Insights: Publications

PTAB Update: The USPTO Issues Revised Interim Guidelines for Director Review

JULY 24, 2023 Written by Justin L. Krieger and Nicoletta M. Kennedy

The USPTO issued Revised Interim Guidelines today on the process for requesting Director Review of PTAB decisions. Since the U.S. Supreme Court's decision in *United States v. Arthrex*, 141 S.Ct. 1970 (2021), which held that the Director must have discretion to review decisions rendered by the PTAB's Administrative Patent Judge's, the USPTO has issued several updates to its procedures for requesting Director Review. This newest iteration retains several of the features of the prior Guidelines while making a few significant modifications.

What has changed:

• **Director Review Of Institution Decision:** Under the prior Guidelines, PTAB litigants were limited to requesting Director Review of Final Written Decisions (FWD), which are issued after a case has been instituted and goes to trial. Under the Revised Guidelines, Director Review requests are available for other areas of Board jurisdiction. Specifically, a party to a Board decision may now request Director Review of the Board's (1) decision whether to institute a trial, (2) final written decision, or (3) decision granting a request for rehearing.

• **Delegated Rehearing Panel:** The Director now has the option of delegating review of a Board decision to a Delegated Rehearing Panel (DRP), which is a panel of judges delegated by the Director with the task of reviewing Board decisions. The DRP will contain three members selected from the Chief Judge, Deputy Chief Judge, Vice Chief Judges, and Senior Lead Judges, excluding judges who served on the original Board panel for the case under review or otherwise have a conflict with the case. A party may file one request for rehearing of a DRP decision, but parties are not permitted to file further requests for Director Review of a decision of the DRP.

• **Advisory Committee:** All requests for Director Review will be reviewed by an Advisory Committee, which will provide its recommendation to the Director. Regardless of the recommendation provided by the Advisory Committee, the Director may determine that a decision should be delegated to the DRP. The Advisory Committee will include at least 11 members (7 for a quorum) and includes representatives from various USPTO business units who serve at the discretion of the Director.

• **Precedential Opinion Panel eliminated:** The Revised Interim Guidelines have eliminated the Precedential Opinion Panel (POP) and replaced it with the Revised Interim Guidelines and a new Appeals Review Panel (ARP). The Director may convene the ARP sua sponte to review a PTAB decision or a decision in an ex parte appeal, reexamination appeal, or reissue appeal. The ARP will be selected by the Director and, by default, consists of the Director, the Commissioner for Patents, and the Chief Judge of the Patent Trial and Appeal Board. Requests for ARP review will not be accepted or considered. ARP decisions will be non-precedential by default, but the public may submit nominations for precedential or informative designation using the PTAB Decision Nomination web form <https://www.uspto.gov/patents/ptab/ptab-decision-nomination>, which may be submitted anonymously, or by sending an email to PTAB_Decision_Nomination@uspto.gov.

What stays the same:

• Under the Revised Interim Guidelines, a party dissatisfied with a Board decision has two options: (i) it can request rehearing before the same panel of judges, or (ii) it can request Director Review of the decision. It cannot do both.
• In an *inter partes* review, post grant review, and derivation proceedings, a party may submit a Director Review request by concurrently: (1) filing a Request for Rehearing by the Director in the Patent Trial and Appeal Case Tracking System (P-TACTS); and (2) emailing the Director at Director_PTABDecision_Review@uspto.gov, copying counsel for all parties to the proceeding. A Director Review request is not perfected until both submissions are made.
• The Director may grant review of Board decisions *sua sponte* (on the Director's own initiative).

Practitioner Takeaway:

The Revised Interim Guidelines provide increased clarity regarding the Director Review process and expand its application to all phases of PTAB trials, including decisions on institution of trial. Those concerned that Requesting Rehearing of a Board decision before the same panel of judges may not provide a sufficiently objective level of review should strongly consider the alternative of Requesting Director Review.

Related People



Justin L. Krieger
t 303.405.1486
jkrieger@ktslaw.com



Nicoletta M. Kennedy
t 202.639.4711
nkennedy@ktslaw.com