

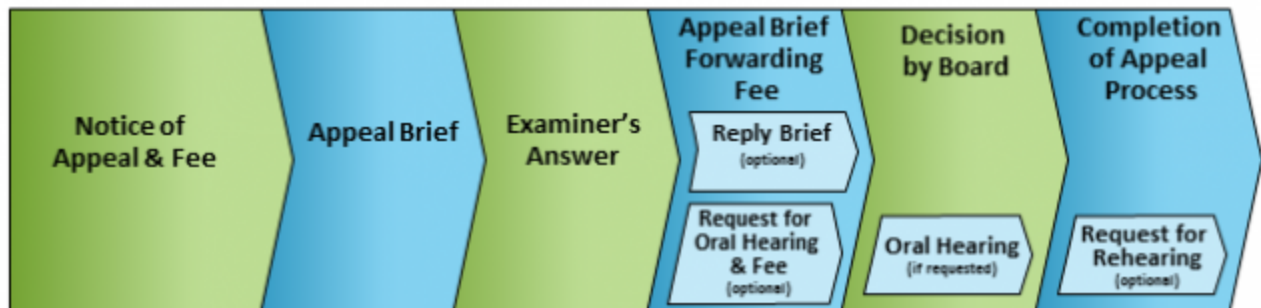


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Appeals

Information about ex parte appeals conducted by the Patent Trial and Appeal Board (PTAB) from adverse decisions of examiners in patent applications, reissue applications, and reexamination proceedings.

Appeals – General Process



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▾ General process

▾ Notice of appeal

Who can file a notice of appeal?

Patent applicant

- 35 U.S.C. 134(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.
- 37 C.F.R. 41.31(a)(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 the title for reply.

Patent owner

- 35 U.S.C. 134(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.
- 37 C.F.R. 41.31(a)(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.
- 37 C.F.R. 41.31(a)(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.

When to file a notice of appeal

Patent applicant

- An applicant for a patent may file a notice of appeal upon any claim being twice rejected. 35 U.S.C. 134(a); 37 C.F.R. 41.31(a)(1).

Patent owner

- In a reexamination, upon any claim being finally rejected. 35 U.S.C. 134(b) PATENT OWNER.
- In an ex parte reexamination filed under § 1.510 and before November 29, 1999, upon any claim being twice rejected by the Examiner. 37 C.F.R. 41.31(a)(2).
- In an ex parte reexamination filed under § 1.510 and on or after November 29, upon any claim being finally rejected. 37 C.F.R. 41.31(a)(3).

How to file a notice of appeal

- File a Notice of Appeal, [form AIA/31](#)
- Pay required fees

Appeal claims

- 37 C.F.R. 41.31(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless canceled by an amendment filed by the applicant and entered by the Office.

▼ Appeal brief

Requirements

- An appeal 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.
- Within 2 months from the date of filing the Notice of Appeal: No extension of time is required even if the 2-month date falls after a 3-month shortened statutory period for reply set in the Office Action from which the appeal was taken. 37 C.F.R. 41.37(a); MPEP 1205.01.
- After 2 months from the date of filing the Notice of Appeal and prior to a 3-month shortened statutory period for reply set in the Office Action from which the appeal was taken: Must file a petition for a one month extension of time. 37 C.F.R. 41.37; MPEP 1205.01.
- Must be accompanied with the payment of any appeal brief fee set forth in 37 C.F.R. 41.20(b)(2).
- For help to prepare an appeal brief, the Board offers an [appeal brief template](#) and [instructions](#) to guide appellants; these documents are featured on the "[Preparing an Ex Parte Appeal Brief Webpage](#)."

Deadlines

- Within 2 months from the date of filing the notice of appeal: No extension of time is required even if the 2-month date falls after a 3-month shortened statutory period for reply set in the office action from which the appeal was taken. 37 C.F.R. 41.37(a); MPEP 1205.01.
- After 2 months from the date of filing the notice of appeal: Must file a petition for an extension of time under 37 C.F.R. 1.136(a) along with the appropriate fee. See MPEP 1205.01; 37 C.F.R. 1.136(b), 37 C.F.R. 1.550(c).

Consequences of not filing an appeal brief

- If the application does not contain any allowed claims: the appeal will be dismissed and the application will go abandoned. MPEP 1205.01.
- If the application contains any allowed claims: 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: (1) A request for continued examination (RCE) accompanied by a submission (i.e., a reply under 37 C.F.R. 1.111) and any applicable fees; or (2) an appeal brief and the appeal brief fee to reinstate the appeal.

- If the application contains claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim and no allowed claims: the appeal will be dismissed and the application will go abandoned. MPEP 1205.01.

▼ Examiner's Answer

Contains new ground of rejection, either designated or undesignated

- [Responding to new grounds of rejection in an examiner's answer](#)

▼ Reply brief and appeal brief forwarding fee

Reply brief

- Under [37 CFR 41.41\(a\)\(1\)](#), a single reply brief may be filed 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.

When required

- 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](#)).

Appeal forwarding fee

- [Fee and payment information](#)

▼ Oral hearing (if requested)

Requesting an oral hearing

- [AIA/32](#) Request for Oral Hearing Before the Patent Trial and Appeal Board

Conducting an oral hearing

- [Hearings](#)

▼ Decision by Board

Affirmed

- 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. 37 CFR 41.54
- Proceedings on the application are considered terminated by the failure to timely file an appeal to the court or a civil action except: (1) where claims stand allowed in the application; or (2) where the nature of the decision requires further action by the examiner. 37 CFR 1.197(a).
- To continue prosecution of the application, an amendment can be filed after the Board's decision which presents a new or amended claim or claims along with a request for continued examination (RCE) under [37 CFR 1.114](#) and the fee set forth in [37 CFR 1.17\(e\)](#). See [MPEP § 706.07\(h\)](#), subsection XI.

Affirmed-in-part

- The decision reverses all of the examiner's rejections pertaining to at least one, but not all, of the claims.

Reversed

- A complete reversal of the examiner's rejection(s) brings the case up for immediate action by the examiner. The examiner should not regard a reversal as an opportunity to make a new search to uncover other and better references. See MPEP 1214.04. However, if the examiner has specific knowledge of a particular reference or references which indicate nonpatentability of any of the appealed claims, the examiner should submit the matter to the Technology Center (TC) Director or Central Reexamination Unit

(CRU) for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection.

▼ Request for rehearing (optional)

When to file a request for rehearing

- An appellant may file a request for rehearing within two (2) months of the date of the original decision of the Board. 37 CFR 41.52(a)(1).

How to file a request for rehearing

- 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 are not permitted in the request for rehearing except as permitted by 37 CFR 41.52(a)(2)-(a)(4). 37 CFR 41.52(a)(1).

Decision on a request for rehearing

- No request for rehearing from a decision on rehearing is 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. 37 CFR 41.52(a)(1).

▼ Resources

▼ Ex parte appeals

- [Board rules for ex parte appeals](#)
- [MPEP Chapter 1200 \(appeals\)](#)
- [MPEP Chapter 2200 \(ex parte reexamination\)](#)
- [Board rules for appeals filed before January 2012](#) [PDF]
- [Practice tips and checklists to reduce non-compliant briefs](#)
This page includes a listing of the top eight reasons briefs are found to be non-compliant, checklists used by the Office to determine if briefs comply with the rules, and forms used by the Office to notify parties of non-compliant briefs.
- [Practice tips for writing effective appeal briefs](#)
- [Patent Center](#)

▼ Inter parte appeals

- [Board rules for inter partes appeals](#)
- [MPEP Chapter 2600 \(inter partes reexamination\)](#)
- [Board rules for appeals filed before January 2012](#) [PDF]
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▼ Forms

- [AIA/31](#) Notice of Appeal
 - [AIA/32](#) Request for Oral Hearing Before the Patent Trial and Appeal Board
- [Fee and payment information](#)
 - [Suggestion box](#)
 - [Guidance on petitions under CFR Rule 41.3 to the PTAB](#)

▼ Frequently asked questions (FAQs)

- [Frequently asked questions \(FAQs\)](#)

Please send suggestions regarding the appeals process to the Board at [PTAB Appeals Suggestions](#).

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