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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**.

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