

Michael  
Fleming

Digitally signed by Michael  
Fleming  
DN: cn=Michael Fleming,  
c=US, o=Board of Patent  
Appeals and Interferences,  
ou=Chief Administrative  
Patent Judge  
Date: 2006.12.07 20:06:47  
-05'00'

**BOARD OF PATENT APPEALS AND INTERFERENCES**  
**STANDARD OPERATING PROCEDURE 4**  
**STANDARDS OF AN EX PARTE APPEAL DECISION<sup>1</sup>**

The purpose of this document is to set standards for the format and style of opinions in support of decisions by the Board of Patent Appeals and Interferences (Board). Standards are set with the following objectives in mind: to ensure that opinions are professional looking; to place the focus on the substantive underlying basis for opinions rather than on style and format; to increase the efficiency of opinion writing; and to maintain high quality. For example, now that opinions are posted on the web, it is important to remove distractions caused by variations in style and formatting as the reader moves from one opinion to the next. Having standards in place also increases efficiency by allowing a higher reliance upon paralegal staff in opinion preparation. Standards also provide uniformity in opinion writing with a focus on improving appearance, grammar, and citation. The following mandatory directives are set forth to accomplish these objectives.

This Standard Operating Procedure creates internal norms for the administration of the 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. Formatting

Opinions are formatted in Microsoft Word as follows.

- A. Initial codes and settings in Microsoft Word
1. Justification -LEFT
  2. Widow-Orphan Protection -ON
  3. Font -Times New Roman 14
  4. Line spacing -1.5
  5. Margins -1.25 inch on each side, 1.0 inch on top and bottom (default of MS Word)
  6. Footnote, headers, and footers -same size font as text on page, single-spaced.
  7. Page numbers are located at the bottom, center, of each page of the opinion, except for the first page (no page numbering on the first page).

---

<sup>1</sup> This SOP does not apply to procedures for inter partes reexamination appeals. See SOP 5 and 6 for guidance for appeals in this type of application.

## B. Emphasis

Every letter of a section heading is capitalized, e.g., “DECISION ON APPEAL” or “CONCLUSION”. The letters are *not* underlined, italicized, or bolded.

Every letter of the outcome of the opinion is capitalized and underlined, e.g., “AFFIRMED”. The letters are *not* bolded or italicized.

## C. Explanation

Left justification is adopted because it evenly spaces the words on the line. Even spacing makes the document easier to read. Also, full justification, while professional looking, is harder to format and can result in large gaps between words that make a document harder to read.

Widow-orphan protection prevents the first and last lines of a paragraph from appearing on a separate page from the rest of the paragraph. This helps keep the thought of the paragraph unified.

Times New Roman is selected as the font because it is a traditional style typeface adapted for use on computer screens. The letter size of Times New Roman 14 is easy to read on the computer screen. Also, Times New Roman is a proportional font, and therefore 14-point has been chosen. Italics is more recognizable using Times New Roman font versus Arial. Times New Roman is chosen rather than a sans-serif font, such as Arial, because the Times New Roman font has a more formal appearance.

1.5 line spacing is adopted for space-saving purposes (as compared to double spacing), and for its professional look. 1.5 line-spaced documents are easier to read than single-spaced documents.

1.25 inch margins (left and right) are used because this is the default position in Microsoft Word.

The footnote font size is the same as the text font size because anything smaller is less legible.

Italics are used in citations and titles rather than underlining because in electronic documents underlining is easily confused with hyperlinks. Moreover, underlining was historically used as a means to indicate to a publisher to italicize what was underlined (when using typewriters, before computers). Italics look more professional in a published document.

The above document settings were chosen to impart accessibility for the sight impaired, for improved legibility, and for providing a professional appearance to the final document.

## II. Citation

The most recent edition of *The Bluebook: A Uniform System of Citation* is to be used for determining proper citation, wherever applicable. For instance, at the publication date of this SOP, the most current version of the *Bluebook* is the 18<sup>th</sup> edition published in 2005. The Bluebook standard has been chosen as the tool for proper citation because it is the well-accepted legal citation system used in the United States. Some commonly used examples of citations found in Board rules of citation taken from the 18<sup>th</sup> edition of the Bluebook are listed below.

BLUEBOOK RULE	EXAMPLE
Case citation Rule B5  Parallel citation to the Federal Reporter and the United States Patent Quarterly when applicable	<i>In re Widmer</i> , 353 F.2d 752, 757, 147 USPQ 518, 523 (CCPA 1965).
Statute, rule, and regulation citation Rule B6 See also Rule 14.2 for more guidance on rules and regulations.	35 U.S.C. § 103(a) (2004).  37 C.F.R. § 41.37 (c)(1)(vii) (2004).
Book citation Rule B8	21 Charles Alan Wright & Arthur R. Miller, <i>Federal Practice and Procedure</i> § 1006 (2d ed. 1987).
Journal citation Rule B9	Kenneth R. Feinberg, <i>Mediation-A Preferred Method of Dispute Resolution</i> , 16 Pepp. L. Rev. 5, 14 (1989).

BLUEBOOK RULE	EXAMPLE
<p>Documents in the Record            Rule B10            Abbreviate document names according to Table BT.1            Enclose in Parentheses according to rule B10.2            Pinpoint cite according to B10.3.            Use abbreviations of document subsections (columns, lines, etc.) according to Table T16</p>	<p>Appellants admit that Smith describes a widget as claimed (Br. 6).<sup>2</sup></p> <p>The Examiner finds that Smith describes a widget as claimed (Answer 7).</p> <p>The Examiner finds Smith describes the claimed widget (Answer 7: 3-10).</p> <p>Smith describes a widget as claimed (Smith, col. 4, ll. 5-10).</p>
<p>Capitalize “Appellant” and “Examiner”, and capitalize documents in the record.            Rule B10.6</p>	<p>Both the Examiner and Appellant discuss this issue in the Answer and in the Brief, respectively.</p>
<p>Direct Citations to Internet Sources            Rule 18.2.3</p>	<p><i>Castro v. United States</i>, No. 02-6683, slip op. at 8 (U.S. Dec. 15, 2003), <a href="http://www.supremecourtus.gov/opinions/03pdf/02-6683.pdf">http://www.supremecourtus.gov/opinions/03pdf/02-6683.pdf</a>.</p>

### III. Standardized Text

When reproducing a list of evidence relied upon by the Examiner, the following format is used.

#### A. Patent documents

List patent documents in a three-column list, in the order from earliest issue date to latest issue date.

In the first column, list the last name of the first inventor. Do not include “et. al.” If relying upon a translation of the document, state “as translated” in parentheses, if there is just one translation of record. If such a short form statement would cause confusion or a longer explanation is required

---

<sup>2</sup> This example uses an abbreviation for the word “Brief.” Abbreviations are to be used when the Bluebook provides an abbreviation for a particular word. If the Bluebook does not provide a word with a particular abbreviation, then that word is not abbreviated (use the full word). Such an example is the word “Specification.”

(c.g., when there is more than one translation and a full citation is required), place the information in a footnote to prevent confusion.

In the second column, include the following three elements: (A) the two-character country code (US for United States of America); (B) the patent or publication number; and (C) the WIPO ST.16 kind code (A1 for pre-grant Publication, B1 for patent with no pre-grant publication, etc.) if it is listed with the patent or publication number on the patent document. See *Manual of Patent Examining Procedure* § 901.04(a) (8<sup>th</sup> ed., rev., Oct. 2005) for a list of WIPO ST.16 kind codes.

In the third column, list the publication or issue date, and abbreviate the month to 3 letters followed by a period. For U.S. patents that qualify as prior art under 35U.S.C. § 102(e) rather than § 102(b), list the effective filing date in parentheses in the next line after the issue date *only* when such a date is a material fact in the case.

#### 1. Example

The examiner relies upon the following references as evidence of unpatentability:

Szwargulski	US 3,520,330	Jul 14, 1970
Mays (as translated)	DE 24 06 313	Aug. 28, 1975
Biseibutsu	EP 0424193A2	Apr 24, 1991
Gorman	PCT/US91/05013	Feb. 6, 1992
Tai	US 2001/0027076 A1	Oct. 4, 2001
Chen	US 6,710,101 B1	Mar. 23, 2004 (filed May 5, 2002)
Sasaki	JP 61091254	Jan. 20, 2005
Timblee	WO 9208346	May 12, 2005

B. For non-patent literature, follow Bluebook rules.

#### C. Working Document

A working document entitled "Working Document for Standardized Text" has been created and is available on the S: drive, in the Appeals Processing folder.

This working document has examples of standardized text/formatting not specifically addressed by this SOP, or has examples needful of further explanation.

Additions to this working document will occur as new items are raised and addressed.

#### IV. Grammar

- A. The Quick Access Reference for Writers, 5<sup>th</sup> Edition, from Prentice Hall is used as the standard reference guide for assistance with grammar usage when writing opinions.
- B. Sometimes more than one option is provided in the Quick Access Reference for Writers. The following is an example of which option to use in such a circumstance.

Example: there is a choice between "x, y, and z" versus "x, y and z." We will follow the American practice of placing a comma before "and".

#### V. Dispute Resolution

When there is a dispute on a particular usage of grammar or citation, the dispute shall be resolved by first consulting the Quick Access Reference for Writers, the Bluebook, and this SOP. For issues arising that are not covered by the Quick Access Reference, the Bluebook, or this SOP, the issue should be brought to the attention of the lead paralegal. The lead paralegal will resolve the dispute. The decision can be appealed to the supervisory paralegal and then to the Vice Chief Judge and Chief Judge. The lead paralegal and supervisory paralegal will add the resolved disputes to Working Document for Standardized Text placed on the S: drive.

#### VI. Quality Oversight

- A. In order to ensure (1) optimum efficiency in proofreading, (2) correct citation, and (3) correct grammar usage, practice the following procedure.

The Lead Paralegal is to review the grammatical and citation changes made by an APJ in a draft opinion to determine discipline team member performance in proofreading and correction.

APJs are encouraged to provide feedback directly to the discipline team member in such a way that helps him/her achieve higher levels of proofreading and correction.

If, for example, citations have not been inserted or corrected to conform with Bluebook rules, the APJ should inform the discipline team member that correction is required, cc'ing the Lead Paralegal.

If corrections are not accomplished within a reasonable amount of time, the APJ should inform the Lead Paralegal. APJs are also encouraged to point out exceptionally thorough proofreading to the Lead Paralegal.

When there is a dispute concerning corrections between the APJ and PL/LT, inform the Lead Paralegal so he/she can handle the issue.

VII. Copy of the First and Last Pages of an Opinion

- A. A copy of a standard first page and last page of a regular opinion, a reissue opinion, and an ex parte reexamination opinion is set forth on the following pages.
- B. The examples of the titles given on the standard first pages are standard and must be consistently used.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* [INVENTOR(S)]

---

Appeal [number]  
Application [number]  
Technology Center [number]

---

Decided: [Date of mailing]

---

Before [FULL NAME], [FULL NAME], and [FULL NAME], *Administrative Patent Judges*.

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Titles: DECISION ON APPEAL  
ORDER REMANDING TO THE EXAMINER  
DECISION ON REQUEST FOR REHEARING  
ORDER DISMISSING APPEAL  
DECISION ON PETITION  
ORDER REQUIRING APPELLANT TO BRIEF AN ADDITIONAL MATTER



Appeal [number]  
Application [number]

[OUTCOME, e.g., AFFIRMED]

[APJ initials]

[initials of PL/LT **only**]

[MAILING ADDRESS OF APPELLANT]

[page number using numeral only]

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

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* [INVENTOR(S)]

---

Appeal [number]  
Application [number]  
Patent [number]  
Technology Center [number]

---

Decided: [Date of mailing]

---

Before [FULL NAME], [FULL NAME], and [FULL NAME], *Administrative Patent Judges*.

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Titles: DECISION ON APPEAL  
ORDER REMANDING TO THE EXAMINER  
DECISION ON REQUEST FOR REHEARING  
ORDER DISMISSING APPEAL  
DECISION ON PETITION  
ORDER REQUIRING APPELLANT TO BRIEF AN ADDITIONAL MATTER

Appeal [number]  
Application [number]  
Patent [number]

[OUTCOME, e.g., AFFIRMED]

[APJ initials]

[initials of PL/LT only]

[MAILING ADDRESS OF APPELLANT]

[page number using numeral only]

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

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* [PATENT OWNER]  
Patent Owner and Appellant

---

Appeal [number]  
Reexamination Control [number]  
Patent [number]  
Technology Center [number]

---

Decided: [Date of mailing]

---

Before [FULL NAME], [FULL NAME], and [FULL NAME], *Administrative Patent Judges*.

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Titles: DECISION ON APPEAL  
ORDER REMANDING TO THE EXAMINER  
DECISION ON REQUEST FOR REHEARING  
ORDER DISMISSING APPEAL  
DECISION ON PETITION  
ORDER REQUIRING APPELLANT TO BRIEF AN ADDITIONAL MATTER

Appeal [number]  
Reexamination Control [number]  
Patent [number]

[OUTCOME, e.g., AFFIRMED]

[APJ initials]

[initials of PL/LT only]

[MAILING ADDRESS OF APPELLANT]

[page number using numeral only]

### VIII. Template of the First and Last Pages of an Opinion

A template of a standard first page and last page of a board opinion can be found at the following website: <http://uspto-a-acts-3:81/launcher.jsp>.

Click on the “Correspondence” block, and navigate to the template entitled “First/LastPage”.

### IX. Section 508 Compliance

Section 508 of the U.S. Rehabilitation Act requires that all Federal agencies' electronic and information technology is accessible to people with disabilities. This requirement includes all Board opinions that are posted on the FOIA section of the USPTO's web page.

Associating an alternate text with an image or figure in a document needs to be done while drafting the document in MS Word (that is, when the document is created). The guidelines to comply with § 508 require that a text equivalent content be associated with all non-text elements (images or figures) within a document to provide equivalent access.

To meet this requirement, the Board has standardized the format by which images and figures are identified and described in the text of the document during its creation to minimize the need to electronically tag the image or figure. The format used in addressing images or figures so that the documents will technically comply with the § 508 requirements is set forth below.

The format simply requires the following:

1. A statement identifying the image/figure must immediately precede the image.

Example:

Bilstad Figure 2 is reproduced below:



2. A statement describing the image/figure must immediately follow after the image.

Example:

Bilstad's Figure 2 depicts a school house.

Ensuring that Board opinions comply with § 508 is the responsibility of the discipline team member. As a result, APJs must make sure that opinions are processed through a discipline team member so that the discipline team member can verify that the opinion is Section 508 compliant.