MEMORANDUM

February 12, 2009

TO: Vice Chief Administrative Patent Judge
    Administrative Patent Judges

FROM: MICHAEL R. FLEMING
      Chief Administrative Patent Judge

SUBJECT: Standard Operating Procedure 1 (Revision 13)
    Assignment of judges to merits panels, motions panels, and expanded panels

The attached document supersedes Board of Patent Appeals and Interferences’ Standard Operating Procedure 1 (Revision 12) dated August 10, 2005, on the same subject matter.

Attachment
BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 1 (REVISION 13)

ASSIGNMENT OF JUDGES TO MERITS PANELS,
MOTIONS PANELS, AND EXPANDED PANELS

The following applies to the assignment of Administrative Patent Judges (judges) to merits panels,\(^1\) motions panels,\(^2\) and expanded panels\(^3\) in appeals and interferences.

Except as provided in section IV.C. of this Standard Operating Procedure (SOP), assignments (designations under 35 U.S.C. § 6) of judges to panels of the Board of Patent Appeals and Interferences (Board) are made by the administrative personnel of the Board, under the direction of the Chief Administrative Patent Judge (Chief Judge). The Director's authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. See Manual of Patent Examining Procedure § 1002.02(f) (8th ed., rev.2, May 2004).

This 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 and comments made by the Chief Judge and any other judge, are considered part of the deliberative process.

I. Administrative Divisions of the Board

A. The Chief Judge and Vice Chief Administrative Patent Judge (Vice Chief Judge) are ex officio members of all administrative divisions and may administer interferences or otherwise participate in rendering panel decisions.

B. The judges of the Board are assigned to a division based on technical or legal discipline.

II. Designation of Merits Panels

A. In general, the Chief Judge will designate judges as the merits panel to decide \textit{ex parte} appeals based upon their legal and technical expertise.

B. In general, the Chief Judge will designate judges as merits panels to decide \textit{ex parte} and \textit{inter partes} reexamination appeals.

C. In general, the Chief Judge will designate a judge or judges, as appropriate, for all matters for interferences.

\(^1\) Three-judge panels designated to decide appeals and enter final decisions in interferences.
\(^2\) Three-judge panels designated to enter interlocutory orders where a panel is appropriate, including, e.g., requests for reconsideration of non-final decisions in interferences.
\(^3\) Panels consisting of more than three judges.
III. Expanded Panels

From time to time it may be necessary to expand a merits or motions panel. The following applies to the use of expanded panels.

A. Reasons for expanding a panel include:
   1. An issue of exceptional importance, such as where serious questions have been raised about the continuing viability of an apparently applicable prior precedential opinion of the Board.
   2. Conflicting decisions by different panels of the Board.
   3. A substantial difference of opinion among judges on a significant issue pending before the Board.
   4. A written request from the Commissioner for Patents or the Commissioner’s delegate identifying a particular appeal as one containing an issue of first impression, which written request shall become part of the administrative record. This request may be made in advance of decision by the Board or in connection with a request for rehearing.
   5. A written request from the Commissioner for Patents or the Commissioner’s delegate identifying a particular appeal as one presenting an issue governed by a prior decision of the Board,
      a) representing that the Commissioner for Patents has determined that it would not be in the public interest to follow the prior decision, and
      b) asking the Board to reconsider and overrule the prior decision, which written request shall become part of the administrative record. This request may be made in advance of decision by the Board or in connection with a request for rehearing.

B. Generally, an odd number of judges will be designated to decide cases in which an expanded panel is to be used. The Chief Judge will determine when an expanded panel is to be designated.

C. A judge, a merits panel, or a motions panel may suggest to the Chief Judge the need for the designation of an expanded panel. Likewise, the Patent Examining Operation, an applicant or patent owner in an appeal, or a party in an interference may suggest the need for an expanded panel.

D. When an expanded panel is designated after a case initially has been assigned to a three-judge panel but before a decision is entered by the merits panel, the judges initially designated shall be designated, if available, as part of the expanded panel.

E. When an expanded panel is designated after entry of a decision by a merits panel but before consideration of a request for rehearing of the decision of the merits panel, the judges
on the merits panel shall, if available, be designated as part of the expanded panel. The expanded panel shall decide the rehearing on its merits.

F. Generally, expanded panels will include the Chief Judge, a Vice Chief Judge, and additional judges to be assigned by the Chief Judge. The selection of the additional judges shall be based on the technical or legal expertise of the judges.

G. When the Chief Judge is disqualified, recused, or otherwise unable to sit, judges shall be assigned by a Vice Chief Judge and a Vice Chief Judge shall preside.

H. When the Chief Judge and all Vice Chief Judges are disqualified, recused, or otherwise unable to sit, the judges shall be assigned by the Board’s senior management staff and the most senior judge shall preside.

I. In an appropriate circumstance, the Chief Judge may designate an expanded panel consisting of any number of judges, including an expanded panel consisting of all judges, to decide a case.

J. The Chief Judge may require a decision by an expanded panel of seven (7) or more judges to be circulated to each judge of the Board prior to entry of the decision. Within two weeks, each judge not designated on the panel may comment on the decision. Comments shall be in writing (for purposes of this SOP, comments “in writing” include comments transmitted by e-mail) and shall be presented to each member of the expanded panel, with a copy to the Chief Judge and Vice Chief Judge.

IV. Assignment of Cases to Judges

A. A panel designation will be provided for each appeal and interference.

B. A judge assigned to handle an interference should arrange for a substitute judge to act on the case in the absence (i.e., leave, etc.) of the judge assigned to the interference.

C. Except where a party requests and agrees to entry of a pro forma adverse judgment under 37 CFR § 41.127(b), whenever a decision in an interference proceeding requires entry by a panel of judges, the judge to whom the interference is assigned shall have the lead Trial Division judge request an assignment of a panel.

D. The judges designated on a merits panel, motions panel, or expanded panel shall not be changed without authority of the Chief Judge or the Vice Chief Judge. When satisfied that there is good reason to change the panel already designated, the Chief Judge or Vice Chief Judge will approve a revised designation after making whatever changes are determined to be appropriate or will direct senior management staff to enter a revised designation. From time to time, the Chief Judge may authorize Board administrative personnel to alter the panel already designated.
E. A reasonable effort should be made to preserve the roles of judges assigned as the Number 1, Number 2, and Number 3 judges in *ex parte* appeals. However, when the judge assigned the role of Number 1 is of the opinion that it would be in the interest of efficient administration of the Board, the judge assigned the role of Number 1 is authorized to change the roles of judges assigned the roles of Number 2 and Number 3. An instance in which it would be appropriate to change the roles is when the judge assigned the role of Number 2 is on leave for more than a brief period of time. Another appropriate instance in which to change the roles is when after conference with the other judges assigned to the appeal, the judge initially assigned the role of Number 1 is not part of the majority, one of the judges initially assigned the roles of Number 2 and Number 3 will author the majority opinion. Any member of a panel may request that the conference include all members of the panel.
BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 7

DESIGNATION OF BOARD DECISIONS/ORDERS AS INFORMATIVE

This Standard Operating Procedure (SOP) describes the process by which decisions/orders of the Board of Patent Appeals and Interferences (Board) are designated as informative opinions in accordance with the Notice of the Chief Administrative Patent Judge of December 27, 2006, 1314 Off. Gaz. Pat. & Tm. Office 4 (Jan. 23, 2007).

The purpose of an informative opinion is to illustrate norms of Board decision-making for the public, the patent examining corps, and future Board panels. Id. Informative opinions are not binding on the Board. Informative opinions will be posted at:

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

The process for designating a decision/order as an informative opinion is exclusively an internal process that takes place after a decision/order has been mailed by the Board. The Chief Administrative Patent Judge (CAPJ) makes the final determination as to whether a decision/order is to be designated as an informative opinion.

This SOP creates internal operating procedures for the Board and does not create any legally enforceable rights.
I. Review Committee

A. In seeking to make an informed determination, the CAPJ may form an advisory Review Committee to recommend whether a decision/order is appropriate for designation as an informative opinion.

B. The Review Committee is a committee of Board personnel designated by the CAPJ.

C. The CAPJ will designate a Point of Contact (POC) for the Review Committee to facilitate the evaluation process.

D. The POC serves as a liaison to the Review Committee and not as a member of the Review Committee.

II. Procedure For Identifying Candidate Decisions/Orders To Be Designated as Informative Opinions

A. Any APJ may nominate a decision/order to be designated as an informative opinion by submitting the decision/order and a written statement to his/her Lead Administrative Patent Judge (LAPJ) stating the reasons why a particular decision/order should be designated as an informative opinion.

B. After internal considerations within the discipline team, the Lead APJ will decide whether to recommend the decision/order to be designated as an informative opinion.

C. The CAPJ, Vice CAPJ, or a LAPJ can submit a decision/order to the Review Committee via the POC for consideration as an informative opinion.
III. Procedure For Designating Decisions/Orders As Informative Opinions

A. The Review Committee will review the appropriate submission, including the decision/order and any comments from the LAPJ or APJ who submitted the decision/order.

B. The Review Committee members will individually submit their recommendations to the POC on whether designation of the decision/order as an informative opinion is appropriate.

C. The POC will collect the recommendations of the Review Committee members and forward them to the CAPJ.

D. The CAPJ will make the final determination as to whether a decision/order is to be designated as an informative opinion.

E. If the CAPJ’s determination is to designate a decision/order as an informative opinion, the decision/order will be posted at:
http://www.uspto.gov/web/offices/dcom/bpai/informative_opinions.html
BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 8

ASSIGNMENT OF JUDGES TO EX PARTE MERITS PANELS

This Standard Operating Procedure (SOP) describes the process by which judges are assigned to merits panels in ex parte appeals by the Chief Judge’s designee(s).

This Standard Operating Procedure creates internal norms for the administration of the Board of Patent Appeals and Interferences (Board) and complements Standard Operating Procedure 1 (SOP 1), Assignment of judges to merits panels, motions panels, and expanded panels. It does not create any legally enforceable rights.

I. Chief Judge’s Authority to Delegate

The Director’s authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. See Manual of Patent Examining Procedure § 1002.02(f) (8th ed., rev.6, September 2007).

II. Chief Judge’s Designee(s)

A. At the discretion of the Chief Judge, at least one employee, hereinafter designee, may be delegated the task of assigning merits panels (designations under 35 U.S.C. § 6) to ex parte appeals at such times as the Chief Judge deems appropriate.

B. Employees selected to serve as designees will be notified of their selection by the Chief Judge.

C. The delegation to a designee of the task of assigning merits panels is a temporary delegation and is for a time period within the discretion of the Chief Judge.

D. Designee(s) will become familiar with the guidance of SOP 1.
E. Designee(s) will follow the assignment guidance provided by the Working Document accompanying this SOP.

F. At all times, the Chief Judge has the discretion to limit or expand the scope of a designee’s delegation.

III. Discipline Reviewer

A. The Chief Judge has the discretion of appointing at least one employee to review ex parte appeals in a discipline to facilitate the assignment process, at such times as the Chief Judge deems appropriate.

B. Employees selected to serve as discipline reviewers will be notified of their selection by the Chief Judge.

C. The appointment to serve as a discipline reviewer is temporary and is for a time period within the discretion of the Chief Judge.

D. Discipline reviewers are to become familiar with the issues of interest to the Chief Judge.

E. Designee(s) are to follow the assignment guidance provided by the accompanying Working Document.

F. At all times, the Chief Judge has the discretion to limit or expand the scope of the tasks to be performed by a discipline reviewer.
PATENT TRIAL AND APPEAL BOARD

STANDARD OPERATING PROCEDURE 9

Procedure for Decisions Remanded from the Federal Circuit for Further Proceedings

This Standard Operating Procedure (SOP) addresses the procedure for handling all decisions on cases remanded from the Court of Appeals for the Federal Circuit (Federal Circuit) to the Patent Trial and Appeal Board (Board) for further proceedings. This SOP creates internal norms for the administration of the Board to promote consistency. It also provides guidance to the parties, the public, and the Board regarding Board decisions remanded from the Federal Circuit. This SOP does not create any legally enforceable rights. The procedures described in this SOP are part of the Board’s deliberative process.

The Board has established a goal to issue decisions on remanded cases within six months of the Board’s receipt of the Federal Circuit’s mandate. The mandate makes the judgment of the Federal Circuit final and releases jurisdiction of the remanded case to the Board.

The Chief Administrative Patent Judge (Chief Judge) and the Deputy Chief Administrative Patent Judge (Deputy Chief Judge) believe that identifying and discussing potential issues soon after the Federal Circuit’s opinion will facilitate timely issuance of decisions on remand. Thus, the Chief Judge and/or the Deputy Chief Judge will discuss each remanded case with the panel before the issuance of the mandate, and before the panel expends substantial effort on the case. The Chief Judge and Deputy Chief Judge request that the panel schedule a meeting within thirty days of receiving notice of the Federal Circuit’s decision.1 The panel

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1 Please note that this meeting is expected to occur before the mandate issues from the Federal Circuit. Under Rule 41(b) of the Federal Rules of Appellate Procedure, a mandate “must issue 7 days after the time to file a petition for rehearing expires, or 7 days after entry of an order denying a timely petition for panel rehearing, petition for rehearing en banc, or motion for stay of mandate, whichever is later.” Because there is a 30-day period under Fed. Cir. R. 40(c) for filing a rehearing petition, the mandate usually issues 37 days after judgment if no party seeks rehearing or a stay of the mandate. However, in cases in which the Director
may arrange for the meeting by contacting the Chief Judge’s or Deputy Chief Judge’s administrative assistant.

The Chief Judge and/or Deputy Chief Judge may assign delegate(s) to meet with the panel in lieu of, or in addition to, the Chief Judge and Deputy Chief Judge. The Chief Judge may also elect to expand the panel assigned to the remanded case in accordance with SOP 1. The Chief Judge, however, expects panel expansion to be a rare occurrence.

Panels should be prepared to discuss the issues presented by the Federal Circuit’s decision, as well as the expected procedure for preparing a remand decision. Specific guidance for panels regarding preparing for remand meetings can be found in Appendix 1 to this SOP. Given the early timing of the meeting in the remand process, the meeting is not intended to address the likely substantive outcome.

The parties should expect the remand process to vary somewhat depending on the type of case and the issues presented. Appendix 2 to this SOP provides guidance to parties on remand procedures, plus illustrative examples from recent cases. Notably, certain scenarios may necessitate an extension of the six-month goal for issuing a remand decision.

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has intervened, Rule 40 of the Federal Rules of Appellate Procedure allows for 45 days for any party to petition for rehearing. Thus, when no party petitions, the mandate will issue **52 days** after judgment in those cases.
PATENT TRIAL AND APPEAL BOARD
STANDARD OPERATING PROCEDURE 9
APPENDIX 1

Guidance for Panels in Preparing for Remand Meetings with the Chief Judge and/or Deputy Chief Judge

This Appendix to SOP 9 provides guidance to panels in preparing for the remand meetings discussed in SOP 9. The Chief Judge and Deputy Chief Judge expect that a remand meeting will occur in every remanded case. As noted in SOP 9, the Chief Judge or Deputy Chief Judge may assign delegate(s) to meet with the panel in lieu of, or in addition to, the Chief Judge and Deputy Chief Judge. The Chief Judge also may elect to expand the panel assigned to the remanded case for the specific reasons articulated in SOP 1 (e.g., to address an issue of importance).

The topics to be discussed at a remand meeting depend on the facts and circumstances of each case. In preparing for the meeting the panel should consider the following general topics, if relevant to their particular remand. The panel is welcome—although not required—to provide to the meeting participants a short (e.g., not to exceed two pages), informal summary addressing these and/or other issues in advance of the meeting. The likely substantive outcome need not be determined or discussed at this early stage.

Potential Topics for Remand Meetings

The procedural history, including the procedural history prior to the appeal to Federal Circuit, as well as the outcome and rationale of the Federal Circuit decision, as well as the procedural history of any related appeals.

The issues on remand, including any specific procedural instructions from the Federal Circuit and the substantive issues the panel may need to address.

Any contemplated procedures for the proceedings on remand, including whether the panel anticipates additional briefing from the parties, an additional oral hearing, and/or reopening the record to permit introduction of additional evidence.
The panel should consider whether to recommend that the Chief Judge expand the panel, taking into account the factors expressed in SOP 1.

Any possible **policy considerations**, including whether the Federal Circuit's decision highlights any novel, evolving, or contentious issues of law or policy (i.e., issues not limited to the particular case) or raises any issues of particular importance to the Office or the patent community. The panel should contemplate whether a decision on remand, which involves such an issue, might be considered for precedential designation.
PATENT TRIAL AND APPEAL BOARD
STANDARD OPERATING PROCEDURE 9
APPENDIX 2

Guidance for Parties Regarding Remand Procedures

This Appendix to SOP 9 provides guidance to the parties on procedural issues. The procedure and pace of a remand following a Federal Circuit decision will vary depending on the type of case, the legal and factual issues involved, the specific instructions from the Federal Circuit, the recommendations of the parties, and any other particularities of the case. Considerations guiding remand procedures and common remand scenarios based on a non-exhaustive sample of remanded cases are discussed below.

Parties in remanded trial cases are to contact the Board within ten (10) business days after the mandate issues to arrange a teleconference with the panel. Before the teleconference, the Parties shall meet and confer in a reasonable and good faith attempt to propose a procedure on remand. Parties are encouraged to seek agreement, if possible, on remand procedures including, but not limited to: (1) whether additional briefing is necessary; (2) subject matter limitations on briefing; (3) length of briefing; (4) whether the parties should file briefs concurrently or sequentially; (5) if briefs are filed sequentially, which party should open the briefing; (6) whether a second brief from either party should be permitted; (7) the briefing schedule; (8) whether either party should be permitted to supplement the evidentiary record; (9) limitations, if any, on the type of additional evidence that will be submitted; (10) the schedule for submitting additional evidence, if any; and (11) any other relevant procedural issues. Teleconferences with the panel should take place within the first month after the mandate.

Considerations Guiding Remand Procedures in Trials

Although the panel shall consider procedures proposed by the parties, the panel ultimately will decide the procedures to be followed on remand. For example, the panel will decide whether to permit additional briefing and additional evidence (testimonial and documentary) or hold additional hearings following a remand.
The panel will consider the scope of the remand, as determined from the reasoning and instructions provided by the Federal Circuit, as well as "the effect . . . on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings." See 35 U.S.C. §§ 316(b), 326(b) (setting forth considerations for prescribing regulations under the AIA). Although no statutory time limit exists for completion of a re-opened proceeding following remand, the Board recognizes that delays caused by re-opening the record after remand may be inconsistent with the Board's stated goal of issuing a remand decision within 6 months from the mandate. The panel also will consider the time and expense involved that permitting additional briefing and new evidence will add to the proceeding. This approach is consistent with the expression of Board policy in 37 C.F.R. § 42.1(b): "This part shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding."

Additional briefing

In deciding whether to allow additional briefing by the parties, the panel will take into account whether the parties already have had an adequate opportunity to address the issues raised by the remand. For example, a new or revised claim construction not previously considered may lead the panel to seek additional briefing from the parties. See Microsoft Corp. v. Proxyconn, Inc., Case No. IPR2012-00026 (Paper 77) (PTAB Sept. 1, 2015). A change in the law usually would justify additional briefing to ensure that the parties' positions under the changed authority are presented and considered. Additional briefing, when permitted, will normally be limited to the specific issues raised by the remand. See Proxyconn, supra; see also Dell Inc., v. Acceleron, LLC, Case No. IPR2013-00440 (Paper 46) (PTAB May 26, 2016).

Additional evidence

In most cases, it will not be necessary to re-open the evidentiary record to new testimonial or documentary evidence. A party seeking to re-open the evidentiary record should be prepared to demonstrate why the evidence already before the Board is inadequate and show good cause why additional evidence is necessary. The panel will take into account whether the parties have already had
an adequate opportunity to address the issues raised by the remand with the evidence already of record. The panel will also consider whether additional briefing is sufficient without the submission of additional evidence.

The panel will also consider how much additional time will be necessary to develop a new evidentiary record. For example, opening the record to new documentary evidence may require additional briefing to establish a proper foundation for the evidence and resolve any objections. See SAS Inst., Inc. v. ComplementSoft, LLC, Case No. IPR2013-00226 (Paper 55) (PTAB Jan. 18, 2017). The Board’s discovery rules govern testimonial evidence and cross-examination. See id.

Additional Oral Argument

In most cases, an additional oral hearing will not be authorized. Normally, the existing record and previous oral argument will be sufficient. However, in those situations where new evidence is permitted, the panel may authorize additional oral argument.
**Default Trial Procedures for Common Remand Scenarios**

The chart below reflects the likelihood of the Board permitting additional briefing, evidence, or oral argument for various types of issues addressed on remand. The circumstances of any particular case may justify different outcomes.

<table>
<thead>
<tr>
<th>Remand Scenario</th>
<th>Additional Briefing</th>
<th>Additional Evidence</th>
<th>Oral Argument</th>
</tr>
</thead>
<tbody>
<tr>
<td>Erroneous Claim Interpretation</td>
<td>Yes, unless the claim interpretation to be applied on remand was proposed by one of the parties and the effect thereof has been fully briefed</td>
<td>No, unless evidence of record is insufficient to afford due process</td>
<td>No</td>
</tr>
<tr>
<td>Failure to Consider the Evidence</td>
<td>Yes, unless the evidence was fully briefed on the record</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Inadequate Explanation by the Board</td>
<td>No, unless the briefing on the issues is inadequate for the Board to have made a decision in the first instance</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Erroneous Application of Law</td>
<td>Yes, unless the law was fully briefed on the record but not reflected in Board decision</td>
<td>No</td>
<td>No</td>
</tr>
<tr>
<td>Lack of Due Process/Denial of APA rights</td>
<td>Yes</td>
<td>Yes, for parties whose rights have been violated, unless additional briefing on evidence of record is sufficient to afford due process</td>
<td>Yes, if necessary to afford due process</td>
</tr>
<tr>
<td>Improper Consideration of the Arguments</td>
<td>Yes, unless argument is fully briefed in the record</td>
<td>No</td>
<td>No</td>
</tr>
</tbody>
</table>

*These particular remand scenarios are provided for exemplary guidance only and do not reflect all scenarios that have been or may result from remands by the Federal Circuit.*
Considerations Guiding Remand Procedures in Ex Parte and Reexamination Appeals

In ex parte appeals and reexamination appeals, reversals at the Federal Circuit are considered to be remanded cases to the PTO for further action. Either the Board or the examiner will take up remanded cases depending upon (1) whether the Federal Circuit directed a particular part of the Office to act upon remand, (2) whether the outstanding rejections can be further addressed by the Board either with further explanation of a finding of fact or conclusion of law or with a new ground of rejection based on further findings of fact or reasoning based on the current record, and/or (3) whether a reversal requires a need for further prior art searching by the examiner and/or issuance of a patent or reexamination certificate. Although expected to be a rare occurrence, the Board may ask the appellant or parties to provide further briefing on a matter of law or fact raised by the Federal Circuit. For example, in the case of intervening Federal Circuit law, the Board may seek appellant’s or the parties’ positions on the application of such law to the particular facts already of record. Additional evidence is only permitted upon reopening of prosecution before the examiner.

Default Appeals Procedures for Common Remand Scenarios

These procedures are default and circumstances not contemplated may necessitate a different procedure.

<table>
<thead>
<tr>
<th>Remand Scenario</th>
<th>Prosecution/Reexamination Reopened</th>
</tr>
</thead>
<tbody>
<tr>
<td>Erroneous Claim Interpretation</td>
<td>No, unless alternative claim interpretation renders the present rejection(s) moot</td>
</tr>
<tr>
<td>Failure to Consider the Evidence</td>
<td>No, unless the evidence of record is deemed entirely insufficient to support the present rejection(s)</td>
</tr>
<tr>
<td>Inadequate Explanation</td>
<td>No – the Board provides additional explanation or reverses on the present record</td>
</tr>
<tr>
<td>Erroneous Application of Law</td>
<td>No, unless the correct application of the law renders the present rejection(s) moot</td>
</tr>
<tr>
<td>Lack of Due Process/Denial of APA rights</td>
<td>Yes – typically in the form of a new ground of rejection</td>
</tr>
<tr>
<td>Improper Consideration of the Arguments</td>
<td>No – arguments that were not sufficiently briefed before the Board are deemed waived</td>
</tr>
</tbody>
</table>
Specific Examples of Common Remand Scenarios

1. Remand for erroneous claim interpretation

In trials, some panels have permitted additional briefing on remand limited to the Federal Circuit’s claim interpretation. New evidence was not permitted in those cases. See, e.g., Microsoft Corp. v. Proxyconn, Inc., Case Nos. IPR2012-00026, IPR2013-00109 (Paper 77) (PTAB Sept. 1, 2015) (after remand due to unreasonably broad claim interpretation, the Board authorized simultaneous briefing, but not new evidence or the use of prior art not previously considered in the Board’s final written decision); Straight Path IP Grp., Inc. v. Sipnet EU S.R.O., Case No. IPR2013-00246 (Paper 70) (PTAB Mar. 29, 2016) (after a remand finding error in the Board’s claim interpretation, the Board authorized briefing directed to the impact of the decision on the trial proceeding, but did not authorize new evidence or new argument); PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC, Case No. IPR2013-00342 (Paper 55) (PTAB Aug. 4, 2016) (after remand due to unreasonably broad claim interpretation, the Board denied requests for additional briefing where the requests addressed new issues not related to claim interpretation).

In ex parte and reexamination appeals, the Board has taken up the case and issued a new Decision on Appeal where the record is clear upon remand. See, e.g., Application No. 11/610,411 (after remand for consideration of PTO policy on “configured to” claim language, the Board issued an affirmance decision); Reexamination Control Nos. 90/008,326, 90/011,287 (after remand for consideration of District Court’s alternative claim construction of the same patent, the Board maintained its claim interpretation under the PTO’s broadest reasonable interpretation standard); Reexamination Control No. 90/012,366 (the Board entered a new ground of rejection based on prior art already of record in light of alternative claim interpretation); Reexamination Control Nos. 95/001,305, 95/001,548, 95/001,939 (the Board considered the rejection anew in light of the Federal Circuit’s claim interpretation and entered a new ground of rejection based on new reasoning in light of the new claim interpretation).

However, cases have been taken up by or have been remanded to the examiner for further consideration in situations where a new claim interpretation
renders moot all maintained rejections before the Board, or upon specific order by the Federal Circuit. See, e.g., Application No. 12/392,192 (for an anticipation rejection rendered moot by the Federal Circuit’s claim interpretation, the Board remanded to the examiner for additional findings directed to the new claim interpretation); Reexamination Control No. 90/012,364 (the Board remanded to the examiner for consideration of claim interpretation under a different standard after the patent had expired); Reexamination Control Nos. 95/001,715, 95/001,716 (administrative remand to the examiner because the Federal Circuit “directed the examiner to reevaluate the prior art based on the court’s claim construction”); Reexamination Control No. 95/002,169 (after reversal at Federal Circuit for “unreasonably broad” claim interpretation, examiner issued Reexamination Certificate); Application No. 10/906,508 (after remand for failing to give patentable weight to the preamble, the Board remanded to the examiner for further action).

2. Remand for a failure to properly consider the evidence

In trials, the Board has authorized additional briefing related to the evidence, but not the admission of new evidence. See, e.g., Ariosa Diagnostics v. Verinata Health, Inc., Case No. IPR2013-00276, IPR2013-00277 (Paper 49) (PTAB Jan. 13, 2016) (after remand for failure to sufficiently consider a piece of evidence, the Board permitted additional briefing about that evidence, but did not allow admission of additional evidence).

However, where the Board was able to further consider briefing and evidence already of record, the Board did not allow further briefing. See PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC, Case No. IPR2013-00340 (Paper 85) (PTAB Aug. 4, 2016) (after remand for failure to make factual findings regarding certain limitations, the Board denied requests for additional briefing and evidence and decided the issues on remand based on the arguments and evidence already of record).

In ex parte and reexamination appeals, when evidence is lacking in the record or the Examiner made insufficient factual findings based on the evidence, cases have been taken up by or have been remanded to the examiner for further consideration. See, e.g., Reexamination Control Nos. 95/001,166, 95/000,166,
95/001,122, 95/001,401 (after reversal based on lack of supporting evidence, the examiner took action directly to issue Reexamination Certificate); Application No. 09/874,423 (after reversal for insufficient evidence to support the Board’s findings, the Board administratively remanded to the examiner for further consideration); Application No. 10/529,984 (after remand for insufficient evidence, the examiner took action in issuing a new rejection); Application No. 11/645,067 (after remand for insufficient evidence to support rejection, the Board administratively remanded the case to the examiner for reconsideration of anticipation rejection); Application 12/762,841 (after remand for failure to consider overlooked amendments and evidence, the Board administratively remanded to the examiner for a first consideration).

However, the Board has considered sufficiently examined and briefed, yet overlooked, evidence on remand, and has considered the evidence of record again when specifically instructed by the Federal Circuit’s decision to do so. See, e.g., Reexamination Control Nos. 95/000,326, 95/000,378 (the Board issued a new decision with further detailed explanation after Federal Circuit’s remand for failure to consider the general knowledge of the skilled artisan); Reexamination Control No. 95/001,134 (after Federal Circuit’s determination that substantial evidence did not support the Board’s findings of a lack of nexus and that the secondary consideration evidence was not commensurate in scope with the claims, the Board entered a new ground of rejection with further explanation); Reexamination Control No. 95/000,067 (after Federal Circuit’s remand for relying on facts without considering the facts in light of the Board’s new claim interpretation, the Board included additional fact finding from the record consistent with the Board’s interpretation); Application No. 10/529,984 (after remand for failure to properly consider specific factual findings, the Board issued a decision discussing the particular findings and reversing the rejection); Application No. 10/991,878 (after vacating the Board’s decision for failure to identify evidence supporting its findings and remanding for the Board to “consider whether the evidence of record is sufficient to maintain the Examiner’s rejection,” the Board issued a decision reversing the rejection for lack of evidence).
3. Remand for the Board’s failure to adequately explain its reasoning

In trials, some panels have authorized limited additional briefing, but not new evidence. See, e.g., Cutforth, Inc. v. MotivePower, Inc., Case No. IPR2013-00274 (Paper 37) (PTAB Mar. 31, 2016) (after remand for failure to adequately describe its reasoning for its obviousness determination, the Board authorized additional briefing limited to design choice as a reason to modify the art); In re Warsaw Orthopedic, Inc., Case Nos. IPR2013-00206, IPR2013-00208 (Paper 73) (PTAB Nov. 16, 2016) (after remand for failure to explain how the prior art discloses a claim limitation, the Board authorized additional briefing but not new evidence).

In ex parte and reexamination appeals, the Board has added further explanation without remanding to the examiner when the record is sufficient to do so. See, e.g., Reexamination Control No. 95/000,443 (after remand for consideration of what reason, if any, to combine prior art, the Board reconsidered its obviousness decision on the record already present).

4. Remand for erroneous application of the law

In trials, a remand has warranted additional briefing and a supplemental motion to amend. See, e.g., Veritas Techs. LLC v. Veeam Software Corp., Case No. IPR2014-00090 (Papers 40, 42) (PTAB Jan. 27, 2017) (after remand for improperly denying a motion to amend, the Board authorized Patent Owner to refile its motion to amend (and supporting arguments) as a supplemental motion, Petitioner to file a supplemental opposition, and Patent Owner to file a supplemental reply).

In ex parte and reexamination appeals, the examiner has taken up cases or the Board has remanded cases to the examiner for further consideration where the Federal Circuit’s decision renders moot all the rejections before the Board. See, e.g., Reexamination Control Nos. 95/000,072, 95/001,001, 95/000,153 (after reversal due to the Board’s error in obviousness determination, the examiner took action directly to issue a Reexamination Certificate); Reexamination Control No. 95/001,469 (after remand to consider original claims after a patent expired with pending claim amendments, the Board entered an administrative remand to the examiner to consider the original patent claims in light of the evidence of record);
Application No. 11/578,646 (after vacating the rejection and remanding for insufficient legal reasoning in an obviousness determination, the Board remanded to the examiner for reconsideration in light of Federal Circuit’s decision); Application No. 10/868,312 (after vacating the rejection and remanding for error in applying the printed matter doctrine, the Board remanded to the examiner for reconsideration in light of Federal Circuit’s decision); Application No. 12/825,505 (after reversal of obviousness rejection, the Board administratively remanded to the examiner for further consideration).

However, the Board has addressed the legal issue upon remand when sufficiently briefed on the record. See, e.g., Reexamination Control No. 95/000,196 (after remand for application of wrong priority date for one of the claims, the Board entered new grounds of rejection based on later prior art also of record); Reexamination Control Nos. 95/001,188, 95/001,169 (after remand for consideration of Federal Circuit decision in a related case, the Board entered a new ground of rejection); Application No. 10/378,261 (after reversal due to Board error in an obviousness determination, the Board issued a new decision reconsidering the evidence of record, pursuant to the Federal Circuit decision, and reversing the obviousness rejection); Application No. 08/478,995 (after remand on PTO’s motion due to intervening case law in obviousness-type double patenting rejection, the Board issued a new decision properly addressing the secondary consideration evidence of record); Application No. 09/832,440 (after remand for failure to engage in a proper enablement analysis, the Board entered a new decision applying the missing analysis and affirming the rejections on appeal).

5. Remand for lack of due process or a denial of a party’s procedural rights under the Administrative Procedure Act (APA)

In trials, some panels have authorized additional briefing and additional evidence. See, e.g., SAS Inst., Inc. v. ComplementSoft, LLC, Case No. IPR2013-00226 (Paper 55) (PTAB Jan. 18, 2017) (authorizing briefing and additional declaratory evidence, where Federal Circuit found that final written decision violated APA notice requirements by adopting a new claim interpretation “midstream”).
However, other panels have not authorized submission of additional evidence where additional briefing was sufficient to provide a fair opportunity for a party to respond. See Dell Inc. v. Acceletron, LLC, Case No. IPR2013-00440 (Paper 46) (PTAB May 26, 2016) (after remand for denying the Patent Owner a fair opportunity to respond to arguments raised by a Petitioner for the first time at oral argument and subsequently adopted by the Board in its final written decision, the Board permitted additional briefing on the untimely raised issue).

In ex parte and reexamination appeals, the Board has addressed due process concerns by entering a new ground of rejection and offering the opportunity for the applicant or patent owner to respond accordingly. See, e.g., Reexamination Control No. 95/001,134 (after remand for improper burden shifting and relying on new reasoning that constituted a new ground of rejection, the Board addressed the issues in a new decision entering a new ground of rejection); Reexamination Control Nos. 95/000,067, 95/001,702 (after remand for further consideration of rejections not addressed by the Board in the first decision, the Board issued a new decision with new grounds of rejection); Application Nos. 10/306,057, 10/868,312 (after remand because the Board’s decision introduced a new ground of rejection, the Board issued a new decision designating the affirmance in the original decision as a new ground of rejection); Application No. 10/770,937 (after remand for the Board’s decision introducing new ground of rejection, the Board issued a second decision on request for rehearing designating the original decision as a new ground of rejection).

Where a new issue was not considered by the examiner in the first instance, the Board has remanded the appeal to the examiner. See, e.g., Reexamination Control No. 95/001,555 (after remand for failure to consider certain proposed rejections that were not addressed by the examiner, the Board entered an administrative remand to the examiner for a first consideration).
6. Remands for failure to properly consider the arguments before the Board, such as misapprehending arguments, overlooking arguments, improperly considering arguments that were untimely raised, or improperly considering timely arguments as untimely

In trials, additional briefing has been permitted. See Dell Inc. v. Accelero, LLC, Case No. IPR2013-00440 (Paper 46) (PTAB May 26, 2016) (after remand for denying the Patent Owner a fair opportunity to respond to arguments raised by a Petitioner for the first time at oral argument and subsequently adopted by the Board in its final written decision, the Board permitted additional briefing on the untimely raised issue).

In ex parte appeals and reexaminations, the Board has reviewed arguments that were overlooked but were properly briefed on appeal. See, e.g., Reexamination Control No. 90/010,278 (after remand on PTO’s motion acknowledging failure to address an argument on appeal, the Board issued a new decision on appeal); Application No. 11/811,156 (after remand for failure to address arguments related to analogous art, the Board issued a new decision considering the overlooked arguments and affirming the rejections).

Petition for a writ of certiorari filed in the Supreme Court

In all cases, absent good cause, proceedings on remand generally will not be stayed once the Federal Circuit has issued its mandate, even when a party has petitioned the Supreme Court for a writ of certiorari.2 In trials, a party may

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2 Parties are encouraged to review the Federal Rules of Appellate Procedure, the Federal Circuit Rules of Practice, and the Rules of the Supreme Court of the United States for specific timing requirements. See, e.g., Sup. Ct. R. 13(1) (“Unless otherwise provided by law, a petition for a writ of certiorari to review a judgment in any case, civil or criminal, entered by a state court of last resort or a United States court of appeals (including the United States Court of Appeals for the Armed Forces) is timely when it is filed with the Clerk of this Court within 90 days after entry of the judgment.”). The time period to petition the Supreme Court is separate from the Federal Circuit’s issuance of the mandate to the Board. Parties are reminded that the Federal Circuit may entertain motions to stay the mandate pending the filing of a petition for a writ of certiorari in the Supreme Court under Rule 41(d) of the Federal Rules of Appellate Procedure.
contact the Board to request authorization to file a motion for a stay of proceedings on remand. The Board will consider such requests on a case-by-case basis. The Board may require briefing on a motion to stay the remand proceedings, or, for convenience, the issue may be discussed and decided in a conference call. In deciding whether to stay remand proceedings, the Board’s primary consideration is whether the Supreme Court’s judgment would impact the Board’s decision on remand. See, e.g., **Shaw Indus. Grp., Inc. v. Automated Creel Sys., Inc.**, Case No. IPR2013-00132 (Paper 54) (PTAB Aug. 12, 2016) (the Board, *sua sponte*, staying remand proceedings after petition for writ of certiorari filed), (Paper 60) (Oct. 14, 2016) (maintaining stay after briefing because the Board was persuaded that a Supreme Court decision could impact the Board’s assessment of the remanded issue); **SAS Inst., Inc. v. ComplementSoft, LLC**, Case No. IPR2013-00226 (Paper 48) (PTAB Dec. 15, 2016) (denying stay request after a conference call), (Paper 57) (PTAB Feb. 8, 2017) (denying request to stay because the issue on remand was separable from, and not influenced by, the question presented in the petition for a writ of certiorari). The Board’s decision not to stay remand proceedings does not affect the right of a party to apply to the Supreme Court for a writ of certiorari.