



**UNITED STATES PATENT AND TRADEMARK OFFICE**

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November 19, 2021

**VIA E-MAIL**

Mr. Randy Landreneau  
U.S. Inventor  
17440 Dallas Parkway  
Dallas, TX 75287  
*rlinventor@protonmail.com*

RE: ***Freedom of Information Act (FOIA) Request No. F-21-00186***

Dear Mr. Landreneau:

The United States Patent and Trademark Office (USPTO) FOIA Office has received your e-mail dated Tuesday, August 03, 2021 requesting a copy of the following documents pursuant to the provisions of the Freedom of Information Act, 5 U.S.C. § 552:

1. Request copies of all communications, documents, orders, or letters delegating to Mr. Andrew Hirshfeld the performance of the functions and duties of the Director effective after January 20, 2021, including the identification of the PTO officer who made the delegation, and any documents evidencing Mr. Hirshfeld's acceptance of that delegated authority.
2. Please provide copies of the notifications that the PTO provided under 5 U.S.C. §3349(a)(1) to the Comptroller General of the United States and to each House of Congress of the vacancy that occurred in January, 2021, in the office(s) whose functions and duties were delegated to Mr. Andrew Hirshfeld.
3. Please provide copies of all communications, documents, orders, or letters delegating to the Administrative Patent Judges (APJs) listed in Attachment 1 the Director's authority under 35 U.S.C. §§ 314, 324 to institute the respective trial proceedings identified in Attachment 1, and any documents evidencing each of these APJ's acceptance of that delegated authority. The records under this request also include but are not limited to records of delegation and sub-delegation of other persons in the chain of delegation from the Director to the APJs, including any documents evidencing each of these persons' acceptances of such delegated of other persons in the chain of designation to the APJs, including any documents evidencing each of these persons' acceptances of such delegated authority.
4. Please provide copies of all communications, documents, orders, or letters designating under 35 U.S.C. 6(c) the Administrative Patent Judges (APJs) listed in Attachment 1 to

perform the duty of adjudication on the merits in the respective proceedings identified in Attachment 1, and any documents evidencing each of these APJ's acceptance of that duty. The records under this request also include but are not limited to records of delegation and sub-delegation of other persons in the chain of designation to the APJs, including any documents evidencing each of these persons' acceptances of such delegated authority.

The USPTO has identified documents that are responsive to your request and they are attached. For item (1) of your request, the delegation to Mr. Andrew Hirshfeld to perform the functions and duties of the Director is set forth in USPTO's Agency Organizational Order (AOO) 45-1, and is included in the responsive documents. There are no responsive documents for item (2) of your request because the statutory requirements of 5 U.S.C. § 3349 do not apply to the USPTO. For items (3) and (4) of your request, the Agency has identified standard operating procedures that it believes are responsive to your request, and they are enclosed. In addition, we refer you to 37 C.F.R. § 42.4.

You may contact the FOIA Public Liaison at 571-272-9585 for any further assistance and to discuss any aspect of your request. Additionally, you may contact the Office of Government Information Services (OGIS) at the National Archives and Records Administration to inquire about the FOIA mediation services they offer. The contact information for OGIS is as follows: Office of Government Information Services, National Archives and Records Administration, 8601 Adelphi Road-OGIS, College Park, Maryland 20740-6001, e-mail at [ogis@nara.gov](mailto:ogis@nara.gov); telephone at 202-741-5770; toll free at 1-877-684-6448; or facsimile at 202-741-5769.

You have the right to appeal this initial decision to the Deputy General Counsel, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. An appeal must be received within 90 calendar days from the date of this letter. See 37 C.F.R. § 102.10(a). The appeal must be in writing. You must include a copy of your original request, this letter, and a statement of the reasons why the information should be made available and why this initial denial is in error. Both the letter and the envelope must be clearly marked "Freedom of Information Appeal."

Sincerely,

**Dorothy G. Campbell**

Dorothy G. Campbell  
USPTO FOIA Officer  
Office of General Law



# United States Patent and Trademark Office

*Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office*

MEMORANDUM FOR Wynn Coggins, Deputy Assistant Secretary for Administration,  
Department of Commerce, and Member, Agency Transition  
Directors Council, Department of Commerce

FROM Andrei Iancu, Under Secretary of Commerce for Intellectual  
Property and Director of the U.S. Patent and Trademark Office

DATE August 14, 2020

SUBJECT Succession Plan for Senior Non-Career Appointees

The USPTO has identified the following senior non-career positions, which require career replacement in the event of a presidential transition, and has designated the follow senior career employees to serve in those positions:<sup>1</sup>

Position	Career Official
<b>Director</b> <i>(Andrei Iancu)</i>	Andrew H. Hirshfeld
<b>Deputy Director</b> <i>(Laura Peter)</i>	Coke Morgan Stewart
<b>Chief of Staff</b> <i>(Chris Shipp)</i>	Cordelia Zecher
<b>Office of Governmental Affairs</b> <i>(Branden Ritchie)</i>	Kimberly N. Alton
<b>Chief Communications Officer</b> <i>(Timothy Clark)</i>	Paul S. Rosenthal

<sup>1</sup> Pursuant to the Presidential Transition Enhancements Act of 2019, “[n]ot later than September 15 of a year during which a Presidential election occurs, and in accordance with subchapter III of chapter 33 of title 5, United States Code, the head of each agency shall ensure that a succession plan is in place for each senior non-career position in the agency.” Presidential Transition Enhancements Act of 2019 (Pub. L. 116-121). *See also* Office of Management and Budget Memorandum M-20-24, at pg. 2 ¶ 3 (April 27, 2020, “Implementing the Presidential Transition Act”).

Under 35 U.S.C. § 3, the Deputy Director of the United States Patent and Trademark Office may “act in the capacity of the Director in the event of the absence or incapacity of the Director.” Under the USPTO’s Agency Organization Order (AOO) 45-1 at 2-3 (Nov. 7, 2016), “[i]f both the Under Secretary and Deputy Under Secretary positions are vacant, the Commissioner for Patents and the Commission for Trademarks, in that order, will perform the non-exclusive functions and duties of the Under Secretary.” “In the event there is no Commissioner appointed under 35 U.S.C. § 3(b)(2), the Chief Policy Officer and Director for International Affairs, the Chief Financial Officer, the Chief Administrative Officer, or the General Counsel of the USPTO, in order of length of service in those positions, shall perform the non-exclusive functions and duties of the Under Secretary.” *Id.* Presently, there are two Commissioners appointed under 35 U.S.C. § 3(b)(2), and the current Commissioner for Patents is Andrew H. Hirshfeld.

Neither 35 U.S.C. § 3, nor the USPTO AOO, address replacements for other senior non-career positions. 35 U.S.C. § 3 does require that the USPTO Director and the Deputy Director have “a professional background and experience in patent or trademark law.” Under 35 U.S.C. § 6(a), 15 U.S.C. § 1067(b), and the USPTO AOO, the USPTO Director and Deputy Director serve as members of the Patent and Trademark Trial and Appeal Boards. USPTO AOO 45-1 at 4.

Ms. Stewart, Senior Counsel to the Director, is the most senior career official in the Office of the Under Secretary and Director (OUS) with a professional background and experience in patent or trademark law. Ms. Stewart has served in several senior roles, including as Acting Chief of Staff of the USPTO under two Directors.

Ms. Zecher is a Supervisory Patent Examiner and has served for several years as a Senior Advisor to the Deputy Commissioner for Patents. Most recently, Ms. Zecher has served as a Special Advisor to the Director in the OUS, advising on patent policy, patent operations, and various OUS initiatives.

Ms. Alton is the Deputy Director of the Office of Government Affairs and Oversight and has served in that position since 2016.

Mr. Rosenthal is currently the most senior career official in the Office of the Chief Communications Officer (OCCO) and has served as Acting Chief Communications Officer in past transitions. However, the USPTO is in the process of hiring a more senior career SES employee in the OCCO. Once this individual is hired, he/she will be the most senior career official in the OCCO and would serve as the Acting CCO in the event of a transition.

Depending on the order and timing of the departures of the senior non-career officials, the availability of the designated career officials, and the needs of the Office, the Director may adjust the above designations.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**AGENCY ORGANIZATION ORDER 45-1**

**Agency Organization Order Series**

**Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office**

**Date of Issuance: 11/07/2016**

**Effective Date: 11/07/2016**

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**UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**I. PURPOSE**

This Agency Organization Order (AOO) sets forth the authority and functions of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (Under Secretary), and provides for the organizational structure of the United States Patent and Trademark Office (USPTO).

**II. APPOINTMENT AND GENERAL AUTHORITY OF UNDER SECRETARY AND COMMISSIONERS**

- A. On November 29, 1999, the President signed into law the Patent and Trademark Office Efficiency Act (PTOEA), which establishes the USPTO as an agency of the United States, within the Department of Commerce (DOC).

**Under Secretary and Deputy Under Secretary**

- B. The Under Secretary is appointed by the President, by and with the advice and consent of the Senate, and reports to the Secretary of Commerce (Secretary) with respect to policy matters. The Under Secretary, as established by 35 U.S.C. § 3, is responsible for providing policy direction and management supervision for the USPTO and the issuance of patents and registration of trademarks, and for consulting with the Patent Public Advisory Committee and the Trademark Public Advisory Committee.
- C. The Under Secretary will be assisted by the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office (Deputy Under Secretary) who will act in the capacity of the Under Secretary in the event of the absence or incapacity of the Under Secretary. The Deputy Under Secretary is appointed by the Secretary upon consideration of individuals nominated by the Under Secretary.
- D. The Deputy Under Secretary shall serve as Acting Under Secretary during any period in which the Under Secretary has died, resigned, or otherwise become unable to perform the functions and duties of the office, subject to the limitations set forth in the Federal Vacancies Reform Act of 1998, as amended, 5 U.S.C. § 3345 et seq. The Deputy Under Secretary shall perform the non-exclusive functions and duties of the Under Secretary when the Under Secretary dies, resigns, or is otherwise unable to perform the functions and duties of the Under Secretary, and when there is no Acting Under Secretary. If both the Under Secretary and the Deputy Under Secretary positions are vacant, the Commissioner for Patents and the Commissioner for Trademarks, in that order, will perform the non-exclusive functions and duties of the Under Secretary. In the event there is no Commissioner appointed under 35 U.S.C. § 3(b)(2), the Chief Policy Officer and

Director for International Affairs, the Chief Financial Officer, the Chief Administrative Officer, or the General Counsel of the USPTO, in order of length of service in those positions, shall perform the non-exclusive functions and duties of the Under Secretary.

- E. In the event of the absence or incapacity of the Under Secretary and Deputy Under Secretary, the following officials may be designated by the Under Secretary or Deputy Under Secretary, as appropriate, to perform the non-exclusive functions and duties of the Under Secretary: the Commissioner for Patents, the Commissioner for Trademarks, the Chief Policy Officer and Director for International Affairs, the Chief Financial Officer, the Chief Administrative Officer, or the General Counsel for USPTO.
- F. A Commissioner performing the functions and duties of the Under Secretary will not assist the Secretary in evaluating the performance of the Commissioners.

### Commissioners

- G. The Secretary will appoint a Commissioner for Patents and a Commissioner for Trademarks, each of whom will serve for a five-year term. The Secretary may reappoint a Commissioner to subsequent five-year terms in accordance with PTOEA.
- H. The Under Secretary will appoint such other officers, employees and agents of the Office as deemed necessary to carry out the functions of USPTO, consistent with Title 35, U.S.C.
- I. In accordance with PTOEA and Title 35, U.S.C., in carrying out its functions, USPTO will be subject to the policy direction of the Secretary, but otherwise will retain responsibility for decisions regarding the management and administration of its operations and will exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions, in accordance with applicable provisions of the law.

### Public Advisory Committees

- J. USPTO will have a Patent Public Advisory Committee and a Trademark Public Advisory Committee. The Secretary will appoint nine members to each committee who will serve at the pleasure of the Secretary. The Secretary will designate a chair of each Advisory Committee, each of whom will serve for a three-year term. In addition to the voting members, each Advisory Committee will include a representative of each labor organization recognized by USPTO.
- K. The Under Secretary will consult with the Patent Public Advisory Committee on a regular basis on matters relating to the patent operations of USPTO, will consult with the Trademark Public Advisory Committee on a regular basis on matters relating to the trademark operations of USPTO, and will consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget (OMB) or changing or proposing to change patent or trademark user fees or

patent or trademark regulations that are subject to the requirement to provide notice and opportunity for public comment under Title 5, U.S.C. § 553, as the case may be.

### **Administrative Patent Judges and Administrative Trademark Judges**

- L. The Patent Trial and Appeal Board shall include the Under Secretary, the Deputy Under Secretary, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.
- M. The Trademark Trial and Appeal Board shall include the Under Secretary, the Deputy Under Secretary, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative trademark judges.
- N. Administrative patent judges and administrative trademark judges are appointed by the Secretary, in consultation with the Under Secretary.

### **III. SPECIFIC AUTHORITIES**

- A. Pursuant to the authority vested in the Secretary and the Under Secretary by law, and in recognition of USPTO's responsibility for decisions regarding management and administration of its operations and its independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with the PTOEA and applicable provisions of law, the Under Secretary will exercise the responsibilities relating to USPTO operations and functions including:
  1. The functions prescribed by 17 U.S.C. § 914 regarding the privilege of foreign national, domiciliaries, and sovereign authorities to make interim registrations for mask works pursuant to Chapter 9 of Title 17 and by Executive Order (E.O.) 12504 regarding regulations for the presentation to the President of requests for issuance of proclamations described in such Chapter;
  2. The functions, other than the appointment of Commissioners, prescribed for the Secretary by 35 U.S.C. § 3(b)(2), including recommendation of Commissioners for the Secretary to appoint, formulation of the annual performance plans for the Commissioners, supervision of the Commissioners, and evaluation of the Commissioners with prompt notice to the Secretary of the evaluations;
  3. The functions, other than appointment of members and designation of chairs, prescribed for the Secretary by 35 U.S.C. § 5, including recommendation of public advisory committee members for the Secretary to appoint, recommendation of public advisory committee chairs for the Secretary to designate, and provision of such support to the public advisory committees as required by statute or otherwise as the Under Secretary deems appropriate;



4. The functions prescribed for the Secretary by Chapter 17 of Title 35, U.S.C., except for the appellate function under 35 U.S.C. § 181 (see DOO 10-6, "Office of the General Counsel," § 4.01i);
5. Except as otherwise specified herein, the Under Secretary will exercise the following administrative and management responsibilities:
  - a. Performing the responsibilities of agency head pertaining to USPTO, including the following examples:
    - i. 31 U.S.C. § 3325(a) regarding the certification of vouchers for disbursement of government funds;
    - ii. Any procurement-related authority;
    - iii. Title 5, U.S.C. (Government Organization and Employees);
    - iv. Title 40, U.S.C. (Public Buildings, Property, and Works);
    - v. Title 41, U.S.C. (Public Contracts); and
    - vi. Title 44, U.S.C. (Public Printing and Documents);
  - b. Carrying out responsibilities under Title VII of the Civil Rights Act of 1964, the Equal Employment Opportunity Act of 1972 and all applicable statutes, E.O.s, and regulatory provisions;
  - c. Carrying out responsibilities under:
    - i. The Federal Advisory Committee Act (5 U.S.C. Appendix 2);
    - ii. The Privacy Act (5 U.S.C. § 552a) and implementing directives of the General Services Administration and OMB;
    - iii. The Budget and Accounting Procedures Act of 1950 (P.L. 81-784), subject to III.A.6, below;
    - iv. The Chief Financial Officers Act of 1990 (P.L. 101-576);
    - v. The Government Management Reform Act of 1994 (P.L. 103-356);
    - vi. The Government Performance and Results Act of 1993 (P.L. 103-62);
    - vii. The Federal Records Act (P.L. 81-754);

- viii. The Government Paperwork Elimination Act (P.L. 105-277, Title XVII);
  - ix. The Paperwork Reduction Act of 1995 (P.L. 104-13);
  - x. OMB Circular A-130, "Management of Federal Information Resources;" and Sections 5 and 6 of the Computer Security Act of 1987 (P.L. 100-235) regarding Federal computer systems security training, identification of systems containing sensitive information, and a plan for computer system security and privacy;
  - xi. The Freedom of Information Act (5 U.S.C. § 552);
  - xii. 30 U.S.C. §§ 351-359 and 40 U.S.C. §§ 1314, regarding granting easements and other rights of access to real property, or consenting to the lease of mineral rights;
  - xiii. The Competition in Contracting Act (P.L. 98-369, Title VII);
  - xiv. E.O. 12088 regarding compliance with pollution control standards at USPTO facilities;
  - xv. The Inspector General Act of 1978 (5 U.S.C. Appendix 3);
- d. Exercising responsibilities regarding finance, accounting, fiscal management, budgeting, and planning, subject to section III.A.6, below;
  - e. Procuring real or personal property or goods and services of any kind by USPTO under any Federal law, regulation, directive or order;
  - f. Performing the responsibilities for managing any real property USPTO may acquire, lease, purchase, or acquire responsibility in, including environmental compliance reports;
  - g. Developing and issuing agency administrative orders, policies, standards and procedures for administrative functions in USPTO;
  - h. Providing publications and printing (e.g. micropublishing, design, graphics, editorial, promotional, distribution, and publishing control), library, mail, messenger, and distribution services for USPTO;
  - i. Managing USPTO computer services and electronic mail systems and coordinating with DOC to ensure interoperability;

- j. Monitoring, overseeing, reviewing, managing, maintaining, procuring, or evaluating of USPTO Information Technology (IT) programs, performance, risks, acquisitions, initiatives, resources, personnel, training, or management;
- k. Setting goals for improving the efficiency or effectiveness of USPTO IT operations;
- l. Approving strategic and operational information technology plans and developing information technology policies and procedures, including security;
- m. Managing and maintaining USPTO IT systems for administrative and program management including property and procurement management systems;
- n. Protecting USPTO's assets, operations and personnel;
- o. Managing USPTO's programs for safeguarding national security information (E.O. 12958), personnel security (E.O.s 10450 and 12968), national industrial security (E.O.s 10865 and 12829), physical facility security, and other programs for protecting USPTO's assets, operations, and personnel;
- p. Carrying out responsibilities regarding special studies, reports, technical information, and other related functions under 15 U.S.C. §§ 1525-1527 (P.L. 91-412);
- q. Ensuring USPTO compliance with:
  - i. The provisions of the Federal Managers Financial Integrity Act of 1982 (P.L. 97-255) and acting as the designated senior official for the implementation of OMB Circular A-123, "Management's Responsibility for Enterprise Risk Management and Internal Control," and OMB Circular A-127, "Financial Management Systems;"
  - ii. The Drug-Free Workplace Act (P.L. 111-350, Chapter 81) and the procurement integrity provisions of the Office of Federal Procurement Policy Act Amendments of 1988 (P.L. 100-679);
- r. Establishing policies and procedures for the development and operation of financial management, financial information, and internal control systems;
- s. Providing direction, formulation, analysis, coordination, and

- implementation of USPTO's financial management policies and procedures;
- t. Developing and issuing policies, standards, measures, and procedures for the issuance of patents and the registration of trademarks, and provide functional appraisal and supervision in the conduct of its functions;
  - u. Developing and administering the personnel management policies and programs of USPTO, including the direction, administration, and processing of all matters involving personnel, payroll, and occupational safety and health;
  - v. Executing all functions relating to all elements of all USPTO officers' and employees' annual performance plans, rewards and promotions, except for the plans, bonuses, and agreements of the Under Secretary, the Deputy Under Secretary, the Commissioner for Patents, and the Commissioner for Trademarks;
  - w. Developing, implementing, and improving management structures, systems, tools, and practices to achieve the highest degree of management efficiency, operational effectiveness, and economy, and to limit the opportunity for fraud and mismanagement;
  - x. Coordinating preparation of national emergency plans and the development of preparedness programs required by E.O. 12656 and Federal Preparedness Circular No. 10; and serving as the USPTO's Emergency Coordinator, as required by E.O. 12656;
6. The Under Secretary shall have the authority to provide appropriate communication and coordination, when appropriate, with all other agencies and offices of the Federal Government directly on applicable USPTO matters, including as examples, OMB, subject to the provisions in section III.D of this AOO and the proviso in this paragraph, the Department of the Treasury, the Office of Personnel Management, the Government Accountability Office, the General Services Administration, and other Executive Branch or independent agencies; the House Government Operations Committee, the Budget Committees, Appropriations Committees, and Judiciary Committees of the Congress, the Joint Committee on Printing, the Government Printing Office, and other Legislative Branch committees, offices, and agencies. The Under Secretary shall transmit the USPTO budget directly to OMB, provided, however, that the Under Secretary shall first timely provide the Secretary in advance with the proposed USPTO budget in order to receive the Secretary's policy review and direction before USPTO transmits the budget to OMB; and
7. Such functions under other authorities as are applicable to administration and

management of the USPTO.

- B. Exercise of the authorities described in paragraph A of this section shall be subject to the policy direction, and such functions, powers, duties and responsibilities as are retained by the Secretary, as are set forth in paragraph D, below.
- C. The Under Secretary may, except as precluded by law or regulation, redelegate the authorities in this section to officers and employees of USPTO, subject to such conditions in the exercise of the delegated authorities as the Secretary or Under Secretary may prescribe.
- D. Functions, powers, duties, and responsibilities retained by the Secretary, as policy direction or incidental thereto, include:
1. Policy direction as provided in 35 USC § 1;
  2. The power to accept gifts and bequests on behalf of the USPTO valued at greater than \$35,000;
  3. USPTO shall remain subject to the oversight responsibilities of the Inspector General;
  4. Legal services related to the following:
    - a. Legislation and matters related thereto, as provided in Departmental Organizational Order 10-6;
    - b. Review of regulations subject to the following procedures:
      - i. USPTO shall notify the DOC Office of the General Counsel of all planned rulemaking activity in a timely manner,
      - ii. The DOC Office of the General Counsel may review any rulemaking that it, the USPTO, or OMB determines to be significant or to implicate policy matters, and
      - iii. The USPTO may otherwise promulgate rules relating to agency management or personnel, agency organization, agency procedures or practices, or public property, benefits, or contracts without further review;
    - c. Authorities of the Secretary provided in Chapter 40 of title 15, U.S.C., except with regard to:
      - i. The use of undesignated general gift funds;

- ii. The conduct of studies, reports, technical information, and other related functions under 15 U.S.C. § 1525 (first paragraph) et seq.; and
  - iii. Review of joint projects under the 15 U.S.C. § 1525 (second paragraph) et seq.;
- d. Appellate liaison with the Civil Appellate Section of the United States Department of Justice regarding all appeals of court litigation including litigation for which USPTO otherwise is responsible;
  - e. All functions of the DOC's Designated Agency Ethics Official (DAEO) and agency-head review of all ethics-related collective bargaining agreements or portions thereof, and any ensuing litigation due to the agency-head review, except as USPTO is authorized by statute or other authority to have its own DAEO;
  - f. DOC-wide and other litigation which may affect USPTO as an operating unit of DOC as well as other operating units of DOC;
  - g. Gifts, other than the use of undesignated gift funds;
  - h. Review of Department Organization Orders and Department Administrative Orders;
  - i. Restrictions on expenditures intended or designed to influence Congress on legislation;
  - j. Qui tam actions;
  - k. Advice on grand jury and Congressional investigations.

E. Payment for Services

1. USPTO shall make reimbursements for services provided by DOC into the Working Capital Fund, the Advances and Reimbursements Fund, or other Departmental funds as may be necessary to support the Secretary's policy direction of USPTO and other functions, powers, duties, and responsibilities retained by the Secretary.
2. Except as provided in section III.E.1, USPTO shall receive services from DOC on the basis of mutual agreements entered into under authority of 35 U.S.C. § 2(b)(5), and shall reimburse DOC for services received according to the terms of such agreements.

3. USPTO may enter into agreements under authority of 35 U.S.C. § 2(b)(5) to use services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis.

#### **IV. FUNCTIONS**

The Under Secretary performs the following functions:

- Administers the laws relating to the granting and issuing of patents;
- Administers the laws relating to the registration of trademarks;
- Administers the laws relating to the dissemination to the public of information with respect to patents and trademarks;
- Advises the Secretary on intellectual property policy. Subject to the policy direction of the Secretary, also advises Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries. Advises the President, through the Secretary, on national and certain international intellectual property policy issues.
- Conducts programs, studies, and exchanges of items and services regarding intellectual property;
- Conducts cooperative programs with nongovernmental organizations, foreign intellectual property offices and international intergovernmental organizations;
- Serves as focal point within DOC and is prepared, when requested by appropriate authority and subject to the policy direction of the Secretary, to serve as spokesperson for the Executive Branch on the broad range of domestic and international intellectual property issues confronting the Nation; and
- Performs other functions required or deemed necessary and proper by the Under Secretary in exercising the authority described herein.

#### **V. EFFECT ON OTHER ORDERS**

This AOO supersedes A●O 45-1, dated June 24, 2002, and replaces its content in its entirety.

*Michelle K. Lee*

MICHELLE K. LEE

Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

*11/7/2016*

Date

# PATENT TRIAL AND APPEAL BOARD

## STANDARD OPERATING PROCEDURE 1 (REVISION 15)

### ASSIGNMENT OF JUDGES TO PANELS

This Standard Operating Procedure (“SOP”) describes the process by which judges are assigned to panels in all jurisdictions of the Patent Trial and Appeal Board (“PTAB” or “Board”). These jurisdictions are *ex parte* appeals of patent applications (“*ex parte* appeals”), reexamination appeals, reissue appeals, interferences, and AIA<sup>1</sup> proceedings<sup>2</sup> (collectively “cases”). Assigning panels of at least three administrative patent judges (“APJs” or “judges”) to thousands of cases each year, across multiple jurisdictions, is performed by Board administrative personnel pursuant to the following guidance. The guidance is intended to implement efficient use of the expertise and experience of the APJs, while appropriately balancing APJ workloads and needs of the Board and stakeholders in relation to all jurisdictions of the Board.

This SOP sets forth internal norms for the administration of PTAB. It does not create any legally-enforceable rights. The actions described in this SOP are part of the USPTO’s deliberative process.

#### I. Non-exclusive Delegation of the Director’s Authority to the Chief Judge

“Each appeal, derivation proceeding, post-grant review, and *inter partes* review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director.” 35 U.S.C. § 6. The Director’s authority under 35 U.S.C. § 6(c) to designate panels has been delegated to the Chief Judge. The Chief Judge may further delegate the authority delegated by the Director as explained in further detail in the next section.

The delegated authority is non-exclusive and the Director expressly retains his or her own statutory authority to designate panels. This SOP does not limit the authority of the Director to designate, de-designate, or otherwise alter in any way

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<sup>1</sup> Leahy-Smith America Invents Act, Pub. Law 112–29, 125 Stat. 284 (Sept. 16, 2011) (“AIA”)

<sup>2</sup> AIA proceedings include *inter partes* reviews under 35 U.S.C. § 311; post-grant reviews under 35 U.S.C. § 321; covered business method patent reviews under Leahy-Smith America Invents Act § 18, Pub. Law 112–29, 125 Stat. 284, 329 (Sept. 16, 2011); and derivation proceedings under 35 U.S.C. § 135.



at any time, panels in his or her sole discretion without regard to the procedures set forth herein. *See* 35 U.S.C. § 6(c).

## II. Further Delegation of the Director's Authority by the Chief Judge

- A. At the direction of the Chief Judge, at least one administrative employee (hereinafter "designee") may be delegated the task of assigning merits panels (designations under 35 U.S.C. § 6(c)) for any jurisdictions of the Board, including *ex parte* appeals, reexamination appeals, reissue appeals, interferences, and AIA proceedings at such times as the Chief Judge deems appropriate, and in accordance with the further delegated authority of the Director.
- B. Employees selected to serve as designees will be notified of their selection by the Chief Judge.
- C. The delegation to a designee of the task of assigning merits panels is effective until such time as changed at the direction of the Chief Judge or as otherwise indicated by the Director.
- D. Designee(s) will become familiar with the guidance of this SOP.
- E. Designee(s) will follow the assignment guidelines provided below. Designee(s) are expected to use best efforts to balance the considerations set forth in the guidelines, such that cases are paneled with judges having appropriate jurisdictional designations, technology disciplines, work-load preferences, and docket compositions. The guidelines also strive for a balance of experience levels on panels, while also taking into account the needs of the Board.
- F. All actions taken pursuant to authority further delegated in accordance with this section are subject to review by the Chief Judge and ultimate review by the Director.

III. Guidelines for Paneling *ex parte* appeals, reexamination appeals, reissue appeals, and AIA proceedings

A. Designee(s) assign the three judges on a panel as APJ1, APJ2, and APJ3. To facilitate the equal balancing of workloads among judges, it is expected that, so long as APJ1 is in the majority, APJ1 will do a significant portion of the writing, including any significant writing assignments, and case management for a case, in consultation with APJ2 and APJ3.

Notwithstanding these provisions, any of the three APJs assigned to a case may draft written work product in the case, and in all circumstances all three APJs provide input on significant writing assignments except in rare circumstances where fewer than all three APJs are available and there is no statutory requirement for a three APJ panel.

1. Significant writing assignments in *ex parte* appeals and reissue appeals include appeals decisions pursuant to 35 U.S.C. § 134(a).
2. Significant writing assignments in reexamination appeals include *ex parte* reexamination appeals decisions pursuant to 35 U.S.C. § 134(b) and *inter partes* reexamination appeals decisions pursuant to pre-AIA 35 U.S.C. § 134(b) and/or (c).
3. Significant writing assignments in AIA proceedings include decisions on institution (DIs) pursuant to 35 U.S.C. §§ 314 and 324 and final written decisions (FWDs) pursuant to 35 U.S.C. §§ 318 and 328.
4. Significant writing assignments for all Board cases also may include decisions on requests for rehearing or decisions on remand from the United States Court of Appeals for the Federal Circuit or a United States District Court.
5. In addition, the Chief Judge may designate other written work product, produced pursuant to the Board's statutory authority, as significant writing assignments, as appropriate for purposes of docket management. *See, e.g.*, 35 U.S.C. § 135 (derivations); pre-AIA 35 U.S.C. § 135 (interferences).

B. **Avoidance of conflicts of interest:** Each judge must provide a list of conflicts to the designee(s).

1. Guidance on situations giving rise to a conflict are set forth in the Summary of Ethics Rules promulgated by the United States Department of Commerce for the United States Patent and Trademark Office, available at <https://ogc.commerce.gov/page/ethics-rules> (“USPTO Ethics Rules”).
2. Designee(s) must not panel a judge on any case having a conflict.
3. Each judge must update his or her conflicts, as defined in Section III.B.1, if the judge becomes aware of a conflict during the course of a proceeding or otherwise.
4. Each judge is responsible ultimately for avoiding a conflict, and informing the designee(s) that re-paneling may be needed upon becoming aware of a conflict in a particular case.

C. **Paneling by jurisdiction designation:** By default, all judges work on *ex parte* appeals. As described further below, some judges are assigned to be paneled only on *ex parte* appeals, while other judges also are assigned to be paneled on cases in other jurisdictions of the Board (e.g., reexamination appeals and/or AIA proceedings).

1. Jurisdiction designations are made by PTAB leadership, taking into account, among other things, the expressed jurisdictional preference(s) of each judge, the overall docket composition of the Board, and the needs of the Board.
2. Designee(s) maintain current records of each judge’s designated jurisdiction(s).
3. Designee(s) should ensure that judges are paneled in accordance with their designated jurisdiction(s). For example, Designee(s) should ensure that a judge who is assigned to be paneled only on *ex parte* appeals is not paneled on cases in other jurisdictions absent contrary direction from PTAB leadership.

#### D. Periodic paneling:

1. For judges assigned to be paneled only on *ex parte* appeals, designee(s) will automatically assign *ex parte* appeals to a judge's docket on a regular, periodic basis, with the goal of maintaining a given judge's docket size at a target level. To request additional appeals, up to a designated maximum number of *ex parte* appeals, a judge should contact the designee(s) to request that additional *ex parte* appeals be added to his or her docket. The judge's supervisor must approve all requests in excess of the designated maximum number.
  - a. A judge who is assigned to be paneled only on *ex parte* appeals generally will be assigned one *ex parte* appeal as APJ2 and one *ex parte* appeal as APJ3 for each *ex parte* appeal assigned to the judge as APJ1.
2. A judge who is assigned to be paneled on cases in other jurisdictions of the Board (e.g., a judge assigned to handle reexamination appeals and/or AIA proceedings) is not automatically paneled on *ex parte* appeals.
  - a. To request *ex parte* appeals to be added to his or her docket, a judge who is assigned to be paneled on cases in other jurisdictions of the Board should contact the designee(s) to request a certain number of additional *ex parte* appeals, up to a designated maximum, and also notify the judge's supervisor. The judge's supervisor must approve all requests in excess of the designated maximum number.
  - b. A judge who is assigned to be paneled on cases in other jurisdictions of the Board generally will be assigned one *ex parte* appeal as APJ2 and one *ex parte* appeal as APJ3 for each *ex parte* appeal assigned to the judge as APJ1.

3. Designee(s) panel AIA proceedings on a regular, periodic basis (monthly). Each month, designee(s) identify and panel AIA proceedings after a Notice of Filing Date Accorded (“NFDA”) is mailed the previous month. These cases will have a projected decision on institution (“DI”) statutory due date six months from the NFDA. A final written decision (“FWD”) has a statutory due date 12 months from the date a DI is issued. In paneling AIA proceedings, designee(s) take into account these dates, as well as the dockets of the assigned judges and the needs of the Board, as set forth below.

E. **Paneling by technology:** Designee(s) should, when possible, match the technology discipline elections of a judge to the technology discipline at issue in each case.

1. Designee(s) should ensure a match between the technology discipline of the case and the technology discipline preferences of the paneled judges.
2. Each judge is characterized as having preferences in one or more of the following technology disciplines—biotechnology/pharma, business methods, chemical, electrical, mechanical, and design.
  - a. Each judge indicates a primary technology preference and, where appropriate, additional technology preferences.
3. Designee(s) panel cases according to technology discipline.
  - a. A technology cluster is a group of judges that are paneled together routinely to decide cases in a particular technology discipline. There are one or more technology clusters encompassing each of the technology disciplines listed in Section III.E.2 above. There also are clusters for reexamination appeals, design patents, reissue appeals, and interferences.
  - b. A case is first assigned to a “master docket” for the technology discipline corresponding to the subject matter of the claims at issue. Master dockets generally are determined based on the USPTO examination classification of the underlying case.

- c. Designee(s) assign each case to a panel of judges having the appropriate technology preferences, as practicable. A judge may be assigned to a case of a particular technology discipline if that judge has indicated a technology preference for that technology discipline, primary or otherwise. However, the designee(s) should attempt to fill a given judge's docket with cases from his or her primary technology preference.
- d. If Board needs dictate, however, a judge may be assigned to a case relating to any technology or cluster.
- e. Designee(s) will attempt to assign *ex parte* appeals with three judges in the same technology cluster.
- f. Designee(s) will assign *ex parte* appeals for design patent applications to panels of APJs in the design cluster, whenever feasible. If necessary, APJ3 may be a judge outside of the design cluster.
- g. Designee(s) will assign reexamination appeals for reexamination applications to panels of APJs in the reexamination cluster, whenever feasible.
- h. Reissue appeal paneling will occur as stated below, whenever feasible.
  - i. Designee(s) will assign reissue appeals involving rejections under 35 U.S.C. § 251 to panels of APJs in the reissue cluster.
  - ii. Designee(s) will assign reissue appeals not involving rejections under 35 U.S.C. § 251 to panels of APJs in the technology cluster corresponding to the technology discipline of the case.
  - iii. Designee(s) will assign a reissue appeal merged with a reexamination appeal to the panel assigned to the corresponding reexamination appeal.
- i. Designee(s) will assign interferences to panels of APJs in the interference cluster.

- j. Designee(s) will assign AIA proceedings involving design patents, derivation proceedings, covered business method patent reviews, post-grant reviews, interferences, and reexaminations, with judges that have been assigned to be paneled on those cases, whenever feasible.

**F. Paneling by experience:** Designee(s) will panel judges new to deciding *ex parte* appeals or AIA proceedings with more experienced judges. Designee(s) will not panel new judges on cases with other new judges or other less experienced judges absent contrary direction from PTAB leadership.

**G. Paneling related cases:**

1. Designee(s) should assign *ex parte* appeals for which there was a prior appeal to the same panel that heard the prior appeal, if possible.
  - a. Where a large number of applications are related, additional factors should be considered in paneling appeals for such applications to ensure decision consistency. For instance, a dedicated panel of three judges may be set up to handle such appeals. Such a panel should help ensure decision consistency across a large number of related applications.

2. For reexamination appeal proceedings, to facilitate efficiency and consistency of results, designee(s) should assign reexamination appeal proceedings challenging the same patent, or involving the same patent owner and involving related subject matter, to the same panel of judges, when possible. When a reexamination appeal proceeding is based on a patent that is/was also involved in an AIA proceeding, then designee(s) should assign the authoring judge of the DI and/or the FWD in the related AIA proceeding as APJ3 in the reexamination appeal, to ensure consistency in the proceedings. Alternatively, when an AIA proceeding is based on a patent that is/was also involved in a reexamination proceeding, then designee(s) should assign the authoring judge of significant writing assignments in the related reexamination appeal proceeding as APJ3 in the AIA proceeding, to ensure consistency in the proceedings. Such cases should be identified and paneled before paneling reexamination or AIA proceedings not challenging a previously challenged patent, or involving a patent owner and subject matter subject to a previous challenge.
  
3. For AIA proceedings, to facilitate efficiency and consistency of results, designee(s) should assign families of AIA proceedings challenging the same patent, or involving the same patent owner and involving related subject matter, to the fewest total judges as is practicable in view of statutory deadlines and judge workload and availability. Such cases should be identified and paneled before paneling cases not related by family.
  - a. It is preferred, as workloads permit, to panel as APJ1 a judge who is currently paneled as APJ1 on a pending case in the family or has written decisions on the merits in a previous case within the family. The next most preferred judge for APJ1 is a judge who has previously served as APJ2 or APJ3 on a case in the family.
  - b. APJ2 and APJ3 should be chosen such that cases in the family are paneled with the same three judges, if practicable. If it is not practicable to panel each case in a family with the same three judges, some overlap of judges on the panels is preferred to promote consistency.



- c. When paneling new cases in the family, designee(s) should, where appropriate, seek input from judges currently serving on existing cases in the family regarding the relative ability of those judges to take on more work.
- d. Generally, large families (e.g., four or more cases in a month) unrelated to previous cases by patent owner (in other words, a new family) should be paneled with at least two judges who, after consideration of the judges' other due dates in the intervening months, have availability to author two or more DIs by the projected due dates of the new cases. A judge paneled as APJ1 on a case also should be paneled as APJ2/3 on other cases in the family.
- e. A new case in which a request for joinder has been filed will include a challenge to the same patent that is the subject of an existing case to which joinder is requested. The new case presumptively should be assigned to the same panel as the existing case.
- f. A new case not involving a request for joinder but challenging a patent challenged in a previous case presumptively should be assigned to the same panel as the previous case.
- g. If a patent challenged in a new case has been challenged in multiple previous cases presided over by different panels, designee(s) should take into account judge workloads, which judge has most recently been paneled as APJ1 on a case challenging the patent, and whether the judges have written decisions on the merits as to the challenged patent when assigning a panel in the new case.
- h. Designee(s) should panel unrelated small families of cases and stand-alone cases to judges with availability remaining after paneling large families and cases related to existing cases by patent or patent owner.

## H. Order of handling cases:

1. Designee(s) will assign *ex parte* appeals to panels in order based on the appeal numbers assigned by PTAB when the appeals are received by PTAB. Judges are expected to decide *ex parte* appeals generally in the order the appeals are received by PTAB.
2. Designee(s) will panel pre-GATT cases, i.e., applications filed prior to June 8, 1995, immediately when received by PTAB. *Ex parte* appeals for pre-GATT applications are prioritized based on the age of the application, rather than the appeal number.
3. Designee(s) will prioritize assignment of *ex parte* appeals that have been made special, either through a granted petition to make special of the underlying application or any on-going expedited patent appeal pilot program. Designee(s) will panel such prioritized appeals as may occur at a regular interval to help ensure that such appeals are spread across an appropriate number of judges, such that an individual judge has the capacity to decide the prioritized appeals in an expedited manner.
4. Designee(s) will panel appeals in reexamination and reissue proceedings to ensure such cases are decided with special dispatch.
5. Designee(s) will panel AIA proceedings in a manner that strives to ensure that all statutory deadlines are met.

## I. Cases with hearings

1. Unless the needs of the PTAB require otherwise, designee(s) will panel *ex parte* appeals with hearings with three judges who are paneled on *ex parte* appeals only.
2. Office locations for AIA proceedings and *ex parte* appeals with hearings:
  - a. Designee(s) should panel a case with at least two judges serving in Alexandria or a regional office. The two judges need not serve in the same office.
3. Designee(s) may panel judges from different technology clusters to accommodate a heard *ex parte* appeal conducted outside of the Alexandria office.

## **J. Balancing workload:**

1. Unless an exception applies, designee(s) should assign a judge one case as APJ2 and one case as APJ3 for each case designee(s) assign the judge as APJ1.
2. Judges provide desired relative levels of AIA proceedings and *ex parte* appeal participation to the designee(s). Because significant writing assignments in AIA proceedings (DIs and FWDs) have statutory due dates, before assigning an AIA proceeding to a judge, designee(s) must check the existing assignments for that judge to ascertain whether that judge's workload is substantially above or below his or her target participation level in AIA proceedings. This check can, and should, be performed at multiple stages of the paneling process, as appropriate.
3. Designee(s) should take into consideration the number of significant AIA writing assignments a judge has due in the month of, or months surrounding, the expected due date of a DI in a new AIA proceeding to be assigned to the judge.
4. In cases where a judge presumptively is to receive an APJ1 assignment in an AIA proceeding (e.g., the judge has presided over a previous case challenging the same patent), and the additional case(s) would place the judge significantly over his or her target participation level, designee(s) should contact the judge and obtain feedback from the judge regarding his or her workload before making the assignment.
5. If, after all AIA cases are paneled for a month, a judge's workload is significantly below his or her target participation level in AIA proceedings, designee(s) should give that judge priority in paneling AIA proceedings the following month.

## **K. Release of cases**

1. After panels are preliminarily assigned to all relevant cases in a given time period, the paneled cases are released, i.e., designee(s) will enter the preliminarily paneled cases into the appropriate PTAB database.

2. Occasionally designee(s) will receive a request to release a case to a panel before a regular, periodic release, e.g., the trial support staff may ask for a panel to be created immediately when the parties in a case request authorization to file a motion before the case has been paneled, for example. Designee(s) may panel and release such a case before the remaining cases are released as part of the regular, periodic release. However, if the new case is paneled and released early, designee(s) must mark the case as having been released so that it does not cause confusion when the remainder of the paneled cases are released.

#### **L. Panel changes**

1. Reasons why a panel may change include:
  - a. **RECUSAL** – Judges shall recuse themselves upon becoming aware of an existing or later arising conflict, as defined in Section III.B.1 (referring to USPTO Ethics Rules).
  - b. **UNAVAILABILITY** – Judges may be unavailable for reasons that include: an approved agency leave request (for example, maternity leave, paternity leave, FMLA leave, sick leave, or annual leave); death or serious illness of the judge or a family member; detail assignment within or outside of the USPTO; reassignment; or the retirement or permanent departure of the judge from the agency.
  - c. **DEADLINES** – Judges may be reassigned to meet PTAB’s deadlines (when such deadlines cannot be met by reassigning cases not having a publicly assigned panel).
2. Generally, before a panel has appeared (e.g., in a decision or hearing), a panel may change as is determined by the designees for the foregoing reasons, or at the request of a judge.
3. For all proceedings in which the panel has appeared (e.g., in a decision or hearing), panel changes are disfavored.
  - a. To request removal from a panel the judge should contact the designee(s) and copy his or her supervisor.

- b. A supervisor's approval is NOT required when a judge requests to be removed from a panel due to a conflict as defined in Section III.B.1 (referring to USPTO Ethics Rules).<sup>3</sup> Designee(s) shall grant this request.
  - c. Generally, a supervisor's approval is required for all other requests.
- 4. For all proceedings in which the panel has appeared, panel changes made by the designee(s) that result in the substitution of one or more judges must be finally approved by the Chief Judge or the Deputy Chief Judge, unless the panel change occurs as a result of the process set forth in Standard Operating Procedure 2. The Chief Judge or Deputy Chief Judge will track instances of such repaneling and report to the Director on a periodic basis.
  - a. If finally approved, designee(s) will instruct a trial paralegal to enter an order ("Panel Change Order") of the Chief Judge or the Deputy Chief Judge into the record notifying the parties of the panel change. The Order will identify the new panel and provide the reason for the panel change from the reasons enumerated above (i.e., "recusal," "unavailability," or "deadlines"). Appendix 1 to this SOP provides the form of the Panel Change Order.
- 5. Notwithstanding the foregoing provisions of this section, panel members may reorder themselves as APJ1, APJ2, and APJ3 at the panel's discretion at any time during a proceeding, without obtaining a supervisor's approval. The panel will notify the designee(s) so that the case assignment records may be updated.

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<sup>3</sup> If the judge is not sure about whether the factual circumstances of his or her situation creates the appearance of a conflict, the judge should consult with a Department of Commerce ethics official at: [ethicsdivision@doc.gov](mailto:ethicsdivision@doc.gov). See USPTO Ethics Rules, 1–2 ("Whether particular situations create an appearance that the law or these standards have been violated shall be determined from the perspective of a reasonable person with knowledge of the relevant facts.")

**M. Expanded panels:** An expanded panel is a panel with more than three judges. An expanded panel is not favored and ordinarily will not be used. From time to time, however, it may be desirable to use an expanded panel.

1. An expanded panel may be used, where appropriate, to secure and maintain uniformity of the Board's decisions, e.g., in related cases ordinarily involving different three judge panels.<sup>4</sup>
2. A Board member, including a statutory Board member, may suggest the need for an expanded panel. Likewise, the Patent Business Unit, an applicant for a patent, or a patent owner or petitioner in a case pending before the Board may suggest the need for an expanded panel. If submitted by an applicant, patent owner or petitioner, such request must be included in a briefing paper specifically requesting such relief.
3. When a Board member (1) suggests an expanded panel or (2) receives a suggestion for an expanded panel either from the Patent Business Unit, an applicant for a patent, or a patent owner or petitioner in a case, the Board member sends an e-mail to PTABExpandedPanelRequest@uspto.gov. The written notification shall explain the reason for the suggestion.
4. A member of PTAB leadership designated by the Chief Judge (e.g., a Lead Administrative Patent Judge) monitors expanded panel request e-mails, presents outstanding requests to the Chief Judge on a periodic basis, and notifies panels as to whether the request is granted or denied.
5. Generally, an odd number of judges will be designated to decide cases in which an expanded panel is to be used.
6. All decisions to use an expanded panel must be recommended by the Chief Judge and approved by the Director.

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<sup>4</sup> Reasons such as establishing binding agency authority concerning major policy or procedural issues, or other issues of exceptional importance, are generally expected to be addressed using the procedures set forth in Standard Operating Procedure 2.

7. When an expanded panel is designated (1) after a case initially has been assigned to a panel and (2) before a decision is entered by the panel, the judges initially designated shall be designated, if available, as part of the expanded panel.
  - a. If an expanded panel is approved, Designee(s) will instruct a trial paralegal to enter an order (“Panel Change Order”) of the Chief Judge or the Deputy Chief Judge into the record notifying the parties of the panel change. The Order will identify the expanded panel. Appendix 2 to this SOP provides the form of the Panel Change Order for expanded panels.
8. When an expanded panel is designated (1) after entry of a decision by a panel and (2) to consider a request for rehearing of the decision of the panel, the judges on the initial panel shall, if available, be designated as part of the expanded panel. The expanded panel shall decide the rehearing on its merits.

**PATENT TRIAL AND APPEAL BOARD**  
**STANDARD OPERATING PROCEDURE 1**

**APPENDIX 1**

**Panel Change Order**



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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XXXXX,  
Petitioner

v.

YYYYY,  
Patent Owner.

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Case IPR201X-XXXXX  
Patent X,XXX,XXX

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Before **[INSERT NAME [DEPUTY] CHIEF]**, [*Deputy*] *Chief Administrative Patent Judge*.

PANEL CHANGE ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

IPR201X-XXXXX  
Patent X,XXX,XXX

The parties are notified that the panel has changed in the above referenced proceeding(s). *See* PTAB Standard Operating Procedure 1, Rev. 15. Due to **[insert: recusal, unavailability, or deadlines]**, Administrative Patent Judge AAAAAA replaces Administrative Patent Judge XXXXXX on the panel.

Thus, Administrative Patent Judges AAAAAA, YYYYYY, and ZZZZZZ now constitute the panel for consideration of all matters in this proceeding. *See* PTAB Standard Operating Procedure 1, Rev. 15. All prior decisions and orders remain in effect. The parties may contact the Board at [Trials@uspto.gov](mailto:Trials@uspto.gov) if they have questions.

It is

ORDERED.

IPR201X-XXXXX  
Patent X,XXX,XXX

For PETITIONER:

For PATENT OWNER:

**PATENT TRIAL AND APPEAL BOARD**  
**STANDARD OPERATING PROCEDURE 1**

APPENDIX 2

Panel Change Order

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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XXXXX,  
Petitioner

v.

YYYYY,  
Patent Owner.

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Case IPR201X-XXXXX  
Patent X,XXX,XXX

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Before **[INSERT NAME [DEPUTY] CHIEF]**, [*Deputy*] *Chief*  
*Administrative Patent Judge.*

PANEL CHANGE ORDER  
Conduct of the Proceedings  
*37 C.F.R. § 42.5*

IPR201X-XXXXX  
Patent X,XXX,XXX

The parties are notified that an expanded panel has been designated in the above referenced proceeding(s). *See* PTAB Standard Operating Procedure 1, Rev. 15. Administrative Patent Judges AAAAA and BBBB are added to the panel.

Thus, Administrative Patent Judges AAAAA, BBBB, XXXXX, YYYYY, and ZZZZZ now constitute the panel for consideration of all matters in this proceeding. *See* PTAB Standard Operating Procedure 1, Rev. 15. All prior decisions and orders remain in effect. The parties may contact the Board at [Trials@uspto.gov](mailto:Trials@uspto.gov) if they have questions.

It is

ORDERED.

IPR201X-XXXXX  
Patent X,XXX,XXX

For PETITIONER:

For PATENT OWNER:

## PATENT TRIAL AND APPEAL BOARD

### STANDARD OPERATING PROCEDURE 1 (REVISION 14)

#### ASSIGNMENT OF JUDGES TO MERITS PANELS, INTERLOCUTORY PANELS, AND EXPANDED PANELS

The following applies to the assignment of Administrative Patent Judges (judges) to merits panels,<sup>1</sup> interlocutory panels,<sup>2</sup> and expanded panels<sup>3</sup> in appeals, interferences, and AIA Reviews.<sup>4</sup>

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<sup>1</sup> Merits panels, consisting of no less than three judges, designated to decide appeals, enter decisions on requests for rehearing of appeals decisions, enter final judgments and final decisions on substantive and responsive motions in interferences, and enter final written decisions in a derivation proceeding, an *inter partes* review, a post-grant review, or a transitional covered business method review (collectively, AIA Reviews). Merits panels may also include panels consisting of less than three judges designated to enter declarations in interferences, decisions on institution in AIA Reviews, and requests for rehearing of decisions on institution in AIA Reviews.

<sup>2</sup> Judge or judges designated to enter interlocutory orders in interferences and AIA Reviews, including, e.g., decisions on requests for reconsideration of non-final decisions in interferences, decisions on requests for authorization to file motions in interferences and AIA Reviews, decisions on miscellaneous motions authorized and filed in interferences, and decisions on motions authorized and filed in AIA Reviews.

<sup>3</sup> Expanded panels consisting of the merits panel or interlocutory panel judge(s) and one or more additionally designated judges.

<sup>4</sup> The term AIA Review includes a derivation proceeding under 35 U.S.C. § 135; an *inter partes* review under Chapter 31 of title 35, United States Code; a post-grant review under Chapter 32 of title 35, United States Code; and a transitional covered business method patent review under section 18 of the Leahy-Smith America Invents Act. An AIA Review proceeds in two phases—in the first phase, the Board determines whether to institute a review, and in the second phase, the Board conducts the trial and issues a final decision. *See In re Cuozzo*, 778 F.3d, 1271, 1276 (Fed. Cir. 2015); *St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375-76 (Fed. Cir. 2014).



Except as provided in section IV.C. of this Standard Operating Procedure (SOP), assignments (designations under 35 U.S.C. § 6) of judges to panels of the Patent Trial and Appeal Board (Board) are made by the administrative personnel of the Board, under the direction of the Chief Administrative Patent Judge (Chief Judge). The Director's authority under 35 U.S.C. § 6 to designate panels has been delegated to the Chief Judge. *See Manual of Patent Examining Procedure* § 1002.02(f) (9th ed., March 2014). The Director's authority to institute a trial has been delegated to the Board. *See* 37 C.F.R. § 42.4 (2012); 37 C.F.R. § 42.408 (2012).

This SOP creates internal norms for the administration of the Board. It does not create any legally enforceable rights. The procedures described in this SOP, as they pertain to determinations and comments made by the Chief Judge and any other judge, are considered part of the deliberative process.

## I. Administrative Divisions of the Board

A. The Chief Judge, Deputy Chief Administrative Patent Judge (Deputy Chief Judge) and Vice Chief Administrative Patent Judges (Vice Chief Judges) are members of all administrative divisions and may administer appeals, interferences, and AIA Reviews, or otherwise participate in rendering panel decisions.

## II. Designation of Merits and Interlocutory Panels

A. In general, the Chief Judge will designate judges as the merits panel to decide *ex parte* appeals.

B. In general, the Chief Judge will designate judges as the merits panels to decide *ex parte* and *inter partes* reexamination appeals.

C. In general, the Chief Judge will designate a judge or judges, as appropriate, for all matters for interferences.

D. In general, the Chief Judge will designate a judge or judges, as appropriate, for all matters for AIA Reviews.

### III. Expanded Panels

An expanded panel is not favored and ordinarily will not be used. From time to time, however, it may be necessary to expand a merits or interlocutory panel. The following applies to the use of expanded panels.

#### A. Reasons for expanding a panel include:

1. The proceeding or AIA Review involves an issue of exceptional importance, such as where serious questions have been raised about the continuing viability of an apparently applicable precedential decision of the Board, or a panel of the Board renders a decision that conflicts with a precedential decision of the Board or an authoritative decision of the Board's reviewing courts.
2. Consideration by an expanded panel is necessary to secure and maintain uniformity of the Board's decisions, such as where different panels of the Board render conflicting decisions on issues of statutory interpretation or rule interpretation, or a substantial difference of opinion among judges exists on issues of statutory interpretation or rule interpretation.
3. A written request from the Commissioner for Patents or the Commissioner's delegate identifying a particular matter before the Board as one containing an issue of first impression, which written request shall become part of the administrative record. This request may be made in advance of decision by the Board or in connection with a request for rehearing.
4. A written request from the Commissioner for Patents or the Commissioner's delegate identifying a particular matter before the Board as one presenting an issue governed by a prior decision of the Board,
  - a) representing that the Commissioner for Patents has determined that it would not be in the public interest to follow the prior decision, and
  - b) asking the Board to reconsider and overrule the prior decision,

which written request shall become part of the administrative record. This request may be made in advance of decision by the Board or in connection with a request for rehearing.

B. Generally, an odd number of judges will be designated to decide cases in which an expanded panel is to be used. The Chief Judge will determine when an expanded panel is to be designated.

C. A judge, a merits panel, or an interlocutory panel may suggest to the Chief Judge, Deputy Chief Judge, and/or Vice Chief Judges the need for the designation of an expanded panel. Likewise, the Patent Examining Operation, an applicant or patent owner in an *ex parte* appeal, a party in an *inter partes* reexamination appeal, a party in an interference, or a party in a AIA Review may suggest the need for an expanded panel.

D. When a judge, a merits panel, or an interlocutory panel (1) suggests an expanded panel or (2) receives a suggestion for an expanded panel, the judge, merits panel, or interlocutory panel shall notify the Chief Judge, Deputy Chief Judge, and the Vice Chief Judges of the suggestion, in writing (for purposes of this SOP, a notification “in writing” includes a notification transmitted by e-mail). The written notification shall identify the reason for the suggestion, as well as which, if any, of the factors set forth in Section III.A. apply.

E. When an expanded panel is designated (1) after a case initially has been assigned to a merits or interlocutory panel and (2) before a decision is entered by the panel, the judges initially designated shall be designated, if available, as part of the expanded panel.

F. When an expanded panel is designated (1) after entry of a decision by a merits or interlocutory panel and (2) to consider a request for rehearing of the decision of the panel, the judges on the initial panel shall, if available, be designated as part of the expanded panel. The expanded panel shall decide the rehearing on its merits.

G. Expanded panels will include additional judges to be assigned by the Chief Judge. The selection of the additional judges shall be based on the technical or legal expertise of the judges.

H. In an appropriate circumstance, the Chief Judge may designate an expanded panel consisting of any number of judges to decide a case.

IV. Assignment of Judges

A. A panel designation will be provided for each appeal, interference, and AIA Review.

B. A judge assigned to administer an interference should arrange for a substitute judge to act on cases in the absence (i.e., leave, etc.) of the judge assigned to the interference.

C. Except where a party requests and agrees to entry of a *pro forma* adverse judgment under 37 CFR § 1.662(a), whenever a decision in an interference requires entry by a panel of judges, the judge to whom the interference is assigned shall have the Deputy Chief Judge or a Vice Chief Judge request an assignment of a panel. The Deputy Chief Judge or Vice Chief Judge may delegate the assignment of a panel to a Lead Judge.

D. The judges designated on a merits panel, interlocutory panel, or expanded panel shall not be changed without authority of the Chief Judge, Deputy Chief Judge, or a Vice Chief Judge. When satisfied that there is good reason to change the panel already designated, the Chief Judge, Deputy Chief Judge, or a Vice Chief Judge will approve a revised designation after making whatever changes are determined to be appropriate or will direct senior management staff to enter a revised designation. From time to time, the Chief Judge may authorize Board administrative personnel to alter the panel already designated. For merits panels in *ex parte* appeals, the Chief Judge may authorize a Lead Judge to change a designated merits panel for good reason.