

Training Module for Chapter 12 of the MPEP

(Revised August 16, 2018)

Summary

Chapter 12: Appeal

NOTE: This Chapter now reflects only the current (Post-AIA) *ex parte* appeal practices before the Patent Trial and Appeal Board. This covers appeals wherein the notice of appeal was filed on or after January 23, 2012, or to proceedings commenced on or after September 16, 2012.

[For appeals in *inter partes* reexamination proceedings, see MPEP 2674 to 2883.]

Section 1201 – Introduction

- An appeal is a process in which an applicant, patent owner, or third-party seeks review of a USPTO decision.
- An appeal may be made by:
 - (1) an applicant whose claims have been twice rejected (but not necessarily final rejected) by a primary examiner. The appeal is made to the Patent Trial and Appeal Board.

NOTE: “Twice rejected” could mean in a single application or once in an original application and second time in a continuation application.
(This fact is often tested on the exam.)

- (2) a patent owner in a re-examination hearing to appeal the final rejection of any claim by the primary examiner.

(3) a third-party in an inter partes proceeding where the primary examiner rules in favor of the original or amended patent.

NOTE: GENERAL RULE: Rejections are appealable (to the Patent Trial and Appeal Board) while objections are petitionable (to the Director).

- The notice of appeal (but not the entire appeal) must be filed within the period of reply set in the last Office Action, which is normally a shortened period of 3 months. An extension to 6 months for the appeal is possible with so long as an appropriate petition and fee for the extension of time is filed either prior to or with the notice of appeal.
- Failure to remove all grounds of rejection or to file an appeal after final rejection will result in the application being abandoned *even if one or more claims have been allowed*.
- After filing a notice of appeal, the appellant must file a brief explaining the alleged error in the examiner's reasoning within 2 months from the date of filing the notice of appeal.
- The appellant's brief must be responsive to every ground of rejection stated by the examiner to which he objects.

NOTE: If a ground for rejection stated by the examiner is not addressed in the appellant's brief, the ground of rejection will be sustained by the Board.

- After a brief has been filed, the primary examiner has the option of filing an answer to the appellant's brief. Typically, this includes an explanation of the invention, the rejections issued, and the references for the rejections.
- Sometimes, the examiner's answer can include new grounds for rejection (possibly based on new material provided by the appellant in his brief). If this happens, the applicant may request that the examiner reopen the prosecution in light of the new ground of rejection.

Alternatively, the applicant may simply maintain the appeal by filing a brief contesting the assertions presented in the examiner's answer.

Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and the examiner's answer to the Board.

One peculiarity to the appeal process is that the notice of appeal, unlike most papers, does not need to be signed. (However, other papers that may be submitted with the notice of appeal may require signatures.)

Another peculiarity is that effective March 19, 2012, the fee for filing an appeal brief in an application was reduced to \$0. But, a new fee was added for forwarding an appeal to the Board.

Selected Questions and Answers for Chapter 12

Question 12-1 (Oct03am-36a)

A registered practitioner filed a patent application in the Office in 2016. Following examination and a final rejection, the practitioner timely filed a proper notice of appeal and a proper appeal brief in the application wherein claims 1-3 stand rejected, claims 4 and 5, which depend from claim 1, stand objected to as depending from a rejected claim but are otherwise allowable, and claims 6-10 stand allowed. The appeal involves claims 1-3. After the brief was filed but prior to a decision by the Patent Trial and Appeals Board, the practitioner filed a request for continued examination (RCE) with a submission in accordance with 37 CFR 1.114 without paying the fee set forth in 37 CFR 1.17(e). In accordance with the patent laws, rules and procedures as related in the MPEP, what effect does the filing of the RCE without the fee set forth in Rule 1.17(e) have on the application under appeal?

- (A) The application is abandoned.
- (B) The application is still pending and under appeal awaiting a decision by the Board of Patent Appeals and Interferences, because the RCE was improper.
- (C) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-3 canceled and claims 4-10 allowed.
- (D) The application is still pending; the appeal is considered withdrawn and the application will be passed to issue with claims 1-5 canceled and claims 6-10 allowed.

- (E) The appeal is withdrawn; the application is returned to the primary examiner and prosecution is reopened as to claims 1-10.

ANSWER: (D) is the correct answer. See MPEP §§ 706.07(h), under the heading “X. After Appeal But Before Decision By Board,” and 1215.01. As explained in MPEP § 1215.01, “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.” Thus, the filing of the RCE without the fee results in the withdrawal of the appeal in this application and passage of the application to issue with the allowed claims 6-10 after the cancellation of both rejected claims 1-3 and claims 4 and 5 which are allowable except for their dependency from rejected claim 1 (A) is incorrect. As also explained in MPEP § 1215.01, although an application under appeal having no allowed claims will be considered abandoned by the filing of an improper RCE, an application having allowed claims will be passed to issue with the allowed claims. Upon withdrawal of appeal, claims which are allowable except for their dependency from rejected claims will be treated as if they were rejected. See MPEP § 1215.01. All rejected claims, such as claims 1-3, and claims which are allowable except for their dependency from rejected claims, such as claims 4 and 5, will be canceled. (B) is incorrect. As explained in MPEP § 706.07(h), under the heading “After Appeal But Before Decision By The Board,” proceedings as to the rejected claims are terminated and the application is passed to issue with the allowed claims. MPEP § 1215.01 explains that 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. (C) is incorrect for the reasons explained for (A), and because claims 4 and 5 will be canceled. (E) is incorrect. The RCE, which was filed without the fee, is improper. Thus, as explained in MPEP § 706.07(h), under the heading, “After Appeal But Before Decision By The Board,” proceedings as to the rejected claims are terminated and the application is passed to issue with the allowed claims. MPEP § 1215.01 explains that 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.

Question 12-2 (Oct03am-38a)

Prosecution before the primary examiner results in the rejection of claim 1. Claim 2 was objected to as being allowable except for its dependency from claim 1. Independent claim 3 has been allowed. The rejection of claim 1 is properly appealed to the Patent Trial and Appeal Board. The Board properly affirms the rejection of claim 1. Appellant has filed no response to the decision of the Board, the appellant has taken no action, and the time for filing an appeal to the court or a civil action has expired. In accordance with the patent laws, rules and procedures as related in the MPEP, which of the following actions is the most appropriate response by the examiner?

- (A) The examiner should hold the application abandoned.
- (B) The examiner should cancel claim 1, convert dependent claim 2 into independent form by examiner's amendment, and allow the application.
- (C) The examiner should set a 1-month time limit in which appellant may rewrite the dependent claim in independent form.
- (D) The examiner should cancel claims 1 and 2 and allow the application with claim 3 only.
- (E) None of the above

ANSWER: (D) is the most correct answer. 37 CFR § 1.197(c); MPEP § 1214.06. This case is specifically set forth in MPEP § 1214.06 under the heading "Claims Stand Allowed." Answers (A), (B) and (C) apply only if no claims stand allowed in the application. They are incorrect because the facts state that claim 3 was allowed. See MPEP § 1214.06, under the heading "No Claims Stand Allowed." (B) is incorrect. See MPEP § 1214.06 under the heading "Claims Stand Allowed." Where one or more other claims stand allowed, the examiner is not authorized to convert to independent form a dependent claim that has been objected to (but not allowed or rejected) based on its dependency to a rejected claim. (C) is incorrect. See MPEP § 1214.06 under the heading "Claims Stand Allowed." Where one or more other claims stand allowed, the examiner is not authorized to provide appellant with time to rewrite a dependent claim into independent form where the dependent claim was objected to (but not allowed or rejected) based on its dependency to a rejected claim.

In-Depth Review of Chapter 12

Chapter 12 from the MPEP, in its entirety, is on the selection bar at the top of this page. You are encouraged to familiarize yourself with the general format and structure of the MPEP. However, it is recommended that you quickly scan through most of the chapter - while reading only those sections that are **highlighted in yellow**.

[Chapter 2 MPEP](#)