

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# *Ex parte* appeals

# *Ex parte* appeal to the PTAB

- Alternative to continuing prosecution before the Examiner
- Consideration of the application as is, not a forum for making substantive amendments or submitting new evidence
- Generally results in a decision affirming or reversing the Examiner
  - **The PTAB will not issue a patent. We simply review the Examiner's decision.**

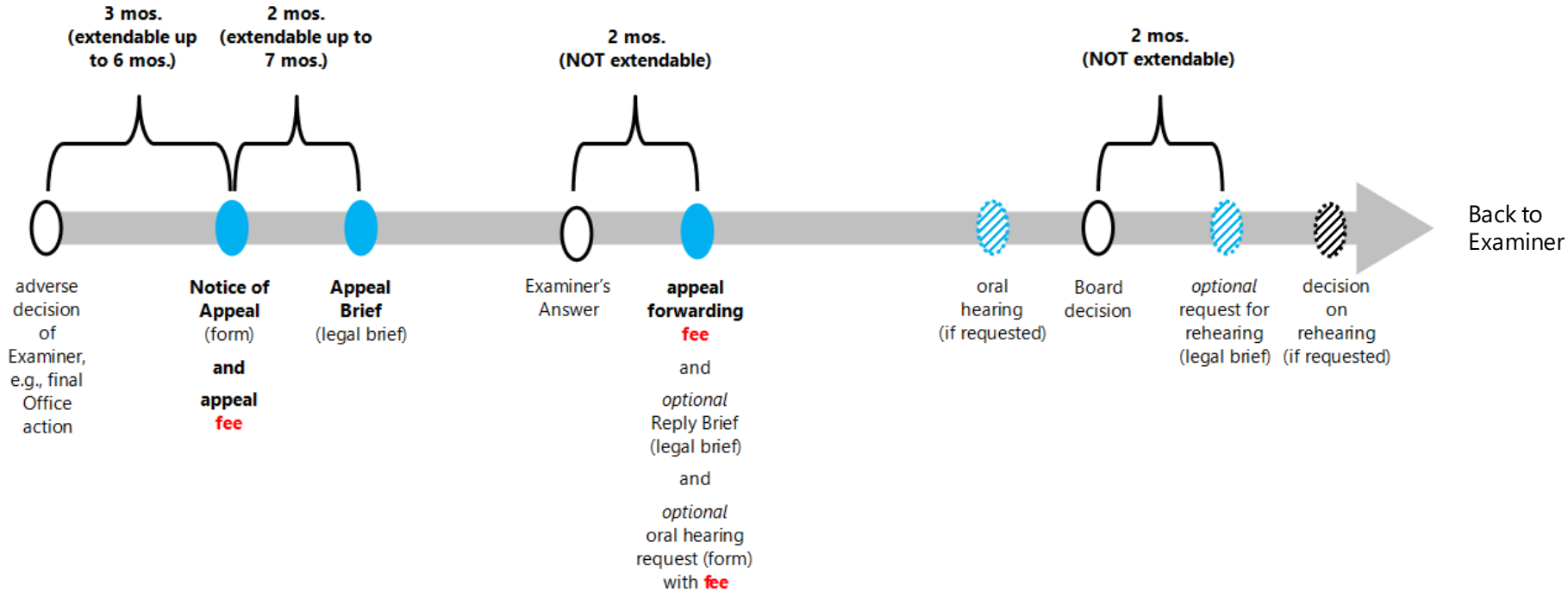
# *Ex parte* appeal to the PTAB

- During original prosecution
  - After twice rejected patent application or a final Office Action by an examiner
- After original prosecution (after a patent issues)
  - Reexamination proceeding
  - Reissue application

# *Ex parte* appeal to the PTAB

- Review by a “fresh pair of eyes,” namely a panel of at least three administrative patent judges, who
  - Have technical backgrounds
  - Are lawyers
  - Have been appointed by the Secretary of Commerce
- A more formal, legal environment within the Office
  - Legal briefing
  - Optional oral argument before panel of judges

# Ex parte appeal process



# *Ex parte* appeal process: 9 steps

- **Step 1:** Adverse Decision of the Examiner
- **Step 2:** Notice of Appeal
- **Step 3:** Appeal Brief
- **Step 4:** Examiner's Answer
- **Step 5:** Appeal Forwarding Fee + Reply Brief (*optional*) + Request for Oral Hearing (*optional*)
- **Step 6:** Oral Hearing (*if requested*)
- **Step 7:** Board decision
- **Step 8:** Request for rehearing (*optional*)
- **Step 9:** Decision on rehearing (*if requested*)

# Step 1: adverse decision of the examiner

- This is generally an Office action including a rejection of one or more claims
- Appeal is taken from the Office action, so the Office action defines the Examiner's position on appeal
- You cannot appeal from *every* Office action
  - Application must be twice rejected
  - The Office action does not have to be final



# Step 2: notice of appeal

- You must give notice that you intend to appeal from the Examiner's decision and pay an appeal fee
- The notice and payment of the fee are due 3 months after the mailing date of the Examiner's decision from which appeal is being taken, e.g., final Office action.
  - This time period is extendable for 3 additional months, so you can file a Notice of Appeal with payment of the appeal fee as late as 6 months after the Examiner's decision
- Office provides a form:  
<https://www.uspto.gov/sites/default/files/documents/aia0031.pdf>



# Notice of appeal form

PTO/AIA/31 (03-14)

Approved for use through 11/30/2020. 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.

NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD		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 _____		In re Application of _____ Application Number _____ Filed _____ For _____ Art Unit _____ Examiner _____
Applicant hereby appeals 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.		

patent application information

fee payment

extension of time (if applicable)

signature information



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.

# Step 3: appeal brief

- No fee due with Appeal Brief
- The Appeal Brief is due 2 months after you file the Notice of Appeal. This time period is extendable for 5 additional months
- Legal brief (not a form) that includes your arguments and defines the appeal
  - The Appeal Brief identifies the issues the judges will consider on appeal
  - The judges generally will not go looking for issues, even issues that would resolve the appeal in your favor
  - If an argument is not raised in the Appeal Brief, it may be waived

# Step 3: appeal brief

- No new evidence or substantive amendment
- Must include certain sections:
  - Real party in interest
  - Related matters, e.g., appeals, AIA proceedings, district court cases
  - Summary of the claimed subject matter
  - Argument
  - Claims appendix
- A *pro se* appellant needs to only “substantially comply” with certain requirements shown in bold

# Appeal brief: argument

37 C.F.R. § 41.37(c)(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).

# Step 4: examiner's answer

- The Examiner's response to the Appeal Brief
  - The Examiner will respond to all of the arguments in the Appeal Brief
  - The Examiner will consider whether to maintain or modify each rejection
- Includes certain sections
  - Ground(s) of Rejection to Be Reviewed on Appeal
    - Withdrawn Rejection(s)
    - New Ground(s) of Rejection
  - Response to Arguments

# Step 5: appeal forwarding fee

- Due 2 months after Examiner's Answer – NOT EXTENDABLE
- Easy to forget
- Office provides a form for submitting payment of the fee:  
<https://www.uspto.gov/sites/default/files/forms/aia0034.pdf>
- May be filed with Reply Brief (optional) and/or request for oral hearing (optional)
  - No fee for reply brief
  - Request for oral hearing requires payment of a fee

# Appeal forwarding fee

Doc code: WFEE.APEAL

Doc Description: Certification and Transmittal of Appeal Forwarding Fee

PTO/AIA/34 (06-14)

CERTIFICATION AND TRANSMITTAL OF APPEAL FORWARDING FEE		Docket Number (Optional)
<p>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, VA 22313-1450" [37 CFR 1.8(a)] on _____.</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		<p>In re Application of _____</p> <p>Application Number _____ Filed _____</p> <p>For _____</p> <p>Art Unit _____ Examiner _____</p>
<p>37 CFR 41.45 specifies that, in order to avoid dismissal of the appeal, appellant must pay the fee set in 37 CFR 41.20(b)(4) within two months of the later of 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.</p> <p>The undersigned certifies that the appropriate fee accompanies this transmittal.</p> <p>The fee for forwarding this appeal is (37 CFR 41.20(b)(4)) \$ _____</p> <p><input type="checkbox"/> Appellant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 50%, and the resulting fee is: \$ _____</p> <p><input type="checkbox"/> Appellant 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.</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____.</p> <p><input type="checkbox"/> Payment made via EFS-Web.</p> <p>Extensions of time under 37 CFR 1.136(a) for patent applications are not applicable to the time period set forth in 37 CFR 41.45. 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 <i>ex parte</i> reexamination proceedings.</p> <p><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></p> <p>I am the</p> <p><input type="checkbox"/> appellant      <input type="checkbox"/> attorney or agent of record      <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34</p> <p>Registration number _____      Registration number _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p> <p>Telephone Number _____</p> <p>Date _____</p> <p><b>NOTE:</b> 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*.</p> <p><input type="checkbox"/> * Total of _____ forms are submitted.</p>		





# Step 5: reply brief

- Optional
- Due 2 months after Examiner's Answer – NOT EXTENDABLE
- Should be submitted at the same time as payment of the appeal forwarding fee
- No additional fee for the reply brief
- Only one reply brief permitted

Source: 37 C.F.R. § 41.41; MPEP §§ 1208, 1208.01



# Step 5: reply brief

- Legal brief (not a form)
- No new evidence or amendment
- No new arguments that were not raised in the appeal brief, unless
  - Responsive to an argument in the Examiner's answer
  - Addressing new ground of rejection in the Examiner's answer

# Step 5: oral hearing request

- Optional
- Due 2 months after Examiner's answer or on the date of filing a reply brief, whichever is earlier – NOT EXTENDABLE
- Must include payment of a fee

Source: 35 U.S.C. § 41(a)(6)(B); 37 C.F.R. § 41.47; MPEP § 1209



# Oral hearing request

PTO/AIA/32 (03-13)

Approved for use through 11/30/2020. 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.

REQUEST FOR ORAL HEARING BEFORE THE PATENT TRIAL AND APPEAL BOARD		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, VA 22313-1450" [37 CFR 1.8(a)]		In re Application of _____
on _____		Application Number _____ Filed _____
Signature _____		For _____
Typed or printed name _____		Art Unit _____ Examiner _____
Applicant hereby <b>requests an oral hearing</b> before the Patent Trial and Appeal Board in the appeal of the above-identified application.		
The fee for this Request for Oral Hearing is (37 CFR 41.20(b)(3))		\$ _____
<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 has already been authorized to charge fees in this application to a Deposit Account.		
<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(b) (PTO/SB/23 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:</b> 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*.		
<input type="checkbox"/> * Total of _____ forms are submitted.		

This collection of information is required by 37 CFR 41.20(b)(3). 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.



# Step 6: oral hearing

- If requested, the Office will notify you of the hearing date. You must reply to the hearing notice and confirm that you will attend the hearing
- Attendance may be in person, telephonically, or via a video connection
- Although rare, the Examiner may appear at the hearing
- Decorum required at all times

# Step 6: oral hearing

- You will have 20 minutes to present your case to three judges, who may be in the hearing room or attending remotely
- Judges will have already read the record on appeal, namely the Office action, appeal brief, Examiner's answer, and reply brief (if filed), and may or may not ask questions
- No new arguments or evidence, absent a showing of good case based on a recent, relevant decision of the PTAB or a Federal Court

# Alexandria hearings

Hearing Room A



Hearing Room B



Hearing Room D



# Regional office hearings

Detroit, MI



Denver, CO



Dallas, TX



San Jose, CA





# Step 7: Board decision

- Three judges will consider all of the arguments and evidence on appeal, confer, decide whether the Examiner erred in rejecting each claim on appeal, and issue a written decision
- If the judges decide the Examiner did not err in rejecting a claim, they will sustain the rejection of the claim
- The outcome of the decision depends on whether the judges decide to sustain all, some, or none of the rejections

*Source:* 37 C.F.R. § 41.50; MPEP § 1213



# Step 7: Board decision

- The outcome may be an affirmance, an affirmance-in-part, a reversal, or new ground(s) of rejection
  - **Affirmance:** Each and every claim subject to a sustained rejection – no non-rejected claim
  - **Affirmance-in-Part:** At least one claim, but not all, subject to a sustained rejection
  - **Reversed:** No claim subject to a rejection – no sustained rejections
  - **New Ground(s) of Rejection:** Judges issue a new rejection of one or more claims



# Step 7: Board decision

- The outcome dictates who is responsible for taking the next step
  - If the outcome is an affirmance or new ground(s) of rejection, you *must* take the next step
  - If the outcome is an affirmance-in-part, you *may* take the next step
  - If the outcome is a reversal, the Examiner will take the next step

# A word about filing appeal papers

- Appellant must file papers using EFS Web:
  - <https://www.uspto.gov/patents-application-process/file-online>
- EFS Web electronic filing guide:  
<https://www.uspto.gov/sites/default/files/patents/process/file/efs/guidance/EFSS-WebQuickStartGuide.pdf>

