

A VIEW BEHIND THE CURTAIN: The BPAI Decision Making Process
Vice Chief Judge James Moore, Vice Chief Judge Allen MacDonald, Judge
Kenneth Hairston, Judge Murriel Crawford
Board of Patent Appeals and Interferences

I. The Board

A. The Board is created by 35 U.S.C. § 6, which mandates the Board's:

1. Duties;

a) The Board's two main responsibilities include:

(1) review of ex parte appeals from adverse decisions of examiners where written appeal is taken by dissatisfied patent applicant, and

(2) conduct interferences to "determine priority" (that is, decide who is the first inventor) whenever applicant claims the same patentable invention which is already claimed by another applicant or patentee.

b) The Board does not "allow" claims of an application and cannot direct an Examiner to pass an application to issuance.

c) Rather, the Board's primary role is to "on written appeal of an applicant, review adverse decisions of examiners" including the findings and conclusions made by the examiner. 35 U.S.C. § 6.

d) The Board also has discretion to enter a new ground of rejection. 37 CFR § 41.50(b).

2. Composition;

a) 35 U.S.C. § 6(a) establishes the Board's membership as the Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the Administrative Patent Judges ("Judges")

b) Original "board of disinterested persons" provided for in Patent Act of 1836

c) Patent Act of 1861 formed the permanent Board of Appeals of "persons of competent legal knowledge and scientific ability"

d) President Lincoln appointed George Harding, Esq. of Philadelphia as the first “Examiner-in-Chief”

3. Membership Qualifications; and

a) The Judges shall be “persons of competent legal knowledge and scientific ability” who are appointed by the Secretary of Commerce upon consultation with the Director

b) Each Judge has a law degree from an accredited law school and has been admitted to at least one state bar

c) Each Judge has at least a bachelors degree in science or engineering or equivalent----Many have advanced degrees in science or engineering or equivalent

4. Panel form of decision-making.

a) 35 U.S.C. § 6(b) requires hearings by 3-member Panels: Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director.”

b) The Director’s authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Administrative Patent Judge, Michael Fleming.

c) Normally, 3-member panels are composed of 3 Judges each involved in the decision-making process.

B. The Board’s Jurisdiction (35 U.S.C. § 134)

1. Final Decisions of an Examiner (“Twice Rejected”)

2. Ex-Parte Appeals: Examiner’s decision rejecting the claims in a patent application

a) Reissue

3. Reexamination Appeals

a) Inter Partes – Patent Owner and Third Party Requestor

b) Ex Parte – Patent Owner

C. BPAI Structure

- 1. Chief Judge Fleming**
 - a) Oversees all administrative and merits operations**
- 2. Merits is split into two Divisions**
 - a) Division 1**
 - (1) Vice Chief Judge James T. Moore**
 - (2) Biotechnology, Computers, Contested Cases, and Interference Sections**
 - (3) ~ 40 Administrative Patent Judges**
 - b) Division 2**
 - (1) Vice Chief Judge Allen R. MacDonald (Acting)**
 - (2) Chemical, Communications/Electrical, and Mechanical/Business Methods Sections**
 - (3) ~ 40 Administrative Patent Judges**
- 3. Each Section is divided into plural chambers**
 - a) Each chamber comprises**
 - (1) Two Judges**
 - (2) Two Patent Attorneys**
 - (3) A Paralegal**
 - b) FY 2010 – Half of Judges are in a chamber**
 - c) FY 2011 – All Judges will be in a chamber**

II. Requirements to Enter Appeals Process

- A. Application must be twice rejected**
- B. Notice of Appeal**
- C. Filing of an Appeal Brief**
- D. Filing of an Examiner's Answer**
- E. Filing of a Reply Brief (optional)**
- F. Docketing - transfers jurisdiction to the Board**
 - 1. Appeal Number assigned**
 - 2. Oral Hearing date assigned, if requested**

III. Standard Operation Procedures (SOP)

A. SOP 1: Assignment of Judges to Panels

B. SOP 2: Publication of Opinions and Binding Precedent

IV. The Appeal at the Board

A. Assigning a Panel by Chief Judge or Vice Chief or Vice Chief (see SOP 1)

B. Oral Hearing (if requested by Appellant)

1. A preliminary conference is held by the Panel before the oral hearing to generally identify the issues

2. A more substantive final conference is held after the hearing

C. APJ Conference

1. Review by the Panel

a) Board is a judicial body reviewing issues raised by Appellant.

b) Board's Findings of Fact must be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

c) The Board's role in an appeal is to, "*on written appeal of an applicant*, review adverse decisions of examiners upon applications for patents." 35 U.S.C. § 6(b) (2006) (emphasis added).

d) (§ 103 example) An Appellant may attempt to overcome an Examiner's obviousness rejection on appeal to the Board by submitting arguments and/or evidence to show that the Examiner made an error in either (1) an underlying finding of fact upon which the final conclusion of obviousness was based, or (2) the reasoning used to reach the legal conclusion of obviousness.

e) (Example cont.) Similarly, the applicant may submit evidence of secondary considerations of non-obviousness. *See Kahn*, 441 F.3d at 985-86 ("On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149

F.3d 1350, 1355 (Fed. Cir. 1998), *overruled in part on other grounds*, *KSR*, 550 U.S. at 422).

- f) The panel reviews adverse Examiner decisions for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“In reviewing the examiner’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.”) (emphasis added). *Ex parte Frye*, ___ USPQ2d ___ (BPAI March 1, 2010) (precedential) <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&flNm=fd2009006013-02-26-2010-1>.
- g) Under 37 CFR § 41.37(c)(1)(vii): appeal brief must include “the contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on.”
- h) Specifically, the Board reviews the particular finding(s) contested by Appellant anew in light of all the evidence and argument on that issue.
- i) Filing a Board appeal does not, unto itself, entitle an Appellant to de novo review of all aspects of a rejection.
- j) The Board will not, as a general matter, unilaterally review uncontested issues and aspects of the rejection. *See, e.g., Hyatt v. Dudas*, 551 F.3d 1307, 1313-14 (Fed. Cir. 2008) (the Board may treat arguments Appellant failed to make for a given ground of rejection as waived).
- k) Thus, the Board will generally not reach the merits of any issues not contested by an Appellant. *Cf. In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant . . .”).

2. Duties of Administrative Patent Judge 1

a) Judge #1

(1) Researches the record

(a) Performs legal research to identify law relevant to the potential issues

(b) Performs technical review of the record to identify evidence which may be relevant to the potential issues

(2) Conferences the case with the Judge(s) on the panel, and in conference presents the potential issues, relevant law and evidence.

(a) For an appeal with an oral hearing, its conference is necessarily split-in-two to first cover items needed to prepare for the hearing and then to cover items that cannot occur until after the hearing

b) Recommendations by Judge #1

(1) During the Panel conference, Judge #1 makes

Recommendations which include:

(a) Issues which the panel should address including any discretionary new ground of rejection under 37 C.F.R. § 41.50(b);

(b) Findings of Fact believed to be relevant to each issue;

(c) Principles of Law believed to be relevant to each issue;

(d) Analysis believed to be appropriate for each issue; and

(e) Result believed to be appropriate for each issue.

- c) **Conference Result**
 - (1) At the conference, the Panel makes **determinations** concerning:
 - (a) **Issues** before the panel;
 - (b) **Findings of Fact** relevant to each issue;
 - (c) **Principles of Law** relevant to each issue;
 - (d) **Appropriate Analysis** for each issue; and
 - (e) **Appropriate Result** for each issue.
- d) **Decision Made in Conference**
 - (1) **How the panel should rule** on each issue:
 - (a) Whether or not the Examiner **reversibly erred** with respect to each rejection on appeal raised by Appellant; and
 - (b) Whether or not a **new ground** of rejection is appropriate;
 - (i) The Panel is required to unanimously agree on any proposed new ground of rejection.

D. Circulating Opinion (see SOP 3)

- 1. **Judge #1 Drafts a Proposed Opinion**
 - a) The Proposed Opinion documents the decision made during the conference
 - b) Proposed Opinion includes:
 - (1) Findings of Fact
 - (2) Principles of Law
 - (3) Analysis applying the Principles of Law to the Findings of Fact
 - (4) Conclusions of Law
- 2. **Duties of Judge #1 After Proposed Opinion is Drafted**
 - a) Upon completion of the Proposed Opinion, Judge #1 finally **confirms**:
 - (1) The correct issues are before the panel

- (2) There are no gaps or errors in the Findings of Fact, Principles of Law, and Analysis for each issue
- (3) The correct decision has been made as to whether the Examiner erred in rejecting the claim(s)
- (4) The appropriateness of any new ground of rejection being made

b) Judge #1 then:

- (1) Approves the Proposed Opinion as Judge #1
- (2) Notifies the other Judge(s) assigned to the panel that the Proposed Opinion is ready for their review and approval

3. Duties of the other Judges

a) Upon receiving notice that the Proposed Opinion is ready for review, the other APJs read the Proposed Opinion and confirm:

- (1) The correct issues are before the panel
- (2) There are no gaps or errors in the Findings of Fact, Principles of Law, and Analysis for each issue
- (3) The correct decision has been made as to whether the Examiner erred in rejecting the claim(s)
- (4) The appropriateness of any new ground of rejection being made

b) The other APJs then:

- (1) Approve the Proposed Opinion, or write a concurring or dissenting opinion
- (2) Notify APJ 1 that the Proposed Opinion has been reviewed and is approved for mailing.

4. Patent Attorney Duties

a) Patent Attorney duties include:

- (1) Reviewing the record
- (2) Researching case law
- (3) Presenting recommendations to the Panel

- b) The Panel of Judges makes all substantive decisions and determinations in view of recommendations
- c) The Patent Attorney then drafts a proposed decision for the Judges
- d) All other functions are carried out by the Judges

E. Signed decision (see SOP 2)

V. Conclusion

1. Visit Our Web Site for statistics, argument dates, opinions, the interference web portal, standard operating procedures, rules and other information: www.uspto.gov/web/offices/dcom/bpai/index.html
2. Questions?