

# Chapter 1200 Appeal

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## 1201 Introduction [R-08.2017]

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny them the patent protection to which they are entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute ([35 U.S.C. 134](#)).

Throughout this chapter, "Board" is used to refer the Patent Trial and Appeal Board and its predecessor organizations, the Board of Patent Appeals and Interferences and the separate Board of Appeals and Board of Interferences.

Unless otherwise noted, the discussion of the *ex parte* appeal practice before the Board in this chapter is primarily directed to appeals wherein the notice of appeal was filed on or after January 23, 2012, or to proceedings commenced on or after September

16, 2012. See Pub. L. 112-29 (September 16, 2011)(known as the Leahy-Smith America Invents Act or the AIA) and final rule “Rules of Practice Before the Board of Patent Appeals and Interferences in *Ex Parte* Appeals, 76 Fed. Reg. 72270 (November 22, 2011).

For information pertaining to the Board’s *ex parte* appeal practice and procedure in effect prior to September 16, 2012, see Chapter 1200 in the MPEP 8th Edition, Rev. 9 (August 2012)(available on the USPTO web site at [www.uspto.gov/web/offices/pac/mpep/old/mpep\\_E8R9.htm](http://www.uspto.gov/web/offices/pac/mpep/old/mpep_E8R9.htm).

The line of demarcation between appealable matters for the Board and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board. Ordinarily, an objection is petitionable, and a rejection is appealable, but when the objection is “determinative of the rejection” the matter may be addressed by the Board. See *In re Hengehold*, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971) and *Ex parte Frye*, 94 USPQ2d 1072, 1078 (Bd. Pat. App. & Int. 2010)(precedential). Some matters which have been determined to be petitionable and not appealable include: a requirement for restriction or election of species, finality, non-entry of amendments, and holdings of abandonment. As [37 CFR 1.181\(f\)](#) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since [37 CFR 1.144](#) states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

This chapter is primarily directed to *ex parte* appeals. For appeals in *inter partes* reexamination proceedings, see [37 CFR 41.60](#) to [41.81](#) and [MPEP §§ 2674](#) to [2683](#).

## 1202 Composition of Board [R-08.2017]

[35 U.S.C. 6](#) provides for a Patent Trial and Appeal Board as follows:

### 35 U.S.C. 6 Patent Trial and Appeal Board.

(a) ESTABLISHMENT AND COMPOSITION.— There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director. Any reference in any Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Board of Patent Appeals and Interferences is deemed to refer to the Patent Trial and Appeal Board.

(b) DUTIES.— The Patent Trial and Appeal Board shall—

(1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);

(2) review appeals of reexaminations pursuant to section 134(b);

(3) conduct derivation proceedings pursuant to section 135; and

(4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

(c) 3-MEMBER PANELS.— Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Patent Trial and Appeal Board may grant rehearings.

(d) TREATMENT OF PRIOR APPOINTMENTS.— The Secretary of Commerce may, in the Secretary’s discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge. It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge’s having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.

35 U.S.C. 6 was amended in Pub. L. 112-29, sec. 7. In addition to changing the duties of the Board and clarifying its membership, the name of the Board was changed from the Board of Patent Appeals and Interferences (BPAI) to the Patent Trial and Appeal Board (PTAB), effective September 16, 2012. Consistent with 35 U.S.C. 6(a), examiners should treat any reference to the BPAI (or its predecessors, the separate Board of Appeals and Board of Interferences) as a reference to the PTAB. In a citation to a decision of the Board (e.g., in an Office

action or Appeal Brief), decisions mailed prior to September 16, 2012 should continue to be cited as decisions of the BPAI or its predecessor organizations.

As provided by 37 CFR 41.2, “Board” means the Patent Trial and Appeal Board and includes:

(A) For a final Board action:

(1) In an appeal or contested case, a panel of the Board;

(2) In a proceeding under [37 CFR 41.3](#), the Chief Administrative Patent Judge or another official acting under an express delegation from the Chief Administrative Patent Judge.

(B) For non-final actions, a Board member or employee acting with the authority of the Board.

“Board member” means the Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office, the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the U.S. Patent and Trademark Office, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges.

## 1203 Administrative Handling [R-08.2017]

*Ex parte* appeals to the Board, and documents relating thereto filed prior to a docketing notice from the Board, are reviewed to determine the business unit of the Office responsible for their processing. Appeal documents, such as the notice of appeal, appeal brief, pre-appeal brief request for review (See [MPEP § 1204.02](#)), and request for extension of time to file the brief, are processed by the Patent Appeal Center.

The Patent Examining Corps has jurisdiction over the application to consider the appeal brief, conduct an appeal conference, draft an examiner's answer, and decide the entry of amendments, evidence, and information disclosure statements filed after final or after notice of appeal. Jurisdiction over the proceeding passes to the Board upon the filing of a reply brief under [37 CFR 41.41](#) or the expiration of the time in which to file such a reply brief, whichever is earlier. See [37 CFR 41.35](#).

Notices of appeal, appeal briefs, and reply briefs are reviewed for compliance with the appropriate rules prior to being forwarded to the examiner. As such, examiners should not identify these documents as defective or noncompliant for failure to comply with procedural rules. In the rare situation where a substantial defect in an appeal document is identified after these reviews, the examiner should contact the Patent Appeal Center to determine whether corrective action should be taken.

The Patent Appeal Center may return the application to the examiner for corrections to the examiner's answer or other outgoing documents when appropriate.

If the brief is not filed within the time designated by [37 CFR 41.37](#), the applicant will be notified that the appeal stands dismissed. See [MPEP § 1215](#).

## I. DOCKETING PROCEDURE

The Board's docketing procedure is designed to provide notification to the appellant within one month of receipt from the Patent Appeals Center of an appealed application at the Board that (A) the appeal has been received at the Board and docketed, or (B) the appeal is being remanded to the examiner for attention to unresolved matters.

If the appeal is ready for docketing three events will occur:

- (A) an appeal number will be assigned;
- (B) the Board will issue a docketing notice; and
- (C) the appeal will be assigned either to a master docket for subsequent reassignment to a panel or directly to a panel of at least three Board members.

If the appeal cannot be docketed due to matters requiring further attention in the patent examining corps, the appeal will be remanded to the patent examining corps with an order indicating why the appeal cannot be docketed. Notification of the remand, in the form of a copy of the order, will be mailed to the appellant.

The docketing notice or order indicating why the appeal cannot be docketed will provide the appellant and the examiner with notification that (A) the

appeal is under the jurisdiction of the Board; or (B) that the appeal is being returned to the patent examining corps to resolve matters requiring attention prior to decision of the appeal. Thus, the appellant will know to which organization to look for the next communication in the appealed application.

## II. “SPECIAL CASE”

If the applicant remains diligent, an application for patent that once has been made special and advanced out of turn by the United States Patent and Trademark Office (Office) for examination will continue to be special throughout its entire course of prosecution in the Office, including appeal, if any, to the Board. See [MPEP § 708.01](#).

A petition to make an application special after the jurisdiction of the appeal has been transferred to the Board may be addressed to the Board. Thus, no such petition will be granted unless the brief has been filed and applicant has made the same type of showing required by the Director under [37 CFR 1.102](#). Therefore, diligent prosecution is essential to a favorable decision on a petition to make special.

## 1204 Notice of Appeal [R-08.2017]

### 35 U.S.C. 134 Appeal to the Patent Trial and Appeal Board.

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

### 35 U.S.C. 41 Patent fees; patent and trademark search systems

(a) GENERAL FEES. — The Director shall charge the following fees:

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#### (6) APPEAL FEES. —

(A) On filing an appeal from the examiner to the Patent Trial and Appeal Board, \$540.

(B) In addition, on filing a brief in support of the appeal, \$540, and on requesting an oral hearing in the appeal before the Patent Trial and Appeal Board, \$1,080.

An additional fee for forwarding an appeal to the Board after Examiner's Answer is set at [37 CFR 41.20\(b\)\(4\)](#).

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### 37 CFR 41.31 Appeal to Board.

(a) *Who may appeal and how to file an appeal* An appeal is taken to the Board by filing a notice of appeal.

(1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § [41.20\(b\)\(1\)](#) within the time period provided under § [1.134](#) of this title for reply.

(2) Every owner of a patent under *ex parte* reexamination filed under § [1.510](#) of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § [41.20\(b\)\(1\)](#) within the time period provided under § [1.134](#) of this title for reply.

(3) Every owner of a patent under *ex parte* reexamination filed under § [1.510](#) of this title on or after November 29, 1999, any of whose claims has been finally (§ [1.113](#) of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § [41.20\(b\)\(1\)](#) within the time period provided under § [1.134](#) of this title for reply.

(b) The signature requirements of §§ [1.33](#) and [11.18\(a\)](#) of this title do not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § [1.136](#) of this title for patent applications and § [1.550\(c\)](#) of this title for *ex parte* reexamination proceedings.

## I. APPEAL FEES

Public Law 112-29, sec. 10 authorizes the Director to set or adjust fees “established, authorized, or charged under title 35.” The fees for appeal as set forth in [35 U.S.C. 41\(a\)\(6\)](#) have been adjusted by rule at [37 CFR 41.20\(b\)](#). See [37 CFR 41.20\(b\)\(1\)](#) for the fee for the filing of a notice of appeal, [37 CFR 41.20\(b\)\(2\)\(i\)](#) for filing an appeal brief in an application or *ex parte* reexamination proceeding, and [37 CFR 41.20\(b\)\(3\)](#) for a request for oral hearing.

Effective March 19, 2013, the fee for filing an appeal brief in an application or *ex parte* reexamination ([37 CFR 41.20\(b\)\(2\)\(i\)](#)) was reduced to \$0, and a new fee for forwarding an appeal in an application or *ex parte* reexamination proceeding to the Board



after the mailing of an examiner's answer was added at [37 CFR 41.20\(b\)\(4\)](#). See [37 CFR 41.45](#) and [MPEP § 1208.01](#) for additional information pertaining to the forwarding fee.

## II. APPEAL BY PATENT APPLICANT

Under [37 CFR 41.31\(a\)\(1\)](#), an applicant for a patent dissatisfied with the primary examiner's decision in the second or subsequent rejection of the applicant's claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in [37 CFR 41.20\(b\)\(1\)](#) within the time period provided under [37 CFR 1.134](#) and [1.136](#). A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice rejected" does not have to be related to a particular application. *See Ex Parte Lemoine*, 46 USPQ2d 1420, 1423 (Bd. Pat. App. & Inter. 1994) ("so long as the applicant has twice been denied a patent, an appeal may be filed"). For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant can choose to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application. Applicant cannot file an appeal in a continuing application, or after filing a request for continued examination (RCE) under [37 CFR 1.114](#), until the application is under a rejection. Accordingly, applicant cannot file a notice of appeal with an RCE, even if the application has been twice rejected prior to the filing of the RCE.

If appellant files an amendment, a notice of appeal and an appeal brief on the same date after the mailing of a final action, [37 CFR 1.116](#) applies. Such an amendment filed after a final action is not entered as a matter of right. It may be admitted if it cancels claims or complies with all requirements of form expressly set forth in previous Office actions; presents rejected claims in better form for consideration on appeal; or amends the specification, including claims, upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

If applicant files a reply under [37 CFR 1.111](#) in response to a second or subsequent non-final

rejection and later files a notice of appeal before the Office considers the reply, or the reply is filed on the same day as the notice of appeal, the notice of appeal is defective and the Office will answer the reply under [37 CFR 1.111](#) in due course. Ordinarily, a notice of appeal would have been proper when at least one claim has been twice rejected. In this instance, however, since applicant has elected to request reconsideration of the rejection (or further examination) by filing a reply under [37 CFR 1.111](#) rather than directly appealing from the second non-final rejection, the notice of appeal is premature. The Office has not had the opportunity to consider the reply under [37 CFR 1.111](#) and issue an Office action in view of the reply. (Note that this is different than after-final situations where a reply under [37 CFR 1.116](#) is not entered as matter of right and applicant is appealing from the final rejection). Applicant must wait to file any appeal until the examiner considers the reply and the claims are rejected again. Once the Office action is mailed in response to the reply applicant may file another notice of appeal under [37 CFR 41.31](#).

Under [37 CFR 41.31\(c\)](#), an applicant is presumed to be appealing all claims under rejection in a particular application unless cancelled by an amendment filed by the applicant and entered by the Office. Thus, an appeal is presumed to be taken from the rejection of all pending claims under rejection in the application regardless of whether the notice of appeal identifies fewer or more than all pending claims under rejection. If an appellant does not file an amendment cancelling claims that the appellant does not wish to appeal, but then also fails to provide any argument in the appeal brief directed to those claims, any challenge to that ground of rejection has been waived, and the Board has discretion to simply affirm any rejections against such claims. *See e.g. Hyatt v. Dudas*, 551 F.3d 1307, 1314, 89 USPQ2d 1465, 1470, (Fed. Cir. 2008). See also [MPEP § 1205.02](#).

Although the rules do not require that the notice of appeal be signed, applicants may file notices of appeal which are signed. It should be noted that the elimination of the requirement to sign a notice of appeal does not affect the requirements for other papers (such as an amendment under [37 CFR 1.116](#)) submitted with the notice, or for other actions

contained within the notice, e.g., an authorization to charge fees to a deposit account or to a credit card, to be signed. See [MPEP § 509](#). Thus, failure to sign the notice of appeal may have unintended adverse consequences; for example, if an unsigned notice of appeal contains an (unsigned) authorization to charge the notice of appeal fee to a deposit account, the notice of appeal will be unacceptable because the notice of appeal fee is lacking.

The notice of appeal must be filed within the period for reply set in the last Office action, which is normally three months for applications. See [MPEP § 714.13](#). For example, failure to remove all grounds of rejection and otherwise place an application in condition for allowance or to file an appeal after final rejection will result in the application becoming abandoned, even if one or more claims have been allowed. The notice of appeal and appropriate fee may be filed up to six months from the date of the Office action (e.g., a final rejection) from which the appeal was taken, so long as an appropriate petition and fee for an extension of time under [37 CFR 1.136\(a\)](#) is filed either prior to or with the notice of appeal.

The use of a separate letter containing the notice of appeal is strongly recommended. Form PTO/SB/31 may be used for filing a notice of appeal. Appellant must file an appeal brief in compliance with [37 CFR 41.37](#) accompanied by the fee set forth in [37 CFR 41.20\(b\)\(2\)](#) within two months from the date of filing the notice of appeal. See [MPEP § 1205](#). Effective March 19, 2013, the fee for filing an appeal brief in an application or *ex parte* reexamination was set at \$0. For as long as this fee remains at \$0, appeal briefs will not be held defective for failure to pay this fee or make any statement about this fee.

### III. APPEAL BY PATENT OWNER

[37 CFR 41.31\(a\)\(2\)](#) and [\(a\)\(3\)](#) provide for appeal to the Board by the patent owner from any decision in an *ex parte* reexamination proceeding adverse to patentability, in accordance with [35 U.S.C. 306](#) and [35 U.S.C. 134](#). See also [MPEP § 2273](#).

In an *ex parte* reexamination filed before November 29, 1999, the patent owner may appeal to the Board after the second rejection of the claims.

In an *ex parte* reexamination filed on or after November 29, 1999, the patent owner may appeal to the Board only after the final rejection of one or more claims in the particular reexamination proceeding for which appeal is sought.

The fee for filing the notice of appeal by a patent owner is set forth in [37 CFR 41.20\(b\)\(1\)](#), and the time period to pay the fee is determined as provided in [37 CFR 1.134](#) and [37 CFR 1.550\(c\)](#).

Failure to file an appeal in an *ex parte* reexamination proceeding will result in issuance of the reexamination certificate under [37 CFR 1.570](#).

Appeals to the Board in *inter partes* reexamination proceedings filed under [35 U.S.C. 311](#) are governed by [37 CFR 41.60](#) through [41.81](#). [37 CFR 41.30](#) through [41.54](#) are not applicable to appeals in *inter partes* reexamination proceedings. See [MPEP § 2674](#) to [§ 2683](#) for appeals in *inter partes* reexamination proceedings.

The use of a separate letter containing the notice of appeal is strongly recommended. Form PTO/SB/31 or Form PTO/AIA/31 may be used for filing a notice of appeal.

PTO/AIA/31 (03-14)

Approved for use through 08/31/2017. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD</b>		Docket Number (Optional)								
I hereby certify that this correspondence is being facsimile transmitted to the USPTO, EFS-Web transmitted to the USPTO, or deposited with the United States Postal Service with sufficient postage in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, on Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____. Signature _____ Typed or printed name _____	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="padding: 5px;">In re Application of</td> </tr> <tr> <td style="width: 60%; padding: 5px;">Application Number</td> <td style="padding: 5px;">Filed</td> </tr> <tr> <td colspan="2" style="padding: 5px;">For</td> </tr> <tr> <td style="padding: 5px;">Art Unit</td> <td style="padding: 5px;">Examiner</td> </tr> </table>		In re Application of		Application Number	Filed	For		Art Unit	Examiner
In re Application of										
Application Number	Filed									
For										
Art Unit	Examiner									
Applicant hereby <b>appeals</b> to the Patent Trial and Appeal Board from the last decision of the examiner.										
The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ _____										
<input type="checkbox"/> Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 50%, and the resulting fee is: \$ _____										
<input type="checkbox"/> Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 75%, and the resulting fee is: \$ _____ Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.										
<input type="checkbox"/> A check in the amount of the fee is enclosed.										
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.										
<input type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____.										
<input type="checkbox"/> Payment made via EFS-Web.										
<input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/AIA/22 or equivalent) is enclosed. For extensions of time in reexamination proceedings, see 37 CFR 1.550.										
<b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b>										
I am the										
<input type="checkbox"/> applicant										
<input type="checkbox"/> attorney or agent of record Registration number _____										
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number _____										
Signature _____										
Typed or printed name _____										
Telephone Number _____										
Date _____										
<b>NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.</b>										
<input type="checkbox"/> * Total of _____ forms are submitted.										

This collection of information is required by 37 CFR 41.20(b)(1) and 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

### Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



#### IV. ACKNOWLEDGEMENT

Appellant may check the status of the application and the receipt date of the notice of appeal on the Office's Patent Application Information Retrieval (PAIR) system via the Internet.

Where the notice of appeal is filed by mail, the Office does not acknowledge receipt by separate letter. However, if a self-addressed postcard is included with the notice of appeal, it will be date stamped and mailed. See [MPEP § 503](#), subsection III.

#### V. DEFECTIVE NOTICE OF APPEAL

Notices of appeal are reviewed by the Patent Appeal Center. If a notice of appeal is defective, the Office will notify the applicant of the non-compliance. A notice of appeal is not a proper reply to the last Office action if none of applicant's claims have been twice rejected. A notice of appeal is defective if it was not timely filed within the time period set forth in the last Office action, or the notice of appeal fee

set forth in [37 CFR 41.20\(b\)\(1\)](#) was not timely filed. Form PTOL-461 (Rev. 9-04 or later), Communication Re: Appeal, should be used to indicate defects in a notice of appeal. This communication is done by the Patent Appeal Center rather than by the examiner. In the rare event that these defects are identified after the notice of appeal is entered, the examiner should contact the Patent Appeal Center to determine the appropriate action to take.

When appellant files an appeal brief without first filing a notice of appeal, the Office treats the appeal brief as a notice of appeal and an appeal brief. For this situation, appellant must file the brief within the time period for reply set forth in the last Office action and the brief must be accompanied by the fees under [37 CFR 41.20\(b\)\(1\) and \(b\)\(2\)](#) for filing a notice of appeal and an appeal brief in compliance with [37 CFR 41.31](#) and [41.37](#). Effective March 19, 2013, the fee for filing an appeal brief in an application or *ex parte* reexamination was set at \$0. For as long as this fee remains at \$0, appeal briefs will not be held defective for failure to pay this fee or make any statement about this fee.

<b>Communication Re: Appeal</b>	Application No.	Applicant(s)
	Examiner	Art Unit

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

1. ☐ The Notice of Appeal filed on \_\_\_\_\_ is not acceptable because:

- (a) ☐ it was not timely filed.
- (b) ☐ the statutory fee for filing the appeal was not submitted. See 37 CFR 41.20(b)(1).
- (c) ☐ the appeal fee received on \_\_\_\_\_ was not timely filed.
- (d) ☐ the submitted fee of \$\_\_\_\_\_ is insufficient. The appeal fee required by 37 CFR 41.20(b)(1) is \$\_\_\_\_\_.
- (e) ☐ the appeal is not in compliance with 37 CFR 41.31(a)(1) in that no claim has been twice rejected.
- (f) ☐ a Notice of Allowability, PTO-37, was mailed by the Office on \_\_\_\_\_.

2. ☐ The appeal brief filed on \_\_\_\_\_ is NOT acceptable for the reason(s) indicated below:

- (a) ☐ the brief and/or brief fee is untimely. See 37 CFR 41.37(a).
- (b) ☐ the statutory fee for filing the brief has not been submitted. See 37 CFR 41.20(b)(2).
- (c) ☐ the submitted brief fee of \$\_\_\_\_\_ is insufficient. The brief fee required by 37 CFR 41.20(b)(2) is \$\_\_\_\_\_.

**The appeal in this application will be dismissed unless corrective action is taken to timely submit the brief and requisite fee. See 37 CFR 41.37(a)(1). Extensions of time may be obtained under 37 CFR 1.136(a). See 37 CFR 41.37(e).**

3. ☐ The appeal in this application is DISMISSED because:

- (a) ☐ the statutory fee for filing the brief as required under 37 CFR 41.20(b)(2) was not timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (b) ☐ the brief was not timely filed and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.
- (c) ☐ a Request for Continued Examination (RCE) under 37 CFR 1.114 was filed on \_\_\_\_\_.
- (d) ☐ other: \_\_\_\_\_.

4. ☐ Because of the dismissal of the appeal, this application:

- (a) ☐ is abandoned because there are no allowed claims.
- (b) ☐ is before the examiner for final disposition because it contains allowed claims. Prosecution on the merits remains CLOSED.
- (c) ☐ is before the examiner for consideration.

### 1204.01 Reinstatement of Appeal [R-11.2013]

If an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a new notice of appeal in compliance with [37 CFR 41.31](#) and a complete new appeal brief in compliance with [37 CFR 41.37](#). Any previously paid appeal fees set forth in [37 CFR 41.20](#) for filing a notice of appeal, filing an appeal brief (if applicable), requesting an oral hearing (if applicable) and forwarding the appeal to the Board (if applicable) will be applied to the new appeal on the same application as long as a final Board decision has not been made on the prior appeal. If, however, the appeal fees have increased since they were previously paid, then appellant must pay the difference between the current fee(s) and the amount previously paid. Appellant must file a complete new appeal brief in compliance with the format and content requirements of [37 CFR 41.37\(c\)](#) within two months from the date of filing the new notice of appeal. See [MPEP § 1205](#).

### 1204.02 Pre-Appeal Brief Review Request and Conference Pilot Program [R-08.2017]

Since July of 2005 the Office has provided an ongoing pilot program in which an appellant, upon the filing of a notice of appeal may also request a pre-appeal brief review. See [“Pre-Appeal Brief Conference Pilot Program,” 1296 OG 67 \(July 12, 2005\)](#) and [“Extension of the Pilot Pre-Appeal Brief Conference Program,” 1303 OG 21 \(February 7, 2006\)](#). This program does not apply to reexamination proceedings. Presenting a request for pre-appeal brief review does not change the fee required to file a notice of appeal and does not require a separate fee. No extensions of time to file the request for review later than the notice of appeal are available.

In order to be proper the applicant must file a notice of appeal in compliance with [37 CFR 41.31](#). The request for pre-appeal brief review must be filed with the filing of the notice of appeal and before the filing of an appeal brief. Form PTO/AIA/33, “Pre-Appeal Brief Request for Review” may be used for filing the request. The request must be accompanied by arguments in a separate paper entitled, “Pre-Appeal Brief Request for Review”. The request may not exceed five (5) total pages and

should provide a succinct, concise and focused set of arguments for which the review is being requested. Requests are limited to appealable, not petitionable matters. See [MPEP § 1201](#). A request that fails to comply with these requirements should be dismissed.

Upon receipt of a properly filed request, a supervisor will designate a panel of appropriate reviewers to review the appellant's remarks and the examiner's rejections. The panel will include at least a supervisor and the examiner of record and will have the authority to reopen prosecution if appropriate. The appellant will not be permitted to attend the review and no interviews will be granted prior to issuance of the pre-appeal brief review decision.

After the review is complete, the Office will mail a decision on the status of the application. The decision will state one of the following:

- (A) The application remains under appeal because there is at least one actual issue for appeal.
- (B) Prosecution on the merits is reopened and an appropriate Office communication will follow in due course. In appropriate circumstances, a proposed amendment may accompany the panel's decision proposing changes that, if accepted, may result in an indication of allowability for the contested claim(s).
- (C) The application is allowed on the existing claims and prosecution remains closed.
- (D) The request fails to comply with the submission requirements and is dismissed.

The panel's review will be terminated if the applicant files any of the following responses after filing a request, but prior to a decision by the appointed panel of examiners assigned to conduct the review.

- (A) An appeal brief.
- (B) A request for continued examination.
- (C) An after final amendment.
- (D) An affidavit or other evidence.
- (E) An express abandonment.

After a panel decision, the time period for filing an appeal brief will be reset to be one month from the

mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever greater. Further, the time period for filing of the appeal brief is extendible under [37 CFR 1.136](#).

For as long as this pilot program remains in effect, submission of a pre-appeal review request may extend the period for filing an appeal brief until a decision is made on the request or the request is otherwise dismissed.

### **1204.03 Interviews After Notice of Appeal [R-11.2013]**

As indicated in [MPEP § 713.09](#), one interview after final rejection is normally permitted. Where a notice of appeal is filed in an application or *ex parte* reexamination, the phrase "after final rejection" includes only the time from the mailing of the final rejection through the filing of an appeal brief. However, as indicated in the notice ["Pre-Appeal Brief Conference Pilot Program," 1296 OG 76 \(July 12, 2005\)](#), no interviews will be granted from the filing of a request for pre-appeal review through issuance of a decision on the request. See [MPEP § 1204.02](#).

Except in unusual situations, no interview is permitted after the appeal brief is filed. See [MPEP § 713.05](#). Where an appeal brief is filed in an application or *ex parte* reexamination, the phrase "after the appeal brief is filed" includes the time from filing of the appeal brief through the first of a decision by the Board, the mailing by the examiner of a rejection or other paper with a response period, the mailing of a notice of defective appeal brief, or the mailing of a notice of allowance.

Effective March 19, 2013, [37 CFR 41.20\(b\)\(4\)](#) sets a fee to forward an appeal to the Board after the mailing of an examiner's answer. While appellants may desire an interview after mailing of an examiner's answer and prior to payment of this fee, interviews during this time period are likely to confuse the record on appeal and are not permitted except in unusual situations. These unusual circumstances may include situations where appellant wishes to cancel all appealed claims and proceed to issue with claims previously indicated as

allowable, or where the examiner is convinced that some but not all of the previously rejected claims are in condition for allowance.

After the time specified in [37 CFR 41.35\(a\)](#), the application or *ex parte* reexamination is no longer under the jurisdiction of the examiner. While the examiner has no jurisdiction over a proceeding after the time set in [37 CFR 41.35\(a\)](#), the Director of the USPTO or appropriate delegate has the authority to remand the proceeding to the examiner under [37 CFR 41.35\(c\)](#). Requests for interviews on cases under the jurisdiction of the Board should be granted only with specific approval of the Technology Center Director upon a showing in writing of extraordinary circumstances that justify a remand from the Board to the examiner in order to conduct an interview.

### **1204.04 Official Record on Appeal [R-08.2017]**

#### *37 CFR 41.30 Definitions.*

\*\*\*\*\*

*Evidence* means something (including testimony, documents and tangible objects) that tends to prove or disprove the existence of an alleged fact, except that for the purpose of this subpart *Evidence* does not include dictionaries, which may be cited before the Board.

\*\*\*\*\*

*Record* means the items listed in the content listing of the Image File Wrapper of the official file of the application or reexamination proceeding on appeal or the official file of the Office if other than the Image File Wrapper, excluding amendments, Evidence, and other documents that were not entered. In the case of an issued patent being reissued or reexamined, the *Record* further includes the *Record* of the patent being reissued or reexamined.

The official record on appeal contains the items listed in the content listing of the Image File Wrapper or the official file of the Office if other than the Image File Wrapper, excluding any amendments, evidence, or other documents that were not entered or indicated considered by the examiner. Because an examiner's refusal to enter an amendment, evidence, or other document is a petitionable matter that is not subject to review by the Board, the exclusion of such non-entered documents from the definition of "Record" reflects the fact that the Board's review of patentability determinations is

properly based on the record of all entered and indicated considered documents in the file.

An information disclosure statement or petition that is held in abeyance while the Board possesses jurisdiction over the proceeding is not an entered or indicated considered document and therefore is excluded from the definition of “Record” until such time as it is entered or indicated to have been considered.

The definition of “Record” includes the items listed in the content listing of the Image File Wrapper because, in some cases, physical items that form part of the official file are not able to be scanned into the Image File Wrapper and are maintained elsewhere, such as in an artifact file. Some examples of such items include original drawings in design patent applications and sequence listings. In such cases, the Image File Wrapper will include an entry in the content listing that points to this artifact file or other record.

In the case of an issued patent being reissued or reexamined, the Record further includes the Record of the patent being reissued or reexamined.

All references listed on an Information Disclosure Statement (i.e., Form PTO/SB/08a or 08b), which have been indicated as having been considered by the examiner, or listed on a form PTO-892 are included in the definition of Record even if each of the so listed references does not separately appear in the content listing of the Image File Wrapper.

For the purposes of appeal, “Evidence” does not encompass dictionaries. Excluding dictionaries from the definition of “Evidence” thus allows appellants to refer to dictionaries in their briefs, which would otherwise be precluded under [37 CFR 41.33\(d\)\(2\)](#) (absent existence of one of the enumerated exceptions). It further allows examiners to refer to dictionaries in the examiner’s answers without automatically rendering a rejection a new ground under [37 CFR 41.39\(a\)\(2\)](#). Treating dictionaries in this manner is consistent with Supreme Court and Federal Circuit precedent, which contemplate that such materials may be consulted by tribunals “at any time.” See, e.g., *Nix v. Hedden*, 149 U.S. 304, 307 (1893) (citations omitted) (admitting dictionaries

to understand the ordinary meaning of terms “not as evidence, but only as aids to the memory and understanding of the court”); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1322–23, 75 USPQ2d 1321, 1333 (Fed. Cir. 2005) (*en banc*) (“[J]udges are free to consult dictionaries and technical treatises at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.”) (citation omitted); *In re Boon*, 439 F.2d 724, 727–28, 169 USPQ 231, 234 (CCPA 1971) (holding citation to dictionary was not tantamount to the assertion of a new ground of rejection “where such a reference is a standard work, cited only to support a fact judicially noticed and, as here, the fact so noticed plays a minor role, serving only to fill in the gaps which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection.” (emphasis and internal quotations omitted)). Thus, [37 CFR 41.30](#) permits both the applicant and examiner to submit them to the Board during the briefing stage.

## 1205 Appeal Brief [R-11.2013]

### *37 CFR 41.37 Appeal brief.*

(a) *Timing.* Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § [41.31](#). The appeal brief fee in an application or *ex parte* reexamination proceeding is \$0.00, but if the appeal results in an examiner’s answer, the appeal forwarding fee set forth in § [37 CFR 41.20\(b\)\(4\)](#) must be paid within the time period specified in § [41.45](#) to avoid dismissal of an appeal.

(b) *Failure to file a brief.* On failure to file the brief within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

### (c) *Content of appeal brief.*

(1) Except as otherwise provided in this paragraph, the brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (v) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i), (c)(1)(ii), (c)(1)(iv), and (c)(1)(v) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest at the time the appeal brief is filed, except that such statement is not required if the named inventor or inventors are themselves the real party in interest. If an appeal brief does not contain a statement of the real party in interest, the Office may assume that the named inventor or inventors are the real party in interest.



(ii) *Related appeals, interferences, and trials.* A statement identifying by application, patent, appeal, interference, or trial number all other prior and pending appeals, interferences, trials before the Board, or judicial proceedings (collectively, "related cases") which satisfy all of the following conditions: involve an application or patent owned by the appellant or assignee, are known to appellant, the appellant's legal representative, or assignee, and may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal, except that such statement is not required if there are no such related cases. If an appeal brief does not contain a statement of related cases, the Office may assume that there are no such related cases.

(iii) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the rejected independent claims, which shall refer to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters. For each rejected independent claim, and for each dependent claim argued separately under the provisions of paragraph (c)(1)(iv) of this section, if the claim contains a means plus function or step plus function recitation as permitted by [35 U.S.C. 112\(f\)](#), then the concise explanation must identify the structure, material, or acts described in the specification in the Record as corresponding to each claimed function with reference to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters. Reference to the patent application publication does not satisfy the requirements of this paragraph.

(iv) *Argument.* The arguments of appellant with respect to each ground of rejection, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the Record relied on. The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant. Except as provided for in §§ [41.41](#), [41.47](#) and [41.52](#), any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal. Each ground of rejection contested by appellant must be argued under a separate heading, and each heading shall reasonably identify the ground of rejection being contested (e.g., by claim number, statutory basis, and applied reference, if any). For each ground of rejection applying to two or more claims, the claims may be argued separately (claims are considered by appellant as separately patentable), as a group (all claims subject to the ground of rejection stand or fall together), or as a subgroup (a subset of the claims subject to the ground of rejection stand or fall together). When multiple claims subject to the same ground of rejection are argued as a group or subgroup by appellant, the Board may select a single claim from the group or subgroup and may decide the appeal as to the ground of rejection with respect to the group or subgroup on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or as a subgroup shall be argued under a separate subheading that identifies the claim(s) by number. A statement which merely points out what a claim

recites will not be considered an argument for separate patentability of the claim.

(v) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence. See § [37 CFR 1.116](#) of this title for treatment of amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § [41.33](#) for treatment of amendments, affidavits or other Evidence filed after the date of filing the appeal. Review of an examiner's refusal to admit an amendment or Evidence is by petition to the Director. See § [1.181](#) of this title.

(d) *Notice of non-compliance.* If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not, within the set time period, file an amended brief that overcomes all the reasons for non-compliance stated in the notification, the appeal will stand dismissed. Review of a determination of non-compliance is by petition to the Chief Administrative Patent Judge. See § [41.3](#).

(e) *Extensions of time.* The time periods set forth in this section are extendable under the provisions of § [1.136](#) of this title for patent applications and § [1.550\(c\)](#) of this title for *ex parte* reexamination proceedings.

## 1205.01 Time for Filing Appeal Brief [R-08.2017]

[37 CFR 41.37\(a\)](#) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief and the appeal brief fee set forth in [37 CFR 41.20\(b\)\(2\)](#). Any brief in an application or an *ex parte* reexamination proceeding filed on or after March 19, 2013 need not be accompanied by an appeal brief fee as the [37 CFR 41.20\(b\)\(2\)](#) fee amount on or after that date is set at \$0.

The usual period of time in which appellant must file his or her brief is 2 months from the date of the notice of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under [37 CFR 1.8](#)) is the date from which this 2-month time period is measured. See [MPEP § 512](#). If the notice of appeal is filed in accordance with [37 CFR 1.10](#) using the Priority Mail Express<sup>®</sup> service of the United States Postal Service (USPS), the date of deposit with the USPS is the date from which this 2-month time period is measured because the date of deposit shown by the "date accepted" on the Priority Mail Express<sup>®</sup> label

or other official USPS notation is considered to be the date of receipt. See [MPEP § 513](#).

[37 CFR 41.37\(a\)](#) does not permit the brief to be filed within the time allowed for reply to the action from which the appeal was taken even if such time is later. Once appellant timely files a notice of appeal in compliance with [37 CFR 41.31](#), the time period for reply set forth in the last Office action is tolled and is no longer relevant for the time period for filing an appeal brief. For example, if appellant filed a notice of appeal within one month from the mailing of a final Office action which sets forth a 3-month shortened statutory period for reply, and then the appellant filed an appeal brief after 2 months from the filing date of the notice of appeal, a petition for an extension of time for one month would be required, even if the brief was filed but within three (3) months from the mailing of the final action. Similarly, if the appellant files a request for continued examination (RCE) under [37 CFR 1.114](#), instead of an appeal brief, after two (2) months from the filing date of the notice of appeal a petition for an extension of time would be required, even if the RCE was filed within three (3) months from the mailing of the final action.

This 2-month time period for a patent application may be extended under [37 CFR 1.136\(a\)](#), and if [37 CFR 1.136\(a\)](#) is not available, under [37 CFR 1.136\(b\)](#) for extraordinary circumstances. In an *ex parte* reexamination proceeding, the time period can be extended only under the provisions of [37 CFR 1.550\(c\)](#). See also [MPEP § 2274](#).

In the event that the appellant finds that they are unable to file a brief within the time period allotted by the rule, they may file a petition for extension of time under [37 CFR 1.136\(a\)](#) with the appropriate fee. Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved under [37 CFR 1.136\(b\)](#). Where a proper petition for extension of time is filed, the new due date is computed from the receipt date of the notice of appeal, as opposed to the original due date. For example, if a notice of appeal's receipt date is December 30, the appeal brief would be due on the following February 28 (or 29, if it is a leap year), if not a Saturday, Sunday or federal holiday. If the period for filing an appeal brief is extended by one

month the appeal brief would be due on March 30, if not a Saturday, Sunday, or federal holiday.

#### ¶ 12.210 Extension To File Brief - Granted

The request for an extension of time under [37 CFR 1.136\(b\)](#) for filing the appeal brief under [37 CFR 41.37](#) filed on [1] has been **approved** for [2].

##### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 2, insert the amount of time the extension of time has been approved for.
3. This form paragraph should only be used when [37 CFR 1.136\(a\)](#) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in [37 CFR 41.39\(b\)](#) and [37 CFR 41.50\(a\)\(2\)](#).

#### ¶ 12.211 Extension To File Brief - Denied

The request for an extension of time under [37 CFR 1.136\(b\)](#) for filing the appeal brief under [37 CFR 41.37](#) filed on [1] has been **disapproved** because no sufficient cause for the extension has been shown.

##### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. This form paragraph should only be used when [37 CFR 1.136\(a\)](#) is not available or has been exhausted, such as in litigation reissues or when appellant requests to reopen prosecution or file a reply brief as set forth in [37 CFR 41.39\(b\)](#) and [37 CFR 41.50\(a\)\(2\)](#).

When an application is revived after abandonment for failure on the part of the appellant to take appropriate action after final rejection, and the petition to revive was accompanied by a notice of appeal, appellant has 2 months, from the mailing date of the Director's affirmative decision on the petition, in which to file the appeal brief. The time period for filing the appeal brief may be extended under [37 CFR 1.136](#).

#### FAILURE TO TIMELY FILE AN APPEAL BRIEF

The appeal ordinarily will be dismissed if the brief is not filed within the period provided by [37 CFR 41.37\(a\)](#) or within such additional time as may be properly extended. Effective March 19, 2013, the statutory fee for filing an appeal brief was adjusted to \$0. As long as the fee under [37 CFR 41.20\(b\)\(2\)](#) remains \$0, the appeal will not be dismissed for failure to pay the fee.

A brief must be filed to preserve appellant's right to the appealed claims, notwithstanding circumstances such as:

(A) the filing of a petition to invoke the supervisory authority of the Director under [37 CFR 1.181](#);

(B) the filing of an amendment, even if it is one which the examiner previously has indicated may place one or more claims in condition for allowance, unless the examiner, in acting on the amendment, disposes of all issues on appeal;

(C) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner withdrawing the final rejection from which appeal has been taken.

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See [MPEP § 1215.04](#). If there are no allowed claims, the application is abandoned as of the date the brief was due. Claims which have been objected to as dependent from a rejected claim do not stand allowed. In an *ex parte* reexamination proceeding, failure to file the brief will result in the issuance of the certificate under [37 CFR 1.570](#).

#### ¶ 12.209 Appeal Dismissed - Allowed Claims, Formal Matters Remaining

In view of applicant's failure to file a brief within the time prescribed by [37 CFR 41.37\(a\)](#), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See [37 CFR 1.197\(b\)](#).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire TWO MONTHS from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under [37 CFR 1.136](#).

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.

2. This form paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See [MPEP § 1215.04](#).

3. In bracket 2, insert a description of the formal matters to be corrected.

4. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See [MPEP § 1215.04](#).

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application under [37 CFR 1.137](#), as in other cases of abandonment. See [MPEP § 711.03\(c\)](#). If the appeal is dismissed, but the application is not abandoned because there is at least one allowed claim, the applicant may file a petition to reinstate the claims and the appeal, but a showing equivalent to that in a petition to revive under [37 CFR 1.137](#) is required. See [MPEP § 711.03\(c\)](#). In addition to the petition and petition fee, appellant must file:

(A) A request for continued examination (RCE) under [37 CFR 1.114](#) accompanied by a submission (i.e., a reply under [37 CFR 1.111](#)) and the fee as set forth in [37 CFR 1.17\(e\)](#) if the application is a utility or plant application filed on or after June 8, 1995, or a continuing application under [37 CFR 1.53\(b\)](#) (or a CPA under [37 CFR 1.53\(d\)](#) if the application is a design application); or

(B) An appeal brief and the appeal brief fee to reinstate the appeal. Effective March 19, 2013, the statutory fee for filing an appeal brief in an application or *ex parte* reexamination proceeding was adjusted to \$0. For so long as the fee under [37 CFR 41.20\(b\)\(2\)](#) remains \$0, the appeal will not be dismissed for failure to pay the fee. A proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be in error, filing a petition, pointing out the error, may be sufficient.

## 1205.02 Appeal Brief Content [R-08.2017]

Only one copy of the appeal brief is required. Any brief for which the notice of appeal was filed on or after January 23, 2012 must comply with the requirements set forth in current [37 CFR 41.37](#). For

information pertaining to the Board's *ex parte* appeal practice and procedure that is applicable if the notice of appeal was filed before January 23, 2012 (or if proceedings were commenced before September 16, 2012), see Chapter 1200 in the MPEP 8th Edition, Rev. 9 (August 2012)(available on the USPTO web site at [www.uspto.gov/web/offices/pac/mpep.htm](http://www.uspto.gov/web/offices/pac/mpep.htm)).

Appellant must file a brief under [37 CFR 41.37](#) within two months from the date of filing the notice of appeal under [37 CFR 41.31](#). The appeal brief fee in an application or *ex parte* reexamination proceeding is \$0.00. For so long as the adjusted fee for filing an appeal brief remains at \$0, the brief need not be accompanied by an attempt to pay the fee under [37 CFR 41.20\(b\)\(2\)](#). A brief that is filed on or after January 23, 2012 that fails to comply with the requirements set forth in [37 CFR 41.37\(c\)](#) shall be held to be non-compliant under [37 CFR 41.37\(d\)](#). The brief, as well as every other document relating to an appeal, should indicate the number of the Technology Center (TC) to which the application or patent under reexamination is assigned and the application or reexamination control number. Oral argument at a hearing will not remedy deficiencies in a brief. The following discussion of the contents of an appeal brief pertains to briefs filed pursuant to the requirements set forth in [37 CFR 41.37](#).

An appellant's brief must present arguments responsive to every ground of rejection stated by the examiner in the Office action from which the appeal has been taken (as modified by any advisory action and/or pre-appeal brief conference decision). See [37 CFR 41.31\(c\)](#) and [37 CFR 41.37\(c\)\(1\)\(iv\)](#). If a ground of rejection stated by the examiner is not addressed in the appellant's brief, appellant has waived any challenge to that ground of rejection and the Board may summarily sustain it, unless the examiner subsequently withdrew the rejection in the examiner's answer. See [37 CFR 41.39\(a\)\(1\)](#). The fact that appellant may consider a ground to be clearly improper does not justify failure to point out to the Board the reasons for that belief, including an explanation of why the examiner erred as to the ground of rejection.

The mere filing of a document titled as a brief will not necessarily be considered to be in compliance

with [37 CFR 41.37\(c\)](#). The rule requires that the brief must set forth arguments and the basis therefor, with citations of the statutes, regulations, authorities and parts of the record relied upon. It is essential that the Board be provided with a brief fully stating the position of the appellant with respect to each ground of rejection presented for review in the appeal so that no search of the Record is required in order to determine that position. Thus, the brief should not incorporate or reference previous responses. [37 CFR 41.37\(c\)\(1\)](#) requires that the brief contain specific items, as discussed below. The brief must have all of the required items under appropriate headings in the order indicated in [37 CFR 41.37\(c\)\(1\)](#). [37 CFR 41.37\(c\)\(1\)](#) provides that in certain circumstances, the items listed in paragraphs (c)(1)(i) and (c)(1)(ii) may be omitted from an appeal brief and further provides that the Office may assume certain information about the appeal should these items be omitted from the appeal brief. As such, the headings are not required to be included in the appeal brief in the event that an item is not applicable (i.e., the real party in interest is the inventor(s), or there are no related appeals). To assist appellants in complying with [37 CFR 41.37](#), the Board has posted checklists for notices of appeal and appeal briefs on the USPTO Web site at [www.uspto.gov/patents-application-process/appealing-patent-decisions/procedures/guidance-reduce-non-compliant](http://www.uspto.gov/patents-application-process/appealing-patent-decisions/procedures/guidance-reduce-non-compliant).

An exception to the requirement that all the items specified in [37 CFR 41.37\(c\)\(1\)](#) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro se* appellant which does not contain all of the items specified in [37 CFR 41.37\(c\)\(1\)](#) will be accepted as long as it substantially complies with the requirements of subparagraphs (i), (ii), (iv) and (v).

While it is no longer a requirement to include an evidence appendix, the Office strongly encourages and appreciates receiving copies of the evidence relied upon (e.g., copies of declarations and affidavits, evidence of secondary considerations, etc.). This ensures that the Board is considering the proper evidence and avoids any confusion as to the particular evidence referenced in the appeal brief.



In the alternative, the Board recommends that appellants clearly identify in the appeal brief the evidence relied upon using a clear description of the evidence along with the date of entry of such evidence into the Image File Wrapper.

An amendment or other evidence submitted under [37 CFR 1.116](#) or [37 CFR 41.33](#) will not be entered as part of the record for the appeal unless entered by the examiner.

The specific items required by [37 CFR 41.37\(c\)\(1\)](#) are:

(i) *Real party in interest.* A statement identifying by name the real party in interest at the time the appeal brief is filed, except that such statement is not required if the named inventor or inventors are themselves the real party in interest. If an appeal brief does not contain a statement of the real party in interest, the Office may assume that the named inventor or inventors are the real party in interest.

The identification of the real party in interest allows members of the Board to comply with ethics regulations associated with working in matters in which the member has a financial interest to avoid any potential conflict of interest. When an application is assigned to a subsidiary corporation, the real party in interest is both the assignee and either the parent corporation or corporations, in the case of joint ventures. One example of a statement identifying the real party in interest is: The real party in interest is XXXX corporation, the assignee of record, which is a subsidiary of a joint venture between YYYY corporation and ZZZZ corporation.

(ii) *Related appeals, interferences, and trials.* A statement identifying by application, patent, appeal, interference, or trial number all other prior and pending appeals, interferences, trials before the Board, or judicial proceedings (collectively, "related cases") which satisfy all of the following conditions: Involve an application or patent owned by the appellant or assignee; are known to appellant, the appellant's legal representative, or assignee; and may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. If there are no such related cases, the appellant is not required to include the

statement, and if the appellant has not included the statement, then the Office may assume that there are no such related cases.

The rule does not require Appellant to provide copies of decisions in related cases.

(iii) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the rejected independent claims, which shall refer to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters. For each rejected independent claim, and for each dependent claim argued separately under the provisions of paragraph (c)(1)(iv) of this section, if the claim contains a means plus function or step plus function recitation as permitted by [35 U.S.C. 112\(f\)](#), then the concise explanation must identify the structure, material, or acts described in the specification in the Record as corresponding to each claimed function with reference to the specification in the Record by page and line number or by paragraph number, and to the drawing, if any, by reference characters. Reference to the patent application publication does not satisfy the requirements of this paragraph.

(iv) *Argument.* The arguments of appellant with respect to each ground of rejection and the basis therefor, including citations of statutes, regulations, authorities and parts of the Record relied on, should be presented in this section. The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant. See *Ex parte Frye*, 94 USPQ2d 1072, 1075-76 (BPAI 2010) (per curiam) (precedential) and *In re Jung*, 637 F.3d 1356, 98 USPQ2d 1174 (Fed. Cir. 2011). A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

[37 CFR 41.37\(c\)\(1\)\(iv\)](#) contains the following sentence:

Except as provided for in §§ 41.41, 41.47 and 41.52, any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.



This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider for purposes of the present appeal should be included in the appeal brief. It should be noted that arguments not presented in the briefs and made for the first time at the oral hearing are not normally entitled to consideration except as provided for in [37 CFR 41.47](#). *In re Chiddix*, 209 USPQ 78 (Comm'r Pat. 1980); *Rosenblum v. Hiroshima*, 220 USPQ 383 (Comm'r Pat. 1983).

This sentence is not intended to preclude the filing of a supplemental brief or document if new authority should become available or relevant after the brief or reply brief was filed. An example of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief or reply brief was filed.

This sentence is also limited to “the present appeal” and is not intended to extend the Board’s refusal to consider other arguments or authorities to subsequent appeals in the same application or to appeals in other applications.

Each ground of rejection must be argued under a separate heading, which clearly identifies the ground of rejection being contested. For each ground of rejection applying to two or more claims, the claims may be argued separately (claims are considered by appellants as separately patentable), as a group (all claims subject to the ground of rejection stand or fall together), or as a subgroup (a subset of the claims subject to the ground of rejection stand or fall together). When multiple claims subject to the same ground of rejection are argued as a group or subgroup by appellant, the Board may select a single claim from the group of claims and may decide the appeal as to the ground of rejection with respect to the group or subgroup of claims as to the ground of rejection on the basis of the selected claim alone. The failure of appellant to separately argue claims which appellant has grouped together constitutes a waiver of any argument that the Board must consider the patentability of any grouped claim separately. See *In re McDaniel*, 293 F.3d 1379, 1384, 63 USPQ2d 1462, 1465-66 (Fed. Cir. 2002). Under each heading identifying the ground of rejection being contested, any claim(s) argued separately or

as a subgroup shall be placed under a separate subheading that identifies the claim(s) by number.

For example, if Claims 1 to 5 stand rejected under [35 U.S.C. 102\(a\)\(2\)](#) as being anticipated by U.S. Patent No. Y and appellant is arguing only the limitations of independent claim 1, and thereby grouping dependent claims 2 to 5 to stand or fall with independent claim 1, then one possible heading as required by this subsection could be “Rejection under 35 U.S.C. 102(a)(2) over U.S. Patent No. Y” and an optional subheading would be “Claims 1 to 5.” Another example is where claims 1 to 3 stand rejected under [35 U.S.C. 102\(a\)\(2\)](#) as being anticipated by U.S. Patent No. Z and appellant wishes to argue separately the patentability of each claim, a possible heading as required by this subsection could be “Rejection under 35 U.S.C. 102(a)(2) over U.S. Patent No. Z,” and the required subheadings would be “Claim 1,” “Claim 2” and “Claim 3.” Under each subheading the appellant would present the argument for patentability of that claim. Another example is where claims 1-10 stand rejected under [35 U.S.C. 102\(a\)\(2\)](#) as being anticipated over U.S. Patent No. X and appellant wishes to argue claims 1-3 as a first subgroup, claim 4 separately, and claims 5-10 as another subgroup. A possible heading as required by this subsection could be “Rejection under 35 U.S.C. 102(a)(2) over U.S. Patent No. X,” and the required subheadings would be “Claims 1-3,” “Claim 4,” and “Claims 5-10.” To make certain that an argument for separate consideration of a claim or subgroup of claims is not overlooked by the examiner or by the Board, the rule requires appellant to use a subheading for each claim for which separate consideration by the Board is desired.

(v) *Claims appendix*. An appendix containing a copy of the claims involved in the appeal.

The copy of the claims should be a clean copy and should not include any markings such as brackets or underlining except for claims in a reissue application and a reexamination proceeding. See [MPEP § 1454](#) for the presentation of the copy of the claims in a reissue application. See [37 CFR 1.530\(d\)](#) and (f) for reexamination proceedings, see also [MPEP § 2274](#) for *ex parte* reexamination and [MPEP § 2675](#) for *inter partes* reexamination.

The copy of the claims should be double-spaced and the appendix should start on a new page. [37 CFR 41.37\(c\)\(1\)](#) merely specifies the minimum requirements for a brief. An appellant may include in the brief a list of references, table of contents, table of cases, copies of evidence entered by the examiner and relied upon in the brief, etc. A brief is in compliance with [37 CFR 41.37\(c\)\(1\)](#) as long as it includes items (i) to (v) in the order set forth and does not include prohibited material.

[37 CFR 41.37\(c\)\(2\)](#) prohibits the inclusion in a brief of any new or non-admitted amendment, affidavit or other evidence. If an appellant wishes to seek review of an examiner's refusal to admit an amendment, affidavit or evidence, such review is by petition to the Director under [37 CFR 1.181](#). The time for filing this petition, described in [37 CFR 1.181\(f\)](#), is based on the date the examiner refused to enter the amendment, affidavit or evidence and not the date the brief is filed.

An example of a format and content for an appeal brief for a patent application is a brief containing the following items, with each item starting on a separate page:

(A) Identification page setting forth the applicant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Appeal Brief);

(B) Table of Contents page(s);

(C) Real party in interest page(s);

(D) Related appeals, interferences, and trials page(s);

(E) Summary of claimed subject matter page(s);

(F) Argument page(s);

(G) Claims appendix page(s);

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal. If an appellant wishes to remove claims from consideration on appeal, the appellant must submit an amendment to cancel the claims from the application. See [37 CFR 41.31\(c\)](#) and [37 CFR 41.33](#).

An appellant may, of course, choose not to present arguments or rely upon particular evidence as to certain claim rejections; however, such arguments and evidence are waived for purposes of the appeal and the Board may summarily sustain any grounds of rejections not argued. Examiners should no longer follow the practice described in *Ex parte Ghuman*, 88 USPQ2d 1478, 2008 WL 2109842 (BPAI 2008) (precedential, but superseded by rule). [37 CFR 41.31\(c\)](#) supersedes the Office's procedure under *Ghuman* and also simplifies practice for examiners by no longer requiring examiners to cancel non-appealed claims.

A timely filed brief will be referred to the Patent Appeal Center for consideration of its compliance with the applicable rules. If the brief is proper it will be forwarded to the examiner for preparation of an examiner's answer if the application is not allowable. The examiner's answer may withdraw the rejection of claims, if appropriate. The examiner, with supervisory approval, may also determine that it is necessary to reopen prosecution to enter a new ground of rejection. See [MPEP § 1207.04](#).

### **1205.03 Non-Compliant Appeal Brief and Amended Brief [R-08.2017]**

The Patent Appeals Center has the responsibility for determining whether appeal briefs filed in patent applications comply with [37 CFR 41.37](#), and will complete the determination before the appeal brief is forwarded to the examiner for consideration. The determination should be completed within approximately one month from the filing of the appeal brief. If the appeal brief is determined to be compliant with the rules or it contains only minor informalities that do not affect the Office's ability to render a decision, the Patent Appeals Center will accept the appeal brief and forward it to the examiner for consideration. If the Patent Appeals Center determines that the appeal brief is non-compliant with [37 CFR 41.37](#) and sends appellant a notice of non-compliant brief requiring a corrected brief, appellant will be required to file a corrected brief within the time period set forth in the notice to avoid the dismissal of the appeal. The Patent Appeals Center will also have the responsibility for determining whether corrected briefs comply with [37 CFR 41.37](#).

If appellant disagrees with the holding of noncompliance, a petition under [37 CFR 41.3](#) may be filed. Filing a petition will not toll the time period for reply set in the notice. Appellant must timely reply to the notice or the Office communication that requires an amended brief.

Once an appeal brief is accepted by the Board as in compliance with [37 CFR 41.37](#), the appeal brief will not later be held as defective by the Patent Appeals Center or the examiner. The Board will not return or remand the application to the examiner for issues related to a non-compliant appeal brief. Furthermore, examiners are not required to review appeal briefs for the purposes of determining whether the appeal briefs comply with [37 CFR 41.37](#). Accordingly, the Notification of Non-Compliant Appeal Brief (PTOL-462) and form paragraphs for holding an appeal brief defective are no longer available in OACS for the examiner to use.

Furthermore, the Patent Appeals Center will correspond directly with the appellant on non-compliant brief issues. Examiners may use form paragraphs 12.249 – 12.279.01 to draft examiner's answers to respond to appeal briefs filed in any format. In those rare situations where an appeal brief contains serious defects that will prevent the examiner from drafting an examiner's answer, the primary examiner should report the issue to the Patent Appeals Center.

The patent examining corps has jurisdiction over the application to consider the appeal brief, conduct an appeal conference, decide the entry of amendments, evidence, and information disclosure statements filed after final or after the filing of a notice of appeal, and draft an examiner's answer until jurisdiction passes to the Board pursuant to [37 CFR 41.35\(a\)](#). Furthermore, petitions concerning the refusal to enter amendments and/or evidence remain delegated according to [MPEP §§ 1002.02\(b\)](#) and [1002.02\(c\)](#).

## **1206 Amendments and Affidavits or Other Evidence Filed With or After Appeal [R-08.2017]**

*37 CFR 41.33 Amendments and affidavits or other evidence after appeal.*

(a) Amendments filed after the date of filing an appeal pursuant to § [41.31\(a\)\(1\) through \(a\)\(3\)](#) and prior to the date a

brief is filed pursuant to § [41.37](#) may be admitted as provided in § [1.116](#) of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § [41.37](#) may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § [41.31\(a\)\(1\) through \(a\)\(3\)](#) will not be admitted except as permitted by §§ [41.39\(b\)\(1\)](#), [41.50\(a\)\(2\)\(i\)](#), and [41.50\(b\)\(1\)](#).

(d)(1) An affidavit or other Evidence filed after the date of filing an appeal pursuant to § [41.31\(a\)\(1\) through \(a\)\(3\)](#) and prior to the date of filing a brief pursuant to § [41.37](#) may be admitted if the examiner determines that the affidavit or other Evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other Evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other Evidence filed after the date of filing an appeal pursuant to § [41.31\(a\)\(1\) through \(a\)\(3\)](#) will not be admitted except as permitted by §§ [41.39\(b\)\(1\)](#), [41.50\(a\)\(2\)\(i\)](#), and [41.50\(b\)\(1\)](#).

### **I. AMENDMENTS**

A new amendment must be submitted in a separate paper. Entry of a new amendment in an application on appeal is not a matter of right. The entry of an amendment (which may not include a new affidavit, declaration, exhibit or other evidence) submitted in an application on appeal is governed by [37 CFR 41.33](#).

Amendments filed after the filing of a notice of appeal, but prior to the date of filing a brief, may be admitted only to:

(A) cancel claims;

(B) comply with any requirement of form expressly set forth in a previous action;

(C) present rejected claims in better form for consideration on appeal; or

(D) amend the specification or claims upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. See [37 CFR 41.33\(a\)](#).

If the examiner denies the entry of such an amendment, the examiner should use form PTOL-303, "Advisory Action Before the Filing of

an Appeal Brief,” to notify the applicant of the non-entry and the reason for non-entry.

Amendments filed **on or after** the date of filing a brief pursuant to [37 CFR 41.37](#) and within the time period set forth in [37 CFR 90.3](#) may be admitted only to:

(A) cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding; or

(B) rewrite dependent claims into independent form.

[37 CFR 41.37\(c\)\(2\)](#) provides that a brief shall not include any non-admitted amendment. Thus, appellants may not include an amendment under [37 CFR 41.33\(b\)](#) in the appeal brief. Should appellants wish to file an amendment at the same time as a brief, appellants must submit such an amendment in a paper separate from the appeal brief.

Rewriting dependent claims into independent form as permitted under [37 CFR 41.33\(b\)\(2\)](#) includes the following situations:

(A) rewriting a dependent claim in independent form by adding thereto the limitations of the parent claim(s); and

(B) rewriting an independent claim to incorporate therein all the subject matter of a dependent claim, canceling the dependent claim and in conjunction therewith changing the dependency of claims which had depended from the dependent claim being canceled to the amended independent claim that incorporates therein all the subject matter of the now canceled dependent claim.

Amendments filed after jurisdiction of the appeal is transferred to the Board are not considered prior to the expiration of the time period set forth in [37 CFR 90.3](#) unless the case is remanded by the Board for consideration of the amendment. If an amendment is considered non-compliant the applicant may not be granted additional time to submit a substitute amendment. As such, it is recommended that appellant rewrite dependent claims, which have been objected to as being allowable except for their dependency on a rejected independent claim, before the appeal is forwarded to the Board. Such

amendments must be filed before the expiration of the time period set forth in [37 CFR 90.3](#), to avoid cancellation of the objected to claims. This includes dependent claims in which the rejections are withdrawn by the examiner in the Examiner’s Answer. See [MPEP §§ 1214.06](#) and [1214.07](#).

If the examiner denies entry of an amendment filed on or after the date of filing a brief, the examiner should use form PTOL-304, “Advisory Action After the Filing of an Appeal Brief,” to notify the applicant of the non-entry and the reason for non-entry.

Examiners must respond to all amendments filed after an appeal has been taken and prior to transfer of jurisdiction to the Board under [37 CFR 41.35\(a\)](#). If the examiner indicates (in the advisory action) that an amendment would be entered, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be impacted by the entry of the amendment except where an amendment merely cancels claims or rewrites dependent claims in independent form. If the examiner determines that an amendment clearly places the application in condition for allowance, the examiner may enter the amendment and allow the application. Except for amendments that meet the conditions set forth above, all other amendments submitted after the date of filing a notice of appeal will not be entered except as permitted by [37 CFR 41.39\(b\)\(1\)](#), [41.50\(a\)\(2\)\(i\)](#) and [41.50\(b\)\(1\)](#).

See [MPEP §§ 714.02](#), [714.12](#) and [714.13](#) for the treatment of amendments, affidavits and other evidence submitted after the mailing of a final rejection or a non-final rejection, but prior to the filing of a notice of appeal under [37 CFR 41.31\(a\)](#). Any amendment, affidavit or other evidence filed after the mailing date of a final Office action and on or before the date of the notice of appeal will be treated by the Office as being filed prior to the notice of appeal and treated under [37 CFR 1.116](#). Any amendment, affidavit or other evidence filed after the mailing date of a non-final Office action and on or before the date of notice of appeal will be treated by the Office as being filed prior to the notice of appeal and treated under [37 CFR 1.111](#).

An amendment, affidavit or other evidence received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded for that purpose. See [MPEP §§ 1210](#) and [1211.02](#).

## II. AFFIDAVITS OR OTHER EVIDENCE

Affidavits or other evidence (e.g., declarations or exhibits) submitted after the date of filing a notice of appeal, but prior to the date of filing a brief pursuant to [37 CFR 41.37](#), may be admitted if the examiner determines that:

(A) the affidavits or other evidence overcomes all rejections under appeal; and

(B) a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

If the examiner denies the entry of such an affidavit or other evidence, the examiner should use form PTOL-303, “Advisory Action Before the Filing of an Appeal Brief,” to notify the applicant of the non-entry and the reason for non-entry.

If the examiner determines that an affidavit or other evidence clearly places the application in condition for allowance, the examiner may enter the affidavit or other evidence and allow the application. Except as noted above, all other affidavits or other evidence filed after the date of filing a notice of appeal pursuant to [37 CFR 41.31\(a\)\(1\) - \(a\)\(3\)](#) will not be admitted except as permitted by [37 CFR 41.39\(b\)\(1\)](#), [41.50\(a\)\(2\)\(i\)](#) and [41.50\(b\)\(1\)](#).

An amendment, affidavit or other evidence received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded or returned by the Board for such purpose. See [MPEP §§ 1210](#) and [1211.02](#).

Information Disclosure Statements submitted after the date of a notice of appeal are normally held in abeyance pending a decision on the appeal. Consideration of Information Disclosure Statements is based on [MPEP § 609](#) and [37 CFR 1.97](#) and [1.98](#) and not on [37 CFR 41.33](#).



<b>Advisory Action Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	Examiner	Art Unit	AIA (First Inventor to File) Status No

**—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —**

THE REPLY FILED \_\_\_\_\_ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

**NO NOTICE OF APPEAL FILED**

1. ☐ The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

c) ☐ A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires \_\_\_\_\_ months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.

*Examiner Note:* If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because

a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

b) ☐ They raise the issue of new matter (see NOTE below);

c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): (a) ☐ will not be entered, or (b) ☐ will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on \_\_\_\_\_.

9. ☐ The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

10. ☐ The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

11. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

12. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.

13. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

14. ☐ Other: \_\_\_\_\_.

**STATUS OF CLAIMS**

15. The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

<b>Advisory Action</b> <b>After the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	Examiner	Art Unit	AIA (First Inventor to File) Status No
<p align="center"><i>--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i></p> <p>The reply filed _____ is acknowledged.</p> <p><input type="checkbox"/> A declaration(s)/affidavit(s) under <b>37 CFR 1.130(b)</b> was/were filed on _____.</p> <p>1. <input type="checkbox"/> The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will <u>not</u> be entered because:</p> <p style="padding-left: 40px;">a. <input type="checkbox"/> The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).</p> <p style="padding-left: 40px;">b. <input type="checkbox"/> The affidavit or other evidence is not timely filed before the filing of an appeal brief. See 37 CFR 41.33(d)(2).</p> <p>2. <input type="checkbox"/> The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.</p> <p style="padding-left: 40px;">Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).</p> <p>3. <input type="checkbox"/> The reply is entered. An explanation of the status of the claims after entry is below or attached.</p> <p>4. <input type="checkbox"/> Other: _____</p>			

## 1207 Examiner's Answer [R-11.2013]

### 37 CFR 41.39 Examiner's answer.

(a) *Content of examiner's answer.* The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief.

(1) An examiner's answer is deemed to incorporate all of the grounds of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory action and pre-appeal brief conference decision), unless the examiner's answer expressly indicates that a ground of rejection has been withdrawn.

(2) An examiner's answer may include a new ground of rejection. For purposes of the examiner's answer, any rejection that relies upon any Evidence not relied upon in the Office action from which the appeal is taken (as modified by any advisory action) shall be designated by the primary examiner as a new ground of rejection. The examiner must obtain the approval of the Director to furnish an answer that includes a new ground of rejection.

(b) *Appellant's response to new ground of rejection.* If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address as set forth in § 41.37(c)(1)(iv) each new ground of rejection and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this of this title) or other Evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

After an appeal brief under 37 CFR 41.37 has been filed and the examiner has considered the issues on appeal, the examiner may:

(A) reopen prosecution to enter a new ground of rejection with approval from the supervisory patent examiner (see MPEP § 1207.04);

(B) allow the application if the examiner determines that the rejections have been overcome and no new ground of rejection is appropriate; or

(C) maintain the appeal by conducting an appeal conference (MPEP § 1207.01) and drafting an examiner's answer (MPEP § 1207.02).

### 1207.01 Appeal Conference [R-08.2017]

An appeal conference is mandatory in all cases in which an acceptable brief (MPEP § 1205) has been filed. However, if the examiner charged with the responsibility of preparing the examiner's answer reaches a conclusion that the appeal should not go forward and the supervisory patent examiner (SPE) approves, then no appeal conference is necessary. In this case, the examiner may reopen prosecution and issue another Office action or may prepare a notice of allowability if appropriate. See MPEP § 1207.04. In circumstances where a notice of allowability is prepared, it may be appropriate to include reasons for allowance. See MPEP § 1302.14.

The participants of the appeal conference should include (1) the examiner charged with preparation of the examiner's answer, (2) a supervisory patent examiner (SPE), and (3) another examiner, known as a conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. During the appeal conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

The examiner responsible for preparing the examiner's answer should weigh the arguments of the other examiners presented during the appeal conference. If it is determined that the rejection(s) should be maintained, the examiner responsible for preparing the examiner's answer will prepare the examiner's answer.

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place

their initials next to their name. This will make the record clear that an appeal conference has been held. If the examiner's answer contains a new ground of rejection, it must clearly designate the rejection as a new ground of rejection. [37 CFR 41.39](#) specifies that new grounds of rejection must be approved by the Director - i.e., Director of the USPTO. This authority has been delegated to the Technology Center (TC) Directors or their designee(s). The answer must also include the signature of a Technology Center (TC) Director or designee to indicate that they approve the new ground of rejection. See [MPEP § 1207.03](#) and form paragraph 12.279.01

The Patent Appeals Center will review the examiner's answer to determine whether there is an indication that an appeal conference has been held. If the examiner's answer does not contain the appropriate indication that an appeal conference has been held (i.e., including the names of the conferees and identifying themselves as the conferees along with their initials), the Patent Appeals Center may return the application to the examiner for corrective action.

## **1207.02 Contents of Examiner's Answer [R-08.2017]**

Examiner's answers may be returned for correction by the Patent Appeals Center if they do not comply with the guidelines set forth below.

(A) The examiner's answer should include, under appropriate headings, in the order indicated, the following items:

(1) *Grounds of Rejection to be Reviewed on Appeal.*

A statement that every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory action and pre-appeal brief conference decision) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS."

The examiner must treat all pending, rejected claims as being on appeal, and must maintain all of the rejections set forth in the Office action from which

the appeal is taken, unless appellant has overcome the rejection (e.g., by submitting persuasive arguments, an acceptable terminal disclaimer, or evidence). In situations where the appellant makes a request to hold a rejection in abeyance or did not present any argument on a rejection in the appeal brief, the examiner should maintain the rejection in the examiner's answer.

*Withdrawn Rejections* – Under the subheading "WITHDRAWN REJECTIONS," the examiner should list any grounds of rejection that are being withdrawn (e.g., those that have been overcome by appellant.)

*New Grounds of Rejection* – Under the subheading "NEW GROUNDS OF REJECTION," the examiner must set forth any new grounds of rejection. An examiner's answer that contains a new ground of rejection must be approved and signed by the Director (or their designee). For each new ground of rejection, a complete explanation supporting the rejection must be provided with a proper reference to the applicable statute, prior art references relied upon, and the claim numbers of the claims that are subject to the rejection in the examiner's answer.

(2) *Response to Argument.* A statement of whether the examiner disagrees with each of the arguments of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such argument. The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief.

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner. While [37 CFR 41.39\(a\)](#) states the examiner "may" furnish a written answer, current procedures do not permit an appeal to proceed to the Board without an examiner's answer. The mailing date of the examiner's answer begins the period for filing a reply brief, which in turn transfers jurisdiction to the Board as described in [37 CFR 41.35\(a\)](#). In addition, the mailing date of the examiner's answer begins the time for appellants to request for an oral hearing as described in [37 CFR 41.47\(b\)](#). In the event that the final rejection fully addresses the arguments in the appeal brief, the examiner should complete an examiner's answer

with a typical “Grounds of Rejection to be Reviewed on Appeal” section and a simplified “Response to Arguments” section that simply refers to the appropriate portion of the final rejection.

Before preparing the answer, the examiner should make certain that each after-final amendment or evidence has been indicated as being entered or not-entered and an advisory action has been entered for each after-final amendment or evidence to notify the appellant of the entry or non-entry. The Board may remand to the examiner any application in which an after-final amendment or evidence has not been indicated as entered or not-entered and acted upon in an advisory action.

The examiner should treat affidavits, declarations, or exhibits filed with the notice of appeal in accordance with [37 CFR 1.116](#). If an affidavit, declaration, or exhibit was refused entry in the Record under [37 CFR 1.116](#) or prohibited by [37 CFR 41.33](#), the examiner should not comment on it in the examiner’s answer. Likewise, it would be improper for appellant to rely on an affidavit, declaration, or exhibit, which was not entered, in an appeal brief. If appellant has grounds for challenging the non-entry of an affidavit, declaration, or exhibit, they should file a timely petition under [37 CFR 1.181](#) seeking supervisory review of the non-entry. Any affidavits or declarations in the file swearing behind a reference should be clearly identified by the examiner as being considered under [37 CFR 1.131](#).

If a document being relied upon by the examiner in support of a rejection is in a language other than English, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. The translation may be a machine translation or an English equivalent of the non-English document. See [MPEP § 706.02](#) for reliance upon abstracts and foreign language documents in support of a rejection.

Examiners are not required to make any determination whether fewer than all of the rejected claims are identified by the appellant as being appealed. The Board will presume that all of the rejected claims are on appeal except for any claims subsequently canceled by an amendment filed by appellant. Therefore, the examiner will treat all

pending, rejected claims as being on appeal, and maintain all of the rejections set forth in the Office action from which the appeal is taken, unless appellant has overcome the rejection (e.g., by submitting persuasive arguments, an acceptable terminal disclaimer, or evidence). In situations where the appellant makes a request to hold a rejection in abeyance or did not present any argument on a rejection in the appeal brief, the examiner should maintain the rejection in the examiner’s answer and should identify that the appellant has not argued the rejection in the appeal brief.

Because of the practice of the Office in entering amendments after final action under justifiable circumstances for purposes of appeal, many cases coming before the Board for consideration contain claims which are not the claims treated in the examiner’s final rejection. They are either entirely new claims or amended versions of the finally rejected claims or both. Where an amendment under [37 CFR 1.116](#) or [41.33](#) would be entered for appeal purposes, the examiner must identify (in an advisory action) how one or more individual rejections set forth in the final rejection would be used to reject the added or amended claim(s).

The examiner should reevaluate their position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to in the “WITHDRAWN REJECTIONS” subsection of the examiner’s answer. If the examiner withdraws all of the rejections of an independent claim that was previously under rejection while still maintaining the rejections of other claims, then the answer should note the change of status of the claim(s). The answer should also include changes to the status of dependent claims should all rejections of a dependent claim be withdrawn. If the examiner withdraws all rejections to a dependent claim, while maintaining the rejection of the independent claim from which the claim depends, the applicant may file an amendment pursuant to [37 CFR 41.33\(b\)\(2\)](#) rewriting the claims in independent form. If the rejection of the independent claim is affirmed on appeal, the amendment to rewrite the claim in independent form under [37 CFR 41.33\(b\)\(2\)](#) must be presented prior to the expiration of the time period set forth in [37 CFR 90.3](#). See [MPEP §§ 1214.06](#) and [1214.07](#).



A new ground of rejection is permitted in an examiner's answer. See [MPEP § 1207.03](#). If reopening of prosecution is necessary, the examiner must obtain approval from the supervisory patent examiner prior to reopening prosecution after an appeal. See [MPEP § 1002.02\(d\)](#) and [§ 1207.04](#).

All correspondence with the Board, whether by the examiner or the appellant, must be on the record. No unpublished decisions which are unavailable to the general public by reason of [35 U.S.C. 122\(a\)](#) can be cited by the examiner or the appellant except that either the examiner or the appellant may cite an unpublished decision in an application having common ownership with the application on appeal.

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file, and an explanatory memorandum should be forwarded to the TC Director for consideration. See [MPEP § 1003](#). If approved by the TC Director, the examiner's answer should be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for final approval.

(B) FORM PARAGRAPHS. A form suitable for the examiner's answer is as follows:

¶ 12.249 Examiner's Answer Cover Sheet

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: [1]

Filing Date: [2]

Appellant(s): [3]

[4]

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed [5].

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. This form paragraph is printed with the USPTO letterhead.

3. In bracket 1, insert the application number of the appealed application.
4. In bracket 2, insert the filing date of the appealed application.
5. In bracket 3, insert the name(s) of the appellant.
6. In bracket 4, insert the name of the registered representative of the appellant.
7. In bracket 5, indicate the date on which the brief was filed.

¶ 12.254 Grounds of Rejection to be Reviewed on Appeal

*(1) Grounds of Rejection to be Reviewed on Appeal*

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. Follow this form paragraph with form paragraph 12.254.01 or 12.254.02.

¶ 12.254.01 Statement of Grounds of Rejection, not modified

Every ground of rejection set forth in the Office action dated [1] from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the mailing date of the Office action from which the appeal is being taken.
3. Use form paragraph 12.255 to restate the grounds of rejection and supporting rationale for each rejection involved in the appeal, when needed.
4. Use form paragraph 12.256 to introduce any new grounds of rejection.
5. Use form paragraph 12.257 to withdraw a ground of rejection previously made in the final Office action or last Office action.
6. Use this form paragraph when there was no modification made to the grounds of rejection in an advisory action or pre-appeal conference decision.

¶ 12.254.02 Statement of Grounds of Rejection, modified

The ground(s) of rejection set forth in the Office action dated [1] from which the appeal is taken have been modified by the [2] dated [3]. A list of rejections withdrawn by the examiner (if any) is included under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.

2. In bracket 1, insert the mailing date of the Office action from which the appeal is being taken.
3. In bracket 2, insert --advisory action-- and/or --pre-appeal brief conference decision--.
4. In bracket 3, insert the mailing date of the advisory action and/or pre-appeal brief conference decision--.
5. Use form paragraph 12.255 to restate the grounds of rejection and supporting rationale for each rejection involved in the appeal, when needed.
6. Use form paragraph 12.256 to introduce any new grounds of rejection.
7. Use form paragraph 12.257 to withdraw a ground of rejection previously made in the final Office action or last Office action.
8. Use this form paragraph when the grounds of rejection were modified in an advisory action or pre-appeal brief conference decision.

#### ¶ 12.255 Restatement of Rejection

The following ground(s) of rejection are applicable to the appealed claims.

[1]

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. Precede this form paragraph with either 12.254.01 or 12.254.02.
3. Use this form paragraph to optionally include a statement of rejection and/or supporting rationale for every ground of rejection involved in the appeal.
4. Only use this form paragraph when the restatement of the rejection does not include any new ground(s) of rejection.
5. In bracket 1, explain each ground of rejection maintained by the examiner.

#### ¶ 12.256 New Grounds of Rejection - Heading

##### NEW GROUNDS OF REJECTION

[1]

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. Any new ground(s) of rejection in the examiner's answer must be prominently identified (e.g., using this form paragraph).
3. Provide a concise statement of each new ground of rejection presented for review in bracket 1; and
4. Conclude an examiner's answer raising new grounds of rejection with form paragraph 12.279.01: (1) to notify applicant of the reply period and options following the new grounds of

rejection; and (2) to include the required approval of the TC Director or the TC Director's designee.

#### ¶ 12.257 Withdrawn Rejections

##### WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. [1].

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the grounds of rejection that have been withdrawn.

#### ¶ 12.261 Response to Argument

##### (2) Response to Argument

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. If an issue raised by appellant was fully responded to under the "Grounds of Rejection to be Reviewed on Appeal" portion, no additional response is required here.
3. If an issue has been raised by appellant that was not fully responded to under "Grounds of Rejection to be Reviewed on Appeal," a full response must be provided after this form paragraph.

#### ¶ 12.279 Conclusion to Examiner's Answer, No New Grounds of Rejection

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

[1]

Conferees:

[2]

[3]

**Requirement to pay appeal forwarding fee.** In order to avoid dismissal of the instant appeal in any application or *ex parte* reexamination proceeding, [37 CFR 41.45](#) requires payment of an appeal forwarding fee within the time permitted by [37 CFR 41.45\(a\)](#), unless appellant had timely paid the fee for filing a brief required by [37 CFR 41.20\(b\)](#) in effect on March 18, 2013.

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.

2. In bracket 1, insert initials of the examiner and the date.
3. In bracket 2, insert names of the conferees. The conferees must also place their initials next to their names.
4. In bracket 3, insert correspondence address of record.
5. If the examiner's answer includes a new ground of rejection, use form paragraph 12.279.01 instead of this form paragraph.

**¶ 12.279.01 Conclusion to Examiner's Answer Raising New Grounds of Rejection**

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (I) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under [37 CFR 1.111](#) with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with [37 CFR 41.39\(b\)\(1\)](#) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in [37 CFR 41.41](#). Such a reply brief must address each new ground of rejection as set forth in [37 CFR 41.37\(c\)\(1\)](#) and should be in compliance with the other requirements of [37 CFR 41.37\(c\)](#). If a reply brief filed pursuant to [37 CFR 41.39\(b\)\(2\)](#) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under [37 CFR 41.39\(b\)\(1\)](#).

Extensions of time under [37 CFR 1.136\(a\)](#) are not applicable to the TWO MONTH time period set forth above. See [37 CFR 1.136\(b\)](#) for extensions of time to reply for patent applications and [37 CFR 1.550\(c\)](#) for extensions of time to reply for *ex parte* reexamination proceedings.

Respectfully submitted,

[1]

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (I) above by signing below:**

[2]

Conferees:

[3]

[4]

**Requirement to pay appeal forwarding fee.** In order to avoid dismissal of the instant appeal in any application or *ex parte* reexamination proceeding, [37 CFR 41.45](#) requires payment of an appeal forwarding fee within the time permitted by [37 CFR 41.45\(a\)](#), unless appellant had timely paid the fee for filing a brief required by [37 CFR 41.20\(b\)](#) in effect on March 18, 2013.

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert initials of the examiner and the date.
3. In bracket 2, insert TC Director's or designee's signature. All new grounds of rejection must be approved by a TC Director or designee.
4. In bracket 3, insert names of the conferees. The conferees must also place their initials next to their names.
5. In bracket 4, insert correspondence address of record.

**¶ 12.279.02 Dismissal Following New Ground(s) of Rejection in Examiner's Answer**

Appellant failed to timely respond to the examiner's answer mailed on [1] that included a new ground of rejection. Under [37 CFR 41.39\(b\)](#), if an examiner's answer contains a rejection designated as a new ground of rejection, appellant must, within two months from the date of the examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under [37 CFR 1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under [37 CFR 41.41](#), addressing each new ground of rejection, to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection. In view of appellant's failure to file a reply under [37 CFR 1.111](#) or a reply brief within the time period required by [37 CFR 41.39](#), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the mailing date of the examiner's answer.
3. In bracket 2, insert the claim numbers of the claims subject to the new ground of rejection.
4. In bracket 3, insert the claim numbers of the claims that are not subject to the new ground of rejection.

### 1207.03 New Ground of Rejection in Examiner's Answer [R-08.2017]

[37 CFR 41.39\(a\)\(2\)](#) permits the entry of a new ground of rejection in an examiner's answer.

At the time of preparing the answer to an appeal brief, the examiner may decide that they should apply a new ground of rejection against some or all of the pending claims. In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the answer. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See [MPEP §§ 1002.02\(d\)](#) and [1207.04](#).

#### I. REQUIREMENTS FOR A NEW GROUND OF REJECTION

Any new ground of rejection made by an examiner in an answer must be:

(A) approved by a Technology Center (TC) Director or designee; and

(B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section under the subheading "New Grounds of Rejection" of the answer (see [MPEP § 1207.02](#)). The examiner may use form paragraph 12.256.

The examiner's answer must provide appellant a two-month time period for reply. The examiner may use form paragraph 12.279.01 to notify appellant of the period for reply and to include the approval of the TC Director or designee. In response to an examiner's answer that contains a new ground of rejection, appellant must either file:

(A) a reply in compliance with [37 CFR 1.111](#) to request that prosecution be reopened; or

(B) a reply brief that addresses each new ground of rejection in compliance with [37 CFR 41.37\(c\)\(1\)\(iv\)](#) to maintain the appeal.

Appellant must file the reply or reply brief within two months from the date of the examiner's answer to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection. See [37 CFR 41.39\(b\)](#) and subsection "V.

APPELLANT'S REPLY TO NEW GROUNDS OF REJECTION" below.

#### II. SITUATIONS WHERE NEW GROUNDS OF REJECTION ARE NOT PERMISSIBLE

A new ground of rejection would not be permitted to reject a previously allowed or objected to claim even if the new ground of rejection would rely upon evidence already of Record. In this instance, rather than making a new ground of rejection in an examiner's answer, if the basis for the new ground of rejection was approved by a supervisory patent examiner as currently set forth in [MPEP § 1207.04](#), the examiner would reopen prosecution.

#### III. DESIGNATION AS A NEW GROUND OF REJECTION IN AN EXAMINER'S ANSWER

The following discussion is for the limited "purposes of the examiner's answer," as per [37 CFR 41.39\(a\)\(2\)](#). This discussion does not apply to new grounds of rejection made in final rejections under [37 CFR 1.113](#). The reason for this distinction is that [37 CFR 1.116](#) affords applicants the opportunity to submit rebuttal evidence after a final rejection but on or before the date of filing a notice of appeal. An appellant's ability to introduce new evidence after the filing of an appeal is more limited under [37 CFR 41.33\(d\)](#) than it is prior to the appeal. Thus, applicants are able to present rebuttal evidence in response to a final rejection, while they are not permitted to do so in response to an examiner's answer on appeal, unless an answer is designated as containing a new ground of rejection.

If Evidence (such as a new prior art reference, but not including a newly relied upon dictionary definition) is applied or cited for the first time in an examiner's answer, then [37 CFR 41.39\(a\)\(2\)](#) requires that the rejection be designated as a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection and be designated as a new ground of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3

(CCPA 1970). See [MPEP § 2144.03](#) for guidance on the citation of a new reference to support Official Notice taken in Office actions made prior to an examiner's answer.

See [37 CFR 41.30](#) and [MPEP § 1204.04](#) for a detailed discussion of what constitutes "evidence" for the purposes of appeal.

A position or rationale that changes the “basic thrust of the rejection” will also give rise to a new ground of rejection. *In re Kronig*, 539 F.2d 1300, 1303, 190 USPQ 425, 427 (CCPA 1976). A rejection relying on the same statutory basis and same prior art references, may nevertheless raise a new ground of rejection, when the rejection relies on new facts or rationales not previously raised. See *In re Leithem*, 661 F.3d 1316, 100 USPQ2d 1155 (Fed. Cir. 2011); *Rambus v. Rea*, 731 F.3d 1248, 108 USPQ2d 1400 (Fed. Cir. 2013) (the inclusion of a new motivation to combine prior art references did not merely elaborate on the examiner's findings with “more detail”). However, the examiner need not use identical language in both the examiner's answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the examiner's answer responds to appellant's arguments using different language, or restates the reasoning of the rejection in a different way, so long as the “basic thrust of the rejection” is the same. *In re Kronig*, 539 F.2d at 1303, 190 USPQ at 427; see also *In re Jung*, 637 F.3d 1356, 1364–65, 98 USPQ2d 1174, 1180 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time “did not change the rejection” and appellant had fair opportunity to respond); *In re Noznick*, 391 F.2d 946, 949, 157 USPQ 266, 269 (CCPA 1968) (no new ground of rejection made when “explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner”); *In re Krammes*, 314 F.2d 813, 817, 137 USPQ 60, 63 (CCPA 1963) (“It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of rejection.” (citations omitted)); *In re Cowles*, 156 F.2d 551, 555, 70 USPQ 419, 422 (CCPA 1946)

(holding that the use of “different language” does not necessarily trigger a new ground of rejection).

## **1207.03(a) Determining Whether a Ground of Rejection is New [R-08.2017]**

### **I. SITUATIONS WHERE A GROUND OF REJECTION IS NEW**

The following examples are intended to provide guidance as to what constitutes a new ground of rejection in an examiner's answer. What constitutes a “new ground of rejection” is a highly fact-specific question. See, e.g., *Kronig*, 539 F.2d at 1303, 190 USPQ at 427 (finding new ground entered based upon “facts of this case” and declining to find other cases controlling given “the distinctive facts at bar”); *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970) (“[l]ooking at the facts of this case, we are constrained to hold” that a new ground was entered). If a situation arises that does not fall neatly within any of the following examples, it is recommended that the examiner identify the example below that is most analogous to the situation at hand, keeping in mind that “the ultimate criterion of whether a rejection is considered ‘new’ \* \* \* is whether appellants have had fair opportunity to react to the thrust of the rejection.” *Kronig*, 539 F.2d at 1302, 190 USPQ at 426.

#### ***Factual Situations That Constitute a New Ground of Rejection***

##### **1. *Changing the statutory basis of rejection from 35 U.S.C. 102 to 35 U.S.C. 103.***

If the examiner's answer changes the statutory basis of the rejection from 35 U.S.C. 102 to 35 U.S.C. 103, then the rejection should be designated as a new ground of rejection. For example, in *In re Hughes*, 345 F.2d 184, 145 USPQ 467 (CCPA 1965), the Board affirmed an examiner's rejection under 35 U.S.C. 102 over a single reference. On appeal, the Solicitor argued that the Board's decision should be sustained under 35 U.S.C. 103 over that same reference. The court declined to sustain the rejection under 35 U.S.C. 103, holding that a change in the statutory basis of rejection would constitute a new ground of rejection, and observed that “the issues arising under the two sections [35 U.S.C. 102 and 103] may be vastly different, and may call for the



production and introduction of quite different types of evidence.” *Hughes*, 345 F.2d at 186–87, 145 USPQ at 469.

2. *Changing the statutory basis of rejection from 35 U.S.C. 103 to 35 U.S.C. 102, based on a different teaching.*

If the examiner’s answer changes the statutory basis of the rejection from 35 U.S.C. 103 to 35 U.S.C. 102, and relies on a different portion of a reference which goes beyond the scope of the portion that was previously relied upon, then the rejection should be designated as a new ground of rejection. For example, in *In re Echerd*, 471 F.2d 632, 176 USPQ 321 (CCPA 1973), the examiner rejected the claims under 35 U.S.C. 103 over a combination of two references. The Board then changed the ground of rejection to 35 U.S.C. 102 over one of those references, relying on a different portion of that reference for some claim limitations, and asserted that the remaining claim limitations were inherently present in that reference. The court held that the Board’s affirmance constituted a new ground of rejection. *Echerd*, 471 F.2d at 635, 176 USPQ at 323 (“[A]ppellants should have been accorded an opportunity to present rebuttal evidence as to the new assumptions of inherent characteristics. \* \* \*” (citation omitted)).

3. *Citing new calculations in support of overlapping ranges.*

If a claim reciting a range is rejected as anticipated or obvious based on prior art that falls within or overlaps with the claimed range (see [MPEP §§ 2131.03](#) and [2144.05](#)), and the rejection is based upon range values identified and calculated for the first time in the examiner’s answer, then the rejection should be designated as a new ground of rejection. For example, in *In re Kumar*, 418 F.3d 1361, 76 USPQ2d 1048 (Fed. Cir. 2005), the examiner rejected the claims under 35 U.S.C. 103 based on overlapping ranges of particle sizes and size distributions. The Board affirmed the rejection, but included in its decision an identification of specific values in the prior art and an appendix containing calculations to support the *prima facie* case of obviousness. The court held the Board’s reliance upon those values to constitute a new ground of rejection, stating that “the Board found facts not found by the examiner regarding the differences

between the prior art and the claimed invention, which in fairness required an opportunity for response.” *Kumar*, 418 F.3d at 1368, 76 USPQ2d at 1052 (citation omitted).

4. *Citing new structure in support of structural obviousness.*

If, in support of an obviousness rejection based on close structural similarity (see [MPEP § 2144.09](#)), the examiner’s answer relies on a different structure than the one on which the examiner previously relied, then the rejection should be designated as a new ground of rejection. For example, in *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967), the examiner rejected claims to a chemical composition under 35 U.S.C. 103 based on the composition’s structural similarity to a prior art compound disclosed in a reference. The Board affirmed the rejection under 35 U.S.C. 103 over that same reference, but did so based on a different compound than the one the examiner cited. The court held that the Board’s decision constituted a new ground of rejection, stating, “Under such circumstances, we conclude that when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference.” *Wiechert*, 370 F.2d at 933, 152 USPQ at 252.

5. *Pointing to a different portion of the claim to maintain a “new matter” rejection.*

If, in support of a claim rejection under [35 U.S.C. 112](#) based on new matter (see [MPEP § 2163.06](#)), a different feature or aspect of the rejected claim is believed to constitute new matter, then the rejection should be designated as a new ground of rejection. For example, in *In re Waymouth*, 486 F.2d 1058, 179 USPQ 627 (CCPA 1973), the claims included the limitation “said sodium iodide \* \* \* present in amount of at least 0.17 mg./cc. of said arc tube volume.” The examiner’s rejection stated that the claimed “sodium iodide” constituted new matter because the specification was alleged only to disclose “sodium.” The Board affirmed the rejection, but did so on a “wholly different basis,” namely, that the specification failed to disclose the claimed “0.17 mg./cc.” volume limitation. *Waymouth*, 486 F.2d at 1060, 179 USPQ at 629. The court held that the Board’s rationale constituted a new ground of

rejection, “necessitating different responses by appellants.” *Id.* at 1061, 179 USPQ at 629.

## II. SITUATIONS THAT ARE NOT CONSIDERED NEW GROUNDS OF REJECTION

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under [35 U.S.C. 103](#) does not constitute a new ground of rejection).

In addition, if:

(A) an amendment under [37 CFR 1.116](#) [or [41.33](#)] proposes to add or amend one or more claims;

(B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and

(C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal has been taken would be used to reject the added or amended claims, then

(1) the appeal brief must address the rejection(s) of the added or amended claim(s) and

(2) the examiner’s answer may include the rejection(s) of the added or amended claims. Such rejection(s) made in the examiner’s answer would not be considered as a new ground of rejection.

The filing of such an amendment represents appellant’s consent to proceed with the appeal process. For example, when an amendment under [37 CFR 1.116](#) or [41.33](#) cancels a claim (the “canceled claim”) and incorporates its limitations into the claim upon which it depends or rewrites the claim as a new independent claim (the “appealed claim”), the appealed claim contains the limitations of the canceled claim (i.e., the only difference between the appealed claim and the canceled claim is the claim number). In such situations, the appellant

has been given a fair opportunity to react to the ground of rejection (albeit to a claim having a different claim number). Thus, such a rejection does not constitute a “new ground of rejection” within the meaning of [37 CFR 41.39](#).

The phrase “individual rejections” addresses situations such as the following: the action contains a rejection of claim 1 under [35 U.S.C. 102](#) on the basis of Reference A, a rejection of claim 2 (which depends upon claim 1) under [35 U.S.C. 103](#) on the basis of Reference A in view of Reference B and a rejection of claim 3 (which depends upon claim 1) under [35 U.S.C. 103](#) on the basis of Reference A in view of Reference C. In this situation, the action contains the following “individual rejections”: (1) [35 U.S.C. 102](#) on the basis of Reference A; (2) [35 U.S.C. 103](#) on the basis of Reference A in view of Reference B; and (3) [35 U.S.C. 103](#) on the basis of Reference A in view of Reference C. The action, however, does not contain any rejection on the basis of A in view of B and C. If an amendment under [37 CFR 1.116](#) or [41.33](#) proposes to combine the limitations of claims 1 and 2 together into amended claim 1 and cancels claim 2, a rejection of amended claim 1 under [35 U.S.C. 103](#) on the basis of Reference A in view of Reference B would be appropriate and would not be considered a new ground of rejection within the meaning of [37 CFR 41.39](#), provided the applicant was advised that this rejection would be applied to amended claim 1 in an advisory action. Furthermore, since claim 3 (which depends upon claim 1) would include the limitations of the original claims 1, 2, and 3, a rejection of amended claim 3 (amended by the amendment to original claim 1) under [35 U.S.C. 103](#) on the basis of Reference A in view of Reference B and Reference C may be appropriate and would not be considered a new ground of rejection within the meaning of [37 CFR 41.39](#), provided applicant was advised that this rejection would be applied to amended claim 3 in the advisory action. Of course, as amended claim 3 includes the limitations of the original claims 1, 2, and 3, amended claim 3 is a newly proposed claim in the application raising a new issue (i.e., a new ground of rejection), and such an amendment under [37 CFR 1.116](#) or [41.33](#) may properly be refused entry as raising a new issue.

It must be emphasized that [37 CFR 41.39\(a\)\(2\)](#) does not change the existing practice with respect to amendment after final rejection practice ([37 CFR 1.116](#)). The fact that [37 CFR 41.39\(a\)\(2\)](#) would authorize the rejection in an examiner's answer of a claim sought to be added or amended in an amendment under [37 CFR 1.116](#) or [41.33](#) has no effect on whether the amendment under [37 CFR 1.116](#) or [41.33](#) is entitled to entry. The provisions of [37 CFR 1.116](#) or [41.33](#) control whether an amendment under [37 CFR 1.116](#) or [41.33](#) is entitled to entry; the provisions of [37 CFR 41.39\(a\)\(2\)](#) permits a new ground of rejection to be included in an answer against a claim added or amended in an amendment under [37 CFR 1.116](#) or [41.33](#).

Where a newly cited reference is added merely as evidence of the prior statement made by the examiner as to what is "well-known" in the art which was challenged for the first time in the appeal brief, the citation of the reference in the examiner's answer would not ordinarily constitute a new ground of rejection within the meaning of [37 CFR 41.39\(a\)\(2\)](#). See also [MPEP § 2144.03](#).

#### ***Factual Situations That Do Not Constitute a New Ground of Rejection***

##### ***1. Citing a different portion of a reference to elaborate upon that which has been cited previously.***

If the examiner's answer cites a different portion of an applied reference which goes no farther than, and merely elaborates upon, what is taught in the previously cited portion of that reference, then the rejection does not constitute a new ground of rejection. For example, in *In re DBC*, 545 F.3d 1373, 89 USPQ2d 1123 (Fed. Cir. 2008), the examiner rejected the claims under 35 U.S.C. 103 over a combination of references, including the English translation of the abstract for a Japanese patent. The examiner cited the English abstract for two claim limitations: (1) Mangosteen rind, and (2) fruit or vegetable juice. The Board affirmed the rejection under 35 U.S.C. 103 over the same references, but instead of citing the abstract, the Board cited an Example on page 16 of the English translation of the Japanese reference, which was not before the examiner. *DBC*, 545 F.3d at 1381, 89

USPQ2d at 1129. Importantly, the Board cited the Example for the same two claim limitations taught in the abstract, and the Example merely elaborated upon the medicinal qualities of the mangosteen rind (which medicinal qualities were not claimed) and taught orange juice as the preferred fruit juice (while the claim merely recited fruit or vegetable juice). Hence, the Example merely provided a more specific disclosure of the same two generic limitations that were fully taught by the abstract. The court held that this did not constitute a new ground of rejection because "the example in the translation goes no farther than, and merely elaborates upon, what is taught by the abstract." *DBC*, 545 F.3d at 1382 n.5, 89 USPQ2d at 1130 n.5.

##### ***2. Changing the statutory basis of rejection from 35 U.S.C. 103 to 35 U.S.C. 102, but relying on the same teachings.***

If the examiner's answer changes the statutory basis of the rejection from 35 U.S.C. 103 to 35 U.S.C. 102, and relies on the same teachings of the remaining reference to support the 35 U.S.C. 102 rejection, then the rejection does not constitute a new ground of rejection. For example, in *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978), a claim directed to a genus of chemical compounds was rejected under 35 U.S.C. 103 over a combination of references. The primary reference disclosed a species that fell within the claimed genus. Both the examiner and the Board cited the species to reject the claim under 35 U.S.C. 103. The court affirmed the rejection, but did so under 35 U.S.C. 102, stating that "lack of novelty is the epitome of obviousness." *May*, 574 F.2d at 1089, 197 USPQ at 607 (citing *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974)). Because the court relied on the same prior art species as both the examiner and Board, the court held that this did not constitute a new ground of rejection. *May*, 574 F.2d at 1089, 197 USPQ at 607.

##### ***3. Relying on fewer than all references in support of a 35 U.S.C. 103 rejection, but relying on the same teachings.***

If the examiner's answer removes one or more references from the statement of rejection under 35 U.S.C. 103, and relies on the same teachings of the remaining references to support the 35 U.S.C. 103 rejection, then the rejection does not constitute a

new ground of rejection. For example, in *In re Kronig*, 539 F.2d 1300, 1302, 190 USPQ 425, 427 (CCPA 1976), the examiner rejected the claims under 35 U.S.C. 103 over four references. The Board affirmed the rejection under 35 U.S.C. 103, but limited its discussion to three of the references applied by the examiner. *Id.* The Board relied upon the references for the same teachings as did the examiner. The court held that this did not constitute a new ground of rejection. *Kronig*, 539 F.2d at 1303, 190 USPQ at 427 (“Having compared the rationale of the rejection advanced by the examiner and the board on this record, we are convinced that the basic thrust of the rejection at the examiner and board level was the same.”). See also *In re Bush*, 296 F.2d 491, 495–96, 131 USPQ 263, 266–67 (CCPA 1961) (Examiner rejected claims 28 and 29 under 35 U.S.C. 103 based upon “Whitney in view of Harth;” Board did not enter new ground of rejection by relying only on Whitney).

4. *Changing the order of references in the statement of rejection, but relying on the same teachings of those references.*

If the examiner’s answer changes the order of references in the statement of rejection under 35 U.S.C. 103, and relies on the same teachings of those references to support the 35 U.S.C. 103 rejection, then the rejection does not constitute a new ground of rejection. For example, in *In re Cowles*, 156 F.2d 551, 552, 70 USPQ 419, 420 (CCPA 1946), the examiner rejected the claims under 35 U.S.C. 103 over “Foret in view of either Preleuthner or Seyfried.” The Board affirmed the rejection under 35 U.S.C. 103, but styled the statement of rejection as to some of the rejected claims as “Seyfried in view of Foret,” but relied on the same teachings of Seyfried and Foret on which the examiner relied. The court held that this did not constitute a new ground of rejection. *Cowles*, 156 F.2d at 554, 70 USPQ at 421–22. See also *In re Krammes*, 314 F.2d 813, 816–17, 137 USPQ 60, 63 (CCPA 1963) (holding that a different “order of combining the references” did not constitute a new ground of rejection because each reference was cited for the “same teaching” previously cited).

5. *Considering, in order to respond to applicant’s arguments, other portions of a reference submitted by the applicant.*

If an applicant submits a new reference to argue, for example, that the prior art “teaches away” from the claimed invention (see [MPEP § 2145](#)), and the examiner’s answer points to portions of that same reference to counter the argument, then the rejection does not constitute a new ground of rejection. In *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986), the claimed invention was directed to a process for sulfonating diphenyl sulfone at a temperature above 127° C. *Id.* at 1039, 228 USPQ at 685. The examiner rejected the claims under 35 U.S.C. 103 over a single reference. The applicant submitted three additional references as evidence that the prior art teaches away from performing sulfonation above 127° C, citing portions of those references which taught lower temperature reactions. The Board affirmed the rejection, finding the applicant’s evidence unpersuasive. On appeal, the Solicitor responded to the applicant’s “teaching away” argument by pointing to other portions of those same references which, contrary to applicant’s argument, disclosed reactions occurring above 127° C. The court held that this did not constitute a new ground of rejection because “[t]he Solicitor has done no more than search the references of record for disclosures pertinent to the same arguments for which [applicant] cited the references.” *Hedges*, 783 F.2d at 1039–40, 228 USPQ at 686.

## **1207.03(b) Petition to Designate a New Ground of Rejection and to Reopen Prosecution [R-11.2013]**

### **37 CFR 41.40 Tolling of time period to file a reply brief.**

(a) *Timing.* Any request to seek review of the primary examiner’s failure to designate a rejection as a new ground of rejection in an examiner’s answer must be by way of a petition to the Director under § [1.181](#) of this title filed within two months from the entry of the examiner’s answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

(b) *Petition granted and prosecution reopened.* A decision granting a petition under § [1.181](#) to designate a new ground of rejection in an examiner’s answer will provide a two-month time period in which appellant must file a reply under § [1.111](#) of this title to reopen the prosecution before the primary examiner. On failure to timely file a reply under § [1.111](#), the appeal will stand dismissed.

(c) *Petition not granted and appeal maintained.* A decision refusing to grant a petition under § [1.181](#) of this title to designate a new ground of rejection in an examiner’s answer will provide



a two-month time period in which appellant may file only a single reply brief under § [41.41](#).

(d) *Withdrawal of petition and appeal maintained.* If a reply brief under § [41.41](#) is filed within two months from the date of the examiner's answer and on or after the filing of a petition under § [1.181](#) to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal.

(e) *Extensions of time.* Extensions of time under § [1.136\(a\)](#) of this title for patent applications are not applicable to the time period set forth in this section. See § [1.136\(b\)](#) of this title for extensions of time to reply for patent applications and § [1.550\(c\)](#) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

Appellant cannot request to reopen prosecution pursuant to [37 CFR 41.39\(b\)](#) if the examiner's answer does not have a rejection that is designated as a new ground of rejection.

[37 CFR 41.40](#) sets forth the exclusive procedure for an appellant to request review of the primary examiner's failure to designate a rejection as a new ground of rejection via a petition to the Director under [37 CFR 1.181](#). This procedure should be used if an appellant feels an answer includes a new ground of rejection that has not been designated as such and wishes to reopen prosecution so that new amendments or evidence may be submitted in response to the rejection. However, if appellant wishes to submit only arguments, the filing of a petition under [37 CFR 1.181](#) would not be necessary because appellant may submit the arguments in a reply brief. Any such petition under [37 CFR 1.181](#) must be filed within two months from the entry of the examiner's answer and prior to the filing of a reply brief.

The authority to decide petitions under [37 CFR 41.40](#) is delegated to the TC Director or designee. A decision granting a petition under [37 CFR 41.40](#) will provide a two-month time period in which appellant must file a reply under [37 CFR 1.111](#) to avoid the dismissal of the appeal. No corrected examiner's answer will be provided.

If the petition is granted, appellant may present amendment, evidence, and/or arguments in the reply under [37 CFR 1.111](#) that are directed to other rejections that are not new grounds of rejection. An after-final amendment or evidence that was previously refused entry is not automatically entered.

Appellant may include such amendment or evidence in the reply. Upon filing of the reply, the prosecution will be reopened and the examiner will consider the reply. The examiner may make the next Office action final (if appropriate). See [MPEP § 706.07\(a\)](#).

On the other hand, if the Office refuses to grant a petition under [37 CFR 1.181](#) requesting designation as a new ground of rejection under [37 CFR 41.40](#), the appeal will be maintained. A decision refusing to grant a petition will provide a two-month time period in which appellant may file only a single reply brief under [37 CFR 41.40](#). The jurisdiction will pass to the Board upon the filing of a reply brief or the expiration of the two-month time period, whichever is earlier. See [37 CFR 41.35\(a\)](#).

Any reply brief that is filed within two months from the date of the examiner's answer, but before a decision on the petition, will be treated as a request to withdraw the petition and to maintain the appeal. No decision on the petition will be provided. Jurisdiction will pass to the Board upon the filing of the reply brief. See [37 CFR 41.35\(a\)](#).

The time periods set forth in [37 CFR 41.40](#) are not extendable under [37 CFR 1.136\(a\)](#), but are extendable under [37 CFR 1.136\(b\)](#) for patent applications and [37 CFR 1.550\(c\)](#) for *ex parte* reexamination proceedings. See [37 CFR 41.40\(e\)](#).

## 1207.03(c) Appellant's Reply to New Grounds of Rejection [R-08.2017]

### *37 CFR 41.39 Examiner's answer.*

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(b) *Appellant's response to new ground of rejection.* If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § [1.111](#) of this title with or without amendment or submission of affidavits (§§ [1.130](#), [1.131](#) or [1.132](#) of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § [1.112](#) of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.



(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address as set forth in § 41.37(c)(1)(iv) each new ground of rejection and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other Evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

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The provisions of 37 CFR 41.39(b) apply only to rejections that are designated as new grounds of rejection in the examiner's answer. If appellant believes there is an undesignated new ground of rejection, review is by way of the procedure established in 37 CFR 41.40.

The two month time period for reply is not extendable under 37 CFR 1.136(a), but is extendable under 37 CFR 1.136(b) for patent applications and 37 CFR 1.550(c) for *ex parte* reexamination proceedings. See 37 CFR 41.39(c).

#### **I. REQUEST THAT PROSECUTION BE REOPENED BY FILING A REPLY**

If appellant requests that prosecution be reopened, the appellant must file a reply that addresses each new ground of rejection set forth in the examiner's answer in compliance with 37 CFR 1.111 within two months from the mailing of the examiner's answer. The reply may also include amendments, evidence, and/or arguments directed to claims not subject to the new ground of rejection or other rejections. If there is an after-final amendment (or affidavit or other evidence) that was not entered, appellant may include such amendment (or affidavit or other evidence) in the reply to the examiner's answer.

If the reply is not fully responsive to the new ground of rejection, but the reply is *bona fide*, the examiner should provide a time period for appellant to complete the reply pursuant to 37 CFR 1.135(c). See MPEP § 714.03. If the reply is not *bona fide* (e.g., does not address the new ground of rejection) and the two-month time period has expired, examiner must *sua sponte* dismiss the appeal. See subsection "III. Failure to Reply to a New Ground of Rejection" below.

Once appellant files a reply in compliance with 37 CFR 1.111 in response to an examiner's answer that contains a new ground of rejection, the examiner must reopen prosecution by entering and considering the reply. The examiner may make the next Office action final unless the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

#### **II. REQUEST THAT THE APPEAL BE MAINTAINED BY FILING A REPLY BRIEF**

If appellant requests that the appeal be maintained, the appellant must file a reply brief that addresses each new ground of rejection set forth in the answer in compliance with 37 CFR 41.37(c)(1)(vii) within two months from the mailing of the answer. The reply brief should include the following items, with each item starting on a separate page, so as to follow the other requirements of a brief as set forth in 37 CFR 41.37(c):

(1) Identification page setting forth the appellant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Reply Brief);

(2) Argument page(s).

The reply brief must also be in compliance with requirements set forth in 37 CFR 41.41, e.g., it cannot include any new amendment or affidavit. If the reply brief is accompanied by any amendment or evidence, it will be treated as a request that prosecution be reopened under 37 CFR 41.39(b)(1) assuming the answer contained a rejection designated as a new ground.

The reply brief may include new arguments responsive to the designated new grounds of rejection. Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer, including any designated new ground of

rejection, will not be considered by the Board for purposes of the appeal, unless good cause is shown.

Unless the Board remands the appeal under [37 CFR 41.50\(a\)\(1\)](#) for further action by the examiner, the examiner may not answer the reply brief. Jurisdiction passes to the Board immediately on filing of a reply brief or expiration of the period to do so.

### III. FAILURE TO REPLY TO A NEW GROUND OF REJECTION

As specified in [37 CFR 41.35](#), jurisdiction over the proceeding passes to the Board on filing of a reply brief or the expiration of time to file a reply brief. Therefore, examiners will not normally make determinations as to the sufficiency of a reply to a new ground of rejection.

If appellant fails to timely file a reply under [37 CFR 1.111](#) or a reply brief in response to an examiner's answer that contains a new ground of rejection, the appeal will be *sua sponte* dismissed as to the claims subject to the new ground of rejection. If all of the claims under appeal are subject to the new ground of rejection, the entire appeal will be dismissed.

If the appeal is dismissed by the Board, the examiner should follow the procedure set forth in [MPEP § 1215](#).

### 1207.04 Reopening of Prosecution After Appeal [R-11.2013]

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection in response to appellant's brief. A new ground as used in this subsection includes both a new ground that would not be proper in an examiner's answer as described in [MPEP § 1207.03](#), subsection II and a new ground that would be proper (with appropriate supervisory approval) as described in [MPEP § 1207.03](#), subsection III. In deciding whether to reopen prosecution or to add a new ground of rejection to an examiner's answer where proper under [MPEP § 1207.03](#) et seq., examiners and their supervisors should consider the degree to which the rejection previously of record is being changed, any previous reopenings after appeal brief, and the overall

pendency of the application. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under [37 CFR 1.97\(c\)](#) where no statement under [37 CFR 1.97\(e\)](#) was filed. See [MPEP § 706.07\(a\)](#). Ordinarily any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits as part of the action reopening prosecution. Where more than one after final amendments that conflict with each other were filed, e.g., the same claim is replaced by more than one amendment with new proposed claims of differing scope, than the first amendment should be entered and the subsequent amendments should not be entered.

Form paragraph 12.239 may be used when reopening prosecution:

#### ¶ 12.239 Reopening of Prosecution After Appeal Brief

In view of the [1] filed on [2], PROSECUTION IS HEREBY REOPENED. [3] set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under [37 CFR 1.111](#) (if this Office action is non-final) or a reply under [37 CFR 1.113](#) (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under [37 CFR 41.31](#) followed by an appeal brief under [37 CFR 41.37](#). The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in [37 CFR 41.20](#) have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

[4]

#### Examiner Note:

- For use if the notice of appeal was filed on or after January 23, 2012.
- In bracket 1, insert --appeal brief-- or --amended appeal brief--.
- In bracket 2, insert the date on which the brief was filed.
- In bracket 3, insert --A new ground of rejection is-- or --New grounds of rejection are--.

5. In bracket 4, insert the SPE's signature. Approval of the SPE is required to reopen prosecution after an appeal. See [MPEP §§ 1002.02\(d\)](#) and [1207.04](#).

6. Use this form paragraph to reopen prosecution in order to make a new ground of rejection of claims. The Office action following a reopening of prosecution may be made final if all new grounds of rejection were either (A) necessitated by amendment or (B) based on information presented in an information disclosure statement under [37 CFR 1.97\(c\)](#) where no statement under [37 CFR 1.97\(e\)](#) was filed. See [MPEP § 706.07\(a\)](#).

After reopening of prosecution, appellant must exercise one of the following options to avoid abandonment of the application:

(A) file a reply under [37 CFR 1.111](#), if the Office action is non-final;

(B) file a reply under [37 CFR 1.113](#), if the Office action is final; or

(C) initiate a new appeal by filing a new notice of appeal under [37 CFR 41.31](#).

If appellant elects to continue prosecution and prosecution was reopened prior to a decision on the merits by the Board, the fee paid for the notice of appeal, appeal brief (if applicable), forwarding an appeal to the Board (if applicable) and request for oral hearing (if applicable) will be applied to a later appeal on the same application. If, however, the appeal fees set forth in [37 CFR 41.20](#) have increased since they were previously paid, applicant must pay the difference between the increased fees and the amount previously paid. If appellant elects to initiate a new appeal by filing a notice of appeal, appellant must file a complete new brief in compliance with [37 CFR 41.37](#) within two months from the filing of the new notice of appeal. See [MPEP § 1204.01](#) for more information on reinstatement of an appeal.

## **1207.05 Substitute Examiner's Answer [R-11.2013]**

After receipt of a reply brief in compliance with [37 CFR 41.41](#), jurisdiction over the appeal passes to the Board. Normally, the examiner does not need to acknowledge the reply brief and will not have an opportunity for further comment prior to a decision by the Board. However, the Board may remand the appeal to the examiner to furnish a substitute examiner's answer responsive to the remand.

*37 CFR 41.50 Decisions and other actions by the Board.*

(a)(1) *Affirmance and reversal.* The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

(2) If a substitute examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the substitute examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *Reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under [§ 1.111](#) of this title with or without amendment or submission of affidavits ([§§ 1.130, 1.131](#) or [1.132](#) of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. A request that complies with this paragraph (a) will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of [§ 1.112](#) of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in [§ 41.41](#). If such a reply brief is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

\*\*\*\*\*

The examiner may only furnish a substitute examiner's answer in response to a remand.

In response to a substitute examiner's answer that is written in response to a remand by the Board for further consideration of a rejection, appellant must either file: (1) a reply under [37 CFR 1.111](#) to request that prosecution be reopened; or (2) a reply brief to request that the appeal be maintained, within two months from the mailing of the substitute examiner's answer, to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. Examiner may include a new ground of rejection in the substitute examiner's answer responding to a remand by the Board for further consideration of a rejection. See [MPEP § 1207.03](#).

## I. SUBSTITUTE EXAMINER'S ANSWER RESPONDING TO A REMAND FOR FURTHER CONSIDERATION OF REJECTION

The examiner may provide a substitute examiner's answer in response to a remand by the Board for further consideration of a rejection under [37 CFR 41.50\(a\)](#). Appellant must respond to such substitute examiner's answer and has the option to request that prosecution be reopened. A substitute examiner's answer written in response to a remand by the Board for further consideration of a rejection pursuant to [37 CFR 41.50\(a\)\(2\)](#) may set forth a new ground of rejection. Any new ground of rejection made in such a substitute examiner's answer must comply with the requirements set forth in [MPEP § 1207.03](#). The examiner may use form paragraph 12.285 in preparing the substitute examiner's answer responding a remand by the Board for further consideration of a rejection.

### ¶ 12.285 Substitute Examiner's Answer - On Remand FOR FURTHER CONSIDERATION OF A REJECTION

Pursuant to the remand under [37 CFR 41.50\(a\)\(1\)](#) by the Patent Trial and Appeal Board on [1] for further consideration of a rejection, a substitute Examiner's Answer under [37 CFR 41.50\(a\)\(2\)](#) is set forth below: [2].

The appellant must within **TWO MONTHS** from the date of the substitute examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under [37 CFR 1.111](#) with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See [37 CFR 41.50\(a\)\(2\)\(i\)](#).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in [37 CFR 41.41](#). If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under [37 CFR 41.50\(a\)\(2\)\(i\)](#). See [37 CFR 41.50\(a\)\(2\)\(ii\)](#).

Extensions of time under [37 CFR 1.136\(a\)](#) are not applicable to the **TWO MONTH** time period set forth above. See [37 CFR 1.136\(b\)](#) for extensions of time to reply for patent applications and [37 CFR 1.550\(c\)](#) for extensions of time to reply for *ex parte* reexamination proceedings.

A Technology Center Director or designee has approved this substitute examiner's answer by signing below:

[3]

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the date of the remand.
3. In bracket 2, provide reasons supporting the rejections set forth in the substitute Examiner's Answer.
4. In bracket 3, insert the TC Director's or designee's signature. A TC Director or designee must approve every substitute examiner's answer.

#### A. Appellant's Reply

If a substitute examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to [37 CFR 41.50\(a\)\(2\)](#), the appellant must, within two months of the date of the substitute examiner's answer, exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *Reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under [37 CFR 1.111](#) with or without amendment or submission of affidavits ([37 CFR 1.130](#), [1.131](#) or [1.132](#)) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. A request that complies with [37 CFR 41.50\(a\)\(2\)\(i\)](#) will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of [37 CFR 1.112](#). Any request that prosecution be reopened under [37 CFR 41.50\(a\)\(2\)\(i\)](#) will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in [37 CFR 41.41](#). If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under [37 CFR 41.50\(a\)\(2\)\(i\)](#).

The two month time period for reply is not extendable under [37 CFR 1.136\(a\)](#), but is extendable



under [37 CFR 1.136\(b\)](#) for patent applications and [37 CFR 1.550\(c\)](#) for *ex parte* reexamination proceedings.

### **1. Request That Prosecution Be Reopened by Filing a Reply**

If appellant requests that prosecution be reopened, the appellant must file a reply that addresses each ground of rejection set forth in the substitute examiner's answer in compliance with [37 CFR 1.111](#) within two months from the mailing of the substitute examiner's answer. The reply may also include amendments, evidence, and/or arguments directed to claims not subject to the ground of rejection set forth in the substitute examiner's answer or other rejections. If there is after-final amendment (or affidavit or other evidence) that was not entered, appellant may include such amendment in the reply to the substitute examiner's answer.

If the reply is not fully responsive to the ground of rejection set forth in the substitute examiner's answer, but the reply is *bona fide*, the examiner should provide a time period for appellant to complete the reply pursuant to [37 CFR 1.135\(c\)](#). If the reply is not *bona fide* (e.g., does not address the ground of rejection) and the two-month time period has expired, the examiner must *sua sponte* dismiss the appeal as to the claims subject to the rejection for which the Board has remanded the case.

Once appellant files a reply in compliance with [37 CFR 1.111](#) in response to a substitute examiner's answer responding to a remand by the Board for further consideration of a rejection under [37 CFR 41.50\(a\)](#), the examiner must reopen prosecution by entering and considering the reply. Examiner may make the next Office action final unless the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in [37 CFR 1.97\(c\)](#) with the fee set forth in [37 CFR 1.17\(p\)](#). See [MPEP § 706.07\(a\)](#).

### **2. Request That the Appeal Be Maintained by Filing a Reply Brief**

If appellant requests that the appeal be maintained, the appellant must file a reply brief to address each grounds of rejection set forth in the substitute examiner's answer in compliance with [37 CFR 41.37\(c\)\(1\)\(iv\)](#) within two months from the mailing of the substitute examiner's answer. The reply brief must also be in compliance with requirements set forth in [37 CFR 41.41](#) (e.g., it cannot include any new amendment or affidavit). If the reply brief is accompanied by an amendment, affidavit or other evidence, it will be treated as a request that prosecution be reopened before the examiner.

#### ***B. Failure To Reply to a Substitute Examiner's Answer Under 37 CFR 41.50(a)***

If appellant fails to timely file a reply under [37 CFR 1.111](#) or a reply brief in response to a substitute examiner's answer that was written in response to a remand by the Board for further consideration of a rejection under [37 CFR 41.50\(a\)](#), the appeal will be *sua sponte* dismissed as to the claims subject to the rejection for which the Board has remanded the proceeding. As jurisdiction passes to the Board at the expiration of time to file a reply brief, the Board will prepare and mail the dismissal. If all of the claims under appeal are subject to the rejection, the entire appeal will be dismissed. The examiner should follow the procedure set forth in [MPEP § 1215](#) after the appeal is dismissed. For example, if there is no allowed claim in the application, the application would be abandoned when the two-month time period has expired.

If only some of the claims under appeal are subject to the rejection, the dismissal of the appeal as to those claims operates as an authorization to cancel those claims and the appeal continues as to the remaining claims. The Board will render a decision in due course.

## **II. SUBSTITUTE EXAMINER'S ANSWER RESPONDING TO A REMAND THAT IS NOT FOR FURTHER CONSIDERATION OF REJECTION**

The Director of the USPTO may remand an appeal to the examiner. See [37 CFR 41.35\(c\)](#). The Board



may remand an application to the examiner for a reason that is not for further consideration of a rejection, such as to consider an information disclosure statement filed before jurisdiction over the appeal transferred to the Board under [37 CFR 41.35\(d\)](#), a reply brief that raised new issues that were not considered by the examiner, an amendment, or an affidavit. See [MPEP § 1211](#). Consideration of any Information Disclosure Statement or petition filed while the Board possesses jurisdiction over the proceeding will be held in abeyance until the Board's jurisdiction ends. The examiner may provide a substitute examiner's answer in response to the remand. Appellant may respond by filing a reply brief within two months from the mailing of the substitute answer. Appellant does not have the option to request that prosecution be reopened pursuant to [37 CFR 41.50\(a\)](#) unless the remand by the Board is for further consideration of a rejection under [37 CFR 41.50\(a\)](#).

## 1208 Reply Briefs and Fee for Forwarding Appeal [R-11.2013]

### *37 CFR 41.40 Tolling of time period to file a reply brief.*

(a) *Timing.* Any request to seek review of the primary examiner's failure to designate a rejection as a new ground of rejection in an examiner's answer must be by way of a petition to the Director under § [1.181](#) of this title filed within two months from the entry of the examiner's answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

(b) *Petition granted and prosecution reopened.* A decision granting a petition under § [1.181](#) to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant must file a reply under § [1.111](#) of this title to reopen the prosecution before the primary examiner. On failure to timely file a reply under § [1.111](#), the appeal will stand dismissed.

(c) *Petition not granted and appeal maintained.* A decision refusing to grant a petition under § [1.181](#) of this title to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant may file only a single reply brief under § 41.41.

(d) *Withdrawal of petition and appeal maintained.* If a reply brief under § 41.41 is filed within two months from the date of the examiner's answer and on or after the filing of a petition under § [1.181](#) to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal.

(e) *Extensions of time.* Extensions of time under § [1.136\(a\)](#) of this title for patent applications are not applicable to the time

period set forth in this section. See § [1.136\(b\)](#) of this title for extensions of time to reply for patent applications and § [1.550\(c\)](#) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

### *37 CFR 41.41 Reply brief.*

(a) *Timing.* Appellant may file only a single reply brief to an examiner's answer within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under § [1.181](#) of this title to designate a new ground of rejection in an examiner's answer.

#### (b) *Content.*

(1) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence. See § [37 CFR 1.116](#) of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § [41.33](#) for amendments, affidavits or other Evidence filed after the date of filing the appeal.

(2) Any argument raised in the reply brief which was not raised in the appeal brief, or is not responsive to an argument raised in the examiner's answer, including any designated new ground of rejection, will not be considered by the Board for purposes of the present appeal, unless good cause is shown.

(c) *Extensions of time.* Extensions of time under § [1.136\(a\)](#) of this title for patent applications are not applicable to the time period set forth in this section. See § [1.136\(b\)](#) of this title for extensions of time to reply for patent applications and § [1.550\(c\)](#) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

## I. REPLY BRIEF

Under [37 CFR 41.41\(a\)\(1\)](#), appellant may file a single reply brief as a matter of right within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under [37 CFR 1.181](#) to designate a new ground of rejection in an examiner's answer. Extensions of time to file the reply brief may be granted pursuant to [37 CFR 1.136\(b\)](#) (for patent applications) or [1.550\(c\)](#) (for *ex parte* reexamination proceedings). Extensions of time under [37 CFR 1.136\(a\)](#) are not permitted. Normally, appellant is not required to file a reply brief to respond to an examiner's answer, and if appellant does not file a reply brief within the two month period of time, the application will be forwarded to the Board for decision on the appeal. In response to the following, however, appellant is required to file either a reply brief to maintain the appeal or a reply under [37 CFR 1.111](#) to reopen prosecution:

(A) An examiner's answer that designates a new ground of rejection pursuant to [37 CFR 41.39](#) (see [MPEP § 1207.03](#)); or

(B) A substitute examiner's answer responding to a remand by the Board for further consideration of a rejection pursuant to [37 CFR 41.50\(a\)](#) (see [MPEP § 1207.05](#)). Such a substitute examiner's answer may contain a new ground of rejection (also see [MPEP § 1207.03](#)).

If appellant requests that the appeal be maintained in response to a new ground of rejection made in an examiner's answer or a substitute examiner's answer, the appellant must file a reply brief to address each new ground of rejection set forth in the answer in compliance with [37 CFR 41.37\(c\)\(1\)\(iv\)](#) within two months from the mailing of the answer. The reply brief should include the following items, with each item starting on a separate page, so as to follow the other requirements of a brief as set forth in [37 CFR 41.37\(c\)](#):

(A) Identification page setting forth the appellant's name(s), the application number, the filing date of the application, the title of the invention, the name of the examiner, the art unit of the examiner and the title of the paper (i.e., Reply Brief);

(B) Argument page(s).

New or non-admitted affidavits, and/or other evidence are not permitted in a reply brief. Any new amendment must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of [37 CFR 41.33](#). A paper that contains an amendment is not a reply brief within the meaning of [37 CFR 41.41](#). Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

If a reply brief is filed in response to a substitute examiner's answer under [37 CFR 41.50\(a\)](#) that was written in response to a remand by the Board for further consideration of a rejection, any reply brief accompanied by an amendment, affidavit or other evidence will be treated as a request that prosecution be reopened before the examiner. If appellant fails to file a reply brief or a reply under [37 CFR 1.111](#) within two months from the mailing of the examiner's answer that contains a new ground of rejection, or a substitute examiner's answer under [37 CFR 41.50\(a\)](#), the appeal may be dismissed. See [MPEP § 1207.03](#) and [§ 1207.05](#).

## II. EXAMINER'S RESPONSE TO A REPLY BRIEF

After receipt of a reply brief under 37 CFR 41.41, jurisdiction over the appeal passes to the Board. Normally, the examiner does not need to acknowledge the reply brief and will not have an opportunity for further argument prior to a decision by the Board. However, the Board may remand the appeal to the examiner to furnish a substitute examiner's answer responsive to the remand.

### 1208.01 Fee for Forwarding an Appeal to the Board [R-11.2013]

#### *37 CFR 41.45 Appeal forwarding fee*

(a) *Timing.* Appellant in an application or *ex parte* reexamination proceeding must pay the fee set forth in [§ 37 CFR 41.20\(b\)\(4\)](#) within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under [§ 1.181](#) of this chapter to designate a new ground of rejection in an examiner's answer.

(b) *Failure to pay appeal forwarding fee.* On failure to pay the fee set forth in [§ 37 CFR 41.20\(b\)\(4\)](#) within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c) *Extensions of time.* Extensions of time under [§ 1.136\(a\)](#) of this title for patent applications are not applicable to the time period set forth in this section. See [§ 1.136\(b\)](#) of this title for extensions of time to reply for patent applications and [§ 1.550\(c\)](#) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

The examiner's answer should provide notice that the appeal forwarding fee must be paid within the requisite time period or the appeal will stand dismissed. See form paragraphs 12.279 and 12.279.01. It is preferable that appellants pay this fee at the same time any reply brief is filed.

Effective March 19, 2013, the fee for filing an appeal brief in an application or *ex parte* reexamination was reduced to \$0 and a new fee was added for forwarding the appeal to the Board after the mailing of an examiner's answer. Failure to pay this appeal forwarding fee results in the dismissal of the appeal. In the event that appellant fails to timely pay the fee, the appeal is dismissed by rule and the examiner should proceed as indicated in [MPEP § 1215](#) regardless of whether a separate paper is mailed dismissing the appeal. The requirement to pay the appeal forwarding fee is waived when the appeal brief fee was paid before March 19, 2013. As long as the waiver is in effect, applicants having paid the

appeal brief fee before March 19, 2013 will not be required to pay the appeal forwarding fee.

The appeal forwarding fee does not apply to *inter partes* reexamination appeals.

## 1209 Oral Hearing [R-11.2013]

### 37 CFR 41.47 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided on the briefs without an oral hearing will receive the same consideration by the Board as appeals decided after an oral hearing.

(b) If appellant desires an oral hearing, appellant must file, as a separate paper captioned "REQUEST FOR ORAL HEARING," a written request for such hearing accompanied by the fee set forth in § 41.20(b)(3) within two months from the date of the examiner's answer or on the date of filing of a reply brief, whichever is earlier.

(c) If no request and fee for oral hearing have been timely filed by appellant as required by paragraph (b) of this section, the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

(d) If appellant has complied with all the requirements of paragraph (b) of this section, a date for the oral hearing will be set, and due notice thereof given to appellant. If an oral hearing is held, an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. A hearing will be held as stated in the notice, and oral argument will ordinarily be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered.

(e)(1) Appellant will argue first and may reserve time for rebuttal. At the oral hearing, appellant may only rely on Evidence that has been previously entered and considered by the primary examiner and present argument that has been relied upon in the brief or reply brief except as permitted by paragraph (e)(2) of this section. The primary examiner may only rely on argument and Evidence relied upon in an answer except as permitted by paragraph (e)(2) of this section.

(2) Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(f) Notwithstanding the submission of a request for oral hearing complying with this rule, if the Board decides that a hearing is not necessary, the Board will so notify appellant.

(g) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

37 CFR 41.47(b) provides that an appellant who desires an oral hearing before the Board must request the hearing by filing, in a separate paper captioned "REQUEST FOR ORAL HEARING," a written request therefor, accompanied by the appropriate fee set forth in 37 CFR 41.20(b)(3), within 2 months after the date of the examiner's answer or the date of filing of a reply brief, whichever is earlier. This time period ensures that any request for oral hearing is received not later than when jurisdiction over the proceeding passes to the Board (37 CFR 41.35(a)). Form PTO/SB/32 may be used to request an oral hearing. This time period may only be extended by filing a request under either 37 CFR 1.136(b) or, if the appeal involves an *ex parte* reexamination proceeding, under 37 CFR 1.550(c).

If the written request for an oral hearing is not filed in a separate paper captioned "REQUEST FOR ORAL HEARING," the request is improper and the appeal will be assigned for consideration and decision on the briefs without an oral hearing. Likewise, if the request is not timely filed or accompanied by the appropriate fee, the request is improper and the appeal will be assigned for consideration and decision on the briefs without an oral hearing.

A notice of hearing, stating the date, the time, and the docket, is forwarded to the appellant in due course. If appellant fails to confirm the hearing within the time required in the notice of hearing or the appellant waives the hearing, the appeal will be removed from the hearing docket and assigned on brief in due course. No refund of the fee for requesting an oral hearing will be made. Similarly, after confirmation, if no appearance is made at the scheduled hearing, the appeal will be decided on brief. Since failure to notify the Board of waiver of hearing in advance of the assigned date results in a waste of the Board's resources, appellant should inform the Board of a change in plans at the earliest possible opportunity. If the Director or the Board determines that a hearing is not necessary (e.g., a Director-ordered remand to the examiner is necessary or it is clear that the rejection(s) cannot be sustained), appellant will be notified.

If appellant has any special request, such as for a particular date, day of the week, or afternoon vs.

morning hearing session, this will be taken into consideration in setting the hearing, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case and does not place an undue administrative burden on the Board.

The appellant may also file a request, in a separate paper addressed to the Clerk of the Board, to present his/her arguments via telephone or an audio-video connection. The appellant making the request will be required to bear the cost of the telephone call or the audio-video connection. Prior to the hearing date, the Board's IT specialist may contact the appellant making an audio-video request to confirm software compatibility.

The appellant may file a request, in a separate paper addressed to the Clerk of the Board, to use a projector while presenting his/her arguments (e.g., for a PowerPoint® presentation). The Office may provide a projector for the appellant's use subject to availability. The appellant making the request is responsible for providing his or her own laptop or mobile computer.

If the time set in the notice of hearing conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request, in a separate paper addressed to the Clerk of the Board. However, in view of the administrative burden involved in rescheduling hearings and the potential delay which may result in the issuance of any patent based on the application on appeal, postponements are discouraged and will not be granted in the absence of convincing reasons in support of the requested change.

Normally, 20 minutes are allowed for appellant to explain his or her position. If appellant believes that additional time will be necessary, the appellant should file a request in a separate paper addressed to the Clerk of the Board well in advance of the hearing. The request for such time will be taken into consideration in assigning the hearing date. The final decision on whether additional time is to be granted rests within the discretion of the senior member of the panel hearing the case.

At the oral hearing, appellant may only rely on evidence that has been previously entered and considered by the primary examiner and present arguments that have been relied upon in the brief or reply brief. Upon a showing of good cause, appellant and/or the primary examiner may rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court.

The Board's current procedure permits members of the public to attend oral hearings in appeals of reexamination proceedings, reissues, and published applications. Members of the public are not permitted to attend appeals of non-published applications. More information is available at [http://uspto.gov/ip/boards/public\\_hearing\\_info.jsp](http://uspto.gov/ip/boards/public_hearing_info.jsp). All parties, including USPTO employees, attending oral hearings should be particularly mindful of the published Hearing Room Protocol/Decorum. Appropriate attire is clothing that would be worn for an important business meeting.

[37 CFR 41.47\(f\)](#) provides that notwithstanding the submission of a request for oral hearing, if the Board decides that a hearing is not necessary, the Board will so notify appellant. Examples as to when it would be appropriate for the Board to decide that an oral hearing is not necessary include those where the Board has become convinced, prior to hearing, that the examiner's position cannot be sustained or where the Director determines that the proceeding must be remanded to the examiner under [37 CFR 41.35\(c\)](#).

## **PARTICIPATION BY EXAMINER**

If the appellant has requested an oral hearing and the primary examiner wishes to appear and present an oral argument before the Board, a request to present oral argument must be set forth in a separate letter on a form PTOL-90 using form paragraph 12.279.03.

### **¶ 12.279.03 Request to Present Oral Arguments**

The examiner requests the opportunity to present arguments at the oral hearing.

#### **Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.



2. Use this form paragraph only if an oral hearing has been requested by appellant and the primary examiner intends to present an oral argument.

3. This form paragraph must be included as a separate letter on a form PTOL-90.

In those appeals in which an oral hearing has been confirmed by the appellant and the primary examiner has indicated a desire to participate in the oral argument, oral argument will generally only be held if the appellant actually appears for oral argument. If the appellant fails to make an appearance for oral argument, the hearing typically will be waived, and the primary examiner will not be given an opportunity to participate unless the panel hearing the case deems that a presentation by the primary examiner would be useful.

After the oral hearing has been confirmed and the date set as provided in [37 CFR 41.47\(d\)](#), the primary examiner and the examiner's supervisor should be notified of the date and time of the hearing. In those cases where the Board requests the presentation of an oral argument by or on behalf of the primary examiner, the Board's request may, where appropriate, indicate specific points or questions to which the argument should be particularly directed.

On the day of the hearing, examiners associated with the appeal should notify the usher at the Board that they are associated with the appeal and that they are attending the hearing. In addition, the primary examiner associated with the appeal should indicate whether they plan to participate in the oral hearing. At the hearing, after the appellant has made his or her presentation, the examiner will be allowed 15 minutes to reply as well as to present a statement which clearly sets forth his or her position with respect to the issues and rejections of record. Generally, the primary examiner may rely on only argument and evidence relied upon in the examiner's answer. The primary examiner may, however, rely on a new argument based upon a recent relevant decision of either the Board or a Federal Court. Appellant may utilize any allotted time not used in the initial presentation for rebuttal.

## 1210 Actions Subsequent to Examiner's Answer but Before Board's Decision [R-11.2013]

### I. JURISDICTION OF BOARD

#### *37 CFR 41.35 Jurisdiction over appeal.*

(a) *Beginning of jurisdiction.* Jurisdiction over the proceeding passes to the Board upon the filing of a reply brief under § [41.41](#) or the expiration of the time in which to file such a reply brief, whichever is earlier.

(b) *End of jurisdiction.* The jurisdiction of the Board ends when:

(1) The Director or the Board enters a remand order (*see* §§ [41.35\(c\)](#), [41.35\(e\)](#), and [41.50\(a\)\(1\)](#)),

(2) The Board enters a final decision (*see* § [41.2](#)) and judicial review is sought or the time for seeking judicial review has expired,

(3) An express abandonment which complies with § [1.138](#) of this title is recognized,

(4) A request for continued examination is filed which complies with § [1.114](#) of this title,

(5) Appellant fails to take any required action under §§ [41.39\(b\)](#), [41.50\(a\)\(2\)](#), [41.50\(b\)](#), or [41.50\(d\)](#), and the Board enters an order of dismissal, or

(6) Appellant reopens prosecution pursuant to § [41.40\(b\)](#) or in response to a new ground of rejection entered in a decision of the Board (*see* § [41.50\(b\)\(1\)](#)).

(c) *Remand ordered by the Director.* Prior to the entry of a decision on the appeal by the Board (*see* § [41.50](#)), the Director may sua sponte order the proceeding remanded to the examiner.

(d) *Documents filed during Board's jurisdiction.* Except for petitions authorized by this part, consideration of any information disclosure statement or petition filed while the Board possesses jurisdiction over the proceeding will be held in abeyance until the Board's jurisdiction ends.

(e) *Administrative remands ordered by the Board.* If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish jurisdiction to the examiner or take other appropriate action to permit completion of the file.

Jurisdiction over the application passes from the Technology Centers to the Board at the time specified in [37 CFR 41.35\(b\)](#).

Any amendment or other paper relating to the appeal filed thereafter, but prior to the decision of the Board, may be considered by the examiner only in the event the case is remanded for that purpose.



## II. ABANDONMENT OF APPEAL: APPLICATION REFILED OR ABANDONED

To avoid the rendering of decisions by the Board in applications which appellants have decided to abandon or to refile as continuations, appellants should promptly inform the Clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Failure to exercise appropriate diligence in this matter may result in the Board's refusing an otherwise proper request to vacate its decision.

See [MPEP § 1215.01](#) - [§ 1215.03](#) concerning the withdrawal of appeals.

### 1211 Remand by Director or Board [R-08.2017]

Both the Director and the Board have the authority to remand a case to the examiner when necessary. See [37 CFR 41.35\(c\) and \(e\)](#), and [37 CFR 41.40\(a\)](#). As specified by [37 CFR 41.50\(e\)](#), a remand by the Board is not appealable (i.e. not final for purposes of judicial review). In any remand, jurisdiction over the appeal is transferred from the Board back to the examiner. Following the remand, the examiner should take action consistent with the remand order. In the absence of other guidance in the remand order, the examiner should take an action described in [MPEP § 1207](#).

For example, the Director may remand a case for consideration of a new ground of rejection pursuant to [37 CFR 41.35\(c\)](#) where there has been a change in the law that calls for a new ground of rejection to be entered. Such a remand may require the examiner to prepare a substitute examiner's answer to enter the new ground of rejection.

#### 1211.01 Remand by Board for Further Consideration of Rejection [R-11.2013]

A substitute examiner's answer written in response to a remand by the Board for consideration of a rejection pursuant to [37 CFR 41.50\(a\)\(1\)](#) may set forth a new ground of rejection. See [MPEP § 1207.03](#).

If a substitute examiner's answer is written in response to a remand by the Board for consideration of a rejection pursuant to [37 CFR 41.50\(a\)\(1\)](#) (even when there is no new ground of rejection made in the substitute examiner's answer), the appellant must exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(A) *Reopen prosecution*. Request that prosecution be reopened before the examiner by filing a reply under [37 CFR 1.111](#) with or without amendment or submission of affidavits ([37 CFR 1.131\(a\)](#), [37 CFR 1.131\(c\)](#) or [1.132](#)) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. A request that complies with [37 CFR 41.50\(a\)\(2\)\(i\)](#) will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of [37 CFR 1.112](#). Any request that prosecution be reopened under [37 CFR 41.50\(a\)\(2\)\(i\)](#) will be treated as a request to withdraw the appeal.

(B) *Maintain appeal*. Request that the appeal be maintained by filing a reply brief as provided in [37 CFR 41.41](#). If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under [37 CFR 41.50\(a\)\(2\)\(i\)](#).

See [MPEP § 1207.03](#) for information on new grounds of rejection.

See [MPEP § 1207.05](#) for information on substitute examiner's answer and appellant's response to a substitute examiner's answer.

See [MPEP § 1208](#) for information on reply briefs.

The following are two examples of situations where there may be a remand by the Board for examiner action that is not for further consideration of a rejection:

(A) A remand to consider an Information Disclosure Statement; and

(B) A remand for the examiner to consider a reply brief.

[37 CFR 41.50\(a\)\(2\)](#) does not apply when the remand by the Board is not for further consideration of a rejection. The Board will normally indicate in the remand whether [37 CFR 41.50\(a\)\(2\)\(i\)](#) applies. Appellant cannot request that prosecution be reopened under [37 CFR 41.50\(a\)\(2\)\(i\)](#) and is not required to reply to a substitute examiner's answer that is written in response to a remand that is not for further consideration of a rejection.

The following form paragraph may be used in preparing the substitute examiner's answer after a remand from the Board:

**¶ 12.285 Substitute Examiner's Answer - On Remand FOR FURTHER CONSIDERATION OF A REJECTION**

Pursuant to the remand under [37 CFR 41.50\(a\)\(1\)](#) by the Patent Trial and Appeal Board on [1] for further consideration of a rejection, a substitute Examiner's Answer under [37 CFR 41.50\(a\)\(2\)](#) is set forth below: [2].

The appellant must within **TWO MONTHS** from the date of the substitute examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under [37 CFR 1.111](#) with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See [37 CFR 41.50\(a\)\(2\)\(i\)](#).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in [37 CFR 41.41](#). If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under [37 CFR 41.50\(a\)\(2\)\(i\)](#). See [37 CFR 41.50\(a\)\(2\)\(ii\)](#).

Extensions of time under [37 CFR 1.136\(a\)](#) are not applicable to the **TWO MONTH** time period set forth above. See [37 CFR 1.136\(b\)](#) for extensions of time to reply for patent applications and [37 CFR 1.550\(c\)](#) for extensions of time to reply for *ex parte* reexamination proceedings.

**A Technology Center Director or designee has approved this substitute examiner's answer by signing below:**

[3]

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the date of the remand.
3. In bracket 2, provide reasons supporting the rejections set forth in the substitute Examiner's Answer.
4. In bracket 3, insert the TC Director's or designee's signature. A TC Director or designee must approve every substitute examiner's answer.

The supervisory patent examiner must approve any action in which a remanded application is withdrawn from appeal. See [MPEP §§ 706.07\(e\)](#) and [1002.02\(d\)](#). If the examiner decides to withdraw the final rejection and reopen prosecution to enter a new ground of rejection, approval from the supervisory patent examiner is required. See [MPEP § 1207.04](#).

**1211.02 Remand To Consider Amendment [R-11.2013]**

There is no obligation resting on the Board to consider new or amended claims submitted while it has jurisdiction of the appeal. *In re Sweet*, 136 F.2d 722, 58 USPQ 327 (CCPA 1943). However, a proposed amendment filed after the date of filing of a brief to either cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or to rewrite dependent claims into independent form may be remanded for consideration by the examiner. See [MPEP § 1206](#).

If the proposed amendment is in effect an abandonment of the appeal, the appeal will normally be dismissed by the Board.

**1211.03 Remand To Consider Affidavits or Declarations [R-11.2013]**

Affidavits or declarations filed with the filing of a notice of appeal but before jurisdiction passes to the Board (see [MPEP § 1206](#)) will be considered for entry only if the appellant makes the necessary showing under [37 CFR 1.116\(e\)](#) as to why they are necessary and were not earlier presented. Authority from the Board is not necessary to consider such affidavits or declarations. Affidavits or declarations filed after a final rejection and prior to a notice of appeal are handled as provided in [MPEP §§ 715.09](#),

[716](#), and [716.01](#). If such evidence has not been treated by the examiner, the Board or the Director may remand the proceeding to permit the examiner to consider such evidence.

In the case of affidavits or declarations filed after the filing of a notice of appeal, but before a jurisdiction passes to the Board under [37 CFR 41.35](#), the examiner is without authority to consider the same unless the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented have been made. See [MPEP § 1206](#).

It is not the custom of the Board to remand affidavits or declarations offered in connection with a request for rehearing of its decision where no rejection has been made under [37 CFR 41.50\(b\)](#). Affidavits or declarations submitted for this purpose, not remanded to the examiner, are considered only as arguments. *In re Martin*, 154 F.2d 126, 69 USPQ 75 (CCPA 1946).

For remand to the examiner to consider appellant's response relating to a [37 CFR 41.50\(b\)](#) rejection, see [MPEP § 1214.01](#).

#### **1211.04 Remand by Board for Further Search [R-08.2012]**

It should be extremely rare for the Board to remand a case to the examiner for further search. A remand to the examiner extends the total pendency of an application and may necessitate an extension of the patent term under [35 U.S.C. 154\(b\)](#). See [MPEP § 2710](#). When such a remand is necessary, the Board should conduct a search (on-line or otherwise) of at least one subclass and cite art from that subclass to demonstrate the basis on which it concludes that a search of this area would be material. The art cited need not be art upon which a rejection can be made.

#### **1212 Board Requires Appellant to Address Matter [R-08.2017]**

*37 CFR 41.50 Decisions and other actions by the Board.*

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(d) *Request for briefing and information.* The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a time period within which to respond to such an order. Failure to timely comply with the order may result in the sua sponte dismissal of the appeal.

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[37 CFR 41.50\(d\)](#) authorizes the Board to require appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. This may include, for example: (A) the applicability of particular case law that has not been previously identified as relevant to an issue in the appeal; or (B) the applicability of prior art that has not been made of record. However, consideration of information disclosure statements filed while the Board possesses jurisdiction over the appeal will be held in abeyance until the Board's jurisdiction ends. See [37 CFR 41.35\(d\)](#).

The rule further provides that the appellant will be given a time period within which to respond to the requirement. Extensions of time are only available under [37 CFR 1.136\(b\)](#). Failure to respond within the time period set by the Board may result in dismissal of the appeal.

The making of a requirement under [37 CFR 41.50\(d\)](#) is discretionary with the Board. The authority granted in [37 CFR 41.50\(d\)](#) does not affect the Board's authority to remand a case to the examiner in a situation where the Board considers action by the examiner in the first instance to be necessary or desirable. See [MPEP § 1211](#). Also, after an appellant has replied to a requirement under [37 CFR 41.50\(d\)](#), a remand by the Board to the examiner may be appropriate to permit the examiner to respond to the appellant's response to the Board's order.

#### **1213 Decision by Board [R-11.2013]**

*37 CFR 41.50 Decisions and other actions by the Board.*

(a)(1) *Affirmance and reversal.* The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

(2) If a substitute examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the substitute examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *Reopen prosecution.* Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. A request that complies with this paragraph (a) will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

(b) *New ground of rejection.* Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, and designate such a statement as a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) *Review of undesignated new ground of rejection.* Any request to seek review of a panel's failure to designate a new ground of rejection in its decision must be raised by filing a request for rehearing as set forth in § 41.52. Failure of appellant to timely file such a request for rehearing will constitute a waiver

of any arguments that a decision contains an undesignated new ground of rejection.

(d) *Request for briefing and information.* The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a time period within which to respond to such an order. Failure to timely comply with the order may result in the sua sponte dismissal of the appeal.

(e) *Remand not final action.* Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

(f) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

After consideration of the Record including appellant's briefs and the examiner's answers, the Board writes its decision, affirming the examiner in whole or in part, or reversing the examiner's decision, sometimes also setting forth a new ground of rejection.

37 CFR 41.50(e) provides that a decision of the Board which includes a remand will not be considered final for judicial review. The Board, following conclusion of the proceedings before the examiner, will either adopt its earlier decision as final for judicial review or will render a new decision based on all appealed claims, as it considers appropriate. In either case, final action by the Board will give rise to the alternatives available to an appellant following a decision by the Board.

On occasion, the Board has refused to consider an appeal until after the conclusion of a pending civil action or appeal to the Court of Appeals for the Federal Circuit involving issues identical with and/or similar to those presented in the later appeal. Such suspension of action, postponing consideration of the appeal until the Board has the benefit of a court decision which may be determinative of the issues involved, has been recognized as sound practice. An appellant is not entitled, after obtaining a final decision by the U.S. Patent and Trademark Office on an issue in a case, to utilize the prolonged pendency of a court proceeding as a means for



avoiding *res judicata* while relitigating the same or substantially the same issue in another application.

An appellant may petition that the decision be withheld to permit the refiling of the application at any time prior to the mailing of the decision. Up to 30 days may be granted, although the time is usually limited as much as possible. The Board will be more prone to entertain the appellant's petition where the petition is filed early, obviating the necessity for an oral hearing or even for the setting of the oral hearing date. If the case has already been set for oral hearing, the petition should include a request to vacate the hearing date, *not* to postpone it.

In a situation where a withdrawal of the appeal is filed on the same day that the decision is mailed, a petition to vacate the decision will be denied.

See [MPEP § 1214.01](#) concerning the procedure following a new ground of rejection by the Board under [37 CFR 41.50\(b\)](#).

A remark by the Board that a certain feature does not appear in a claim is not to be taken as a statement that the claim may be allowed if the feature is supplied by amendment. *Ex parte Norlund*, 1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913). A remark by the Board shall not be construed by appellant to give appellant authority to amend the claim.

## 1213.01 [Reserved]

## 1213.02 New Grounds of Rejection by Board [R-11.2013]

### *37 CFR 41.50 Decisions and other actions by the Board.*

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(b) *New ground of rejection.* Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, and designate such a statement as a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § [41.52](#) by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

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(f) *Extensions of time.* Extensions of time under § [1.136\(a\)](#) of this title for patent applications are not applicable to the time periods set forth in this section. See § [1.136\(b\)](#) of this title for extensions of time to reply for patent applications and § [1.550\(c\)](#) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

Under [37 CFR 41.50\(b\)](#), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner. When the Board exercises its authority to make a new ground of rejection it must also designate that rejection as a new ground of rejection.

The Board's reversal of a rejection should not be interpreted as an instruction to the Examiner to allow the claims so rejected. See [MPEP § 1214.04](#) for further discussion of the procedure following a reversal of the examiner's decision. The Board's primary role is to review the adverse decision as presented by the Examiner, and not to conduct its own separate examination of the claims. Further, since the exercise of authority under [37 CFR 41.50\(b\)](#) is discretionary, no inference should be drawn from a failure to exercise that discretion.

While the Board is authorized to reject allowed claims, this authorization is not intended as an instruction to the Board to examine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on



different grounds from those applied against the rejected claims.

See [MPEP § 1214.01](#) for the procedure following a new ground of rejection under [37 CFR 41.50\(b\)](#).

### 1213.03 Publication of and Public Access to Board Decision [R-11.2013]

#### *37 CFR 41.6 Public availability of Board records.*

##### (a) *Publication.*

(1) *Generally.* Any Board action is available for public inspection without a party's permission if rendered in a file open to the public pursuant to § [1.11](#) of this title or in an application that has been published in accordance with §§ [1.211](#) to [1.221](#) of this title. The Office may independently publish any Board action that is available for public inspection.

(2) *Determination of special circumstances.* Any Board action not publishable under paragraph (a)(1) of this section may be published or made available for public inspection if the Director believes that special circumstances warrant publication and a party does not, within two months after being notified of the intention to make the action public, object in writing on the ground that the action discloses the objecting party's trade secret or other confidential information and states with specificity that such information is not otherwise publicly available. If the action discloses such information, the party shall identify the deletions in the text of the action considered necessary to protect the information. If the affected party considers that the entire action must be withheld from the public to protect such information, the party must explain why. The party will be given time, not less than twenty days, to request reconsideration and seek court review before any contested portion of the action is made public over its objection.

##### (b) *Record of proceeding.*

(1) The record of a Board proceeding is available to the public unless a patent application not otherwise available to the public is involved.

(2) Notwithstanding paragraph (b)(1) of this section, after a final Board action in or judgment in a Board proceeding, the record of the Board proceeding will be made available to the public if any involved file is or becomes open to the public under § [1.11](#) of this title or an involved application is or becomes published under §§ [1.211](#) to [1.221](#) of this title.

Any Board decision is available for public inspection without a party's permission if rendered in a file open to the public pursuant to [37 CFR 1.11](#) or in an application that has been published in accordance with [37 CFR 1.211](#) through [1.221](#). The Office may independently publish any Board action that is available for public inspection.

Decisions of the Board which are open to the public are available in electronic form on the USPTO Web

site (<http://www.uspto.gov>) in the FOIA reading room.

Any Board decision rendered in a file not open to the public pursuant to [37 CFR 1.11](#) or in an application that has not been published in accordance with [37 CFR 1.211](#) through [1.221](#) may be published or made available for public inspection under [37 CFR 41.6\(a\)\(2\)](#) if the Director believes that special circumstances warrant publication.

### 1214 Procedure Following Decision by Board [R-11.2013]

#### *37 CFR 41.54 Action following decision.*

After decision by the Board, jurisdiction over an application or patent under *ex parte* reexamination proceeding passes to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application or patent under *ex parte* reexamination proceeding may require, to carry into effect the decision.

After an appeal to the Board has been decided, a copy of the decision is provided to appellant and placed in IFW. The 63-day time period for filing an appeal or commencing a civil action under [37 CFR 90.3](#), or the two month period for filing a request for rehearing under [37 CFR 41.52](#), begins to run from the "MAIL DATE" if the decision is provided by paper delivery, or the "NOTIFICATION DATE" if the decision is provided by electronic delivery, as shown on the FORM PTOL-90A attached to the decision. The application is returned to the Technology Center electronically via a change in the PALM status code reflecting the decision of the Board. If the Board decision affirms or affirms in part the decision of the examiner, the examiner must await the expiration of this two month period before taking any further action.

### 1214.01 Procedure Following New Ground of Rejection by Board [R-08.2017]

When the Board designates a new ground of rejection under [37 CFR 41.50\(b\)](#), the appellant, as to each claim so rejected, has the option of:

(A) reopening prosecution before the examiner by submitting an appropriate amendment and/or new evidence ([37 CFR 41.50\(b\)\(1\)](#)); or

(B) requesting rehearing before the Board ([37 CFR 41.50\(b\)\(2\)](#)).

This procedure only applies where the Board designates a rejection as a new ground of rejection under [37 CFR 41.50\(b\)](#). If an appellant believes that a Board decision that appears to be an affirmance is actually a new ground of rejection, review of any undesignated new ground of rejection is by way of [37 CFR 41.50\(c\)](#) and [37 CFR 41.52](#) and not through the procedure described here.

Where a decision designates a new ground of rejection under [37 CFR 41.50\(b\)](#), the Board retains jurisdiction over the appeal until:

(a) the time for response expires and the Board enters an order of dismissal ([37 CFR 41.35\(b\)\(5\)](#)), or

(b) appellant reopens prosecution in response to the new grounds of rejection ([37 CFR 41.35\(b\)\(6\)](#)).

The amendment and/or new evidence under [37 CFR 41.50\(b\)\(1\)](#), or the request for rehearing under [37 CFR 41.50\(b\)\(2\)](#), must be filed within 2 months from the date of the Board's decision. In accordance with [37 CFR 41.50\(f\)](#), this 2-month time period may not be extended by the filing of a petition and fee under [37 CFR 1.136\(a\)](#), but only under the provisions of [37 CFR 1.136\(b\)](#), or under [37 CFR 1.550\(c\)](#) if the appeal involves an *ex parte* reexamination proceeding.

If an appellant files an appropriate amendment or new evidence (see paragraph I below) as to less than all of the claims rejected by the Board under [37 CFR 41.50\(b\)](#), and a request for rehearing (see paragraph II below) as to the remainder of the claims so rejected, the examiner will not consider the claims for which rehearing was requested. The request for rehearing will be considered by the Board after prosecution before the examiner with respect to the first group of claims is terminated. Argument as to any of the claims rejected by the Board which is not accompanied by an appropriate amendment or new evidence as to those claims will be treated as a request for rehearing as to those claims.

## I. SUBMISSION OF AMENDMENT OR NEW EVIDENCE

[37 CFR 41.50\(b\)\(1\)](#) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or new evidence relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. *Ex parte Comstock*, 317 O.G. 4, 1923 C.D. 82 (Comm'r Pat. 1923). An amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate. The new claims will not be entered, and the examiner should consult a supervisor to have the entry in the file changed to a request for rehearing under [37 CFR 41.50\(b\)\(2\)](#), if it contains any argument concerning the Board's rejection. The "new evidence" under the rule may be a showing under [37 CFR 1.130](#), [1.131](#) or [1.132](#), as may be appropriate.

If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, it will be treated as a request for rehearing under [37 CFR 41.50\(b\)\(2\)](#).

The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under [37 CFR 41.50\(b\)](#) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the [37 CFR 41.50\(b\)](#) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further

prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the [37 CFR 41.50\(b\)](#) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board. If the rejection under [37 CFR 41.50\(b\)](#) is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the [37 CFR 41.50\(b\)](#) rejection and may not include the affirmed rejection. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under [37 CFR 41.50\(b\)](#) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered.

The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See [MPEP §§ 1214.03](#) and [1216](#). The date of the decision is the "mailing date" or "notification date" indicated on form PTOL-90 accompanying the Board decision. See *In re McNeil-PPC*, 574 F.3d 1393, 91 USPQ2d 1576 (Fed. Cir. 2009).

If the examiner does not consider that the amendment and/or new evidence overcomes the rejection, the examiner will again reject the claims. If appropriate, the rejection will be made final.

An applicant in whose application such a final rejection has been made by the examiner may mistakenly believe that they are entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of [37 CFR 41.50\(b\)\(1\)](#), after such a final rejection, an applicant who desires further review of the matter must file a new appeal to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees.

## II. REQUEST FOR REHEARING

Instead of filing an amendment and/or new evidence under [37 CFR 41.50\(b\)\(1\)](#), an appellant may elect to proceed under [37 CFR 41.50\(b\)\(2\)](#) and file a request for rehearing of the Board's new rejection. The rule requires that the request for rehearing "must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought." By proceeding in this manner, the appellant waives their right to further prosecution before the examiner. *In re Greenfield*, 40 F.2d 775, 5 USPQ 474 (CCPA 1930). This waiver extends to the appellant's right to amend claims under [37 CFR 41.50\(b\)\(1\)](#); appellant may still invoke the limited right to rewrite dependent claims not subject to the new grounds of rejection into independent form. See [MPEP § 1214.06](#). A request for rehearing accompanied by an appropriate amendment of the claims rejected by the Board, and/or by new evidence, does not constitute a proper request for rehearing under [37 CFR 41.50\(b\)\(2\)](#), and will be treated as a submission under [37 CFR 41.50\(b\)\(1\)](#).

If the Board's decision also includes an affirmance of the examiner's rejection, a request for rehearing of the affirmance (see [MPEP §§ 1214.03](#) and [1214.06](#), subsection IV.) should be filed in a separate paper to facilitate consideration.

### 1214.02 [Reserved]

### 1214.03 Rehearing [R-11.2013]

#### *37 CFR 41.52 Rehearing.*

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised, and Evidence not previously relied upon, pursuant to §§ [41.37](#), [41.41](#), or [41.47](#) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its

decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

(2) Appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection designated pursuant to § [41.50\(b\)](#) are permitted.

(4) New arguments that the Board's decision contains an undesignated new ground of rejection are permitted.

(b) Extensions of time under § [1.136\(a\)](#) of this title for patent applications are not applicable to the time period set forth in this section. See § [1.136\(b\)](#) of this title for extensions of time to reply for patent applications and § [1.550\(c\)](#) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

The term “rehearing” is used in [37 CFR 41.52](#) for consistency with the language of [35 U.S.C. 6\(b\)](#). It should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record. It is not the normal practice of the Board to grant rehearings in the sense of another oral hearing.

*Ex parte Argoudelis*, 157 USPQ 437, 441 (Bd. App. 1967), *rev'd. on other grounds*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970).

[37 CFR 41.52](#) provides that any request for rehearing must specifically state the points believed to have been misapprehended or overlooked in the Board's decision. Experience has shown that many requests for rehearing are nothing more than reargument of appellant's position on appeal. In response, the rule was revised to limit requests to the points of law or fact which appellant feels were overlooked or misapprehended by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except appellant may present (A) new argument(s) based upon a recent relevant decision of either the Board or a Federal Court, (B) new argument(s) responding to a new ground of rejection made pursuant to [37 CFR 41.50\(b\)](#), and (C) new argument(s) that the Board's decision contains an undesignated new ground of rejection. If appellant relies upon a recent relevant decision of either the Board or a Federal Court, a remand by the Board to the examiner to respond to that new argument may be appropriate.

The 2-month period provided by [37 CFR 41.52\(a\)](#) for filing a request for rehearing can only be extended under the provisions of [37 CFR 1.136\(b\)](#) or under [37 CFR 1.550\(c\)](#) if the appeal involves an *ex parte* reexamination proceeding.

For extension of time to appeal to the Court of Appeals for the Federal Circuit or commence a civil action under 37 CFR 90.3(c), see [MPEP § 1216](#) and [§ 1002.02\(o\)](#).

For requests for reconsideration by the examiner, see [MPEP § 1214.04](#).

Should an Administrative Patent Judge (APJ) retire or otherwise become unavailable to reconsider a decision, normally another APJ will be designated as a substitute for the unavailable APJ.

## **1214.04 Examiner Reversed in Whole [R-08.2017]**

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under [37 CFR 41.50\(b\)](#) or the application contains withdrawn claims to a non-elected invention), the examiner should refer to the situations outlined in [MPEP § 1214.06](#) for appropriate guidance.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, they should submit the matter to the Technology Center (TC) Director or Central



Reexamination Unit (CRU) Director for authorization to reopen prosecution under [37 CFR 1.198](#) for the purpose of entering the new rejection. See [MPEP § 1002.02\(c\)](#) and [MPEP § 1214.07](#). The TC or CRU Director's approval is placed on the action reopening prosecution.

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the return of the application to the TC or the reexamination proceeding or reissue application to the CRU.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC or CRU Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the answers before the Board and evidence not previously relied upon in the answers are not permitted in the request for rehearing except that the examiner may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

The request should set a period of 2 months for the appellant to file a reply.

If the request for rehearing is approved by the Office of the Deputy Commissioner for Patent Examination Policy, the TC or CRU will enter the request for rehearing in the electronic file and a copy will be mailed or given to the appellant.

### **1214.05 Cancellation of Claims Not Appealed [R-11.2013]**

Pursuant to [37 CFR 41.31\(c\)](#), an appeal is presumed to be taken from the rejection of all claims. Where, in an appeal brief filed before January 23, 2012, an appellant withdraws some of the appealed claims (i.e., claims subject to a ground of rejection that the appellant did not present for review in the brief), and the Board reverses the examiner on the remaining appealed claims, the withdrawal is treated as an

authorization to cancel the withdrawn claims. It is necessary for the examiner to notify the appellant of the cancellation of the withdrawn claims. See [MPEP § 1205.02](#).

### **1214.06 Examiner Sustained in Whole or in Part; Claims Require Action [R-08.2017]**

#### ***37 CFR 41.35 Jurisdiction over appeal.***

\*\*\*\*\*

(b) *End of jurisdiction.* The jurisdiction of the Board ends when:

\*\*\*\*\*

(2) The Board enters a final decision (*see* § [41.2](#)) and judicial review is sought or the time for seeking judicial review has expired,

\*\*\*\*\*

#### ***37 CFR 1.197 Termination of proceedings.***

(a) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action except:

(1) Where claims stand allowed in an application; or

(2) Where the nature of the decision requires further action by the examiner.

(b) The date of termination of proceedings on an application is the date on which the appeal is dismissed or the date on which the time for appeal to the U.S. Court of Appeals for the Federal Circuit or review by civil action (§ [90.3](#) of this chapter) expires in the absence of further appeal or review. If an appeal to the U.S. Court of Appeals for the Federal Circuit or a civil action has been filed, proceedings on an application are considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

The practice under the situations identified in subsections I-III below is similar to the practice after a decision of the court outlined in [MPEP § 1216.01](#). Examiners must be very careful that applications and *ex parte* reexamination proceedings that leave the jurisdiction of the Board are not overlooked because every case is up for action by the examiner in the event no court review has been sought. See [MPEP §§ 1216.01](#) and [1216.02](#) for procedure where court review is sought.

As provided by [37 CFR 90.3](#), the time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District



Court for the Eastern District of Virginia is the same for both tribunals, that is, 63 days plus any additional time requested and granted under [37 CFR 90.3\(c\)](#). In the event a request for rehearing is timely filed before the Board, or as extended by the Director. See [MPEP § 1216](#). When the time for seeking court review has passed without such review being sought, the examiner must take up the application or *ex parte* reexamination for consideration. The situations which can arise will involve one or more of the following circumstances:

## I. NO CLAIMS STAND ALLOWED

The proceedings in an application or *ex parte* reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. In an application, a Notice of Abandonment should be prepared and mailed once the period for seeking review under [37 CFR 90.3](#) has expired. In an *ex parte* reexamination proceeding, a notice of intent to issue a reexamination certificate should be issued under [37 CFR 1.570](#) once the period for seeking review under [37 CFR 90.3](#) has expired.

If the application includes a non-statutory double patenting rejection which was affirmed by the Board or a provisional rejection that was not addressed by the Board, the applicant may file a proper terminal disclaimer prior to the expiration of the period for seeking review under [37 CFR 90.3](#) to overcome the rejection. If the terminal disclaimer is insufficient to overcome the rejection the applicant will not be granted additional time to correct the deficiency. See [MPEP §§ 804.02](#) and [1490](#).

Claims indicated as allowable but objected to prior to appeal because of their dependency from rejected claims will be treated as if they were rejected, unless an amendment pursuant to [37 CFR 41.33\(b\)\(2\)](#) rewriting such claims in independent form is filed within the period for seeking review under [37 CFR 90.3](#). See [MPEP § 1206](#). The following examples illustrate the appropriate approach to be taken by the examiner in various situations in applications:

(A) If claims 1-2 are pending, the Board affirms a rejection of independent claim 1, dependent claim 2 was objected to prior to forwarding of the appeal as being allowable except for its dependency from

claim 1 and claim 2 remains in dependent form, the examiner should hold the application abandoned.

(B) If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, after expiration of the period for further appeal, the examiner should proceed in one of two ways:

(1) Convert the dependent claim into independent form by examiner's amendment, cancel all claims in which the rejection was affirmed, and issue the application; or

(2) Set a 2-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under [37 CFR 1.136\(a\)](#) are available. If no timely reply is received, the application is abandoned since no claims stand allowed.

The following form paragraph may be used where appropriate:

### ¶ 12.291 Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (No Allowed Claim)

The Patent Trial Appeal Board affirmed the rejection(s) against independent claim(s) [1], but reversed all rejections against claim(s) [2] dependent thereon. There are no allowed claims in the application. The independent claim(s) is/are cancelled by the examiner in accordance with [MPEP § 1214.06](#). Applicant is given a TWO MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form to avoid ABANDONMENT of the application. EXTENSIONS OF TIME UNDER [37 CFR 1.136\(a\)](#) ARE AVAILABLE. Prosecution is otherwise closed.

#### Examiner Note:

- For use if the notice of appeal was filed on or after January 23, 2012.
- In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).
- In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).

For procedures in reexamination proceedings, see [MPEP § 2278](#), subsection I.

## II. CLAIMS STAND ALLOWED

The appellant is not required to file a reply. The examiner issues the application or *ex parte* reexamination certificate on the claims which stand allowed. It is not necessary for the applicant or patent owner to cancel the rejected claims, since they may

be canceled by the examiner in an examiner's amendment.

If the Board affirms a rejection of claim 1, claim 2 was objected to prior to appeal as being allowable except for its dependency from claim 1 and independent claim 3 is allowed, the examiner should cancel claims 1 and 2 and issue the application or *ex parte* reexamination certificate with claim 3 only.

If the Board affirms a rejection against independent claim 1, reverses all rejections against dependent claim 2 and claim 3 is allowed, after expiration of the period for further appeal, the examiner should either:

(A) Convert dependent claim 2 into independent form by examiner's amendment, cancel claim 1 in which the rejection was affirmed, and issue the application or *ex parte* reexamination certificate with claims 2 and 3; or

(B) Set a time limit in which appellant may rewrite dependent claim 2 in independent form. Extensions of time under [37 CFR 1.136\(a\)](#) will not be permitted. If no timely reply is received, the examiner will cancel claims 1 and 2 and issue the application with allowed claim 3 only.

The following form paragraphs may be used where appropriate:

**¶ 12.292 Examiner Sustained in Part - Requirement of Rewriting Dependent Claims (At Least One Allowed Claim)**

The Patent Trial and Appeal Board affirmed the rejection(s) against independent claim(s) [1], but reversed all rejections against claim(s) [2] dependent thereon. The independent claim(s) is/are cancelled by the examiner in accordance with [MPEP § 1214.06](#). Applicant is given a TWO MONTH TIME PERIOD from the mailing date of this letter in which to present the dependent claim(s) in independent form. EXTENSIONS OF TIME UNDER [37 CFR 1.136](#) ARE AVAILABLE. Failure to comply will result in cancellation of the dependent claims and the application will be allowed with claim(s) [3]. Prosecution is otherwise closed.

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, enter the independent claim number(s) for which the Board affirmed the rejection(s).
3. In bracket 2, enter the dependent claim number(s) for which the Board reversed the rejection(s).

4. In bracket 3, enter the claim number(s) of the allowed claims.

If uncorrected matters of form which cannot be handled without written correspondence remain in the application, the examiner should take appropriate action but prosecution is otherwise closed. A letter such as that set forth in form paragraph 12.297 is suggested:

**¶ 12.297 Period For Seeking Court Review Has Lapsed**

The period under [37 CFR 90.3](#) for seeking court review of the decision by the Patent Trial and Appeal Board rendered [1] has expired and no further action has been taken by appellant. The proceedings as to the rejected claims are considered terminated; see [37 CFR 1.197\(b\)](#).

The application will be passed to issue on allowed claim [2] provided the following formal matters are promptly corrected: [3]. Prosecution is otherwise closed.

Applicant is required to make the necessary corrections addressing the outstanding formal matters within a shortened statutory period set to expire TWO MONTHS from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under [37 CFR 1.136](#).

**Examiner Note:**

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, enter the mailing date of the decision (or notification date of the decision if electronic mail notification was sent to the appellant under the e-Office Action program).
3. In bracket 2, identify the allowed claims.
4. In bracket 3, identify the formal matters that need correction.

For procedures in reexamination proceedings, see [MPEP § 2278](#), subsection II.

### III. CLAIMS REQUIRE ACTION

A decision of the Board may include a reversal of a rejection that brings certain claims up for action on the merits. These decisions include the reversal of the rejection of generic claims in an application containing claims to nonelected species not previously acted upon. The application may also contain a provisional rejection which was not reached in the Board's decision. The examiner will take up the application for appropriate action on the matters thus brought up. However, the application

is not considered open to further prosecution except as to such matters.

*A. Application contains non-elected claims*

If, upon review of the decision of the Board, the elected claims are in condition for allowance and the application contains claims directed to a non-elected invention, whether the election was made with or without traverse, the non-elected invention should be considered for rejoinder. See [MPEP § 821.04](#).

If the decision of the Board includes a reversal of all rejections of a generic claim, pending claims drawn to a non-elected species must be acted upon. The only exception is when, the examiner reopens prosecution and enters a new ground of rejection of the generic claim and determines that the election of species continues to be appropriate; in such situations the generic claim and any claims drawn to the elected species are examined on the merits and claims drawn to non-elected species remain withdrawn from consideration. See [MPEP § 809](#).

*B. Application contains a provisional nonstatutory double patenting rejection, which was not reached by the Board.*

If a decision by the Board does not include an opinion on a provisional nonstatutory double patenting rejection, and includes a reversal of all other grounds as to a claim rejected based on provisional nonstatutory double patenting and the applicant has not filed a proper terminal disclaimer, the examiner must act upon the provisional nonstatutory double patenting rejection. The examiner must first determine if any reference application used in the provisional nonstatutory double patenting rejection has issued as a patent. If the reference application has issued, the provisional rejection should be re-issued as a non-provisional rejection and a terminal disclaimer should be required, for example, by using form paragraphs 8.33-8.39 as appropriate. See [MPEP § 804](#), subsection II.B. If the reference application has been abandoned or has not matured to a patent and the provisional double patenting rejection is the only remaining rejection in the application the examiner should withdraw the provisional rejection.

#### IV. 37 CFR 41.50(b) REJECTION

Where the Board makes a new rejection under [37 CFR 41.50\(b\)](#) and no action is taken with reference thereto by appellant within 2 months, the examiner should proceed in the manner indicated in paragraphs I-III of this section as appropriate. See [MPEP § 1214.01](#).

If the Board affirms the examiner's rejection, but also enters a new ground of rejection under [37 CFR 41.50\(b\)](#), the subsequent procedure depends upon the action taken by the appellant with respect to the [37 CFR 41.50\(b\)](#) rejection.

(A) If the appellant elects to proceed before the examiner with regard to the new rejection (see [MPEP § 1214.01](#), subsection I., the Board's affirmance will be treated as nonfinal, and no request for rehearing of the affirmance need be filed at that time. In order to proceed before the examiner, applicant must amend the newly rejected claims or submit new evidence, as defined in 37 CFR 41.33, or both. If applicant presents arguments against the new grounds of rejection without amendment or evidence, jurisdiction over the appeal should remain with the Board. The Board, having made the new ground of rejection and thus having the most complete understanding of the logic and analysis that led to the new ground, is in the best position to evaluate appellant's rebuttal arguments in a request for rehearing. It is only in the instance where appellant chooses to amend the claims or submit new evidence that prosecution must be reopened and the case returned to the examiner to consider the amendment and/or new evidence in the first instance. Should an examiner discover that a reply containing only arguments against a new ground of rejection has been returned to the examining corps, the appeal should be returned to the Board for appropriate handling.

Prosecution before the examiner of the [37 CFR 41.50\(b\)](#) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the [37 CFR 41.50\(b\)](#) rejection. If an application becomes allowed, it should not be returned to the Board. Likewise, if an application is

abandoned for any reason, it should not be returned to the Board. If the rejection under [37 CFR 41.50\(b\)](#) is not overcome, the applicant (or patent owner in an *ex parte* reexamination proceeding) can file a second appeal (as discussed below). Such appeal must be limited to the [37 CFR 41.50\(b\)](#) rejection and may not include the affirmed rejection. If an application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under [37 CFR 41.50\(b\)](#) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered. Similarly, the file of any *ex parte* reexamination proceeding including decisions including rejections affirmed by the Board but made non-final for purposes of judicial review must be returned to the Board so that the affirmance can be made final by the Board. The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See [MPEP §§ 1214.03](#) and [1216](#).

(B) If the appellant elects to request rehearing of the new rejection (see [MPEP § 1214.01](#), paragraph II), the request for rehearing of the new rejection and of the affirmance must be filed within 2 months from the date of the Board's decision.

### 1214.07 Reopening of Prosecution [R-11.2013]

#### *37 CFR 1.198 Reopening after a final decision of the Patent Trial and Appeal Board.*

When a decision by the Patent Trial and Appeal Board on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § [1.114](#) or § [41.50](#) of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Sometimes an amendment is filed after the Board's decision which presents a new or amended claim or claims. In view of the fact that prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under [37 CFR 1.114](#) and the fee set forth in [37 CFR 1.17\(e\)](#), prosecution of the application will be reopened and the amendment will be entered. See [MPEP § 706.07\(h\)](#), subsection

XI. Note that the RCE practice under [37 CFR 1.114](#) does not apply to utility or plant patent applications filed before June 8, 1995 or to design applications. See [37 CFR 1.114\(d\)](#) and [MPEP § 706.07\(h\)](#), subsection I. If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be entered, and with the concurrence of the supervisory patent examiner, the amendment will be entered. Note [MPEP § 1002.02\(d\)](#).

Where the amendment cannot be entered, the examiner should write to the appellant indicating that the amendment cannot be entered and stating the reason why. The refusal may not be arbitrary or capricious.

Form paragraph 12.298 should be used:

#### ¶ 12.298 Amendment After Board Decision, Entry Refused

The amendment filed [1] after a decision by the Patent Trial and Appeal Board is not entered because prosecution is closed. As provided in [37 CFR 1.198](#), prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner after a final decision of the Board except under the provisions of [37 CFR 1.114](#) (request for continued examination) or [37 CFR 41.50](#) without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the date the amendment was filed.
3. This form paragraph is not to be used where a [37 CFR 41.50\(b\)](#) rejection has been made by the Board.

In the event that claims stand allowed in the application under the conditions set forth in [MPEP § 1214.06](#), paragraph II, the application should be passed to issue.

Petitions under [37 CFR 1.198](#) to reopen or reconsider prosecution of a case after decision by the Board, where no court action has been filed, are decided by the Technology Center Director, [MPEP § 1002.02\(c\)](#).

The Director of the USPTO also entertains petitions under [37 CFR 1.198](#) to reopen certain cases in which an appellant has sought review under [35 U.S.C. 141](#) or [145](#). This procedure is restricted to cases which



have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:

(A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;

(B) When the decision of the Board asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

(C) When the decision of the Board is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

Such petitions will not be ordinarily entertained after the filing of the Director's brief in cases in which review has been sought under [35 U.S.C. 141](#), or after trial in a [35 U.S.C. 145](#) case.

In the case of an appeal under [35 U.S.C. 141](#), if the petition is granted, steps will be taken to request the court to remand the case to the U. S. Patent and Trademark Office. If so remanded, the proposed amendments, evidence, and arguments will be entered of record in the application file for consideration, and further action will be taken by the Board in the first instance or by the examiner as may be appropriate. In the case of civil action under [35 U.S.C. 145](#), steps will be taken for obtaining dismissal of the action without prejudice to consideration of the proposals.

## **1215 Withdrawal or Dismissal of Appeal [R-11.2013]**

### **1215.01 Withdrawal of Appeal [R-11.2013]**

Where, after an appeal has been filed and before decision by the Board, an applicant withdraws the appeal after the period for reply to the final rejection has expired, the application is to be considered abandoned as of the date on which the appeal was withdrawn unless there are allowed claims in the case.

Where a letter abandoning the application is filed in accordance with [37 CFR 1.138](#), the effective date of abandonment is the date of recognition of the letter by an appropriate official of the Office or a different date, if so specified in the letter itself. See [MPEP § 711.01](#).

If a brief has been filed within the time permitted by [37 CFR 41.37](#) (or any extension thereof) and an answer mailed and appellant withdraws the appeal prior to transfer of jurisdiction to the Board under [37 CFR 41.35\(a\)](#), the application is returned to the examiner. If appellant withdraws the appeal after jurisdiction has been transferred to the Board, dismissal of the appeal will be handled by the Board.

Prior to a decision by the Board, if an applicant wishes to withdraw an application from appeal and to reopen prosecution of the application, applicant can file a request for continued examination (RCE) under [37 CFR 1.114](#), accompanied by a submission (i.e., a reply responsive within the meaning of [37 CFR 1.111](#) to the last outstanding Office action) and the RCE fee set forth under [37 CFR 1.17\(e\)](#). Note that the RCE practice under [37 CFR 1.114](#) does not apply to utility or plant patent applications filed before June 8, 1995, design applications, or reexamination proceedings. See [37 CFR 1.114\(d\)](#) and [MPEP § 706.07\(h\)](#), subsection X., for more details. An appeal brief or reply brief (or related papers) is not a submission under [37 CFR 1.114](#), unless the transmittal letter of the RCE contains a statement that incorporates by reference the arguments in a previously filed appeal brief or reply brief. See [MPEP § 706.07\(h\)](#), subsection II. The filing of an RCE will be treated as a withdrawal of the appeal by the applicant, regardless of whether



the RCE includes the appropriate fee or a submission. Therefore, when an RCE is filed without the appropriate fee or a submission in an application that has no allowed claims, the application will be considered abandoned. To avoid abandonment, the RCE should be filed in compliance with [37 CFR 1.114](#). See [MPEP § 706.07\(h\)](#), subsections I-II.

Once appellant has filed a notice of appeal, appellant also may request that prosecution be reopened for the following situations:

(A) In response to a new ground of rejection made in an examiner's answer, appellant may file a reply in compliance with [37 CFR 1.111](#) that addresses the new ground of rejection within two months from the mailing of the examiner's answer (see [MPEP § 1207.03](#)).

(B) In response to a substitute examiner's answer that is written in response to a remand by the Board for further consideration of a rejection under [37 CFR 41.50\(a\)](#), appellant may file a reply in compliance with [37 CFR 1.111](#) that addresses the rejection in the substitute answer within two months from the mailing of the substitute answer (see [MPEP § 1207.05](#)).

To avoid the rendering of decisions by the Board in applications which have already been refiled as continuations, applicants should promptly inform the Clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Applicants also should advise the Board when an RCE is filed in an application containing an appeal awaiting decision. Failure to exercise appropriate diligence in this matter may result in the Board refusing an otherwise proper request to vacate its decision.

Upon the withdrawal of an appeal, an application having no allowed claims is abandoned, and a notice of abandonment should be mailed. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.

(B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

(C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.

(D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. The examiner should cancel claims 1 and 2 and issue the application or *ex parte* reexamination certificate with claim 3 only.

In an *ex parte* reexamination proceeding, an *ex parte* reexamination certificate should be issued under [37 CFR 1.570](#).

## **1215.02 Claims Standing Allowed [R-08.2012]**

If an application contains allowed claims, as well as claims on appeal, the withdrawal of the appeal does not operate as an abandonment of the application, but is considered a withdrawal of the appeal as to those claims and authority to the examiner to cancel the same. An amendment canceling the appealed claims is equivalent to a withdrawal of the appeal.

## **1215.03 Partial Withdrawal [R-11.2013]**

If an appellant wishes to remove claims from consideration on appeal, the appellant must submit an amendment to cancel the claims from the application. See [37 CFR 41.31\(c\)](#) and [41.33](#). An appellant may, of course, choose not to present arguments or rely upon particular evidence as to certain claim rejections; however, such arguments and evidence are waived for purposes of the appeal and the Board may summarily sustain any grounds of rejections not argued. See [MPEP §§ 1205.02](#) and [1214.05](#).

If appellant fails to respond to a new ground of rejection made in an examiner's answer by either filing a reply brief or a reply under [37 CFR 1.111](#) within 2 months from the mailing of the examiner's

answer, the appeal will be *sua sponte* dismissed by the Board as to the claims subject to the new ground of rejection.

Similarly, if appellant fails to respond to a substitute examiner's answer that is written in response to a remand by the Board for further consideration of a rejection under [37 CFR 41.50\(a\)](#) by either filing a reply brief or a reply under [37 CFR 1.111](#) within 2 months from the mailing of the substitute examiner's answer, the appeal will *sua sponte* dismissed by the Board as to the claims subject to the rejection for which the Board has remanded the proceeding. Such substitute examiner's answer may also include a new ground of rejection.

## 1215.04 Dismissal of Appeal [R-08.2017]

### I. DISMISSAL BECAUSE NO BRIEF WAS FILED

If no brief is filed within the time prescribed by [37 CFR 41.37](#), the appeal stands dismissed by operation of the rule. Unless appellant specifically withdraws the appeal as to rejected claims, the appeal should not be dismissed until the extended period (5 months of extension are available under [37 CFR 1.136\(a\)](#)) to file the brief has expired.

Applications having no allowed claims will be abandoned. Claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. However, as provided in [MPEP § 1214.07](#), if an amendment has been filed which obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner may recommend that the amendment be entered. Note also [MPEP § 1002.02\(d\)](#), which requires the concurrence of the supervisory patent examiner.

The following examples illustrate the appropriate approach to be taken by the examiner in various situations:

(A) Claim 1 is allowed; claims 2 and 3 are rejected. The examiner should cancel claims 2 and 3 and issue the application with claim 1 only.

(B) Claims 1 - 3 are rejected. The examiner should hold the application abandoned.

(C) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1. The examiner should hold the application abandoned.

(D) Claim 1 is rejected and claim 2 is objected to as being allowable except for its dependency from claim 1; independent claim 3 is allowed. If no amendment rewriting claim 2 in independent form has been filed, the examiner should cancel claims 1 and 2 and issue the application.

If formal matters remain to be attended to, the examiner should take appropriate action on such matters. For example (1) the examiner may handle the formal matters by examiner's amendment (see [MPEP § 1302.04](#)) or (2) the examiner may use form paragraph 12.209 to describe the formal matters that applicant is required to correct and set a shortened period for reply. Note that further prosecution on the application or reexamination proceeding is closed except as to such formal matters.

#### ¶ 12.209 Appeal Dismissed - Allowed Claims, Formal Matters Remaining

In view of applicant's failure to file a brief within the time prescribed by [37 CFR 41.37\(a\)](#), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See [37 CFR 1.197\(b\)](#).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire TWO MONTHS from the mailing date of this letter to avoid ABANDONMENT of the application. Extensions of time may be granted under [37 CFR 1.136](#).

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. This form paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See [MPEP § 1215.04](#).
3. In bracket 2, insert a description of the formal matters to be corrected.
4. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See [MPEP § 1215.04](#).

## II. DISMISSAL BECAUSE BRIEF WAS HELD NON-COMPLIANT

An appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with [37 CFR 41.37\(d\)](#). See [MPEP § 1205.03](#) and [37 CFR 41.37\(d\)](#). As in examples (B) - (C) above, if no allowed claims remain in an application, the application is abandoned as of the date the reply to the notice was due. The applicant may petition to revive the application as in other cases of abandonment, and to reinstate the appeal. If the appeal is dismissed, but allowed claims remain in the application, as in examples (A) and (D) above, the application is not abandoned; to reinstate the claims cancelled by the examiner because of the dismissal, the applicant must petition under [37 CFR 1.182](#) to reinstate the claims and the appeal, but a showing equivalent to a petition to revive under [37 CFR 1.137](#) is required. In either event, a proper reply to the notice of noncompliance must be filed before the petition will be considered on its merits.

## III. DISMISSAL BECAUSE APPEAL FORWARDING FEE WAS NOT PAID

As provided in [37 CFR 41.45\(b\)](#) and [MPEP § 1208.01](#), if the appeal forwarding fee set forth in [37 CFR 41.20\(b\)\(4\)](#) is not paid within the period set forth in [37 CFR 41.45\(a\)](#), the appeal will stand dismissed. The application should be handled as set forth in subsection I above.

## IV. DISMISSAL AS TO CLAIMS SUBJECTED TO NEW GROUNDS OF REJECTION IN EXAMINER'S ANSWER

As provided in [MPEP § 1207.03](#), with TC Director approval, [37 CFR 41.39\(a\)\(2\)](#) permits the entry of new grounds of rejection in an examiner's answer. If the appellant does not timely respond to the examiner's answer, form paragraph 12.279.02 may be used to dismiss the appeal as to the claims subject to the new grounds of rejection.

### ¶ 12.279.02 Dismissal Following New Ground(s) of Rejection in Examiner's Answer

Appellant failed to timely respond to the examiner's answer mailed on [1] that included a new ground of rejection. Under [37 CFR 41.39\(b\)](#), if an examiner's answer contains a rejection designated as a new ground of rejection, appellant must, within

two months from the date of the examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under [37 CFR 1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under [37 CFR 41.41](#), addressing each new ground of rejection, to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection. In view of appellant's failure to file a reply under [37 CFR 1.111](#) or a reply brief within the time period required by [37 CFR 41.39](#), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the mailing date of the examiner's answer.
3. In bracket 2, insert the claim numbers of the claims subject to the new ground of rejection.
4. In bracket 3, insert the claim numbers of the claims that are not subject to the new ground of rejection.

## V. DISMISSAL FOLLOWING REMAND FROM THE BOARD

An appeal may be dismissed if an appellant fails to timely and fully reply to a substitute examiner's answer which was written in response to a remand by the Board for further consideration of a rejection under [37 CFR 41.50\(a\)\(1\)](#). Pursuant to [37 CFR 41.50\(a\)\(1\)](#), the appellant must, within two months, from the date of the substitute examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under [37 CFR 1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under [37 CFR 41.41](#), to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. If the appellant fails to timely and fully reply to the substitute examiner's answer the appeal will be dismissed as to the claims subject to the rejection remanded by the Board and those claims cancelled. The examiner may use form paragraph 12.286 to inform the appellant of their options.

### ¶ 12.286 Dismissal Following A Substitute Examiner's Answer Written in Response to a Remand for Further Consideration of a Rejection

Appellant failed to timely respond to the substitute examiner's answer mailed on [1] that was written in response to a remand by the Board for further consideration of a rejection. Under [37](#)

[CFR 41.50\(a\)\(2\)](#), appellant must, within two months from the date of the substitute examiner's answer, file either: (1) a request that prosecution be reopened by filing a reply under [37 CFR 1.111](#); or (2) a request that the appeal be maintained by filing a reply brief under [37 CFR 41.41](#), to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. In view of appellant's failure to file a reply under [37 CFR 1.111](#) or a reply brief within the time period required by [37 CFR 41.50\(a\)\(2\)](#), **the appeal as to claims [2] is dismissed, and these claims are canceled.**

Only claims [3] remain in the application. The appeal continues as to these remaining claims. The application will be forwarded to the Board after mailing of this communication.

#### Examiner Note:

1. For use if the notice of appeal was filed on or after January 23, 2012.
2. In bracket 1, insert the mailing date of the substitute examiner's answer.
3. In bracket 2, insert the claim numbers of the claims subject to the rejection for which the Board has remanded the proceeding.
4. In bracket 3, insert the claim numbers of the claims that are not subject to the rejection.

## 1216 Judicial Review [R-11.2013]

### 35 U.S.C. 141 Appeal to Court of Appeals for the Federal Circuit.

(a) EXAMINATIONS.—An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section [134\(a\)](#) may appeal the Board's decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section [145](#).

(b) REEXAMINATIONS.—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section [134\(a\)](#) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(c) POST-GRANT AND INTER PARTES REVIEWS.—A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section [318\(a\)](#) or [328\(a\)](#) (as the case may be) may appeal the Board's decision only to the United States Court of Appeals for the Federal Circuit.

(d) DERIVATION PROCEEDINGS.—A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section [142](#), files notice with the Director that the party elects to have all further proceedings conducted as provided in section [146](#). If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section

[146](#), the Board's decision shall govern the further proceedings in the case.

### 35 U.S.C. 145 Civil action to obtain patent.

An applicant dissatisfied with the decision of the Patent Trial and Appeal Board in an appeal under [section 134\(a\)](#) may, unless appeal has been taken to the United States Court of Appeals for the Federal Circuit, have remedy by civil action against the Director in the United States District Court for the Eastern District of Virginia if commenced within such time after such decision, not less than sixty days, as the Director appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Patent Trial and Appeal Board, as the facts in the case may appear, and such adjudication shall authorize the Director to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

### 35 U.S.C. 306 Appeal.

The patent owner involved in a reexamination proceeding under this chapter may appeal under the provisions of [section 134](#), and may seek court review under the provisions of [sections 141](#) to [144](#), with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent.

#### 37 CFR 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 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.

#### 37 CFR 90.2 Notice; service.

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

(1) In all appeals, the notice of appeal required by [35 U.S.C. 142](#) must be filed with the Director of the United States Patent and Trademark Office as provided in § [104.2](#) of this title. 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\(b\)](#).

(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 United States Patent and Trademark Office as provided in [§ 104.2](#).

(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.

### **37 CFR 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 his 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 as provided in [§ 104.2](#) of this title.

## **I. JUDICIAL REVIEW OF PATENT APPLICATIONS**

An applicant for a patent who is dissatisfied with a final written decision of the Board (other than a decision of the Board in a derivation proceeding) may seek judicial review either by an appeal to the U.S. Court of Appeals for the Federal Circuit ([35 U.S.C. 141](#)) or by a civil action in the U.S. District Court for the Eastern District of Virginia ([35 U.S.C. 145](#)). By filing an appeal to the U.S. Court of Appeals for the Federal Circuit, the applicant waives the right to seek judicial review by a civil action under [35 U.S.C. 145](#). See [35 U.S.C. 141](#).

## **II. JUDICIAL REVIEW OF REEXAMINATION PROCEEDINGS**

A patent owner who is not satisfied with the final written decision of the Board in an *ex parte* reexamination may seek judicial review of the Board's decision only by appealing the decision of the Board to the U.S. Court of Appeals for the Federal Circuit pursuant to [35 U.S.C. 141](#), [35 U.S.C. 306](#).

Because *inter partes* reexamination procedures are found in Chapter 31 (and not in Chapter 30) of Title 35 of the United States Code, [35 U.S.C. 306](#) does not apply to an *inter partes* reexamination proceeding. Instead, [pre-AIA 35 U.S.C. 315](#) continues to apply to *inter partes* reexamination proceedings. See Leahy-Smith America Invents Act, Pub. L. No. 112-29 § 6(c)(3)(C) and [37 CFR 90.1](#).



Accordingly, the regulations in effect on July 1, 2012 govern judicial review of such proceedings, and this MPEP section does not apply to them. See [MPEP § 2683](#) for further information regarding judicial review of *inter partes* reexamination proceedings.

### III. JUDICIAL REVIEW OF *INTER PARTES* REVIEW, POST-GRANT REVIEW, COVERED BUSINESS METHOD REVIEW, AND DERIVATION PROCEEDINGS

A party dissatisfied with the final written decision of the Board in an *inter partes* review, post-grant review, or covered business method review proceeding may seek judicial review only by appealing the decision to the United States Court of Appeals for the Federal Circuit pursuant to [35 U.S.C. 141](#). See [35 U.S.C. 319](#) and [35 U.S.C. 329](#).

A party dissatisfied with the final written decision of the Board in a derivation proceeding may seek judicial review either by appealing the decision to the United States Court of Appeals for the Federal Circuit pursuant to [35 U.S.C. 141](#) or filing a civil action pursuant to [35 U.S.C. 146](#). An adverse party in a derivation proceeding appealed to the Federal Circuit may elect to have further judicial review proceedings conducted under [35 U.S.C. 146](#) instead.

Any notice of appeal filed in an *inter partes* review, post-grant review, covered business method review, or derivation proceeding 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](#). See [37 CFR 90.2\(a\)\(3\)\(ii\)](#).

### IV. TIME FOR FILING NOTICE OF APPEAL OR COMMENCING CIVIL ACTION

The time for filing a notice of a [35 U.S.C. 141](#) appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action under [35 U.S.C. 145](#) is within 63 days of the Board's decision. [37 CFR 90.3\(a\)](#). The time for filing a notice of election, and for commencing a civil action pursuant to a notice of election, in an appeal from a derivation proceeding is governed by [35 U.S.C. 141\(d\)](#). See [37 CFR 90.2\(a\)\(2\)](#). However, if a timely request for rehearing of the Board's decision is filed, the time

for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action expires 63 days after a decision on a request for rehearing or reconsideration ([37 CFR 90.3\(b\)\(1\)](#)).

The times specified in [37 CFR 90.3](#) are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday, nor a Federal holiday ([37 CFR 90.3\(b\)\(2\)](#)).

### V. TIME FOR FILING CROSS-APPEAL OR CROSS-ACTION

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 U.S. Court of Appeals for the Federal Circuit. See [37 CFR 90.3\(a\)\(1\)](#).

### VI. EXTENSION OF TIME TO SEEK JUDICIAL REVIEW

In [37 CFR 90.3\(c\)](#), the Office has adopted a standard which is similar to the standard used in the Federal courts for granting extensions. Under the rule, the Director may extend the time (A) for good cause if requested before the expiration of the time provided for initiating judicial review or (B) upon a showing of excusable neglect in failing to initiate judicial review if requested after the expiration of the time period. This standard is applicable once the "last" decision has been entered, i.e., either the decision (in circumstances where no timely rehearing is sought) or the decision on rehearing of the Board in an *ex parte* appeal. Extensions of time under [37 CFR 1.136\(b\)](#) and [37 CFR 1.550\(c\)](#) and fee extensions under [37 CFR 1.136\(a\)](#) are not available to extend the time for the purpose of seeking judicial review once a decision or a decision on rehearing has been entered.

Requests for extension of time to seek judicial review under [37 CFR 90.3\(c\)](#) should be addressed or served as provided in [37 CFR 104.2](#). In addition, to expedite the handling of such a request, a copy of the request may be provided to the Office of the Solicitor as follows:

Mail Stop 8  
Office of the Solicitor  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

A copy of the request may also be hand-carried to the Office of the Solicitor.

## VII. APPLICATION UNDER JUDICIAL REVIEW

The administrative file of an application under judicial review will not be opened to the public by the U.S. Patent and Trademark Office, unless it is otherwise available to the public under [37 CFR 1.11](#).

During judicial review, the involved application or reexamination is not under the jurisdiction of the examiner or the Board, unless remanded to the U.S. Patent and Trademark Office by the court. Any amendment can be admitted only under the provisions of [37 CFR 1.198](#). See [MPEP § 1214.07](#).

## VIII. SERVICE OF COURT PAPERS ON THE DIRECTOR

See [MPEP § 1216.01](#) for the proper way to effect service on the Director of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit. See [MPEP § 1216.02](#) for the proper way to effect service on the Director of a complaint in a civil action.

Rule 5(b) of the Federal Rules of Civil Procedure provides that if a party is represented by an attorney, service under this rule must be made on the attorney unless the court orders service on the party. The rule sets forth proper ways to serve papers, including delivering papers to the person or the person's office, or mailing papers to the person's last known address.

Similarly, Rule 25(b) of the Federal Rules of Appellate Procedure provides that “[s]ervice on a party represented by counsel must be made on the party’s counsel.”

Accordingly, all service copies of papers filed in court proceedings in which the Director is a party must be served on the Office of the Solicitor. Service on the Office of the Solicitor may be effected in either of the following ways:

(A) By hand between 8:30 A.M. and 5:00 P.M. EST to the Office of the Solicitor at 600 Dulany Street, Madison West Building, Room 8C43, Alexandria, VA 22314.

(B) By mail in an envelope addressed as follows:  
Mail Stop 8  
Office of the Solicitor  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

While the above mail service address may be supplemented to include the name of the particular attorney assigned to the court case, it must not be supplemented to refer to either the Director or the U.S. Patent and Trademark Office.

Any court papers submitted to the U.S. Patent and Trademark Office other than by mail to the above mail service address or delivered by hand to the Office of the Solicitor are deemed to have been served on the Director when actually received in the Office of the Solicitor.

The above mail service address should not be used for noncourt papers, i.e., papers which are intended to be filed in the U.S. Patent and Trademark Office in connection with an application or other proceeding pending in the U.S. Patent and Trademark Office. ANY NONCOURT PAPERS WHICH ARE MAILED TO THE ABOVE MAIL SERVICE ADDRESS WILL BE RETURNED TO THE SENDER. NO EXCEPTIONS WILL BE MADE TO THIS POLICY.

## 1216.01 Appeals to the U.S. Court of Appeals for the Federal Circuit [R-08.2017]

### 35 U.S.C. 142 Notice of appeal.

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

### 35 U.S.C. 143 Proceedings on appeal.

With respect to an appeal described in [section 142](#), the Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies

of such documents during the pendency of the appeal. In an *ex parte* case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section [135](#) or in an *inter partes* or post-grant review under [chapter 31](#) or [32](#).

### 35 U.S.C. 144 Decision on appeal.

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

Filing an appeal to the U.S. Court of Appeals for the Federal Circuit requires that the applicant (A) file in the U.S. Patent and Trademark Office a written notice of appeal ([35 U.S.C. 142](#)) directed to the Director; (B) file a copy of the notice of appeal with the Board in the manner provided in 37 CFR 41.10(a), 41.10(b), or 42.6(b), as appropriate; and (C) file with the Clerk of the Federal Circuit a copy of the notice of appeal and pay the docket fee for the appeal, as provided by Federal Circuit Rule 52. 37 CFR 90.2(a).

Additionally, the owner of a patent involved in an *ex parte* reexamination proceeding must comply with these requirements, and additionally must also serve the notice of appeal as provided in 37 CFR 1.550(f). 37 CFR 90.2(a)(3)(i). A party appealing the Board's decision in an *inter partes* review, post-grant review, covered business method patent review, or derivation proceeding must include sufficient information in the notice of appeal to allow the Director to determine whether to exercise the right to intervene in the appeal pursuant to 35 U.S.C. 143, and must serve the notice of appeal as provided in 37 CFR 42.6(e).

An adverse party in a derivation proceeding appealed to the U.S. Court of Appeals for the Federal Circuit electing to have further judicial review proceedings conducted under 35 U.S.C. 146 must file a notice of election under 35 U.S.C. 141(d) with the Office as provided in 37 CFR 104.2. Such a party must also file a copy of the notice of election with the Board in the manner provided in 37 CFR 42.6(b), and,

where necessary, must serve a copy of the notice of election pursuant to 37 CFR 42.6(e).

For a notice of appeal to be considered timely filed in the U.S. Patent and Trademark Office, it must: (A) actually reach the U.S. Patent and Trademark Office within the time specified in [37 CFR 90.3](#) (including any extensions) or (B) be mailed within the time specified in 37 CFR 90.3 (including any extensions) by Priority Mail Express® in accordance with [37 CFR 1.10](#).

A Notice of Appeal to the U.S. Court of Appeals for the Federal Circuit should not be mailed to the Director, the Board or the examiner. Nor should it be mailed to the Office of the Solicitor's mail service address for court papers given in [MPEP § 1216](#). Instead, it should be filed in the U.S. Patent and Trademark Office in any one of the following ways:

(A) By mail addressed to the mailing address provided in 37 CFR 104.2(a), in which case the notice of appeal must actually reach the U.S. Patent and Trademark Office by the due date.

(B) By Priority Mail Express® under [37 CFR 1.10](#) addressed to the mailing address provided in 37 CFR 104.2(a), in which case the notice of appeal is deemed filed on the "date-accepted" on the Priority Mail Express® mailing label.

(C) By hand as provided in 37 CFR 104.2(b).

A copy of the notice of appeal and the docket fee should be filed with the Clerk of the U.S. Court of Appeals for the Federal Circuit, whose mailing and actual address is:

U.S. Court of Appeals for the Federal Circuit  
717 Madison Place, N.W.  
Washington, DC 20439

The Solicitor, prior to a decision by the U.S. Court of Appeals for the Federal Circuit, may request that the case be remanded to the U.S. Patent and Trademark Office and prosecution reopened. See [MPEP § 1214.07](#).

## I. OFFICE PROCEDURE FOLLOWING DECISION BY THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

After the U.S. Court of Appeals for the Federal Circuit has heard and decided the appeal, the Clerk of the U.S. Court of Appeals for the Federal Circuit forwards to the U.S. Patent and Trademark Office a certified copy of the court's decision. This certified copy is known as the "mandate." The mandate is entered in the file of the application, reexamination or interference which was the subject of the appeal. The date the mandate was issued by the Federal Circuit marks the conclusion of the appeal, i.e., the termination of proceedings as that term is used in [35 U.S.C. 120](#). See [37 CFR 1.197](#).

The U.S. Court of Appeals for the Federal Circuit's opinion may or may not be precedential. Whether or not the opinion is precedential, the U.S. Patent and Trademark Office will not give the public access to the administrative record of an involved application unless it is otherwise available to the public under [37 CFR 1.11](#). However, since the court record in a [35 U.S.C. 141](#) appeal generally includes a copy of at least part of the application, the application may be inspected at the Federal Circuit. *In re Mosher*, 248 F.2d 956, 115 USPQ 140 (CCPA 1957).

### A. All Claims Rejected

If all claims in the case stand rejected, proceedings in the case are considered terminated on the issue date of the U.S. Court of Appeals for the Federal Circuit's mandate. Because the case is no longer considered pending, it is ordinarily not open to subsequent amendment and prosecution by the applicant. *Continental Can Company v. Schuyler*, 326 F. Supp. 283, 168 USPQ 625 (D.D.C. 1970). However, exceptions may occur where the mandate clearly indicates that further action in the U.S. Patent and Trademark Office is to be taken in accordance with the U.S. Court of Appeals for the Federal Circuit's opinion.

### B. Some Claims Allowed

Where the case includes one or more allowed claims, including claims allowed by the examiner prior to

appeal and claims whose rejections were reversed by either the Board or the court, the proceedings are considered terminated only as to any claims which still stand rejected. It is not necessary for the applicant or patent owner to cancel the rejected claims, since they may be canceled by the examiner in an examiner's amendment. Thus, if no formal matters remain to be attended to, the examiner will pass the application to issue forthwith on the allowed claims or, in the case of a reexamination, will issue a "Notice of Intent to Issue a Reexamination Certificate." See [MPEP § 2287](#). The examiner should set forth the reasons for allowance, referring to and incorporating a copy of the appellate brief and the court decision. See [MPEP § 1302.14](#).

If formal matters remain to be attended to, the examiner promptly should take appropriate action on such matters, such as by an examiner's amendment or by an Office action setting a 1-month (but not less than 30-day) shortened statutory period for reply. However, the application or reexamination proceeding is considered closed to further prosecution except as to such matters.

### C. Remand

Where the decision of the court brings up for action on the merits claims which were not previously considered on the merits (such as a decision reversing a rejection of generic claims in an application containing claims to nonelected species), the examiner will take the case up for appropriate action on the matters thus brought up.

### D. Reopening of Prosecution

In some situations it may be necessary to reopen prosecution of an application after a court decision. Any Office action proposing to reopen prosecution after a court decision must be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for written approval, which will be indicated on the Office action.

## II. DISMISSAL OF APPEAL

After an appeal is docketed in the U.S. Court of Appeals for the Federal Circuit, failure to prosecute the appeal, such as by appellant's failure to file a

brief, may result in dismissal of the appeal by the court. Under particular circumstances, the appeal also may be dismissed by the court on motion of the appellant and/or the Director.

The court proceedings are considered terminated as of the date of the mandate. After dismissal, the action taken by the examiner will be the same as set forth above under the heading “Office Procedure Following Decision by the U.S. Court of Appeals for the Federal Circuit.”

In the event of a dismissal for a reason other than failure to prosecute the appeal, the status of the application or reexamination proceeding must be determined according to the circumstances leading to the dismissal.

### **1216.02 Civil Suits Under 35 U.S.C. 145 and 146 [R-11.2013]**

A civil action under 35 U.S.C. 145 or 146 is commenced by filing a complaint in the U.S. District Court for the Eastern District of Virginia within the time specified in 37 CFR 90.3(a)(3)(i) (see [MPEP § 1216](#)). Furthermore, copies of the complaint and summons must be served in a timely manner on the Director, the U.S. Attorney for the District of Columbia, and the Attorney General in the manner set forth in Rule 4(i) of the Federal Rules of Civil Procedure. All the expenses of the proceedings shall be paid by the applicant (see [35 U.S.C. 145](#)).

The party initiating an action under 35 U.S.C. 146 must also file a copy of the complaint with the Board in the manner provided in 37 CFR 42.6(b) no later than five days after filing the complaint in district court. 37 CFR 90.2(c). Failure to comply with this requirement can result in further action within the Office consistent with the final Board decision.

In an action under [35 U.S.C. 145](#), the plaintiff may introduce evidence not previously presented to the U.S. Patent and Trademark Office. However, plaintiff will be precluded from presenting new issues. *Hyatt v. Kappos*, 625 F.3d 1320 (Fed. Cir. 2010) (en banc), aff’d, 132 S. Ct. 1690 (2012); *DeSeversky v. Brenner*, 424 F.2d 857, 858, 164 USPQ 495, 496 (D.C. Cir. 1970).

Upon termination of the civil action, a statement of the court’s final disposition of the case is placed in the electronic file, which is then returned to the examiner for action in accordance with the same procedures as follow termination of a [35 U.S.C. 141](#) appeal. See [MPEP § 1216.01](#). [37 CFR 1.197\(b\)](#) provides that a civil action is terminated when the time to appeal the judgment expires. Where the exact date when the civil action was terminated is material, the date may be ascertained from the Office of the Solicitor.

The procedures to be followed in the U.S. Patent and Trademark Office after a decision, remand, or dismissal of the case by the district court are the same as the procedures followed with respect to [35 U.S.C. 141](#) appeals. See [MPEP § 1216.01](#).

Any subpoena by the district court for an application or reexamination file should be hand-carried to the Office of the Solicitor.