March 29, 2000

MEMORANDUM

TO: GARY V. HARKCOM
Vice Chief Administrative Patent Judge

All Administrative Patent Judges

FROM: BRUCE H. STONER, JR.
Chief Administrative Patent Judge

SUBJECTS: Standard Operating Procedure 2 (Revision 4)
Publication of opinions and binding precedent

The attached document supersedes Standard Operating Procedure 2 (Revision 3) dated April 9, 1998, on the same subject matter.

cc: Amalia Santiago, Chief Board Administrator

All Program and Resources Administrators

BOARD OF PATENT APPEALS AND INTERFERENCES

STANDARD OPERATING PROCEDURE 2 (REVISION 4)
Effective March 29, 2000

PUBLICATION OF OPINIONS AND BINDING PRECEDENT

The following applies to the publication of opinions and binding precedent of the Board of Patent Appeals and Interferences (Board).

An opinion in support of a Board decision is considered precedential when: (1) a majority of the members of the Board have voted to make the opinion precedential, and (2) the opinion is published or otherwise disseminated. All other opinions of the Board that are published or otherwise disseminated are not considered binding precedent of the Board.

The procedures described in this Standard Operating Procedure (SOP), as they pertain to determinations and comments made by the Chief Administrative Patent Judge and any other Administrative Patent Judge, are considered part of the deliberative process.

Background

In the past, Board opinions have been published in the United States Patent Quarterly, the Official Gazette, and the Decisions of the Commissioner of Patents. Opinions have also been published in electronic form by commercial organizations.

Beginning in late 1997, opinions in support of final decisions of the Board of Patent Appeals and Interferences appearing in issued patents, reissue applications, reexamination proceedings and interference proceedings open to the public have been disseminated by way of the PTO's "Freedom of Information Act" (FOIA) Internet web page. The Internet address of the FOIA web page is:

http://www.uspto.gov/web/offices/com/sol/foia/index.html

Opinions of the Trial Section of the Interference Division have likewise been disseminated by way of links to the Board's web page. The Internet address of the Board's web page is:

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

The availability of these opinions on the FOIA web page does not alter the fact that these opinions are precedential only if a majority of the members of the Board have voted to make the opinion precedential. Public policy favors widespread publication of opinions, even if the opinions are not considered precedential.

Nothing in this SOP should be construed as requiring a member of the public to seek

permission under this SOP to submit any non-precedential opinion of the Board in its possession to any commercial or other entity for publication. Any opinion made available to the public that does not expressly indicate that the opinion is binding precedent of the board shall be deemed to be non-precedential.

Categories of Board opinions

There shall be three categories of Board opinions:

1. Precedential opinions

2. Non-precedential opinions which an authoring judge or panel determines may be published[1]

3. Non-precedential opinions which an authoring judge or panel determines should not be published.

Binding Precedent

The following are considered binding precedent:

1. An opinion of the Supreme Court.

2. An *en banc* decision of the Court of Appeals for the Federal Circuit.

3. A precedential three-judge decision of the Federal Circuit, unless it conflicts with a prior decision of the former Court of Customs and Patent Appeals (CCPA) or the former Court of Claims, in which case the prior decision of the CCPA or the Court of Claims is binding precedent. [2]

4. An opinion of the Board made precedential by the procedures contained in this or earlier versions of Standard Operating Procedure 2.

Administrative Patent Judges encountering conflicts in the decisions of the Court of Appeals for the Federal Circuit, the CCPA, and/or the Court of Claims should call the conflict to the attention of the Chief Administrative Patent Judge.

---

[1] This category includes opinions of a merits or motions panel composed of all members of the Trial Section of the Interference Division when an interference assigned to the Trial Section involves a significant procedural issue applicable to proceedings before the Trial Section and the Trial Section judges deem it appropriate to issue an opinion binding on the Trial Section.

[2] When there is a conflict between decisions of the former CCPA, the latest decision is binding precedent.

A decision of a district court in a civil action involving judicial review (35 U.S.C. §§ 145 or 146) of a decision of the Board governs further proceedings in the case,[3] but otherwise is not binding precedent. A decision of a district court in a civil action in which the Commissioner is not a party is not binding precedent, but may be regarded as *stare decisis* and may serve as a basis for collateral estoppel.

Procedure for making an opinion precedential

The following procedures govern a determination of whether an opinion shall be deemed precedential.

Any Administrative Patent Judge may suggest that any opinion entered by the Board be deemed to be precedential. The suggestion shall be made to the Chief Administrative Patent Judge.

The Chief Administrative Patent Judge or his delegate will circulate the opinion to all judges. Within a time set in the notice circulating the opinion, each judge shall vote "yes" or "no" (without further comment or discussion) on whether the opinion shall be precedential. Failure of a judge to vote within the time set in the notice circulating the opinion will be taken and counted as a "no" vote. If a majority of the members of the Board vote "yes," the opinion will become precedential upon its being published or otherwise disseminated. Clearance for publication, if needed under the rules, will be obtained by the Chief Administrative Patent Judge.

The Chief Administrative Patent Judge, the Vice Chief Administrative Patent Judge and all Administrative Patent Judges are bound by a published or otherwise disseminated precedential opinion of the Board unless the decision supported by the opinion is (1) modified by the Court of Appeals for the Federal Circuit, (2) inconsistent with a decision of the Supreme Court or the Court of Appeals for the Federal Circuit, (3) overruled by a subsequent expanded panel, or (4) overturned by statute.

Non-precedential opinions

When authoring an opinion, a panel or a single judge may determine that the opinion may be published or not published. The fact that a panel or judge determines that an opinion may be published does not mean that it must be published; it means only that the authoring panel or judge has no objection to its being published.

When the panel or the judge has no objection to publication of the opinion, the opinion

[3] An exception would be where the district court did not have jurisdiction. It has been the PTO's position that a district court does not have jurisdiction under 35 U.S.C. § 146 to review that part of a decision of the Board in an interference case where claims of both parties are found to be unpatentable over the prior art (there is no case or controversy between the parties; the controversy is between the parties and the Commissioner; and the Commissioner cannot be compelled to join as a party; hence, there is no Article III jurisdiction). Judicial review of such a decision is exclusively in the Federal Circuit.

should contain the appropriate one of the following headings on the first page:

> The opinion in support of the decision being entered today is ***not*** binding precedent of the Board.

> The opinion in support of the decision being entered today is binding precedent of the Interference Trial Section of the Board of Patent Appeals and Interferences. The opinion is otherwise ***not*** binding precedent of the Board..

When a panel does not consider publication of the opinion warranted, the opinion should contain the following heading on the first page:

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

Any panel or judge seeking to have a non-precedential opinion published shall forward the opinion to the Chief Administrative Patent Judge. Clearance, if needed under the rules, will be obtained by the Chief Administrative Patent Judge. After clearance required by the rules is obtained, or when clearance is not needed, the opinion will be published or otherwise disseminated.

A non-precedential opinion that is published or otherwise disseminated is not binding on other judges and/or panels.

Appendix: Opinions Approved as Binding Precedent of The Board of Patent Appeals and Interferences pursuant to Standard Operating Procedure 2 which have not been modified or reversed by the Federal Circuit:

Reitz v. Inoue, 39 USPQ2d 1838 (Bd. Pat. App. & Int. 1995)
Ex parte Bhide, 42 USPQ2d 1441 (Bd. Pat. App. & Int. 1996)
Ex parte Lemoine - Appeal No. 94-1026 (to be published)
Basmadjian v. Landry - Int. No. 103,694 (to be published)

[End of list as of March 29, 2000]