



The United States Patent and Trademark Office
an agency of the Department of Commerce

search for patents | search for trademarks



PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | ABOUT US

Home Page » Patents » Patent Laws, Regulations, Policies & Procedures » Manual of Patent Examining Procedure » Chapter 1200 » Section 1201

1201-Introduction

1202-Composition of Board

1203-Administrative Handling

1204-Notice of Appeal

- 1204.01-Reinstatement of Appeal
- 1204.02-Pre-Appeal Brief Review Request and Conference Pilot Program
- 1204.03-Interviews After Notice of Appeal
- 1204.04-Official Record on Appeal

1205-Appeal Brief

- 1205.01-Time for Filing Appeal Brief
- 1205.02-Appeal Brief Content
- 1205.03-Non-Compliant Appeal Brief and Amended Brief

1206-Amendments and Affidavits or Other Evidence Filed With or After Appeal

1207-Examiner's Answer

- 1207.01-Appeal Conference
- 1207.02-Contents of Examiner's Answer
- 1207.03-New Ground of Rejection in Examiner's Answer
 - 1207.03(a)-Determining Whether a Ground of Rejection is New
 - 1207.03(b)-Petition to Designate a New Ground of Rejection and to Reopen Prosecution
 - 1207.03(c)-Appellant's Reply to New Grounds of Rejection
- 1207.04-Reopening of Prosecution After Appeal
- 1207.05-Substitute Examiner's Answer

1208-Reply Briefs and Fee for Forwarding Appeal

- 1208.01-Fee for Forwarding an Appeal to the Board

1209-Oral Hearing

1210-Actions Subsequent to Examiner's Answer but Before Board's Decision

1211-Remand by Director or Board

- 1211.01-Remand by Board for Further Consideration of Rejection
- 1211.02-Remand To Consider Amendment
- 1211.03-Remand To Consider Affidavits or Declarations
- 1211.04-Remand by Board for Further Search

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_F8R9.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**.

[\[top\]](#)

1212-Board Requires Appellant to Address Matter
1213-Decision by Board
▪ 1213.01-[Reserved]
▪ 1213.02-New Grounds of Rejection by Board
▪ 1213.03-Publication of and Public Access to Board Decision
1214-Procedure Following Decision by Board
▪ 1214.01-Procedure Following New Ground of Rejection by Board
▪ 1214.02-[Reserved]
▪ 1214.03-Rehearing
▪ 1214.04-Examiner Reversed in Whole
▪ 1214.05-Cancellation of Claims Not Appealed
▪ 1214.06-Examiner Sustained in Whole or in Part; Claims Require Action
▪ 1214.07-Reopening of Prosecution
1215-Withdrawal or Dismissal of Appeal
▪ 1215.01-Withdrawal of Appeal
▪ 1215.02-Claims Standing Allowed
▪ 1215.03-Partial Withdrawal
▪ 1215.04-Dismissal of Appeal
1216-Judicial Review
▪ 1216.01-Appeals to the U.S. Court of Appeals for the Federal Circuit
▪ 1216.02-Civil Suits Under 35 U.S.C. 145 and 146



- » [Accessibility](#)
- » [Privacy Policy](#)
- » [Terms of Use](#)
- » [Security](#)
- » [Emergencies/Security Alerts](#)
- » [Information Quality Guidelines](#)

- » [Federal Activities Inventory Reform \(FAIR\) Act](#)
- » [Notification and Federal Employee Antidiscrimination and Retaliation \(NoFEAR\) Act](#)
- » [Budget & Performance](#)
- » [Freedom of Information Act \(FOIA\)](#)

- » [Department of Commerce NoFEAR Act Report](#)
- » [Regulations.gov](#)
- » [STOP!Fakes.gov](#)
- » [Department of Commerce](#)
- » [USA.gov](#)

- » [Strategy Targeting Organized Piracy \(STOP!\)](#)
- » [Careers](#)
- » [Site Index](#)
- » [Contact Us](#)
- » [USPTO Webmaster](#)