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.

Source: 35 U.S.C. § 134(a); 37 C.F.R. §§ 41.31(a)(1), 41.33, 41.50.
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

Source: 35 U.S.C. § 134(a); 37 C.F.R. §§ 41.31(a)(1), 41.33, 41.50
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

Source: 35 U.S.C. §§ 6, 134(a); 37 C.F.R. §§ 41.31(a)(1), 41.37, 41.41, 41.47
Ex parte appeal process

3 mos. (extendable up to 6 mos.)
- adverse decision of Examiner, e.g., final Office action

2 mos. (extendable up to 7 mos.)
- Notice of Appeal (form) and appeal fee

2 mos. (NOT extendable)
- Appeal Brief (legal brief)
- Examiner's Answer

appeal forwarding fee
and optional Reply Brief (legal brief) and optional oral hearing request (form) with fee

2 mos. (NOT extendable)
- oral hearing (if requested)
- Board decision
- optional request for rehearing (legal brief) and decision on rehearing (if requested)

Back to Examiner
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

Source: 35 U.S.C. § 134; 37 C.F.R. § § 41.31; MPEP § 1204
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

Source: 35 U.S.C. § 41(a)(6)(A); 37 C.F.R. § 41.31(a); MPEP § 1204
**Notice of appeal form**

- **Fee payment**
- **Extension of time (if applicable)**
- **Signature information**

**Notice of Appeal from the Examiner to the Patent Trial and Appeal Board**

<table>
<thead>
<tr>
<th>Docket Number (Optional)</th>
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**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))

- $ [ ]
- $ [ ]
- $ [ ]

- [ ] Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 50%, and the resulting fee is: $ [ ]
- [ ] Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 75%, and the resulting fee is: $ [ ]

A check in the amount of the fee is enclosed.

Payment made via deposit account

A petition for an extension of time under 37 CFR 1.136(a) (PTO/AIA/22 or equivalent) is enclosed.

**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-208.

I am the

- [ ] applicant
- [ ] attorney or agent of record
- [ ] attorney or agent acting under 37 CFR 1.34

**Signature**

Typed or printed name

Telephone number

Date

**NOTE:** This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.34 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below.*

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* A total of [ ] forms are submitted.

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[If you need assistance in completing the form, call 1-800-PTD-2188 and select option 2.]

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**Patent application information**

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**Notice of appeal**

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**Uspto**
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

Source: 37 C.F.R. § 41.37; MPEP § 1205
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

*Source: 37 C.F.R. §§ 41.33, 41.37(c); MPEP §§ 1205, 1206*
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
    o Withdrawn Rejection(s)
    o New Ground(s) of Rejection
  – Response to Arguments

Source: 37 C.F.R. § 41.39; MPEP § 1207
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

Source: 37 C.F.R. § 41.45; MPEP §§ 1208, 1208.01
## Appeal Forwarding Fee

**Doc code**: WFE.APEAL  
**Doc Description**: Certification and Transmittal of Appeal Forwarding Fee

### Certification and Transmittal of Appeal Forwarding Fee

<table>
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<td>Docket Number (Optional)</td>
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<td>Application of</td>
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<td>Examiners</td>
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- **37 CFR 41.45** specifies that, in order to avoid dismissal of the appeal, the 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.

The undersigned certifies that the appropriate fee accompanies this transmittal.

- The fee for forwarding this appeal is (37 CFR 41.20(b)(4))

<table>
<thead>
<tr>
<th>Amount</th>
<th>Details</th>
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<tbody>
<tr>
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</tr>
<tr>
<td>$</td>
<td>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/355 or its equivalent must either be enclosed or have been submitted previously.</td>
</tr>
</tbody>
</table>

- A check in the amount of the fee is enclosed.
- Payment by credit card. Form PTO-2038 is attached.
- The Director hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No.
- Payment made via EFS-Web.

Extensions of time under 37 CFR 1.138(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 1.505(c) for extensions of time to reply for ex parte reexamination proceedings.

**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.

- I am the
- [ ] appellant
- [ ] attorney or agent of record
- [ ] attorney or agent acting under 37 CFR 1.34

**Signature**:  
Typed or printed name:  
Telephone Number:  
Date:  

**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*.

* Total of forms are submitted.

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

Source: 37 C.F.R. § 41.41(b); MPEP § 1208
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
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.

Source: 37 C.F.R. § 41.47; MPEP § 1209
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.

Source: 37 C.F.R. § 41.47; MPEP § 1209
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

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

*Source: MPEP § 1214*
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: