

Patent Prosecution: PTAB Appeals

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A Practice Note discussing patent prosecution ex parte appeals to the US Patent and Trademark Office (USPTO) Patent Trial and Appeal Board (PTAB). This Note addresses key considerations and the requirements for appealing an examiner's rejection of pending claims in a US patent application. The key issues include pre-appeal considerations, the Pre-Appeal Brief Conference Pilot Program, the notice of appeal, appeal brief, reply brief, oral hearing, potential appeal outcomes, and post-appeal decision procedures.

A patent applicant whose claims have been twice rejected may appeal to the Patent Trial and Appeal Board (PTAB) (35 U.S.C. § 134(a); 37 C.F.R. § 41.31(a)(1)). Applicants typically face the decision of whether to appeal after a final office action when the available options are limited (37 C.F.R. § 1.113).

A full ex parte appeal can be costly and time-consuming, but applicants have ways of using a notice of appeal to continue prosecution. This Note addresses:

- The benefits of and alternatives to appeal.
- Using the Pre-Appeal Brief Conference Pilot Program and examiner interviews to seek early resolution.
- Appeal requirements and procedures, including briefing and optional oral hearing.
- Appeal outcomes and post-appeal procedures.

For more information on the patent prosecution process generally, see [Practice Note, Patent Prosecution: Overview](#).

Although appeal procedures are substantially the same for ex parte reexaminations under 35 U.S.C. § 134(b), this Note does not specifically address those appeals. For information on reexamination and appeals, see [Practice Note, Ex Parte Patent Reexamination and Supplemental Examination: Appeal](#).

Appeal-Eligible Applications

Patent prosecution involves correspondence between the patent applicant and the US Patent and Trademark Office (USPTO) examiner as office actions and applicant replies (see [Practice Note, Patent Prosecution: Overview](#)). The examiner typically makes the second or subsequent action on the merits final (see [Practice Note, Patent Prosecution: Final Rejections: Overview of Final Office Actions](#)).

An applicant can appeal to the PTAB after the examiner rejects any of its claims at least twice (35 U.S.C. § 134(a); see [Twice-Rejected Claims](#)). A second or subsequent office action in an application is usually a final action, after which:

- Substantive prosecution is closed (37 C.F.R. § 1.113).
- The USPTO will enter only limited types of responsive amendments (37 C.F.R. § 1.116(b)).
- An amendment does not toll the office action response deadline (37 C.F.R. § 1.116(c)).

To keep the application alive after a final office action, no later than the statutory response deadline, the applicant must:

- Secure the application's allowance.
- Successfully request the examiner withdraw the action's finality.

- File a request for continued examination (RCE).
- File a notice of appeal.

This Note focuses on PTAB appeals after a final USPTO office action.

Applicants can only appeal substantive claim rejections (37 C.F.R. § 41.31(a)(1); MPEP § 1201). Petition practice is available to challenge non-appealable procedural and formal issues such as examiner objections or an office action's finality (37 C.F.R. § 1.181(a)).

Twice-Rejected Claims

The applicant can appeal an application to the PTAB after the examiner rejects any of its claims at least twice (35 U.S.C. § 134(a); 37 C.F.R. § 41.31(a)(1); MPEP § 1204(II)). This requirement is not limited to a claim in a particular application. For example, a claim can be rejected first in a parent application and later rejected in a continuing patent application. In that situation, the applicant may file an appeal in the continuing application concerning the twice-rejected claim, and the examiner may designate the first rejection in the continuing application as final (MPEP § 706.07(b)).

Considering an Ex Parte Appeal to the PTAB

Applicants prosecuting an appeal-eligible patent application should consider:

- The potential benefits of an appeal, recognizing that most appeals are resolved before reaching a final PTAB decision (see [Benefits of Filing an Appeal](#)).
- Alternatives to appeal (see [Alternatives to Filing an Appeal](#)).
- Preparations for filing a PTAB appeal (see [Preliminary Considerations Before Filing an Appeal](#)).

Benefits of Filing an Appeal

Applicants should consider appealing when the rejections are legally or factually wrong and further claim amendments would reduce the claims' commercial value. At a minimum, filing a notice of appeal keeps the application alive. Additionally, several off-ramps mean most appeals are terminated at reduced cost and before a final PTAB decision.

Patent counsel may use the appeal's delay as a placeholder to:

- Prepare and file an amendment under 37 C.F.R. § 1.116 after the notice of appeal (see [Submissions After Notice of Appeal](#)). Applicants might use the time to develop data or other patentability evidence.
- Develop claims for a continuing patent application to cover slowly developing competitive activity or the applicant's developing technology.
- Consider filing an RCE at any time up to the PTAB decision or otherwise withdraw the appeal to accept any allowed claims.

The examiner could withdraw the rejection and reopen prosecution or allow the application after the patent applicant files:

- A response to the office action.
- A pre-appeal brief conference request (see [Pre-Appeal Brief Conference Pilot Program](#)).
- A persuasive appeal brief (see [Examiner's Response to the Appeal Brief](#)).

Although an appeal can be lengthy, USPTO data indicate that only about one third of appeals result in a PTAB decision, indicating that examiners are willing to allow an application or reopen prosecution when faced with an appeal. Effectively negotiating with the examiner in writing through the appeal mechanism is often a successful way to reopen prosecution without filing an RCE and associated loss of patent term adjustment (PTA). Some examiners prefer written advocacy over interviews. An appeal can be the best option when examiner-level data indicate that interviews with the examiner result in allowance less than 60% of the time.

Additionally, an appeal that is successful for at least one claim can result in a day-for-day PTA accrual. For information on PTA, see [Practice Note, Patent Term Adjustment: After-Final Practice and Appeal](#).

Alternatives to Filing an Appeal

Where minor amendments only requiring the examiner's nominal reconsideration of the application would place the claims in condition for allowance, patent counsel may:

- File a response or amendment.
- Interview the examiner (MPEP §§ 713.09 and 1204.03) before filing a response. For more

information on examiner interviews, see [Practice Note, Patent Prosecution: Examiner Interviews](#).

Where any amendments would require substantive claim changes requiring the examiner to review prior art, patent counsel may consider continuing prosecution through:

- An RCE under 37 C.F.R. § 1.114 with an appropriate submission, which continues prosecution of the pending application. For information on RCEs see [Practice Note, Patent Prosecution: Continuing Patent Applications: Request for Continued Examination](#) and [Request for Continued Examination \(RCE\) Checklist](#).
- Accepting any allowed subject matter and filing a continuing application to pursue currently rejected subject matter. For more information on continuing applications, see [Practice Note, Patent Prosecution: Continuing Patent Applications](#).

Where the office action is incomplete by failing to address the applicant's arguments made in the previous reply, patent counsel may wish to consider:

- Contacting the examiner to address the failures and issue a new office action.
- Filing a petition for a complete office action within two months of the office action date (see [Practice Note, Patent Prosecution: 37 C.F.R. § 1.181 Petitions for a Complete Office Action](#)).

Preliminary Considerations Before Filing an Appeal

When considering an appeal, patent counsel should consider:

- The [USPTO Appeals](#) web page, [Ex Parte Appeals FAQs](#), and PTAB appeals guidelines in the July 13, 2023 [USPTO Guidance for Ex Parte Appeals](#).
- Participating in the Pre-Appeal Brief Conference Pilot Program (see Pre-Appeal Brief Conference Pilot Program).
- PTAB appeal fees against alternatives such as an RCE and a continuing application (see [USPTO Fee Schedule](#)).
- The key issues and the attorneys' fees required to prepare and file:
 - the notice of appeal (see Notice of Appeal);
 - the appeal brief (see Appeal Brief Requirements);

- a reply brief (see Applicant's Reply Brief); and
- a request for an oral hearing (see Oral Hearing).

- In response to an appeal brief, the examiner and the PTAB can enter a new ground of rejection (see Answer Including New Ground of Rejection and Decision Containing New Ground of Rejection).
- [Appeals Statistics](#) and [PTAB Dashboard data](#) for the current appeal inventory and pendency.
- Commercially available examiner-level appeal results data.

For a flowchart showing stages of the appeal process, see [Patent Prosecution Flowchart: Appeal](#).

Notice of Appeal

A patent applicant may appeal twice-rejected claims (see Twice-Rejected Claims) to the PTAB by filing within the time set for replying to the pending rejection and any extension:

- A notice of appeal (see [USPTO Form PTO/AIA/31](#)).
- The fee required by 37 C.F.R. § 41.20.

(35 U.S.C. § 134(a); 37 C.F.R. §§ 1.134, 1.136, 41.20, and 41.31.)

When filing a notice of appeal, the patent applicant is presumed to appeal all the rejected claims, except claims canceled in an amendment the examiner entered (37 C.F.R. § 41.31(c)).

A request to participate in the Pre-Appeal Brief Conference Pilot program must be filed with the notice of appeal (see Panel Review Request Filed with the Notice of Appeal).

Submissions After Notice of Appeal

Before filing an appeal brief (see Appeal Brief Requirements), patent counsel may file an amendment after final action under 37 C.F.R. § 1.116, which is generally limited to:

- Canceling claims.
- Complying with claim format requirements.
- Presenting the claims in better form for appeal, such as minor Section 112 issues.
- Amending the specification or claims on a showing of good and sufficient reason why the amendment is necessary and not presented earlier.

(37 C.F.R. § 41.33(a); MPEP § 1206.)

After filing the appeal brief, patent counsel may file an amendment to either:

- Cancel claims.
- Rewrite dependent claims into independent form.

(37 C.F.R. § 41.33(b); MPEP § 1206.)

Patent counsel may also submit additional evidence after filing the notice of appeal but before filing the appeal brief. The examiner will enter the evidence only if they agree that:

- The evidence overcomes all rejections under appeal.
- There are good and sufficient reasons why the evidence is necessary and was not presented earlier.

(37 C.F.R. § 41.33(d); MPEP § 1206.)

Pre-Appeal Brief Conference Pilot Program

The Pre-Appeal Brief Conference Pilot Program allows applicants to request a panel review before the appeal brief is due, which may spare the applicant the time and expense of preparing an appeal brief if the panel determines that the application is either allowable or not in condition for appeal (MPEP § 1204.02).

The program's goals are to identify either:

- The presence or absence of clearly improper rejections based on legal or factual errors, including claim construction errors.
- The omission or presence of essential elements required to establish the appealed rejections.

Before using this program, patent counsel should understand:

- The conditions necessary to request a panel review (see Panel Review Request Filed with the Notice of Appeal).
- The panel review and the decision's format (see Panel Review and Decision).
- Relevant time periods (see Effect of Pre-Appeal Brief Review on Appeal Brief Deadline).

Panel Review Request Filed with the Notice of Appeal

To participate in the program, the patent applicant must file together:

- A notice of appeal and the required fee (see Notice of Appeal).
- A Pre-Appeal Brief Request for Review.

(MPEP § 1204.02.)

The request must not exceed five single-spaced pages, not including a cover page with the case caption and a concluding signature page. There is no separate fee for the request (MPEP § 1204.02).

The request must specify either:

- The clear errors in the examiner's rejection.
- The omission of one or more essential elements needed for a *prima facie* rejection.

For example, where the rejection was based on prior art, the request could demonstrate that either:

- The cited references do not disclose a claim element.
- The examiner's claim construction is unreasonable.

The request should focus on clear errors and the prior art. Complex issues such as Section 101 patent eligibility or Section 103 motivation to combine arguments are better handled using the space available in an appeal brief.

Applicants may use [USPTO Form PTO/AIA/33](#). For additional guidance and a Pre-Appeal Brief Request for Review template, see [Standard Document, Pre-Appeal Brief Request for Review](#).

Panel Review and Decision

A panel of examiners considers the merits of each appealed ground of rejection and issues a written decision. The panel is typically the examiner, their supervisor, and a more senior Quality Assurance Specialist (QAS). Patent counsel cannot attend the review and the panel will not grant any interview before the panel's decision (MPEP § 1204.02).

The panel decision states one of the following outcomes:

- The application remains under appeal because there is at least one issue the panel believes the PTAB will uphold. The panel's decision will not include any explanation or identification of which issues the panel believes will be successful.
- Prosecution on the merits is reopened and an appropriate USPTO communication will follow.

- The pending claims are allowed, and prosecution remains closed.
- The request fails to comply with the submission requirements and is dismissed.

(MPEP § 1204.02.)

The panel will terminate the review if patent counsel files any of the following after the request but before the panel decision:

- An appeal brief.
- An RCE.
- An after-final amendment.
- An affidavit or other evidence.
- An express abandonment.

(MPEP § 1204.02.)

Effect of Pre-Appeal Brief Review on Appeal Brief Deadline

After an unsuccessful panel review, the extendible due date for filing the appeal brief is the later of:

- The remainder of the regular two-month time period to file a reply brief under 37 C.F.R. § 41.37(a).
- One month after the panel decision date, even if the panel decision date is after the regular two-month period.

(MPEP § 1204.02.)

Appeal Briefing and Oral Hearing

The appeal briefing process consists of:

- The patent applicant's appeal brief (see Appeal Brief Requirements).
- The examiner's formal answer or other response to the appeal brief (see Examiner's Response to the Appeal Brief).
- Optionally, an applicant reply brief (see Applicant's Reply Brief).
- Oral hearing, if requested (see Oral Hearing).

Appeal Brief Requirements

Patent counsel must file the appeal brief within the later of:

- Two months after filing the notice of appeal, which is extendable by up to an additional five months (37 C.F.R. §§ 1.136 and 41.37(a); MPEP § 1205.01).
- One month after the panel decision on a request for a Pre-Appeal Brief Conference if patent counsel filed this request (MPEP § 1204.02).

There is no fee for filing an appeal brief (37 C.F.R. § 41.20(b)(2)(i)).

The appeal brief must comply with the sections and content requirements of 37 C.F.R. § 41.37(c), which, among other things, requires arguments responsive to every ground of rejection stated in the appealed office action. For details on these requirements, see [Practice Note, Patent Prosecution: PTAB Appeal Briefs: Appeal Brief Contents](#).

For each ground of rejection applicable to more than one claim, the claims stand or fall together unless argued separately (37 C.F.R. § 41.37(c)(1)(iv)). If argued separately, the PTAB will consider the patentability of each separately argued claim. If the claims are argued together, the PTAB will select the weakest claim for analysis. However, if the PTAB reverses the examiner on the weakest claim, the PTAB will separately consider the elements of each claim argued together to ensure each claim is individually patentable on its own merits. For this reason, the brief should argue each claim separately to maximize PTAB consideration of the applicant's claims and arguments.

The brief can cite relevant portions of the applicant's previous responses but should not incorporate those responses by reference (MPEP § 1205.02).

If the appeal brief does not address a ground of rejection:

- The patent applicant waives any challenge to that rejection.
- The PTAB will summarily sustain that rejection.

(MPEP § 1205.02.)

For more information on appeal briefs, see [Practice Note, Patent Prosecution: PTAB Appeal Briefs](#) and the USPTO's [Practice Tips for Writing Effective Appeal Briefs](#). For a model appeal brief with drafting guidance, see [Standard Document, PTAB Appeal Brief](#).

Examiner interviews are normally unavailable after filing the appeal brief (MPEP § 1204.03). However, an examiner can still contact patent counsel to discuss

proposed amendments up until the filing of the reply brief and payment of the appeal forwarding fee.

Noncompliant or Missing Appeal Brief

If the appeal brief does not comply with 37 C.F.R. § 41.37(c), the USPTO issues a noncompliant brief notice requiring a corrected brief within a certain time period. If the patent applicant does not comply with that notice, the examiner dismisses the appeal. (37 C.F.R. § 41.37(d); MPEP § 1205.03.)

If counsel fails to file a timely appeal brief, the examiner dismisses the appeal and either:

- Acts on any previously allowed claims.
- The application becomes abandoned on the date the appeal brief was due if the examiner had not previously allowed any claims.

(37 C.F.R. § 41.37(b); MPEP § 1205.01.)

The applicant can file a petition to revive application abandoned this way under 37 C.F.R. § 1.137. For information on petitions to revive, see [Practice Note, Patent Prosecution: Petitions: Abandoned Application: Revive Based on Unintentional Delay](#).

If the appeal is dismissed but the application is not abandoned because there is at least one allowed claim, patent counsel can file a petition to reinstate the claims and the appeal, with a showing equivalent to that in a Section 1.137 petition, and either:

- An RCE, with the appropriate submission, to continue prosecution of the abandoned application.
- An appeal brief to reinstate the appeal.

(MPEP § 1205.01.)

Examiner's Response to the Appeal Brief

In response to the appeal brief, the examiner may:

- Allow the application. For more information concerning key steps patent counsel should take on a patent application's allowance, see [Allowed Patent Application Review Checklist](#).
- Reopen prosecution to enter a new ground of rejection (see Reopening Prosecution).
- File an answer (see Examiner's Answer), which may include a new ground of rejection (see Answer Including New Ground of Rejection).

Reopening Prosecution

The examiner, their supervisor, and the QAS all review the appeal brief. The brief may persuade this expanded audience that the PTAB would not sustain the rejection. In this situation, the examiner will either allow the application or, more commonly, reopen prosecution instead of submitting an answer (see *Hyatt v. U.S. Patent and Trademark Office*, 904 F.3d 1361, 1375 (Fed. Cir. 2018)). In this case, the applicant avoids having to pay the appeal forwarding fee under 37 C.F.R. § 41.45.

In deciding whether to reopen prosecution or to include a new ground of rejection in an examiner's answer (see Answer Including New Ground of Rejection), the examiner considers the degree to which the rejections of record is being changed among other factors (MPEP § 1207.04).

Once prosecution reopens and the examiner issues an office action, patent counsel can file any of the following, depending on the situation:

- A reply under 37 C.F.R. § 1.111 if the office action is nonfinal.
- A reply under 37 C.F.R. § 1.113 if the office action is final, which may occur if the new ground of rejection was:
 - required by amendment; or
 - based on information in an information disclosure statement (IDS) under 37 C.F.R. § 1.97(c) where no statement under 37 C.F.R. § 1.97(e) was filed. For more on IDS, see [Practice Note, Patent Prosecution: USPTO Duty of Candor and Information Disclosure](#).
- A notice of appeal to start a new appeal, which should not require additional fees, unless the fees had increased since the previous payment (MPEP § 1204.01).

(MPEP § 1207.04.)

Examiner's Answer

Within two months after the appeal brief's filing date, the examiner may file an answer to the appeal brief, which may:

- Directly address the patent applicant's arguments. The examiner may do this by referring to or repeating portions of the examiner's final rejection if those portions fully respond to the arguments in the appeal brief.

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- Withdraw rejections to some or all of the claims.
- Enter a new ground of rejection.

(37 C.F.R. § 41.39; MPEP § 1207.02.)

Patent counsel should examine the answer to determine whether an undesignated new ground of rejection has been entered (see Answer Including New Ground of Rejection).

To avoid dismissal of the appeal, patent counsel must submit an appeal forwarding fee by the later of:

- Two months after the date of the examiner's answer.
- A decision refusing to grant a petition under 37 C.F.R. § 1.181 to designate a new ground of rejection in the examiner's answer.

(37 C.F.R. §§ 41.20(b)(4) and 41.45; MPEP § 1208.01.)

Answer Including New Ground of Rejection

The examiner must have approval from a Technology Center Director (or designee) to make any new ground of rejection and must prominently identify any new ground of rejection in the answer (37 C.F.R. § 41.39(a)(2); MPEP § 1207.03(I)). A new ground of rejection is any ground that relies on new evidence, for example:

- Changing the statutory basis of the rejection from, for example:
 - Section 102 anticipation to Section 103 obviousness; or
 - obviousness to anticipation based on a different teaching in the prior art reference.
- Adding a new statutory ground of rejection.

(37 C.F.R. § 41.39(a)(2); MPEP §§ 1207.03(III) and 1207.03(a)(I).)

There is no new ground of rejection where the rejection's basic thrust remains the same so that the patent applicant received a fair opportunity to respond to the rejection (MPEP § 1207.03(a)(II)).

Within two months after the date of the examiner's answer identifying a new ground of rejection, patent counsel must request that either:

- Prosecution be reopened and the appeal withdrawn by filing a reply under 37 C.F.R. § 1.111.

- The appeal be maintained by filing a reply brief under 37 C.F.R. § 41.41 that addresses each new ground of rejection.

(37 C.F.R. § 41.39(b); MPEP § 1207.03(c).)

If the examiner's answer includes an undesignated new ground of rejection, the patent applicant may either:

- File a petition with the USPTO Director under 37 C.F.R. § 1.181 within two months after entry of the examiner's answer but before filing a reply brief to reopen prosecution (37 C.F.R. § 41.40(a)). If the USPTO:
 - grants the petition and reopens prosecution, the patent applicant may also submit amendments, evidence, and arguments to the other rejections (37 C.F.R. § 41.40(b); MPEP § 1207.03(b)); or
 - does not grant the petition, the appeal is maintained and the patent applicant must file any reply brief and the appeal forwarding fee under 37 C.F.R. § 41.20(b)(4) within two months (37 C.F.R. §§ 41.40(c) and 41.45; MPEP §§ 1207.03(b) and 1208.01).
- Maintain the appeal by filing a reply brief under 37 C.F.R. § 41.41 within two months after the examiner's answer (37 C.F.R. § 41.40(d)). The reply brief may address the new ground of rejection and the PTAB must consider these arguments (see *In re Durance*, 891 F.3d 991, 1002 (Fed. Cir. 2018)).

Applicant's Reply Brief

Filing a reply brief to the examiner's answer is optional but strongly recommended to avoid any appearance or perception that the applicant is conceding any examiner argument. However, the applicant must file either a reply or a reply under 37 C.F.R. § 1.111 to reopen prosecution if either:

- The examiner's answer designates a new ground of rejection (see Answer Including New Ground of Rejection).
- The examiner submits a substitute answer responding to a remand from the PTAB to further consider a rejection (see Remand).

(37 C.F.R. § 41.39(b); MPEP §§ 1207.03(c), 1207.05, and 1208.)

If filed, it is due within two months after the date of either:

- The examiner's answer.
- The decision refusing to grant a petition under 37 C.F.R. § 1.181 to designate as new a ground of rejection in the examiner's answer (see Answer Including New Ground of Rejection).

(37 C.F.R. § 41.41(a).)

Normally, the examiner does not acknowledge or have an opportunity to comment on the reply brief (MPEP § 1208(II)). The appeal's jurisdiction passes from the examiner to the PTAB after the applicant pays the appeal forwarding fee.

Oral Hearing

An oral hearing is optional and rarely necessary (37 C.F.R. § 41.47(a)). An oral hearing may be helpful where:

- The technology and prior art are complex.
- Claim construction is complex. For more information on claim construction, see [Practice Note, Patent Claim Construction: Overview](#).
- The law is evolving on the relevant issues.
- Patent counsel is concerned that the examiner or the PTAB may not adequately consider the patent applicant's arguments (see *In re Durance*, 891 F.3d at 1002).

To request an oral hearing, patent counsel should file a request and the required fee within the earlier of two months after the examiner's answer or the filing date of a reply brief (37 C.F.R. § 41.47(b); MPEP § 1209). Counsel must either confirm or waive attendance at the hearing within 21 days after the USPTO's Notice of Hearing.

At the hearing, counsel has 20 minutes for argument but may reserve some time for rebuttal (37 C.F.R. §§ 41.47(d), (e)(1); MPEP § 1209; see [USPTO: Duration of Hearing](#)). The argument may:

- Rely only on evidence already of record and may not raise any new argument unless it is based on a recent PTAB or federal court decision.
- Include the use of demonstratives, although patent counsel must request equipment for demonstratives in writing at least three days before the oral hearing (see [USPTO: Use of Demonstratives and Exhibits](#)).

(37 C.F.R. § 41.47(e); MPEP § 1209; see [USPTO: Oral Advocacy Before the PTAB](#).)

For more information on ex parte appeal oral hearings, see [Practice Note, Patent Prosecution: PTAB Appeal Oral Hearings](#).

PTAB Decision

Before the PTAB's decision, patent counsel may:

- File a petition requesting the PTAB to withhold its decision to permit refiling the application (MPEP § 1213).
- Avoid a potentially negative PTAB decision by either:
 - filing a letter expressly abandoning the application according to 37 C.F.R. § 1.138; or
 - withdrawing the appeal.

Patent counsel may also consider filing an RCE before the PTAB decision. The USPTO treats an RCE as a request to withdraw the appeal (MPEP §§ 1210, 1213, and 1215.01). For more information concerning RCEs, see [Practice Note, Patent Prosecution: Continuing Patent Applications: Request for Continued Examination and Request for Continued Examination \(RCE\) Checklist](#).

Before issuing its decision, the PTAB may request that the patent applicant address a particular matter (37 C.F.R. § 41.50(d); MPEP § 1212).

The PTAB's decision may:

- Affirm or reverse the examiner in whole or in part (37 C.F.R. § 41.50(a)(1); see Affirming or Reversing the Examiner).
- Enter a new ground of rejection (37 C.F.R. § 41.50(b); see Decision Containing New Ground of Rejection).
- Remand the application to the examiner (37 C.F.R. § 41.50(a)(1); see Remand).

Affirming or Reversing the Examiner

If the PTAB's decision results in no allowed claims, the examiner is affirmed and the application is abandoned after the period for seeking judicial review expires (see Judicial Review of PTAB Decision). However, during this period, the patent applicant can address:

- A non-statutory double patenting rejection by filing a proper terminal disclaimer. For more information on terminal disclaimers, see [Practice Note, Patent Correction: Statutory and Terminal Disclaimers, Certificates of Correction, and Inventorship: Using Terminal Disclaimers to Limit the Patent Term](#).

- Allowable claims depending from a rejected claim by rewriting the claims in independent form and refiling the amended claims in the USPTO.

(MPEP § 1214.06(I).)

Where the PTAB's decision leaves no claim rejected on any ground, the examiner is reversed. In response, the examiner will usually issue an allowance. However, the PTAB may suggest the examiner consider a certain ground of rejection. Additionally, the examiner can seek Technology Center Director approval to reopen prosecution after a reversal, even after the period for rehearing and judicial review has run, if the PTAB is deemed to have misapprehended some issue of fact or law.

Where the PTAB affirms the rejection of only some claims, the examiner either:

- Cancels the rejected claims in an examiner's amendment, which patent counsel may consider further pursuing in a continuation application.
- Converts dependent claims to independent form or sets a time period for the applicant to file an amendment that rewrites the claims in independent form.

(MPEP § 1214.06(II).)

If the PTAB decision results in claims requiring further action, such as where the application includes non-elected claims or contains a provisional double patenting rejection the PTAB did not address, the examiner will take up the application (MPEP § 1214.06(III)).

Decision Containing New Ground of Rejection

The PTAB's decision may reject any pending claim, including claims the examiner allowed. When the PTAB enters a new ground of rejection:

- It must designate that rejection as new.
- The PTAB's decision is not final for judicial review. Because a PTAB decision designating a new ground of rejection is not a final decision, if an appeal to the Federal Circuit is desired, counsel must request rehearing and await the PTAB's decision on rehearing before filing the appeal.

(37 C.F.R. § 41.50(b); MPEP § 1213.02.)

Within two months after the PTAB's decision entering a new ground of rejection, the applicant must:

- Reopen prosecution only for the new grounds of rejection by submitting claim amendments or new evidence to have the examiner reconsider the application (MPEP § 1214.01(I)).
- Request a rehearing by stating with particularity:
 - the points they believe the PTAB misapprehended or overlooked in entering the new ground of rejection; and
 - all other grounds on which patent counsel seeks rehearing (see Rehearing).
- File an RCE if no claims remain allowed as a result of the new ground of rejection. If no RCE or rehearing request is filed, the appeal will be dismissed and the application abandoned. In this case, the applicant can file a petition to revive along with an RCE to reopen prosecution.

(37 C.F.R. § 41.50(b); MPEP § 1214.01.)

If the PTAB decision includes an undesignated new ground of rejection, the patent applicant must file a request for rehearing under 37 C.F.R. § 41.52 to avoid waiving any argument that the decision contains an undesignated new ground of rejection (37 C.F.R. § 41.50(c); see Rehearing).

Remand

In rare cases, the PTAB may remand the application to the examiner to:

- Reconsider a rejection under 37 C.F.R. § 41.50(a)(1), consider an IDS, or a reply brief (MPEP § 1211.01). In this situation, the examiner may prepare a substitute examiner's answer, to which patent counsel may respond within two months by filing either:
 - a reply under 37 C.F.R. § 1.111 to request that prosecution be reopened; or
 - a reply brief to request that the appeal be maintained.

(37 C.F.R. § 41.50(a)(2).)

- Consider an amendment that cancels claims or rewrites dependent claims in independent form (MPEP § 1211.02).
- Consider an affidavit or declaration where patent counsel demonstrates:
 - its need; and
 - why it was not previously submitted.

(MPEP § 1211.03.)

Patent Prosecution: PTAB Appeals

- Conduct a further search, although this is extremely rare (MPEP § 1211.04).

A PTAB decision that includes a remand is generally not considered final for judicial review (37 C.F.R. § 41.50(e)).

Procedures Following an Unfavorable PTAB Decision

If the PTAB affirms the examiner, in whole or in part, further actions to pursue the rejected claims include:

- Filing a request for rehearing with the PTAB (see Rehearing).
- Filing a further appeal to the Federal Circuit or a civil action in district court (see Judicial Review of PTAB Decision).
- Continuing prosecution of the rejected claims by filing an RCE, an amendment, and the appropriate fee (37 C.F.R. §§ 1.17(e) and 1.114).
- If one or more claims were allowed before the appeal, filing an amendment canceling the rejected appealed claims, which withdraws the appeal. The examiner then acts on the allowed claims. (MPEP § 1215.02.)

Rehearing

The applicant may file a single request for a rehearing under 37 C.F.R. § 41.52. The request must particularly state the points the PTAB overlooked or misapprehended. It cannot present new arguments or evidence except:

- If it is based on a recent PTAB or federal court decision or change in USPTO policy.
- To respond to a new ground of rejection made under 37 C.F.R. § 41.50(b) and make it ripe for judicial review.
- Where the PTAB decision contains an undesignated new ground of rejection, to preserve the issue for appeal.

(37 C.F.R. § 41.52(a); MPEP § 1214.03.)

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Patent counsel must file a request for rehearing within two months after the date of the PTAB's original decision. This time period is extendable only under the provisions of 37 C.F.R. § 1.136(b) (37 C.F.R. § 41.52(a)(1); MPEP § 1214.03).

Judicial Review of PTAB Decision

Judicial review of the final PTAB decision is available by filing, within 63 days after the PTAB's decision, either:

- A Federal Circuit appeal (35 U.S.C. § 141; 37 C.F.R. § 90.3(a)(1)). The notice to the USPTO Director under 35 U.S.C. § 142 must be filed by email unless email cannot be used (37 C.F.R. § 90.2(a)(1); 89 Fed. Reg. 22084 (Mar. 29, 2024)).
- A civil action against the USPTO Director in the US District Court for the Eastern District of Virginia (35 U.S.C. § 145; 37 C.F.R. § 90.3(a)(3)(i)).

If the patent applicant timely filed a request for rehearing (see Rehearing), the 63-day period begins to run from the PTAB's decision on the request for rehearing (37 C.F.R. § 90.3(b)(1)). The USPTO may grant an extension of time in certain situations (37 C.F.R. § 90.3(c)).

In an ex parte appeal to the Federal Circuit, the court:

- Relies on the USPTO patent application prosecution record.
- Applies the substantial evidence standard of review to the USPTO's factual findings.

(35 U.S.C. § 144; see *In re Chapman*, 595 F.3d 1330, 1337 (Fed. Cir. 2010).)

The Federal Circuit does not consider any argument the patent applicant did not previously present.

In a civil action, the district court determines patentability based on:

- The USPTO patent application prosecution and appeal record.
- Any additional evidence submitted by the patent applicant and by the USPTO.

(35 U.S.C. § 145; see *Kappos v. Hyatt*, 566 U.S. 431, 445-46 (2012).)