

New York Intellectual Property Law Association (NYIPLA) Patent Trial and Appeal Board (PTAB) Committee Meeting:

**Request for Comments on Director review, Precedential Opinion Panel
review, and internal circulation and review of PTAB Decisions**

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September 6, 2022

UNITED STATES
PATENT AND TRADEMARK OFFICE



Request for Comments on Director review, Precedential Opinion Panel review, and internal circulation and review of PTAB decisions

Request for Comments

Request for Comments

- The USPTO has implemented a number of interim processes that promote the accuracy, consistency, and integrity of PTAB decision-making AIA proceedings, including
 - The current interim Director review process
 - The Precedential Opinion Panel (POP) process
 - The current interim process for PTAB decision circulation and internal PTAB review
- The USPTO plans to formalize those processes through notice and comment rulemaking



Request for Comments

- To inform such rulemaking, and to inform any modifications to the three interim processes pending formalization, on July 20, 2022, the USPTO published a [Request for Comments](#) (RFC) seeking public input.
- Comments will be accepted through September 19, 2022, through the Federal eRulemaking Portal at www.regulations.gov.



Submit a formal comment

<https://www.federalregister.gov/documents/2022/07/20/2022-15475/request-for-comments-on-director-review-precedential-opinion-panel-review-and-internal-circulation>



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 Notice

Request for Comments on Director Review, Precedential Opinion Panel Review, and Internal Circulation and Review of Patent Trial and Appeal Board Decisions

A Notice by the Patent and Trademark Office on 07/20/2022



 This document has a comment period that ends in 54 days. (09/19/2022)

[SUBMIT A FORMAL COMMENT](#)

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<https://www.regulations.gov/search?filter=PTO-P-2022-0023>



NOTICE

Director Review, Precedential Opinion Panel Review, and Internal Circulation and Review of Patent Trial and Appeal Board Decisions

PTO-P-2022-0023] Request for Comments on Director Review, Precedential Opinion Panel Review, and Internal... To submit comments via the portal, enter docket number *PTO-P-2022-0023* on the homepage and click "Search"

Agency Patent and Trademark Office

Posted Jul 20, 2022

ID PTO-P-2022-0023-0001

 **Comment**

Comments Due Sep 19, 2022

Request for Comments on Director review, Precedential Opinion Panel review, and internal circulation and review of PTAB decisions

Director review

Director review – overview

- On June 21, 2021, the Supreme Court issued its decision in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1986 (2021).
- The Court addressed the Constitution’s Appointments Clause as it relates to administrative patent judges (“APJs”).

Director review – overview

- The Court held that “the unreviewable authority wielded by APJs during *inter partes* review is incompatible with their appointment by the Secretary to an inferior office.”
- The Court’s remedy provides that the Director “may review final PTAB decisions and, upon review, may issue decisions himself on behalf of the Board.”

Director review – overview

- On June 29, 2021, the Office implemented an **interim process for Director review**, consistent with the *Arthrex* decision.
 - The interim process furthers the USPTO’s goal of promoting innovation through consistent and transparent decision-making and the issuance and maintenance of strong patents.
 - The interim process complements three other PTAB procedures the USPTO has in place to promote the same goals: panel rehearing; internal review; and the POP.

Director review – web pages

- On April 22, 2022, the USPTO published two web pages to increase openness as it formalizes the interim Director review process.
 - [Interim process for Director review web page](#), setting forth more details on the interim process and some additional suggestions for parties who wish to request Director review.
 - [Status of Director review requests web page](#), providing information about the proceedings in which Director review has been granted, and a spreadsheet, updated monthly, with the status of all Director review requests.

Director review – procedure

- A party may request Director review of a **final written decision** in an *inter partes* review or a post-grant review by concurrently:
 - filing a **request for rehearing** by the Director of a PTAB decision, and
 - submitting a notification of that request by **email** to Director_PTABDecision_Review@uspto.gov, and copying counsel for the parties.
- **Only a party** to a case may submit a request for Director review. Third party requests for Director review are not permitted.
- During implementation of the interim procedure, the USPTO will **not charge a fee**.



Director review – timing requirements

- A request for rehearing by the Director must satisfy the **timing requirements** of 37 C.F.R. 42.71(d).
 - Must be filed within 30 days of the entry of a final written decision or a decision on rehearing by a PTAB panel.
- A timely request for rehearing by the Director will be considered a request for rehearing under 37 C.F.R. 90.3(b) and will reset the time for appeal or civil action as set forth in that rule.

Director review – procedure

- After a panel issues a final written decision in an *inter partes* review or a post-grant review, a party may request either Director review or rehearing by the original PTAB panel, but **may not request both**.
 - If a party requests panel rehearing, and the panel grants rehearing, a party may subsequently request Director review of that decision.
 - If a party requests both Director review and panel rehearing (either together, or in the alternative), the Office will treat such a request as a request for Director review.

Director review – Advisory Committee

- Director review requests are routed to and considered by an **Advisory Committee** that the Director has established to assist with the process.
 - 11 members
 - Representatives from various USPTO business units
 - No member of the Advisory Committee may participate in considering a request for Director review if that member has a conflict of interest
 - Provides an *advisory* recommendation to the Director

Director review – Decisions

- Decision to grant or deny a request:
 - Director review grants will be posted on the [Status of Director review requests](#) webpage.
 - Director review denials can be found on the Director review status spreadsheet on the status webpage.
- Director review decisions may be issued as precedential, informative, or routine decisions.

Director review – procedure

- The Director may initiate a ***sua sponte review*** of a final written decision and further, may initiate a *sua sponte* review of any PTAB decision, including institution decisions, or a corresponding decision on rehearing.
- If initiated *sua sponte* by the Director, the parties to the proceeding will be given notice and may be given an opportunity for briefing.

Director review – procedure

- The Director’s review may address **any issue**, including issues of fact and issues of law, and will be *de novo*.
- If the Director has a conflict of interest, she will be recused, and the Deputy Director will take the required action.
 - If the Deputy Director has a conflict or the position is vacant, the Commissioner for Patents will take the required action.
- Final written decisions by the Director after Director review are appealable to the U.S. Court of Appeals for the Federal Circuit.

Director review – granted/initiated

as of August 29, 2022

- *Ascend Performance Materials Operations LLC v. Samsung SDI Co.*, IPR2020-00349, Paper 57 (Nov. 1, 2021) (Order granting Director review request)
- *Proppant Express Investments, LLC v. Oren Technologies, LLC*, IPR2018-00733, Paper 95 (Nov. 18, 2021) (Order granting Director review request)
- *Apple Inc. v. Personalized Media Communications LLC*
 - IPR2016-00754, Paper 50 (Mar. 3, 2022) (Order granting Director review request)
 - IPR2016-01520, Paper 47 (Mar. 3, 2022) (Order granting Director review request)
- *MED-EL Elektromedizinische Geräte Ges.m.b.H. v. Advanced Bionics AG*
 - IPR2020-01016, Paper 43 (June 1, 2022) (Order initiating Director review)
 - IPR2021-00044, Paper 41 (June 1, 2022) (Order initiating Director review)
- *OpenSky Industries, LLC v. VLSI Technology LLC*, IPR2021-01064, Paper 41 (June 7, 2022) (Order initiating Director review)

Director review – granted/initiated as of August 29, 2022

- *Patent Quality Assurance, LLC v. VLSI Technology LLC*, IPR2021-01229, Paper 31 (June 7, 2022) (Order initiating Director review)
- *Nested Bean, Inc. v. Big Beings USA Pty Ltd.*, IPR2020-01234, Paper 36 (June 17, 2022) (Order granting Director review and authorizing additional briefing)
- *Boehringer Ingelheim Animal Health USA Inc. v. Kansas State University Research Foundation*, PGR2022-00021, Paper 10 (August 12, 2022) (Order granting Director review)
- *Zynga, Inc. v. IGT*, IPR2022-00199, Paper 17 (August 22, 2022) (Decision granting Director review and affirming Board Institution Decision)
- *Code200, UAB v. Bright Data, Ltd.*
 - IPR2022-00861, Paper 18 (August 23, 2022) (Decision initiating *sua sponte* Director review of the Board’s Decision Denying Institution and Decision Denying Motion for Joinder)
 - IPR2022-00862, Paper 18 (August 23, 2022) (Decision initiating *sua sponte* Director review of the Board’s Decision Denying Institution and Decision Denying Motion for Joinder)

RFC – Director Review questions

1. Should any changes be made to the interim Director review process, and if so, what changes and why?
2. Should **only the parties** to a proceeding be permitted to request Director review, or should third-party requests for Director review be allowed, and if so, which ones and why?
3. Should requests for Director review be **limited to final written decisions** in IPR and PGR? If not, how should they be expanded and why?
4. Should a party to a proceeding be able to request **both Director review and rehearing by the merits panel**? If so, why and how should the two procedures interplay?

RFC – Director Review questions

5. What **criteria** should be used in determining whether to initiate Director review?
6. What **standard of review** should the Director apply in Director review? Should the standard of review change depending on what type of decision is being reviewed?
7. What **standard** should the Director apply in determining whether or not to grant ***sua sponte*** Director review of decisions on institution? Should the standard change if the decision on institution addresses discretionary issues instead of, or in addition to, merits issues?

RFC – Director Review questions

8. Should there be a **time limit** on the Director's ability to reconsider a petition denial? And if so, what should that time limit be?
9. Are there considerations the USPTO should take with regard to the fact that decisions made on Director review are not **precedential** by default, and instead are made and marked precedential only upon designation by the Director?
10. Are there any **other considerations** the USPTO should take into account with respect to Director review?

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Precedential Opinion Panel (POP) review

POP review

- [Standard operating procedure 2](#) (September 2018 update) explains the standards, procedures, and timing for requesting [POP review](#) in a pending case on rehearing
- POP default composition
 - Director
 - Commissioner for Patents
 - PTAB Chief Judge

POP review

- POP review creates binding Board precedent on rehearing by default.
- An online [Amicus Form](#) allows public input on pending POP review requests, within seven business days of entry of the Notification of Receipt of POP Request.

POP review

- Criteria used by POP in deciding whether to grant review:
 - Constitutional questions
 - Important questions regarding statutes, rules, regulations
 - Important issues regarding precedential case law
 - Issues of broad applicability to Board
 - Resolve conflicts between Board decisions
 - Promote certainty and consistency

POP review

- The Director review process does not alter the current POP process.
 - Requests for review of decisions on institution in AIA proceedings or appeal decisions (and other decisions) are not accepted for Director review, but are accepted for POP review
- The USPTO seeks comments on the POP process in view of the Director review process.

RFC – POP review questions

11. Should the POP review process remain in effect, be modified, or be eliminated in view of Director review? Please explain.
12. Are there any other considerations the USPTO should take into account with respect to the POP process?

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Interim Process for PTAB Decision Circulation and Internal PTAB Review

Decision circulation and internal review – overview

- New [interim process for PTAB decision circulation and internal review](#) issued on May 26, 2022
 - Goal of the new interim process is to provide helpful feedback on decisions prior to issuance
 - Furthers the USPTO’s goals of promoting innovation through consistent, clear, and open decision-making

Decision circulation and internal review – overview

- The new interim process makes clear:
 - The Director is not involved, pre-issuance, in directing or otherwise influencing panel decisions
 - The PTAB panel has final authority and responsibility for the content of a decision
- The interim process will be used until the USPTO receives stakeholder feedback and operationally formalizes the process



Decision circulation and internal review – overview

- The new interim process is modeled after the Federal Circuit's
 - [Previous office of the Senior Technical Assistant \(STA\)](#)
 - Provided information on potential conflicts between a panel-approved precedential opinion and any other prior opinions of the court or other relevant precedents
 - [10-day circulation process for precedential decisions](#)
 - Provides non-panel members with an opportunity to review a precedential decision prior to issuance

Interim Process for PTAB Decision Circulation and Internal PTAB Review

Circulation Judge Pool (CJP)

Circulation Judge Pool (CJP)

- The CJP is similar to the Federal Circuit's processes, in that it provides panels with information on:
 - Potential conflicts or inconsistencies with relevant authority, including Director-written guidance and other USPTO policy
 - Potential inconsistencies with other PTAB decisions and suggestions for improved readability and stylistic consistency
- Each decision reviewed by the CJP is reviewed by at least two non-panel PTAB judges

Circulation Judge Pool (CJP)

- The CJP is a representative group of at least eight non-management peer PTAB judges; open to any PTAB judge
 - CJP members will follow the guidance on conflicts of interest set forth in the PTAB's [Standard Operating Procedure 1](#) and will notify other CJP members and recuse themselves from any discussion or analysis involving cases or related cases on which they are paneled
 - In determining whether there is a conflict of interest, the USPTO follows the guidance set forth in the United States Department of Commerce's [Summary of Ethics Rules](#)

Circulation Judge Pool (CJP)

- The CJP identifies notable draft decisions to PTAB Executive Management (e.g., decisions that address issues of first impression, that appear inconsistent with USPTO policy, or that involve areas where policy clarification may be needed).
 - PTAB Executive Management may discuss decisions, **after issuance** with the Director and/or the Director Review Advisory Committee for consideration for Director-initiated review; and/or the Screening Committee for consideration of review by the Precedential Opinion Panel (POP)
 - Periodic meetings of the CJP and PTAB Executive Management may also flag areas for potential policy issuance/clarification that PTAB Executive management may discuss with Director to consider whether to issue new or updated policies through regulation, precedential or informative decisions, and/or a Director guidance memorandum

Optional management review

- Any panel member, optionally and at their sole discretion, may consult with one or more members of PTAB management (i.e., PTAB Executive Management and Lead Judges) regarding a decision prior to issuance
 - Adoption of any suggestions provided by PTAB management based on such consultation is optional
- Unless consulted by a panel member, PTAB management does not make suggestions to the panel on any pre-issuance decisions, either directly or indirectly through the CJP
- As with the CJP's feedback, the panel has final authority and responsibility for the content of a decision, and determines whether and how to incorporate feedback from PTAB management

Process and the USPTO Director

- The Director is not involved, pre-issuance, in directing or otherwise influencing any panel decisions
- The Director is not involved in directing or otherwise influencing the paneling for any proceeding before the PTAB
- CJP provides a mechanism by which the Director may be made aware of decisions to consider for Director-initiated review or POP review, and of areas to consider for issuing new, or modified, USPTO policy to promote a strong intellectual property system

RFC – interim PTAB decision circulation and internal review questions

13. Should any changes be made to the interim PTAB decision circulation and internal review processes, and if so, what changes and why?
14. Are there any other considerations the USPTO should take into account with respect to the interim PTAB decision circulation and internal review processes?

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