

PATENT TRIAL AND APPEAL BOARD

STANDARD OPERATING PROCEDURE 2 (REVISION 8)

PUBLICATION OF OPINIONS AND DESIGNATION OF OPINIONS AS PRECEDENTIAL

This standard operating procedure (SOP) addresses the publication of opinions of the Patent Trial and Appeal Board (Board) and the designation of such opinions as precedential for the United States Patent and Trademark Office. This SOP creates internal norms for Board administration; it does not create any legally enforceable rights. The actions described in this SOP are part of the Board's deliberative process.

I. Purpose

- A. The people of the United States of America have an interest in the Board's activities (5 U.S.C. § 552). Since August 1997, this interest has mainly been addressed through electronic posting of most^{*} final Board opinions (<http://des.uspto.gov/Foia/BPAIReadingRoom.jsp>).
- B. The Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (Director) has an interest in providing policy direction and in creating binding norms for fair and efficient patent examination (35 U.S.C. §§ 2(b)(2) and 3(a)(2)(A)).
- C. The Board enters thousands of opinions every year. This volume may obscure the value of certain electronically posted Board opinions. This SOP provides a mechanism for highlighting certain opinions by designating Board opinions as:
 1. Precedential,
 2. Informative, or
 3. Routine.

* Electronic publication of most opinions depends on whether the underlying application is entitled to confidentiality (35 U.S.C. § 122). Since November 2000, only a relatively small number of opinions remain confidential.

II. Nominating an opinion

- A. The Board consists of administrative patent judges (judges), including a Chief Administrative Patent Judge (Chief Judge) and four *ex officio* members: the Director, the Deputy Director, the Commissioner for Patents and the Commissioner for Trademarks (35 U.S.C. § 6(a)).
- B. Any member of the Board may recommend to the Chief Judge that an opinion, including Board decisions and orders, be designated as precedential or informative.
- C. The appellant, the patentee, a petitioner, or a third party member of the public may, within 60 days of issuance of the opinion, request in writing that an opinion be made precedential, by forwarding that request, along with accompanying reasons, to the Chief Judge. Where a written request for a precedential opinion has been received, the Chief Judge shall respond in writing to the requester to confirm receipt of the request.

III. Precedential opinion

- A. If the Chief Judge considers a nominated opinion to be an appropriate candidate for designation as precedential, the Chief Judge will circulate the opinion to all members of the Board. An opinion may be considered appropriate for any reason, but particular emphasis will be placed on opinions resolving conflicts or addressing novel questions.
- B. During a stated, limited period (typically ten business days), each Board member will be invited to vote and will have an opportunity to comment in writing on whether the opinion should be designated as precedential. The Chief Judge may share the comments with members of the authoring panel.
- C. After the expiration of the period, if a majority of the Board's voting members agree that the opinion should be made precedential, and after considering the Board members' comments, the Chief Judge shall notify the Director of the results of the voting.
- D. If the Director concurs that the opinion should be designated precedential, the Director will so notify the Chief Judge. No opinion may be precedential without concurrency by the Director.
- E. The opinion is then published or otherwise disseminated following notice and opportunity for written objection afforded by 37 C.F.R. § 1.14, in those

instances in which the opinion would not otherwise be open to public inspection.

- F. An opinion designated as precedential under a previous version of this SOP remains precedential unless overcome by subsequent binding authority.
- G. Opinions designated as precedential shall be labeled "Precedential." Precedential opinions shall be posted electronically (<http://www.uspto.gov/ip/boards/bpai/decisions/prec/index.jsp>) and will ordinarily be sent to commercial reporters that routinely publish Board opinions.
- H. Any Board member may notify the Chief Judge of the member's belief that a Board opinion designated as "Precedential" has been overcome by subsequent binding authority. If the Chief Judge determines that the subject Board opinion has been overcome by subsequent binding authority, the Chief Judge shall notify the Director of the Board's determination and the basis therefore. If the Director concurs, the Director will so notify the Chief Judge, and the subject Board opinion shall be removed from the electronic posting of "Precedential" opinions. A notice indicating the opinion's removal shall be posted in its stead.
- I. An opinion is not precedential simply because it has been published in a commercial reporter, involves an expanded panel, or includes an *ex officio* member on the panel. Such factors may, however, augment the persuasiveness of the opinion.

IV. Informative opinion

- A. The Chief Judge may designate any nominated opinion as informative unless it is designated as precedential.
- B. An opinion may be designated as informative for any reason. Considerations include:
 - 1. Providing a representative sample of outcomes (e.g., affirmance or reversal),
 - 2. Providing a representative sample of opinion type (e.g., regular *ex parte* appeal, *inter partes* reexamination appeal, or interference order), and
 - 3. Providing guidance on Board rules and practices.

- C. Opinions designated as informative shall be labeled "Informative." The Director shall be notified of opinions designated as informative in advance of their publication as such. Such notification shall include a brief explanation summarizing the relevant facts that led to the determination of the opinion as informative. Informative opinions shall be posted electronically (<http://www.uspto.gov/ip/boards/bpai/decisions/inform/index.jsp>) and will ordinarily be sent to commercial reporters that routinely publish Board opinions following notice and opportunity for written objection afforded by 37 C.F.R. § 1.14, in those instances in which the opinion would not otherwise be open to public inspection.
- D. An informative opinion may be cited as non-binding authority.

V. Routine opinion

- A. Every Board opinion is, by default, a routine opinion until it is designated as precedential or informative. All opinions, except those not open to public inspection, will continue to be posted electronically (<http://des.uspto.gov/Foia/BPAIRReadingRoom.jsp>).
- B. An opinion is binding law of the case, even if it is not designated as precedential or informative.
- C. A routine opinion should not be cited as authority, but may be cited when necessary as a relevant fact.