

PTAB Clarifies Protocol for Expanded Post-Grant Panels

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Today the **Patent Trial and Appeal Board** (“Board”) posted on its website Revision 14 of its Standard Operating Procedure 1 (SOP 1). SOP 1 covers the assignment of Administrative Patent Judges to merits panels, interlocutory panels, and expanded panels in appeals, interferences, and AIA Reviews. With Revision 14, the Board, among other things, clarifies that although a party may not *request* an expanded panel, a party is permitted to *suggest the need* for one. SOP 1, § III.C, (Rev. 14) (May 8, 2015).

This revision comes on the heels of the Board’s announcement last Friday that it has designated as “Informative” under Standard Operating Procedure 2 (SOP 2) two decisions regarding petitioner requests for expanded panels on rehearing of Board denials of *inter partes* review. In **Conopco, Inc. v. Procter & Gamble Company**, Case IPR2014-00506 (PTAB Dec. 10, 2014) (Paper 25) (“’506 IPR”), the Board denied Petitioner Conopco’s request for rehearing before an expanded panel, including the Chief Judge. In **AOL Inc. v. Coho Licensing LLC**, Case IPR2014-00771 (Mar. 24, 2015) (Paper 12) (“’771 IPR”), the Board went further, deeming Petitioner AOL’s request for an expanded panel for rehearing as improper. Both of these decisions are in fact referenced in the Board’s announcement today of SOP 1 (Rev. 14).

Citing to the then-current version of SOP 1, the ’506 and ’771 IPR decisions both make clear that Board panel members do not have authority to grant a request for panel expansion: “members of the Board deciding an institution matter are not authorized to select themselves or, of their own accord, select other Board members to decide a matter, upon the request of a party or otherwise.” See ’506 IPR at 6; ’771 IPR at 2 (citing Standard Operation Procedure 1). The Board reasoned in each case that, under the Patent Statute, the Director has the sole authority to designate panel members and may delegate that authority. See ’771 IPR at 2. Under SOP 1, “the Chief Judge, on behalf of the Director, may act to expand a panel based on a *suggestion* from a judge or panel.” *Id.*

The AOL decision (’771 IPR) also elaborates on the appropriate circumstances for suggesting panel expansion by considering whether the issue presented by Petitioners in their request for rehearing raised either of the two primary bases for expanding a panel: namely, a conflict of legal authorities or a conflict regarding a contrary legal interpretation of a statute or regulation. The ’771 IPR Board held

that a dissent by one of the three judges in the institution decision with respect to the sufficiency of the evidence presented in a petition, by itself, was not a reason to expand the panel. See '771 IPR at 3.

While neither “Informative” decision is binding authority, both serve to clarify that the Chief Judge, *not* a panel, may in his or her discretion act to expand a panel on a *suggestion*, not a request, from a judge, panel or party. As recently as Monday, the Board panel in *J.P. Morgan Chase & Co. et al. v. Intellectual Ventures II LLC*, Case CBM2014-00157, at 7 (May 11, 2015) (Paper 20) cited to the '506 IPR and reiterated this very notion: “the Chief Judge, on behalf of the Director, may act to expand a panel on a ‘suggestion’ from a judge or panel, an applicant [or] patent owner in an appeal, and a party in an interference,” but Board members themselves cannot “select other Board members to decide the matter, upon request of a party or otherwise”.

With the release of Revision 14 of SOP 1, the Board now makes explicit that this rule applies to expanded panel requests in post-grant proceedings: “Likewise ... a party in a AIA Review *may* suggest the need for an expanded panel.” SOP 1 (Rev. 14), § III.C (emphasis added). The revision also indicates that suggestions must be in the form of written notifications that identify the reasons for the suggestion. SOP 1 (Rev. 14) § III.D.

The Board’s use of its Standard Operating Procedures as a mechanism for regulating parties’ conduct in post-grant proceedings before the Board (SOP 1) and for highlighting to the public certain opinions as “Informative, Representative, and Routine” (SOP 2) is sure to continue in parallel with its increasing work load and developing library of post-grant decisions.

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