

# Michael Fleming

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DN: cn=Michael Fleming,  
c=US, o=Board of Patent  
Appeals and Interferences,  
ou=Chief Administrative  
Patent Judge  
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MEMORANDUM

June 30, 2010

To: Vice Chief Administrative Patent Judges  
Administrative Patent Judges

From: Michael R. Fleming  
Chief Administrative Patent Judge

Subject: Standard Operating Procedure 4 (Revision 2)

The attached document supersedes Board of Patent Appeals and Interferences' Standard Operating Procedure 4, dated November 13, 2009, on the same subject matter.

Attachment:

**BOARD OF PATENT APPEALS AND INTERFERENCES  
STANDARD OPERATING PROCEDURE 4 (Revision 2)  
STANDARDS FOR OPINIONS IN APPEAL DECISIONS**

This document sets standards for the format of opinions in appeal decisions by the Board of Patent Appeals and Interferences (Board).

Standards are set with the following objectives in mind:

- (1) to ensure that opinions look professional;
- (2) to place the focus on the substantive basis for opinions rather than on selecting a format; and
- (3) to maintain high quality.

Having standards in place also increases efficiency by providing guidance to both Administrative Patent Judges (Judges) and administrative staff in opinion preparation. The following directives and recommendations are set forth to accomplish these objectives.

This Standard Operating Procedure (SOP) creates internal norms for the administration of the Board. It does not create any legally enforceable rights.

## I. WORKING RELATIONSHIPS AND RESPONSIBILITIES

Judges and paralegals are organized into teams by technical disciplines, contested cases teams, and also by chambers. Each discipline support team of paralegals includes a supervisory paralegal. Under the guidance of the supervisory paralegal, the paralegals on each support team are expected to become familiar with the organizational and stylistic opinion writing preferences of the Judges on the corresponding APJ discipline team. This familiarity will maximize the efficiency of opinion preparation and minimize unnecessary and duplicative editing.

## II. STANDARDIZATION

### A. Formatting

Opinions are formatted in Microsoft Word as follows:

1. Initial codes and settings in Microsoft Word
  - 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 (MS Word defaults), except the first page which must have a 2 inch top margin
  - f. Footnotes, headers, footers, case captions, and mailing addresses – same size font as text on page, single-spaced
  - g. 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).

h. No explanatory headings are to be placed on the first page of opinions. This is to implement the use of PDF stamps on precedential decisions, informative decisions, and other stamps. This will make the stamps used Section 508 compliant. See Section III below.

i. On the first page of the decision, triple space before the title, e.g., “DECISION ON APPEAL.”

j. A header shall be placed at the left side of the second and each subsequent page of opinions in the form of:

Appeal xxxx-xxxxxx  
Application xx/xxx,xxx

or

Appeal xxxx-xxxxxx  
Reexamination Control xx/xxx,xxx

k. For all opinions in ex parte regular applications and ex parte reissue applications that constitute a *final decision* of the Board for judicial review, the following shall be appended as a footnote from the title on the first page of such opinions:

The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Examples of opinions that do not constitute a final decision of the Board are opinions that include a remand under 37 C.F.R. § 41.50(a) or a new ground of rejection

under 37 C.F.R. § 41.50(b). Opinions that include only affirmances, reversals, or a combination of affirmances and reversals constitute final decisions of the Board.

l. For all opinions in ex parte reexamination proceedings that constitute a *final decision* of the Board for judicial review, the following shall be appended as a footnote from the title on the first page of such opinions:

The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

m. For all opinions in inter partes reexamination proceedings that constitute a *final decision* of the Board for judicial review, the following shall be appended as a footnote from the title on the first page of such opinions:

The one-month time period for filing a request for rehearing, as recited in 37 C.F.R. § 41.79, and the two-month time period for filing an appeal, as recited in 37 C.F.R. § 1.304 (*see* 37 C.F.R. § 1.983(b)(1)), both begin to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

## B. Emphasis

Italics are used for emphasis except when preserving an original typeface or when otherwise needed for clarity.

Capitalization and centering are used for every letter of the title and major headings, without further emphasis, e.g., “DECISION ON APPEAL” or “CONCLUSION.” The format for subheadings is left to the discretion of the authoring Judge.

Capitalization, underlining, and centering are used for every letter of a word describing the outcome at the end of an opinion, without further emphasis, e.g., “AFFIRMED.”

## C. Citation

### 1. Legal and Technical Authority

The authoritative guide for citations is the most recent edition of *The Bluebook: A Uniform System of Citation*. In situations where the *Bluebook* provides no clear citation form or inconsistent forms, the authoring Judge will determine an appropriate citation form.

Italics will be used in case citations for the title (party names).

Parallel citation of opinions is not permitted.

In order of priority, Supreme Court citations are to the United States Reports (U.S.), West’s Supreme Court Reports (S. Ct.), and United States Patent Quarterly (USPQ or USPQ2d). Citation is required only to the highest priority source available.

Court of appeals citations are to the Federal Reporter (F., F.2d or F.3d) or the Federal Appendix (Fed. Appx.), when available. When not available, citations are to the United States Patent Quarterly.

District court citations are to the Federal Supplement (F. Supp. or F. Supp. 2d) or Federal Rules Decisions (F.R.D.), when available. When not available, citations are to the United States Patent Quarterly.

An opinion not available in a printed reporter may be cited to the Westlaw electronic database (2007 WL 1234567).

## 2. Patents and Published Applications

Patents and published applications are identified by at least the surname of the first listed inventor, number (and country code if not U.S.), and issue or publication date prior to any shorthand reference to the document, such as “Jones.” The format and placement of initial reference identification is left to the discretion of the authoring Judge.

For U.S. patents and published applications that qualify as prior art under 35 U.S.C. § 102(e) rather than § 102(b), a § 102(e) filing date is not required unless the date is relevant to an issue in the case.

## 3. Examples

Examples of citations, including identification of references, are provided in the working document described in Section II.F below.

## D. Grammar

The Quick Access Reference for Writers, 5<sup>th</sup> Edition, from Prentice Hall is the recommended reference guide for assistance with grammar usage when writing opinions.

#### E. Separate Opinions

Separate opinions (dissents and concurrences) shall be formatted like majority opinions as described herein. Each separate opinion shall begin on a new page and the pages of such opinion shall be separately numbered.

#### F. Working Document

A working document entitled “SOP 4 Working Document for Standardized Text” is located at “S:\Appeals Processing\SOPs\SOP 4, Style and Formatting of Appeal Opinions.” This working document contains examples of recommended formatting, citation forms, and grammar not specifically addressed by this SOP, including examples requiring further explanation.

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

#### G. Resolution of Issues or Questions

When an issue or question arises concerning a particular formatting item, citation, or usage of grammar, the matter shall be resolved by the authoring Judge in a manner consistent with this SOP.

#### H. Standard First and Last Pages of an Opinion

Examples of a standard first page for opinions are set forth in the attached Appendix for appeals in: an ex parte regular application; an ex parte reissue application; an ex parte reexamination proceeding; and an inter partes reexamination proceeding.



When one of the following titles is appropriate, it should be used:

DECISION ON APPEAL

DECISION ON REQUEST FOR REHEARING

ORDER REMANDING TO THE EXAMINER

ORDER REQUIRING ADDITIONAL BRIEFING BY  
APPELLANT

ORDER DISMISSING APPEAL

Other appropriate titles include:

DECISION ON PETITION

ERRATA

ORDER

An example of a first page for a multiple-opinion decision also is included in the Appendix.

Additionally, an example of a standard last page for opinions is set forth in the Appendix.

### III. SECTION 508 COMPLIANCE

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

Compliance with § 508 requires that a text equivalent content be associated with all non-text elements (images or figures) within a document to provide equivalent access. Associating text equivalent content with an image or figure in a document must be done when the document is created.

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. The format requires the following which are illustrated in the example below):

1. A statement identifying the image/figure must immediately precede the image; and
2. A statement describing the image/figure must immediately follow after the image.

Example:

Figure 2 is reproduced below:

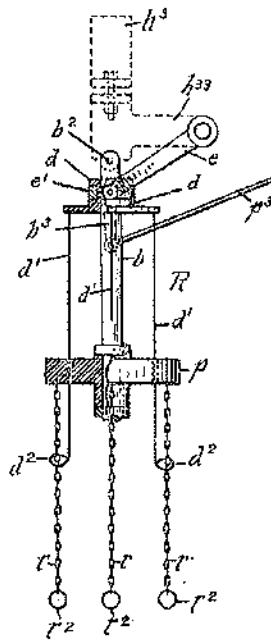


Figure 2 depicts an automobile anti-skid device.

Ensuring that Board opinions comply with § 508 is the responsibility of the paralegal support team member. As a result, Judges must make sure that opinions are processed through a support team member for verification that the opinion is § 508 compliant.

## APPENDIX

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* [INVENTOR(S)]

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

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* [INVENTOR(S)]

---

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

---

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* [PATENT OWNER]  
Appellant

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

---

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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[REQUESTER]

Requester [and Appellant, Cross-Appellant, or Respondent, as appropriate]

v.

Patent of [PATENT OWNER]

Patent Owner [and Appellant, Cross-Appellant, or Respondent, as  
appropriate]

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Appeal [number]

Reexamination Control [number]

Patent [number]

Technology Center [number]

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

[LAST NAME], *Administrative Patent Judge.*

[TITLE]<sup>1</sup>

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The one-month time period for filing a request for rehearing, as recited in 37 C.F.R. § 41.79, and the two-month time period for filing an appeal, as recited in 37 C.F.R. § 1.304 (*see* 37 C.F.R. § 1.983(b)(1)), both begin to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* [INVENTOR(S)]

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

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

Opinion for the Board filed by *Administrative Patent Judge* [NAME].

Opinion Dissenting [Concurring] filed by *Administrative Patent Judge* [NAME].

[LAST NAME], *Administrative Patent Judge*.

[TITLE]<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.



[OUTCOME]

[Judges' initials]

[initials of paralegal/legal instrument examiner only]

[MAILING ADDRESS OF APPELLANT]

[MAILING ADDRESS OF OTHER PARTY WHEN APPROPRIATE]

[page number using numeral only]

MEMORANDUM

March 22, 2011

To: Vice Chief Administrative Patent Judges  
Administrative Patent Judges

From: James T. Moore  
Acting Chief Administrative Patent Judge

Subject: Standard Operating Procedure 4 (Revision 3)

The attached document supersedes Board of Patent Appeals and Interferences' Standard Operating Procedure 4 (Revision 2), dated June 30, 2010, on the same subject matter.

This revision removes the requirement for the footnote on the first page of opinions regarding time periods. It also removes the requirement for the mailing address of appellant to appear on the last page of opinions for regular Ex Parte appeals (does not apply to reexam appeals).

This revision is effective immediately.

Attachment: