

PTAB'S DESIGNATIONS FOR OPINIONS

The Patent Trial and Appeal Board (“the Board” or “PTAB”) uses four designations for issued opinions: (1) precedential; (2) informative; (3) representative; and (4) routine. The significance of each designation and factors considered in selecting certain designations for opinions are explained below.

An opinion of the Board designated as “precedential” is binding on all members of the Board unless overcome by subsequent binding authority.¹ Each Board member i.e., each Administrative Patent Judge on the Board and each statutory member of the Board, is invited to vote on whether an opinion should be designated precedential. A Board member may choose to abstain from voting. An opinion is made precedential only if “a majority of the Board’s *voting members* agree that the opinion should be made precedential” and “the Director concurs that the opinion should be designated precedential.”²

Considerations in favor of a precedential designation include a need to: (1) create binding precedent on recurring issues; (2) address issues of first impression; and (3) resolve conflicts among panels. Considerations against a precedential designation include (1) opinions that turn on the specific facts of the case; or (2) opinions that apply well-established legal principles.

An appellant, a patentee, a petitioner, or a third party member of the public may, within 60 days of issuance of an opinion, request in writing that an opinion be made precedential, by forwarding that request, along with accompanying reasons, to the Chief Judge.³ The Chief Judge shall respond in writing to the requester to confirm receipt of the request.

An opinion of the Board designated as “informative” is not binding authority on the members of the Board. Opinions designated as informative provide the Board’s general consensus on recurring issues and guidance to examiners, appellants, patent owners, or petitioners in areas where parties routinely misapply

¹ An opinion may be designated as precedential as to only a subset of issues addressed in the opinion. *See, e.g., Ex parte Mewherter*, Appeal 2012-007692 (PTAB May 8, 2013), available at http://www.uspto.gov/sites/default/files/ip/boards/bpai/decisions/prec/fd2012_007692_precedential.pdf (Notice as to scope of precedent).

² PTAB Standard Operating Procedure 2 (Rev. 9): Publication of opinions and designation of opinions as precedential, informative, representative, and routine (Sept. 22, 2014) (emphasis added), located at <http://www.uspto.gov/sites/default/files/documents/sop2-revision-9-dated-9-22-2014.pdf>.

³ *See id.* PTAB contact information can be found at <http://www.uspto.gov/about-us/organizational-offices/patent-trial-and-appeal-board/ptab-contact-information>.

the law. An informative opinion also may provide guidance in an underdeveloped or emerging area of law, where the Board wants to wait to see how the cases develop before considering a precedential opinion. Judges often go to some effort in drafting these opinions to give a thorough explication of the law to provide guidance to the public.

An opinion of the Board designated as “representative” likewise is not binding authority on the members of the Board. Representative opinions typically provide a representative sample of outcomes on a matter. This designation is used to bring such opinions to the attention of the public from among the numerous routine opinions issued by the Board.

An opinion of the Board designated as “routine” also is not binding authority on the members of the Board. Every Board opinion is, by default, a routine opinion until it is designated otherwise. Such opinions may have little persuasive value in relation to other Board opinions in other cases. Routine opinions typically turn on the specific facts of the case. Most PTAB opinions are routine.

Listings of the Board’s precedential, informative, and representative opinions are provided on the Board’s Web page, located at <http://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/decisions>. All final Board decisions are posted to the USPTO e-FOIA page, located at <http://e-foia.uspto.gov/Foia/PTABReadingRoom.jsp>, unless an application to which they relate is confidential.