team member.
- If changes involving format and grammar governed by SOP 4 are rejected, the Judge informs the team member (PL/LT) of the rejection. This can be accomplished by an email to the PL/LT explaining the rejection and/or by attaching the opinion with internal comments to the email. Disputes involving formatting, style, and grammar are resolved according to SOP 4. The Judge may commence circulation of the opinion to Judges 2 and 3 without waiting for a response regarding a rejection if doing so will not cause confusion and if doing so will promote efficiency.
- The Judge may further revise the opinion following the standard grammar and formatting conventions set forth in SOP 4. The revised opinion is resaved on the S:\ drive. If the revision involves more than minor changes, track changes are used to show the revisions and the draft is resubmitted to the discipline member for proofreading of the changes. The discipline team member accepts or rejects the changes and makes any further revisions using the track changes function. After proofreading, the S:\ drive is again updated and the Judge emailed. When changes are rejected, the Judge must be informed as to why.
- The Judge provides feedback to the Supervisory Paralegal concerning the quality of proofreading and correction provided by

the discipline team member.

## 7. Email Circulation and Authorization

The authoring Judge circulates the opinion by email (circulation email) for review by the other Judges on the panel.

### a) Order of Circulation

If the case was subject to a two-way conference, the circulation email is first forwarded to the conferee (Judge2) and then to the third member of the panel (Judge3). If the case is an expanded panel case, the circulation email is forwarded from one panel member to the next in the order listed on the assignment sheet.

### b) Editing and Commenting

If a reviewing Judge has suggested changes, these changes will be inserted into the opinion residing on the S\ drive at "xxnnnn-nnnnn circ.doc" using the track changes function of Word. The commenting tools of Word are used to explain changes or ask questions where appropriate.

### c) Conferencing

Reviewing Judges may at any time schedule further conferences to resolve outstanding issues.

### d) Authorization for Mailing

Each of the Judges on the panel shows their agreement with the decision by placing their initials in the appropriate location of the opinion (fd2006-001234 circ.doc) residing on the S\ drive. The initials are placed at the end of majority opinion, concurrence, or dissent depending on where agreement lies. After initialing, the Judge types "I authorize for mailing" in the body of the circulation email and forwards the circulation email to the next Judge for

review cc'ing the authoring Judge until authorizations are obtained from all panel members. The Judge may include further notes with regard to the extent of authorization or other notes. For instance, changes may be noted as mandatory or as discretionary.

#### 8. Mailing by Discipline Team

Once Judge1 receives authorization from all panel members, Judge1 does the following:

- Accepts or rejects all changes (may leave initials as track changes) and deletes all comments. All changes that are not noted as discretionary must be accepted. If Judge1 disagrees with changes not noted as discretionary, Judge1 contacts the Judge who made the changes to resolve the issue and obtain authorization for modification of the change.
- Resolves any outstanding issues such as quotation checks, pinpoint cites, etc. with the Paralegal. (The Opinion must be in final form before it is moved to the Ready for Mailing folder.)
- Moves the opinion (must not contain any track changes or comments in the body of the opinion) from the draft location on the S:\ drive to the "Ready for Mailing" location (S:\Appeals Processing\Opinion Processing\Judge1\Ready for Mailing\), deleting "circ" from the filename. Example filename: fd2006-001234.doc.
- Deletes the circulation file from the draft opinion location on the S:\ drive. If the Judge wishes to save a copy, it should be moved to the Judge's C:\ drive.
- Forwards the circulation email back to the Discipline Team Member with a cc to the appropriate discipline team mailbox to inform them that the decision is ready for mailing. "Ready for mailing" is typed into the subject line of the email. For fd2006-001234.doc, the subject line reads fd2006-001234 Jones/Smith/Doe – ready for mailing.

The Discipline Team Member receiving the email performs the following:

- Reviews the opinion to verify it is ready for mailing. (If there are any active track changes or comments remaining other than the Judge initials at the end of the document, the reviewer notifies the

Judge that the decision is not ready for mailing and waits for a corrected version to be placed in the Ready for Mailing folder.)

If the decision is ready for mailing, the Discipline Team Member:

- Inserts the mailing date after “Decided:” on the first page of the opinion
- Deletes the Judge initials from the last page and saves the changes
- Mails the decision
- Sends the decision to scanning
- Uploads the decision to the e-foia database
- Places a copy of the opinion in the e-foia back up folder
- Updates ACTS and PALM
- Messages (eDAN or Madras)
  - o Reversal or Remand: message the Technology Center
  - o Affirmed, Affirm-in-part, or any decision including rule 41.50 (ex. Affirmed 41.50b; Affirmed-in-part 41.50b; reversed 41.50b) message BPAI-post
- Places on monthly report to be given to Supervisory Paralegal/Administrator
- Moves the decision from the Judge’s Ready for Mailing folder to the Judge’s Mailed Decisions folder
- Emails Judge1. Subject line: xxxnnnn-nnnnnn (Judge1/Judge2/Judge3) – mailed. Example: fd2006-001234 (Jones/Smith/Doc) – mailed.

## 9. Judge Retrieval of Mailed Decision

The decisions must be removed from the Mailed Decisions folders.

- Judges must either delete the mailed copy from the Mailed Decisions folder or move it to his/her own drive.

### *F. New Evidence Cited in the Opinion*

If the panel cites new evidence not of record in the IFW, that evidence must be

placed into the eWF to allow Judge review during opinion circulation and to further allow handling during mailing of the decision. The following procedure may be used to facilitate processing of new evidence.

#### 10. Electronic Copy Available

If the new evidence is in electronic form, the Judge may either insert it into the eWF or email it as an attachment to the Supervisory Paralegal providing instructions to have it inserted into the eWF. The subject line of the email: [Appeal No.] new evidence for eWF. Example: 2006-1234 new evidence for eWF.

#### 11. Paper Copy

If the new evidence is in paper form, the Judge may deliver it to the Supervisory Paralegal for scanning. A cover sheet with Appeal No., Serial No., name for the document, and Judge Name is attached.

a) A designated team member:

- scans the new evidence document
- saves the document under the name "New Evidence [name].pdf,
- inserts the document into the eWF,
- bookmarks the document "New Evidence [name]" and places the bookmark at the end of the eWF,
- emails the Judge, the email including:
  - o subject line: [Appeal No] new evidence [name] inserted into eWF
  - o new evidence document as an attachment

b) Judge saves the attachment to his/her C: drive. This copy is left clean.

c) Board Personnel may bookmark and mark up the eWF copy.

#### 12. Judge Ready for Mailing Email

When the decision is placed in the Ready for Mailing folder, the Ready for Mailing email must include the following:

- Include “new evidence” in the subject line so that the subject line reads “xxnnnnn-nnnnnn Judge1/Judge2/Judge3) – ready for mailing NEW EVIDENCE.”

Example: fd2006-001234 (Jones/Smith/Doe) – ready for mailing NEW EVIDENCE.

- For US Patents, include its number and first inventor name in the body of the email,
- For non-US Patents, attach the document to the email. Name the document “New Evidence [name].pdf.

#### 4. Team Member Processing

After receiving the Ready for Mailing email from the Judge, the team member performs the following in addition to the other tasks required for mailing the decision.

- prepares a PTO-892 listing the document (use eWF to verify document information).
- If the new document is not a US Patent, mail the document with the decision.

#### IV. Requests for Remailing/Errata

Take all requests for remailing to the CAA.

#### V. Procedure for Requests for Rehearing

##### A. Rehearing Intake Procedures

The CRA monitors the BPAI.Inbox of IFW for messages indicating that a



Request for Rehearing has been filed, as well as faxes received from the public. Upon receiving a request for rehearing from the IFW mailbox, the CRA sends a message to a CRA team member. The team member will verify that the PALM status of the application reflects that a request for rehearing has been filed. If not, the CRA will enter the Request for Rehearing into PALM

The CRA team member then messages the Supervisory Paralegal of the appropriate Discipline Team. The Supervisory Paralegal assigns the case to a team member for processing as follows:

- Create or update the eWF.
  - o If an eWF already exists,
    - insert the BPAI Decision from which rehearing is requested and the Request for Rehearing at the beginning of the eWF,
    - place bookmarks to the BPAI decision and Request for Rehearing at the beginning of the bookmark list with the Request for Rehearing bookmark at the top, and
    - place the eWF in the appropriate S:\Appeals Processing\Working Files\Unassigned Cases\On Brief folder according to its master discipline docket,
  - o If an eWF does not exist, one is created as set forth in the procedures above in IIA3 so that the eWF contains all the papers and bookmarks listed in IIA3 plus the BPAI decision and the Request for Rehearing.
  - o Inform the CAA that a Request for Rehearing has been filed, identifying the Request by appeal number.

#### B. Request for Rehearing Panel Assignment Procedures

The CAA monitors the Unassigned Working Files folder and consults with the Chief Judge on whether an expanded panel should be assigned. The case is then assigned to the appropriate panel as set forth for On Brief cases above.

Once the panel is assigned the CAA or a Discipline Team Member performs the following:

- Enters the Request for Rehearing data into ACTS (receipt date equals the eWF creation/update date).
- Enters the panel assignment into ACTS and assigns the rehearing request to Judge1

- Enters due date for decision of rehearing.
- Creates a new electronic assignment sheet with the new panel and rehearing designation.
- Inserts assignment sheet into eWF at top of file
- Relocates the eWF to the S:\Appeals Processing\Working Files\Assigned to Judge folder.
- Judge is notified of docketing of Request for Rehearing in the same manner as in section III.A.
- Processing continues as described in Section III.