

Chapter 1200: Appeal

1201 Introduction

1202 Composition of Board

1203 Administrative Handling

I. DOCKETING PROCEDURE

II. "SPECIAL CASE"

1204 Notice of Appeal

I. APPEAL FEES

II. APPEAL BY PATENT APPLICANT

III. APPEAL BY PATENT OWNER

IV. ACKNOWLEDGEMENT

V. DEFECTIVE 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

I. AMENDMENTS

II. AFFIDAVITS OR OTHER EVIDENCE

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

- I. REQUIREMENTS FOR A NEW GROUND OF REJECTION
- II. SITUATIONS WHERE NEW GROUNDS OF REJECTION ARE NOT PERMISSIBLE
- III. DESIGNATION AS A NEW GROUND OF REJECTION IN AN EXAMINER'S ANSWER

1207.03(a) Determining Whether a Ground of Rejection is New

- I. SITUATIONS WHERE A GROUND OF REJECTION IS NEW
- II. SITUATIONS THAT ARE NOT CONSIDERED NEW GROUNDS OF REJECTION

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

- I. REQUEST THAT PROSECUTION BE REOPENED BY FILING A REPLY
- II. REQUEST THAT THE APPEAL BE MAINTAINED BY FILING A REPLY BRIEF
- III. FAILURE TO REPLY TO A NEW GROUND OF REJECTION

1207.04 Reopening of Prosecution After Appeal

1207.05 Substitute Examiner's Answer

- I. SUBSTITUTE EXAMINER'S ANSWER RESPONDING TO A REMAND FOR FURTHER CONSIDERATION OF REJECTION

- A. Appellant's Reply

- 1. Request That Prosecution Be Reopened by Filing a Reply
 - 2. Request That the Appeal Be Maintained by Filing a Reply Brief

- B. Failure To Reply to a Substitute Examiner's Answer Under 37 CFR 41.50(a)

- II. SUBSTITUTE EXAMINER'S ANSWER RESPONDING TO A REMAND THAT IS NOT FOR FURTHER CONSIDERATION OF REJECTION

1208 Reply Briefs and Fee for Forwarding Appeal

- I. REPLY BRIEF
- II. EXAMINER'S RESPONSE TO A REPLY BRIEF

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
 - I. JURISDICTION OF BOARD
 - II. ABANDONMENT OF APPEAL: APPLICATION REFILED OR ABANDONED
- 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
- 1212 Board Requires Appellant to Address Matter
- 1213 Decision by Board
 - 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
 - I. SUBMISSION OF AMENDMENT OR NEW EVIDENCE
 - II. REQUEST FOR REHEARING
 - 1214.03 Rehearing
 - 1214.04 Examiner Reversed
 - 1214.05 Cancellation of Claims Not Appealed
 - 1214.06 Examiner Sustained in Whole or in Part
 - I. NO CLAIMS STAND ALLOWED
 - II. CLAIMS STAND ALLOWED
 - III. CLAIMS REQUIRE ACTION
 - IV. 37 CFR 41.50(b) REJECTION
 - 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

I. JUDICIAL REVIEW OF PATENT APPLICATIONS

II. JUDICIAL REVIEW OF REEXAMINATION PROCEEDINGS

III. JUDICIAL REVIEW OF INTER PARTES REVIEW, POST-GRANT REVIEW, COVERED BUSINESS METHOD REVIEW, AND DERIVATION PROCEEDINGS

IV. TIME FOR FILING NOTICE OF APPEAL OR COMMENCING CIVIL ACTION

V. TIME FOR FILING CROSS-APPEAL OR CROSS-ACTION

VI. EXTENSION OF TIME TO SEEK JUDICIAL REVIEW

VII. APPLICATION UNDER JUDICIAL REVIEW

VIII. SERVICE OF COURT PAPERS ON THE DIRECTOR

1216.01 Appeals to the U.S. Court of Appeals for the Federal Circuit

I. OFFICE PROCEDURE FOLLOWING DECISION BY THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT

A. All Claims Rejected

B. Some Claims Allowed

C. Remand

D. Reopening of Prosecution

II. DISMISSAL OF APPEAL

1216.02 Civil Suits Under 35 U.S.C. 145 and 146