

U.S. Patent and Trademark Office, Commerce

§ 90.1

decision, the Director may direct the repaneling of the proceeding in a manner consistent with public Board paneling guidance through an Order entered into the record.

§ 43.4 Limited pre-issuance management and Office involvement in decisions.

(a) Except as requested pursuant to paragraph (b) of this section or permitted under paragraph (d) or (e) of this section, prior to issuance of a decision by the panel, no Management Judge or an officer or employee of the Office external to the Board shall initiate communication, directly or through intermediaries, with any member of a panel regarding the decision.

(b) Any individual panel member may request that one or more Management Judges or an officer or employee of the Office external to the Board provide input on a decision prior to issuance. The choice to request input is optional and solely within the discretion of an individual panel member.

(c) It is within the sole discretion of the panel to adopt any edits, suggestions, or feedback provided to the panel by a Management Judge or an officer or employee of the Office external to the Board as part of a review requested under paragraph (b) of this section. The panel has final authority and responsibility for the content of a decision and determines whether and how to incorporate any feedback requested under paragraph (b).

(d) The prohibition of paragraph (a) of this section shall not apply to any Management Judge who is a member of the panel. When sitting as a member of a panel, a Management Judge is a co-equal member of the panel.

(e) Nothing in this section shall prevent a Management Judge from communicating with a panel as to resource needs or the procedural status of any case pending before the Board.

§ 43.5 Review of decisions by non-Management Judges.

If the Office establishes procedures governing the internal circulation and review of decisions prior to issuance to one or more designated members of the Board:

(a) No Management Judge or an officer or employee external to the Board shall participate directly or indirectly in any such review and the reviewing non-Management Judges shall not discuss the substance of any circulated decision with a Management Judge prior to issuance of the decision, except with a Management Judge who is a member of the panel; and

(b) Any edits, suggestions, or feedback provided to the panel pursuant to such circulation and review are optional and in the sole discretion of the panel to accept. The panel has final authority and responsibility for the content of a decision and determines whether and how to incorporate any feedback provided.

§ 43.6 Controlling legal authority; no unwritten or non-public binding policy or guidance.

Notwithstanding any other provision of this part, all decisions of the Board are expected to comport with all applicable statutes, regulations, binding case law, and written Office policy and guidance applicable to Board proceedings. There shall be no unwritten Office or Board policy or guidance that is binding on any panel of the Board. All written policy and guidance binding on panels of the Board shall be made public.

PART 90—JUDICIAL REVIEW OF PATENT TRIAL AND APPEAL BOARD DECISIONS

Sec.

90.1 Scope.

90.2 Notice; service.

90.3 Time for appeal or civil action.

AUTHORITY: 35 U.S.C. 2(b)(2).

SOURCE: 77 FR 48677, Aug. 14, 2012, unless otherwise noted.

§ 90.1 Scope.

The provisions herein govern judicial review for Patent Trial and Appeal Board decisions under chapter 13 of title 35, United States Code. Judicial review of decisions arising out of *inter partes* reexamination proceedings that are requested under 35 U.S.C. 311, and

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where available, judicial review of decisions arising out of interferences declared pursuant to 35 U.S.C. 135 continue to be governed by the pertinent regulations in effect on July 1, 2012.

§ 90.2 Notice; service.

(a) *For an appeal under 35 U.S.C. 141.*

(1)(i) In all appeals, the notice of appeal required by 35 U.S.C. 142 must be filed with the Director by electronic mail to the email address indicated on the United States Patent and Trademark Office's web page for the Office of the General Counsel. This electronically submitted notice will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(ii) A copy of the notice of appeal must also be filed with the Patent Trial and Appeal Board in the appropriate manner provided in §§41.10(a), 41.10(b), or 42.6(b) of this chapter.

(2) In all appeals, the party initiating the appeal must comply with the requirements of the Federal Rules of Appellate Procedure and Rules for the United States Court of Appeals for the Federal Circuit, including:

(i) Serving the requisite number of copies on the Court; and

(ii) Paying the requisite fee for the appeal.

(3) *Additional requirements.* (i) In appeals arising out of an *ex parte* reexamination proceeding ordered pursuant to §1.525, notice of the appeal must be served as provided in §1.550(f) of this title.

(ii) In appeals arising out of an *inter partes* review, a post-grant review, a covered business method patent review, or a derivation proceeding, notice of the appeal must provide sufficient information to allow the Director to determine whether to exercise the right to intervene in the appeal pursuant to

35 U.S.C. 143, and it must be served as provided in §42.6(e) of this title.

(b) *For a notice of election under 35 U.S.C. 141(d) to proceed under 35 U.S.C. 146.* (1) Pursuant to 35 U.S.C. 141(d), if an adverse party elects to have all further review proceedings conducted under 35 U.S.C. 146 instead of under 35 U.S.C. 141, that party must file a notice of election with the Director by electronic mail to the email address indicated on the United States Patent and Trademark Office's web page for the Office of the General Counsel. This electronically submitted notice will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450.

(2) A copy of the notice of election must also be filed with the Patent Trial and Appeal Board in the manner provided in §42.6(b).

(3) A copy of the notice of election must also be served where necessary pursuant to §42.6(e).

(c) *For a civil action under 35 U.S.C. 146.* The party initiating an action under 35 U.S.C. 146 must file a copy of the complaint no later than five business days after filing the complaint in district court with the Patent Trial and Appeal Board in the manner provided in §42.6(b), and the Office of the Solicitor pursuant to §104.2. Failure to comply with this requirement can result in further action within the United States Patent and Trademark Office consistent with the final Board decision.

[77 FR 48677, Aug. 14, 2012, as amended at 89 FR 22086, Mar. 29, 2024]

§ 90.3 Time for appeal or civil action.

(a) *Filing deadline.* (1) *For an appeal under 35 U.S.C. 141.* The notice of appeal filed pursuant to 35 U.S.C. 142 must be filed with the Director of the United States Patent and Trademark Office no later than sixty-three (63) days after

the date of the final Board decision. Any notice of cross-appeal is controlled by Rule 4(a)(3) of the Federal Rules of Appellate Procedure, and any other requirement imposed by the Rules of the United States Court of Appeals for the Federal Circuit.

(2) *For a notice of election under 35 U.S.C. 141(d).* The time for filing a notice of election under 35 U.S.C. 141(d) is governed by 35 U.S.C. 141(d).

(3) *For a civil action under 35 U.S.C. 145 or 146.* (i) A civil action must be commenced no later than sixty-three (63) days after the date of the final Board decision.

(ii) The time for commencing a civil action pursuant to a notice of election under 35 U.S.C. 141(d) is governed by 35 U.S.C. 141(d).

(b) *Time computation.* (1) *Rehearing.* A timely request for rehearing will reset the time for appeal or civil action to no later than sixty-three (63) days after action on the request. Any subsequent request for rehearing from the same party in the same proceeding will not reset the time for seeking judicial review, unless the additional request is permitted by order of the Board.

(2) *Holidays.* If the last day for filing an appeal or civil action falls on a Federal holiday in the District of Columbia, the time is extended pursuant to 35 U.S.C. 21(b).

(c) *Extension of time.* (1) The Director, or the Director's designee, may extend the time for filing an appeal, or commencing a civil action, upon written request if:

(i) Requested before the expiration of the period for filing an appeal or commencing a civil action, and upon a showing of good cause; or

(ii) Requested after the expiration of the period for filing an appeal or commencing a civil action, and upon a showing that the failure to act was the result of excusable neglect.

(2) The request must be filed with the Director by electronic mail to the email address indicated on the United States Patent and Trademark Office's web page for the Office of the General Counsel. This electronically submitted request will be accorded a receipt date, which is the date in Eastern Time when the correspondence is received in the Office, regardless of whether that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. If there is some circumstance in which electronic mail cannot be used, submission may be by Priority Mail Express® to the Office of the Solicitor, United States Patent and Trademark Office, Mail Stop 8, P.O. Box 1450, Alexandria, Virginia 22313-1450.

[77 FR 48677, Aug. 14, 2012, as amended at 89 FR 22086, Mar. 29, 2024]

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EDITORIAL NOTE: This listing is provided for informational purposes only. It is compiled and kept current by the Department of Commerce. This index is updated as of July 1, 2024.

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