

MEMORANDUM

To: All PTAB Users

From: James Donald Smith
Chief Administrative Patent Judge

Subject: Standard Operating Procedure 4 (Revision 5.2)

Date: September 30, 2014

The attached document supersedes the Patent Trial and Appeal Board's Standard Operating Procedure 4 (Revision 5.1), dated June 11, 2014.

This update to SOP4 clarifies the usage of hyphen, "en dash," and "em dash," as well as the use of Board-specific abbreviations in opinions. This version also includes additional formatting issues raised since the dissemination of the last SOP4.

Attachment:
Standard Operating Procedure 4

PATENT TRIAL AND APPEAL BOARD
STANDARD OPERATING PROCEDURE 4 (Revision 5.1)
STANDARDS FOR OPINIONS IN BOARD DECISIONS

This document sets standards for the format of opinions in decisions by the Patent Trial and Appeal Board (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 (APJ) and administrative staff in opinion preparation. The following directives 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

Under the guidance of the supervisory paralegal, the paralegals on each support team are expected to review draft documents for proper citation form, grammar, style, punctuation, and reference to precedents and the evidentiary record. Appendix A provides further details and some specific examples for the application of the standards set out below. Appendix B provides examples for standard first page formatting of opinions.

Appendix C provides helpful hints for using tools available in Microsoft Word to automate consistency with the standards set forth in this document.

II. STANDARDIZATION

A. Formatting¹

1. Opinions are formatted in Microsoft Word; please set the following 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 (including spacing between paragraphs)
 - e. Margins – 1.25 inch on each side, 1.0 inch on top and bottom (MS Word defaults), including the first page.
 - f. Footnotes, headers, footers, case captions, and mailing addresses – same size font as text on page, single-spaced.

¹ This formatting has been selected based on multiple criteria, e.g., readability, reduced size (number of pages) in a resulting paper decision, reduced size (kilobytes) in a resulting electronic file, and conventional usage.

- 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. A header is placed on the front page of AIA and Interference papers including the email, telephone number, paper number, and date. *See Appendix B.*
- 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:

Appeal xxxx-xxxxxx
Application xx/xxx,xxx

or

Appeal xxxx-xxxxxx
Patent x,xxx,xxx
Reexamination Control xx/xxx,xxx

or

IPR xxxx-xxxxxx
Patent x,xxx,xxx

or

CBM xxxx-xxxxxx
Patent x,xxx,xxx

or

Interference No. xxx,xxx
[Party] v [Party]

2. General formatting for the body of an opinion follows:
 - a) Use “keep with next” to keep headings on the same page with the text underneath (click on the paragraph menu and then the “line and page breaks” tab).
 - b) Use “CTRL,” “SHIFT” and “SPACE” at the same time to create a “hard space” which will keep the text on both sides of the space together on the same line of text. This prevents a hanging § symbol or bracket at the end of a line, etc.
 - c) Use “CTRL,” “SHIFT” and “DASH” at the same time to create a “hard dash” which will keep the text on both sides of the dash together on the same line of text.
 - d) Use proper ellipses: use “. . .” [periods with spaces between], not “...” Bluebook Rule 5.3.
 - e) Use an “em dash” to set off phrases within a sentence (see Strunk & White Rule 8). Example: Appellant—in the Reply Brief—acknowledges that Smith teaches hammering a nail. Form an em dash by typing the first word, typing two hyphens, and typing the next word. Microsoft Word will automatically convert the two hyphens into an em dash. Alternatively, hold down the “CTRL”, “ALT”, and minus sign (-) (found on the numeric keypad).
 - f) Use an “en dash” to connect values in a range to express a “to” relationship. Example: 2001–2002 instead of 2001 to 2002. To insert an “en dash” use “CTRL” and minus sign (-) (found on the numeric key pad).
 - g) When hyphenating compound words in a sentence use a “figure dash” (-) which is the dash found on a conventional

keyboard. Compound words are two or more words combined to express one concept. Examples of compound words are: mother-in-law, tractor-trailer, light-year, better-fitting (See also Appendix A ¶ 33.)

- h) Do not use bullet points in the body of an opinion.
- i) Use two spaces after a period at the end of a sentence or citation.

B. Emphasis

Italic or bold type font is acceptable for emphasis.

Capitalize and center every letter of the title and major headings, without further emphasis, e.g., “DECISION ON APPEAL,” “ANALYSIS,” or “CONCLUSION.” The title and/or major heading are **not** underlined, italicized, or bolded.

Capitalize, underline, and center 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*. (See Appendix A, item 15.)

2. Patents and Published Applications

Identify patents and published applications by at least the surname of the first listed inventor, number, country code, 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 APJ.

In pre-AIA applications, 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 are provided in Appendix A.

D. Grammar / Style

William Strunk, Jr. & E. B. White, *Elements of Style* (Longman 4th ed. 1999); William Sabin, *Gregg Reference Manual* (Tribute ed., 11th ed. McGraw-Hill Co. 2011), and Lynn Quitman Troyka & Douglas Hess, *Quick Access Reference for Writers* (Prentice Hall 5th ed. 2007 (or 6th ed. 2010)), are the recommended reference guides for assistance with grammar usage when writing opinions. For a list of other acceptable reference sources, please consult Appendix A, item 30.

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 at the bottom center of each page of the opinion, except for the first page (no page numbering on the first page) but succeeding pages would be numbered (2, 3, 4, etc.).

F. Quality Oversight

1. APJs are encouraged to interact with the Paralegal in order to successfully process decisions.

2. APJs are encouraged to provide positive and/or negative feedback to the *Supervisory Paralegal Specialist* regarding the processing of any draft decision in an effort to ultimately reach and/or achieve higher levels of excellence in decision processing.
3. When an issue or question arises concerning a particular formatting item, citation, or usage of grammar, the matter shall be resolved by following SOP4 and Appendix A.

G. Standard First and Last Pages of an Opinion

Examples of a standard first page for opinions are set forth in the attached Appendix B, which includes examples of pages from: an opinion in a decision on appeal in an *ex parte* regular application; an opinion in a decision on appeal in an *ex parte* reissue application; an opinion in a decision on appeal in an *ex parte* reexamination proceeding; an opinion in a decision on appeal in an *inter partes* reexamination proceeding; a decision in an interference proceeding; a decision in an AIA proceeding; a non-public version of a decision in an AIA proceeding; and a public version of a decision in an AIA proceeding.

When appropriate use one of the following titles:

DECISION

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 for AIA decisions:

DECISION

FINAL WRITTEN DECISION

ERRATUM

ORDER

SCHEDULING ORDER

Examples of a first page for a decision containing a majority opinion and another opinion (e.g., concurring or dissenting), and a standard last page for opinions are set forth in the Appendix B.

H. Decisions Under Seal

If a decision issued in an AIA proceeding contains information subject to a protective order, each page of the opinion must contain text in the header and footer (in red font) as follows:

NON-PUBLIC VERSION – PROTECTIVE ORDER MATERIAL

When the Board issues a public version of the AIA decision, each page of the opinion must contain text in the header and footer (in green font) as follows:

PUBLIC VERSION

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 applies to all final Board opinions that are posted on the eFOIA section of the USPTO's web page and all Board opinions made available to the public in PRPS.

Compliance with § 508 requires that 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:

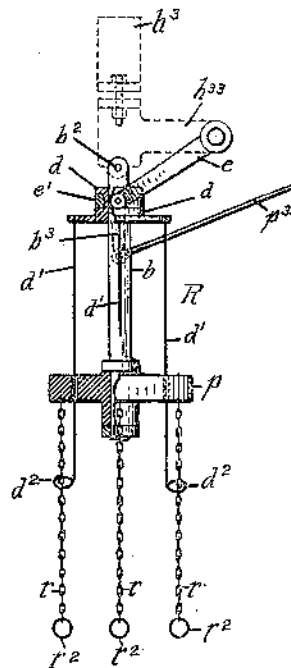


Figure 2 depicts an automobile anti-skid device.

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

Additional resources regarding § 508 compliance can be found at:

<http://ptoweb.uspto.gov/wmb/s508/s508home.html>

<http://www.section508.gov/>

APPENDIX A

Formatting

Capitalization

1. Capitalize the terms “Final Office Action,” “Amendment,” or “Advisory Action” when referring to the title of a document of the instant application on appeal, and capitalize the terms “Petition,” “Preliminary Response,” “Patent Owner’s Response,” or “Petitioner’s(s’) Reply” when referring to the title of a document in an AIA proceeding; likewise, capitalize the words “Examiner,” “Appellant,” “Appellants,” “Petitioner,” and “Patent Owner” when referring to specific persons. Bluebook Rule (hereafter “R”) 8 (pp. 84–86).

Abbreviations

2. Omit periods in abbreviations of four or more words (e.g., PTAB, BPAI, MPEP).
3. Use the symbol “§” as an abbreviation for the word “section,” and “§§” for “sections” throughout the text. However, spell out (“Section”) if used at the beginning of a sentence. R3.3 (pp. 69–70); R6.2(c) (pp. 82).
4. Use the symbol “¶” or “para.” as an abbreviation for the word “paragraph,” and use “¶¶” or “paras.” for “paragraphs” as appropriate per the Bluebook. However, spell out (“Paragraph”) if used at the beginning of a sentence. R3.3 (pp. 69–70); R6.2(c) (pp. 82).
5. Spell out the word “column” within a sentence, but abbreviate as “col.” when used in a citation. Bluebook Table (hereafter “T”) 16 (p. 473). (Ex. 1001, col. 1, ll. 2–3 or Ex. 1001, 1:2–3).

6. Spell out the word “line” or “lines” within a sentence, but abbreviate as “l.” or “ll.” in a citation. T16 (p. 473). (Ex. 1001, col. 1, ll. 2–3 or Ex. 1001, 1:2–3).

7. Other abbreviations used in Board decisions — the following abbreviations represent words commonly used in Board decisions. Most of these abbreviations are taken from the Bluebook.

I. Court Documents (The Bluebook Bluepages Table (hereafter “BT”) 1)

A. The following list includes words that are commonly abbreviated in Board decisions.

| | |
|--------------|-----------------------------|
| Affidavit | Aff. |
| Answer | Answer or Ans. ¹ |
| Appeal | Appeal (<i>See Brief</i>) |
| Appendix | App. |
| Attorney [s] | Att’y [s] |
| Brief | Br. |

If the decision contains only an Appeal Brief, then it should be identified as Br. However, if the decision contains both an Appeal and Reply Brief, they are identified as Appeal Br.(or App. Br.¹) and Reply Br., respectively.

| | |
|--------------|-------------|
| Declaration | Decl. |
| Document [s] | Doc., Docs. |
| Exhibit | Ex. |

¹ We note that this abbreviation is not specifically provided for by the Bluebook, however, it does appear in decisions by the Board.

| | |
|-----------------|---------|
| Hearing | Hr'g |
| Reconsideration | Recons. |
| Rehearing | Reh'g |
| Reply | Reply |
| Request | Req. |
| Transcript | Tr. |

B. Words of more than six letters not appearing in this table may also be abbreviated **if** the abbreviation selected is unambiguous (emphasis added). BT1 (pp. 28–29).

II. Case Names (T6)

| | |
|----------------------|--------|
| Associate | Assoc. |
| Board | Bd. |
| Commission | Comm'n |
| Commissioner | Comm'r |
| Committee | Comm. |
| Company | Co. |
| Corporation | Corp. |
| Department | Dep't |
| Incorporated | Inc. |
| Industr[y, ies, ial] | Indus. |
| International | Int'l |
| Laboratory | Lab. |

III. Subdivisions (T16)

| | |
|-------------|-------------|
| Column [s] | col., cols. |
| Example [s] | ex., eks. |

| | |
|------------|--------------------------|
| Figure [s] | Fig., Figs. ² |
| Line [s] | I., II. |
| Number [s] | no., nos. |
| Rule | R. |
| Volume [s] | vol., vols. |

IV. *Abbreviations for Ex Parte Decisions*

| | |
|-------------------------|------------------------------|
| Examiner's Answer | Answer or Ans. |
| Appeal Brief | Appeal Br., App. Br., or Br. |
| Reply Brief | Reply Br. |
| Non-Final Office Action | Non-Final Act. or Non-Final |
| Final Office Action | Final Action or Final Act. |
| Advisory Action | Adv. Act. |
| Specification | Spec. |

We note that the above abbreviations are not specifically provided for by the Bluebook, however, they do appear in decisions by the Board.

V. *Abbreviations for AIA Decisions*³

| | |
|---|---|
| Petition | Pet. |
| Preliminary Response | Prelim. Resp. |
| Motion ¹ (to amend or other) | (optional abbreviated party name) Mot. |

² We note that Bluebook has "fig." in lower case, we have found that it looks better when "Fig." is capitalized, especially in a string citation.

³ A pinpoint citation to a particular page of the paper may be included after the abbreviation. Note, "at" should not be used to introduce the pinpoint citation. *See* Pet. 4; PO Resp. 8-10; Pet. Reply 15.

| | |
|---|---|
| Patent Owner's Response to Petition | PO Resp. |
| Petitioner's reply to patent owner response | Pet. Reply |
| Opposition ¹ (to motion to amend or other) | (optional abbreviated party name) Opp. |
| Reply ⁴ (to opposition to motion to amend or other) | (optional abbreviated party name) Reply |
| Response to observation | (optional abbreviated party name) Resp. |
| Exhibit | Ex. [number] (optional description) |
| Exhibit List | [PO or Pet.] Ex. List |
| Declaration | Decl. ##:##-##:## (can be used as a short form after initial citation to the Exhibit) |
| Transcript | Tr. ## (can be used as a short form after initial citation to the Exhibit) |
| Corrected/Renewed version of any paper | Corrected/Renewed Paper name |
| Miscellaneous Documents (e.g. Mandatory Notice, Notice of Filing Date, Related Matters, Power of Attorney, etc. . . .) | (optional) Paper Name in PRPS + (required) (Paper #xyz) |
| Decisions | Dec. on Paper Name in PRPS (e.g. Dec. on Mot.) with optional (Paper |

⁴ Note – if it is not readily apparent to which motion this refers, i.e., several motions have been filed, any citation may add an explanatory parenthetical (Paper #xyz) – referencing the document # in PRPS.

| | |
|------------------------|---|
| | #xyz) for clarity |
| Orders | Order Paper Name in PRPS with optional (Paper #xyz) for clarity |
| Request for Rehearing | Req. Reh'g |
| Final Written Decision | Final Dec. |

VI. *Other Abbreviations*

The following abbreviations are also used by the Board:

| | |
|---|---|
| Patent Trial and Appeal Board | PTAB |
| Board of Patent Appeals and Interferences | BPAI |
| Board of Patent Appeals (before 1985) | Bd. App. |
| Board of Patent Interferences (before 1985) | Bd. Pat. Int. |
| Decisions of the Commissioner of Patents | Dec. Comm'r Pat. |
| United States Code | U.S.C. |
| Code of Federal Regulations | C.F.R. |
| Court of Customs and Patent Appeals | CCPA |
| Federal Reporter | F., F.2d, F.3d (1st, 2d, and 3d series) |
| Federal Appendix | F. App'x |
| Federal Register | Fed. Reg. |
| Federal Rules of Civil Procedure | Fed. R. Civ. P. |
| Federal Rules of Evidence | Fed. R. Evid. |
| Federal Supplement | F. Supp. |
| Manual of Patent Examining Procedure | MPEP |
| Official Gazette | Off. Gaz. [or O.G.] |
| United States Patent Quarterly | USPQ |

Use the short cite “*Id.*” sparingly and only in close proximity to the specific authority. Also, if a different pinpoint citation to a page number is included after the “*id.*” use “at,” but do not use “at” when the pinpoint citation is to a section or paragraph. For example, *id.* at 14, but *id.* § 1981. R4.1 (pp. 72–73; Note: the period at the end of *id.* is always italicized).

Italicization

8. The Bluebook provides specific guidance regarding italicization of foreign words within a sentence (in contrast to a word in a citation). The Bluebook provides a list of examples of words that are not italicized. R7 (p. 83). Italicize a foreign word if it is **not** in this list. Accordingly, do not italicize the phrases “*prima facie*,” “*en banc*,” or “*res judicata*.” Additionally, italicize “*e.g.*” and “*i.e.*” only when part of a signal. R7(b) (p. 83). Note: “*inter partes*” is italicized.

9. Italicize signals used in citations. Some examples of signals are shown in the following cites, *see Ex parte Lee*, 31 USPQ2d 1105 (BPAI 1993); *e.g.*, *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). R1.2 (pp. 54–55).

Claim Formatting

10. The formatting of claims is ultimately discretionary with the APJ. Preferably, double-indent and single space claims with 1.5 spaces (9 pt) between claims.

Quotations

11. Follow the Bluebook for quotations. Quotations of 49 words or less should be enclosed in quotation marks but not otherwise set off from the rest of the text. Quotation marks around material quoted inside another quote

should appear as single marks within the quotation. R5.2(b) (p. 77).

Example: “firm resolve to insure that the CIA’s ‘power that flows from money and stealth’ could not be turned”

Block Quotations

12. Follow the Bluebook for block quotations. Quotations of 50 words or more should be in block form, and should be indented on the left and right without quotation marks, and quotation marks should appear as they do in the original. R5.1(a) (p. 76–77).

Citation of judicial/administrative opinions (T1).

13. Whenever a decision is cited in full, give its entire subsequent history, but omit denials of certiorari or denials of similar discretionary appeals, UNLESS the decision is less than two years old or the denial is particularly relevant. R10.7 (pp. 101–103).

14. Do not parallel cite to other sources. A parallel cite references the same case in two or more sources. Example: Do not cite as *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007); cite as *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398 (2007).

15. In order of priority, use the following sources for each of the listed decisions:

- a) Supreme Court citations are to the United States Reports (U.S.), or West’s Supreme Court Reports (S. Ct.)

- b) Court of appeals citations are to the Federal Reporter (F., F.2d or F.3d) or the Federal Appendix (Fed. App.), when available. When not available, citations are to the United States Patent Quarterly.
- c) 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.
- d) An opinion not available in a printed reporter may be cited to the Westlaw electronic database. For example, *Acme Corp. v. Grimlin*, Civ. No. 2013-00598, 2007 WL 1234567, at *5 (N.D. Cal. Jan. 2, 2014). See R10.8.1 (p. 104).
- e) Board decisions are to the United States Patent Quarterly, when available. When not available, citations are to the slip opinions available at PTAB Reading Room. For example, *Ex parte Giles*, Appeal 2011-012860 (PTAB Feb. 24, 2014); *Gillman v. Stoneeagle Servs., Inc.*, Case CBM2013-00047 (PTAB Feb. 18, 2014). See R10.8.1 (p. 104). To provide a pinpoint citation to a particular page, use the following format. *Ex parte Giles*, Appeal 2011-012860, slip op. at 7 (PTAB Feb. 24, 2014); *Gillman v. Stoneeagle Servs., Inc.*, Case CBM2013-00047, slip op. at 9 (PTAB Feb. 18, 2014). You also may provide an explanatory parenthetical with the url link to the opinion:
<http://e-foia.uspto.gov/Foia/PTABReadingRoom.jsp>

16. In citations to Board decisions, abbreviate “Patent Trial and Appeal Board” as “PTAB.” For citation to Board decisions before September 16, 2012, when the Board was known as “Board of Patent Appeals & Interferences,” abbreviate as “BPAI” rather than “Bd. of Pat. App. & Int.”

For citation to Board decisions before February 8, 1985, when the Board was known as the Board of Patent Appeals, and the Board of Patent Interferences, abbreviate as “Bd. App.” and “Bd. Pat. Int.,” respectively.

17. Additional guidance on citation format not addressed specifically in the Bluebook may be found in Federal Circuit decisions.

Citation of references in Board decision

18. The use of a table for the citation of references is at the discretion of the APJ.

When a table is used, we recommend the following format:

The prior art relied upon by the Examiner in rejecting the claims on appeal:

| | | |
|---|--------------------|---------------|
| Lencoski et al. (hereinafter “Lencoski”) | US 6,035,613 | Mar. 14, 2000 |
| Waechter | US 6,113,525 | Sept. 5, 2000 |
| Coley et al. (hereinafter “Coley”) | US 2005/0273436 A1 | Dec. 8, 2005 |
| O’Brien | US 7,000,000 B1 | Feb. 14, 2006 |
| Carlino et al. (hereinafter “Carlino”) | WO 00/39666 | Jul. 6, 2000 |

Metter and Colomb, *WAP enabling existing HTML applications*, Proc. First Australasian User Interface Conference (AUIC) 49 (2000) (hereinafter “Metter”).

Michael R. Isley et al., *Recent Advances in Intraoperative Neuromonitoring of Spinal Cord Function: Pedicle Screw*

Stimulation Techniques, 37 Am. JU. Electroneurodiagnostic Tech. 93 (1997).

Francis A. Carey, *Organic Chemistry* (Kent A. Peterson et al. eds., 6th ed. 2006).

Migraine Definition, Meriam-Webster.com, <http://www.merriam-webster.com/medical/migraine> (last visited May 1, 2014).

Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act; Final Rule, http://www.uspto.gov/aia_implementation/fr_inventor_oath.pdf (last visited May 1, 2014).

As can be seen in the above example, list first the U.S. references, usually in ascending date order, followed by the foreign references, then the journal, book and/or electronic references.

Additional patent literature examples:

Example 1:

Claims 1–16 stand rejected under U.S.C. § 102(e) as being anticipated by Jameson (US 2003/0107596 A1, published June 12, 2003 (filed Dec. 6, 2001))⁵.

Example 2:

The Examiner relies upon the following prior art in rejecting the claims on appeal:

| | | |
|---------|-----------------|---------------|
| Horvitz | US 6,182,133 B1 | Jan. 30, 2001 |
|---------|-----------------|---------------|

⁵ Note that the filing date is ordinarily not required unless the date is relevant to an issue in the case.

| | | |
|-------------------------------|--------------------|---------------|
| Yamada et al. (Yamada) | US 2004/0052504 A1 | Mar. 18, 2004 |
| Sengupta et al. (Sengupta) | US 6,883,019 B1 | Apr. 19, 2005 |

Example 3:

| | | |
|------|-----------------|--|
| Chen | US 6,710,101 B2 | Mar. 23, 2004 (filed Jan. 15, 2003) |
|------|-----------------|--|

In the third column, list the publication or issue date, and abbreviate the month to three (3) letters followed by a period. Exception: Do not abbreviate the months June or July because they contain only four letters, and September is abbreviated Sept. (*see* T12 (p. 444)).

For U.S. patents that qualify as prior art under 35 U.S.C. § 102(e) rather than § 102(b), list the effective filing date in parentheses in the next line after the issue date only when such a date is a material fact in the case.

19. In pre-AIA applications, 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.
20. For non-patent literature (NPL) documents follow Bluebook citation form. *See* R15 (pp. 138–146); R16 (pp. 147–158).
21. Citing to a patent application paragraph, do not include brackets (e.g., The patent application describes elephants. Ex. 1002 ¶ 16; Not: Ex. 1002

¶ [0016] or Ex. 1002 ¶ 0016. There is no comma between the exhibit number and the paragraph symbol. *See* R 3.3 (p. 69–70).

22. Use the Exhibit number to refer to a reference in a citation sentence (e.g., The patent describes elephants. Ex. 1001, col. 1, ll. 2–7 or Ex. 1001, 1: 2–7).

23. The Kind Code is the two (2) digit code that follows the publication number of a U.S. patent or application (e.g., 9,876,564 B1). The Kind Code range is from A to C3 (see explanation and examples below). If a cited publication includes a Kind Code that is not included by the APJ in the decision, the Paralegal should add it to the citation of the reference.

Explanation of Codes A–C:

(a) Kind Codes A1–A2 (and/or A–3 thru A9) will appear on Patent Applications, where a PG Publication is or was issued on or after January 2, 2001.

(b) Kind Codes B1–B2 will appear on Patents only.

(c) Kind Code B1 is used where there was NO Pre-Grant Publication issued prior to March 2001 and the Patent granted on or after January 2, 2001.

(d) Kind Code B2 is used where there WAS a Pre-Grant Publication issued prior to March 2001 and the Patent granted on or after January 2, 2001).

(e) Kind Codes C1–C3: will appear on Reexaminations only.

(f) For additional information consult:

<http://www.uspto.gov/patents/ebc/kindcodesum.jsp>

Miscellaneous Opinion Formatting

24. The format for citations to the record is at the discretion of the APJ, however, the format should be consistent throughout the opinion. Examples:

“Dogs like to bark.” (Ans. 3.)

“Dogs like to bark” (Ans. 3).

“Dogs like to bark.” Ans. 3.

25. Line numbering for interference and reexamination decisions, although not encouraged, is at the discretion of the APJ.

26. Headings stating an opinion is not written for publication or is not binding precedent are not permitted.

27. Use footnotes judiciously and sparingly. However, footnotes are at the discretion of the APJ.

28. Adding spaces on either side of an em dash is at the discretion of the APJ.

29. Referring to the parties generically as Patent Owner and Petitioner or using their actual names is at the discretion of the panel, but the shorthand used must be consistent throughout.

Grammar & Style

30. Use writing styles consistent with recognized grammar reference sources, for example:

William Strunk, Jr. and E. B. White, *Elements of Style* (Longman 4th ed. 1999);

Lynn Quitman Troyka and Douglas Hess, *Quick Access Reference for Writers* (Prentice Hall 5th ed. 2007 (or 6th ed. 2010));

William Sabin, *Gregg Reference Manual* (Tribute ed., 11th ed. McGraw-Hill Co. 2011);

Bryan A. Garner, *Garner on Language and Writing* (American Bar Association, 2009);

Jane E. Aaron, *The Little, Brown Compact Handbook* (Pearson 2007).

Commonly encountered problems include:

31. Avoid split infinitives (use “to go boldly” instead of “to boldly go”) and split verb phrases (use “the response was filed timely” instead of “the response was timely filed”)

Tip: do a global search for “ly” and look for words in between verb phrases

Tip: common problem words include: sufficiently, clearly, properly, specifically, reasonably, generally, explicitly, separately, previously, originally, necessarily

32. Use “that” and “which” properly

a) “that” is defining or restrictive: The lawn mower that is broken is in the garage. (tells which one)

- b) “which” is nondefining or nonrestrictive: The lawn mower, which is broken, is in the garage. (adds a fact about the only lawn mower)
- c) *See Strunk & White* (words that are commonly misused)

33. Hyphenate compound adjectives (e.g., obviousness-type double patenting, well-known feature, long-felt need, etc.) A compound adjective consists of two or more words that function as a unit and express a single thought. These one-thought modifiers are derived from (and take the place of) adjective phrases and clauses. When two or more words are combined to form a compound adjective, a hyphen is usually required. (*See Strunk & White.*)

34. Keep words of compound verbs together (e.g., use “already has been delivered” instead of “has already been delivered”).

35. Avoid passive voice when possible (*see Strunk & White Rule 14*).

36. Be careful using the word “since,” it implies time – you normally will want to use “because.” By the same token, the word “while,” also implies time – you normally will want to use “although.”

37. Unless it does not make sense in context, set off by commas phrases like “therefore” and “thus” (e.g., “Reference X, therefore, teaches Y limitation”).

38. Use punctuation correctly — the most common problem is missing commas (*see Strunk & White – passim*).
39. Use party names consistently (e.g., “Petitioner” and “Patent Owner,” or “Microsoft” and “Apple”).
40. When in doubt, look to Strunk & White for guidance.
41. Use the serial comma, i.e., in a series of three or more terms with a single conjunction, use a comma after each term except the last (*see Strunk & White Rule 2*).
42. Place a comma before a conjunction introducing an independent clause.
43. Use definite, specific, concrete language, and omit needless words such as “clearly,” “meaningfully,” and “itself.”
44. In summaries, use one tense.

APPENDIX B

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte [INVENTOR(S)]

Appeal [number]¹
Application [number]²
Technology Center [number]

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Front page of an opinion in a unanimous decision on appeal from an *ex parte* regular application.

A minimum of three lines of text is required for a decision to begin on the first page.

[No page number on front page]

¹ The record includes a transcript of the oral hearing held ***.

² According to Appellants, the real party in interest is *** (Appeal Br. *).

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte [INVENTOR(S)]

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

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]

Front page of an opinion in a decision appeal from an *ex parte* regular application, where the opinion contains a dissenting opinion.

A minimum of three lines of text is required for a decision to begin on the first page.

[No page number on front page]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte [INVENTOR(S)]

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

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

[LAST NAME], *Administrative Patent Judge*, [concurring/dissenting].

First page of a concurring or dissenting opinion.

A minimum of three lines of text is required for a decision to begin on the first page.

[No page number on first page of concurring/dissenting opinion]³

³ Succeeding pages of the concurring/dissenting opinion are separately numbered (2, 3, 4, etc.).

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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]

Front page of an opinion in a decision on appeal in an *ex parte* reissue application.

A minimum of three lines of text is required for a decision to begin on the first page.

[No page number on front page]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte [PATENT OWNER]
Appellant

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

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Front page of an opinion in a decision on appeal in an *ex parte* reexamination proceeding.

A minimum of three lines of text is required for a decision to begin on the first page.

[No page number on front page]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

[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]

Appeal [number]

Reexamination Control [number]

Patent [number]

Technology Center [number]

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

[LAST NAME], *Administrative Patent Judge.*

Front page of an opinion in a decision on appeal for an *inter partes* reexamination proceeding.

No part of the decision is placed on the front page.

[No page number on front page]

[OUTCOME]

[Judges' initials]

[initials of Paralegal only]

[MAILING ADDRESS OF APPELLANT (REEXAM CASES ONLY)]

[MAILING ADDRESS OF OTHER PARTY WHEN APPROPRIATE
(REEXAM CASES ONLY)]

Last page format

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

[Party name],
Junior Party,
(Patents)

v.

[Party Name]
Senior Party,
(Application No.)

Patent Interference [number]
(Technology Center [number])

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Front page for an opinion in an interference proceeding.

A minimum of three lines of text is required for a decision to begin on the first page.

[no page number on front page]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

[Party name],
Petitioner,

v.

[PATENT OWNER],
Patent Owner.

Case IPR or CBM [number]
Patent [number]

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Front page for an opinion in an AIA proceeding.

A minimum of three lines of text is required for a decision to begin on the first page.

[no page number on front page]

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SOP4 Appendix B
Paper No. [number]
Entered: [date]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

[PARTY NAME],
Petitioner,

v.

[PATENT OWNER],
Patent Owner.

Case IPR or CBM [number]
Patent [number]

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Front page for an opinion in an AIA proceeding.

A minimum of three lines of text is required for a decision to begin on the first page.

[no page number on front page]

PUBLIC VERSION

Trials@uspto.gov
571.272.7822

SOP4 Appendix B
Paper No. [number]
Entered: [date]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

[PARTY NAME],
Petitioner,

v.

[PATENT OWNER],
Patent Owner.

Case IPR or CBM [number]
Patent [number]

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

[LAST NAME], *Administrative Patent Judge*.

[TITLE]

Front page for an opinion in an AIA proceeding.

A minimum of three lines of text is required for a decision to begin on the first page.

[no page number on front page]

APPENDIX C

Additional Microsoft Tools

I. Frequently Used Microsoft Short Cut Keys

| Symbol or Character | Shortcut key |
|-----------------------------------|--|
| Nonbreaking space (Hard space) | Alt+Ctrl+Space |
| - | Ctrl+Shift+“dash” |
| — | Alt+Ctrl+Num- (while holding down Alt and Ctrl keys simultaneously, hit minus sign “-” on number pad) |
| – | Ctrl+Num- |
| ’ | Alt+0146 |
| ’ | Ctrl+’,’ (while holding down Ctrl key and hit apostrophe key 2x) |
| © | Alt+Ctrl+C |
| ® | Alt+Ctrl+R |
| ™ | Alt+Ctrl+T |
| § | Alt+Ctrl+S |
| ¶ | Alt+0182 |
| Insert Endnote | Alt+Ctrl+D |
| Insert Footnote | Alt+Ctrl+F |
| Highlight | Alt+Ctrl+H |
| Print Preview | Alt+Ctrl+I |
| Format AutoFormat | Alt+Ctrl+K |
| Insert List Number Field | Alt+Ctrl+L |
| Insert Annotation | Alt+Ctrl+M |
| View Page | Alt+Ctrl+P |

| | | |
|--|----------------------------|------------|
| | Table Update AutoFormat | Alt+Ctrl+U |
| | Edit Paste Special | Alt+Ctrl+V |
| | Repeat Find | Alt+Ctrl+Y |
| | Go Back | Alt+Ctrl+Z |

II. Assign a shortcut key to a symbol or special character

Begin shortcut key combinations with CTRL, ALT, or a function key.

1. On the **Insert** menu, click **Symbol**.
2. Click the tab with the symbol or character you want.
Note: If you don't see the symbol you want, in the drop-down menus, click a different font or subset.
3. Click the symbol or character you want.
4. Click **Shortcut Key**.
5. In the **Press new shortcut key box**, press the key combination you want to use. For example, press ALT+ the desired key.
6. Look at **Currently assigned to** to see if the shortcut key combination is already assigned to a command or other item.

Reassigning a key combination means that you can no longer use the combination for its original purpose. For example, pressing CTRL+B changes selected text to bold. If you reassign CTRL+B to a new command or other item, you will not be able to bold text by pressing CTRL+B unless you restore the shortcut key assignments to their original settings.

In Microsoft Word the following letters A, B, G, J, Q, W, X as well as number keys 1-9 are not assigned to any particular character or function in conjunction with the ALT+CTRL key combination.

7. Click **Assign**.

III. Replacing existing straight quotes with smart quotes

Use the following method to replace existing straight quotes with smart quotes in a document.

1. To turn on smart quotes, follow these steps:
 - a. On the **Tools** menu [you find this under the File Tab/Help/Option/Proofing] click **AutoCorrect** [**AutoCorrect Options**], and then select the **AutoFormat As You Type** tab.
 - b. Under **Replace as you type**, click to select the "**Straight quotes**" with "**smart quotes**" check box, and then click OK.
2. On the **Edit** menu [under the Home tab], click **Replace**.
3. In the **Find what** box, type a quotation mark.
4. In the **Replace with** box, type a quotation mark.
5. Click **Replace All**.

IV. Removing Line Breaks

1. On the **Edit** menu [under the Home tab], click **Replace**.
2. In the **Find what** box, type ^p.
3. In the **Replace with** box, type a "space".
4. Click **Replace All**.

In Word, a line break in the Search and Replace dialog box is specified with the combination

^p

The “p” stands for paragraph. So searching for ^p and replacing with a space will replace line breaks with spaces.