

## **PATENT TRIAL AND APPEAL BOARD**

### **STANDARD OPERATING PROCEDURE 4**

#### **Procedure for Pre-Issuance Optional Decision Review and Post-Issuance Decision Review**

This Standard Operating Procedure (SOP) addresses the procedure for (i) optional internal circulation and review of Patent Trial and Appeal Board (PTAB or Board) decisions prior to issuance, and (ii) review of PTAB decisions post-issuance. This SOP creates internal norms for the administration of the Board to promote decision consistency and clarity. This SOP does not create any legally enforceable rights. The procedures described in this SOP are part of the Board's deliberative process.

It is important for the efficient delivery of reliable intellectual property rights that the PTAB maintain a consistent and clear approach to substantive areas of patent law and PTAB-specific procedures. As described below, the PTAB provides optional internal decision circulation and review procedures for draft decisions. A PTAB judge on a panel of a particular case may circulate any draft decision to a pool of non-management peer judges prior to issuance. A PTAB judge on the panel may also optionally seek pre-issuance management consultation with a PTAB Management Pre-Issuance Optional Review team (defined below). In either scenario, the pool of non-management peer judges or the PTAB Management Pre-Issuance Optional Review team may provide feedback, for example, regarding potential inconsistencies with relevant authority and other PTAB decisions, for the panel's consideration. The PTAB panel has final authority and responsibility for the content of a decision, and determines whether and in what manner, if at all, to incorporate any feedback received from the pool of non-management peer judges and/or the PTAB Management Pre-Issuance Optional Review team.

The Director is not involved prior to issuance, directly or indirectly, in directing or otherwise influencing PTAB panel decisions, unless the Director is a member of the panel. Similarly, the PTAB Management Pre-Issuance Optional Review team does not provide feedback on decisions prior to issuance unless they are a member of the panel or a panel member requests such feedback.

As described below, the PTAB also uses a procedure for reviewing decisions after issuance. The PTAB Post-Issuance Review team reviews issued decisions and flags certain decisions to consider, for example, as candidates for *sua sponte* Director Review or potential policy clarification.

#### **I. Optional Circulation Judge Pool Review**

##### **A. Circulation Process**

Any panel member, at his or her sole discretion, may choose to circulate a draft decision to a designated pool of non-management peer judges (the “Circulation Judge Pool” or “CJP”) prior to issuance.<sup>1</sup> The particular steps for circulating a decision to the CJP—including copying other panel members on the email to the CJP—may be further described in a separate document.

When CJP review is requested, the decision typically is reviewed by two CJP members (“reviewers”). Each CJP reviewer may edit the draft by providing comments and/or suggested revisions. If warranted, either of the reviewers may discuss one or more of the comments or suggested revisions with the broader CJP group at an upcoming CJP committee meeting, which takes place regularly among all CJP members. After consensus is reached on any discussed comments and suggested revisions, a redlined draft is sent to the panel for consideration before issuance. If a decision is submitted close to an impending deadline when the CJP workload is too heavy to accommodate the deadline, the CJP may elect to have one CJP member conduct a brief review or may decline to review.

For each reviewed decision, the CJP may provide the panel with information regarding potential conflicts or inconsistencies with relevant authority. The CJP also may provide the panel with information regarding potential inconsistencies with other PTAB decisions and suggestions for improved readability and stylistic consistency.

The CJP’s comments and revisions are optional suggestions that a panel may or may not wish to consider in preparing and finalizing the decision. The panel has final authority and responsibility for the content of a decision, and determines whether and in what manner, if at all, to incorporate the feedback from the CJP.

## **B. CJP Membership**

CJP membership is open to any non-management PTAB judge. The CJP includes at least six members, who collectively have technical/scientific backgrounds and legal experience representative of the PTAB judges as a whole. A typical CJP member thinks critically about nuances in the law, has an attention to detail, and keeps up-to-date on applicable written

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<sup>1</sup> The CJP is modeled after both the Federal Circuit’s previous circulation to the Senior Technical Assistant and the Federal Circuit’s 10-day circulation process for precedential decisions. *See* United States Court of Appeals for the Federal Circuit, Internal Operating Procedures, Redlined Copy, 18 (Mar. 1, 2022), available at <https://cafc.uscourts.gov/wp-content/uploads/RulesProceduresAndForms/InternalOperatingProcedures/IOPs-Redline-03012022.pdf> (describing the previous circulation to the Senior Technical Assistant); and United States Court of Appeals for the Federal Circuit, Internal Operating Procedures, 10.5 (July 22, 2022), available at <https://cafc.uscourts.gov/wp-content/uploads/RulesProceduresAndForms/InternalOperatingProcedures.pdf> (describing the 10-day circulation process for precedential decisions).

guidance and policy, Board decisions including precedential cases, and Federal Circuit and Supreme Court case law regarding patentability issues and PTAB practice.

Each CJP member typically serves a one-year term. The terms are typically staggered in that one or more members rotate off the CJP, and one or more new members join the CJP, on a regular basis. The term of an outgoing member and the term of an incoming member replacing that outgoing member will overlap for at least one week to allow for new member orientation.

PTAB Executive Management (i.e., PTAB Chief Judge, Deputy Chief Judge, Vice Chief Judges, Senior Lead Judges, and those acting in any of the foregoing positions) periodically solicits volunteers to serve on the CJP and makes final selections in consultation with that volunteer's supervisor. Judges are chosen so as to contribute to a balanced committee in which members have diverse technical backgrounds and professional experiences. PTAB Executive Management also determines the number of CJP members sufficient to provide a balanced representation and adequately handle the workload.

Each CJP member receives production credit for CJP-related work.

### **C. CJP Interface with PTAB Executive Management**

Separately and additionally, the CJP may have periodic meetings with the PTAB Executive Management to discuss issued decisions that address a notable issue, issued decisions that potentially conflict with relevant authority or other PTAB decisions, and general areas for potential policy clarification. PTAB Executive Management may discuss issues or issued decisions flagged by the CJP with the Director for the purposes of (i) considering whether to issue new or updated policies or guidance, for example, through regulation, precedential or informative decisions, and/or a Director guidance memorandum, and (ii) considering *sua sponte* (on the Director's own initiative) review of a decision.

## **II. Optional Pre-Issuance Consultation with PTAB Management**

Any panel member, at his or her sole discretion, may also optionally request input from a PTAB Management Pre-Issuance Optional Review team regarding a decision prior to issuance. The PTAB Management Pre-Issuance Optional Review team is designated by the PTAB Executive Management and may include a Vice Chief Judge, a Senior Lead Judge, Lead Judges, and those acting in any of the foregoing positions. The PTAB Management Pre-Issuance Optional Review team input may include information regarding potential conflicts or inconsistencies with relevant authority or potential inconsistencies with other PTAB decisions.

When considering a request for input, the PTAB Management Pre-Issuance Optional Review team may consult with senior management in another USPTO business unit for input. In such situations, the PTAB Management Pre-Issuance Optional Review team may share input it receives with the panel. If a panel member seeks input from another USPTO business unit, the

panel member may indicate that in its request to the PTAB Management Pre-Issuance Optional Review team.

The panel's adoption of any suggestions provided by the PTAB Management Pre-Issuance Optional Review team is optional. As with the optional CJP feedback, the panel has final authority and responsibility for the content of a decision, and determines whether and in what manner, if at all, to incorporate the feedback from the PTAB Management Pre-Issuance Optional Review team. Unless requested by a panel member, the PTAB Management Pre-Issuance Optional Review team does not make suggestions to the panel on any pre-issuance decisions, either directly or indirectly. For example, if a CJP review is requested, the PTAB Management Pre-Issuance Optional Review team does not provide any input to the CJP regarding that review.

### **III. Panel Responsibility for Content of Decision**

As discussed above, the PTAB panel has final authority and responsibility for the content of a decision, and determines whether and in what manner, if at all, to incorporate any requested feedback from the CJP or the PTAB Management Pre-Issuance Optional Review team. Failure to incorporate feedback from the CJP or the PTAB Management Pre-Issuance Optional Review team has no effect in and of itself on a PTAB judge's performance review.

Nevertheless, PTAB judges are required by their Performance Appraisal Plan (PAP) to apply pertinent statutes, regulations, binding case law, and written guidance issued by the Director or the Director's delegate that is applicable to PTAB proceedings. Failure to follow pertinent statutes, regulations, binding case law, or written guidance issued by the Director or the Director's delegate could impact the judge's performance review regardless of whether the judge sought or received relevant feedback from the CJP or the PTAB Management Pre-Issuance Optional Review team.

There is no unwritten agency or Board policy or guidance applicable to PTAB proceedings that judges are required to apply. Any written agency or Board policy or guidance that is binding on judges is made public.

When judges on a panel have additional or dissenting views, they may express those views in concurring or dissenting opinions as they deem appropriate. Such views are an important part of the judicial process. They may be impactful to the Director in deciding, for example, whether to review a decision post-issuance.

### **IV. No Director Pre-issuance Involvement**

Although the Director has oversight of USPTO rules, policies, and procedures that must be considered by judges, the Director, Deputy Director, Commissioner for Patents, and Commissioner for Trademarks will not be involved pre-issuance, directly or indirectly, in

directing or otherwise influencing any panel decisions unless they are a panel member. Pursuant to Standard Operating Procedure 1, the Director has delegated the authority to assign judges to panels to the Chief Judge of the PTAB and those to whom the Chief Judge further delegates that authority. The Director will not be involved in directing or otherwise influencing the paneling or repaneling of any specific proceeding before the PTAB prior to issuance of the panel decision. When reviewing or rehearing an issued panel decision, the Director may direct the repaneling of the proceeding in a manner consistent with PTAB paneling guidance.

## **V. Post-Issuance Review**

A PTAB Post-Issuance Review team reviews issued PTAB decisions for consideration for Director-initiated (*sua sponte*) review or policy clarification. The PTAB Post-Issuance Review team is designated by the PTAB Executive Management and may include a Vice Chief Judge, a Senior Lead Judge, Lead Judges, and those acting in any of the foregoing positions. The PTAB Post-Issuance Review team may identify decisions that, for example, address an issue of first impression, appear inconsistent with relevant authority, or involve an area where policy clarification may be needed. After identifying a decision, the PTAB Post-Issuance Review team determines whether to flag the decision for the PTAB Executive Management. If flagged, the PTAB Executive Management, in turn, determines whether to flag the decision to the Director for further attention, such as *sua sponte* Director Review or other review or policy clarification mechanisms.

## **VI. Conflicts of Interest**

If a member of the CJP, the PTAB Management Pre-Issuance Optional Review Team, or the PTAB Post-Issuance Review team has a conflict of interest, they shall notify the other members of their respective team and will recuse themselves from any discussion or analysis of that decision.

In determining whether a conflict of interest exists, the USPTO follows the guidance set forth in the Standards of Ethical Conduct for Employees of the Executive Branch at 5 CFR Part 2635 and will consult with the Department of Commerce Ethics Law and Programs Office, as necessary, to resolve any questions pertaining to conflicts of interest. Conflicts may include, for example, involvement in the examination or prosecution of the underlying patent or a related patent at issue.

Finally, as a matter of policy, the CJP members, the PTAB Management Pre-Issuance Optional Review team members, and the PTAB Post-Issuance Review team members will additionally follow the guidance on conflicts of interest set forth in the PTAB's Standard Operating Procedure 1 and will recuse themselves from any discussion or analysis involving cases or related cases on which they are paneled.