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Understanding The “Twice Rejected” Rule For Initiating An Appeal With The Patent Trial And Appeal Board

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Appeals from United States Patent and Trademark Office rejections of patent applications are a critical component of patent prosecution practice. But, the rule governing the all-important question of when a rejection is ripe for appeal is not the model of clarity that practitioners might expect (See [35 U.S.C. §134](#)). Under 37 CFR §41.31(a)(1) (emphasis added), “[e]very applicant, any of whose claims has been **twice rejected**, may appeal from the decision of the examiner to the [Patent Trial and Appeal] Board (PTAB) by filing a notice of appeal.” The wording of 37 CFR §41.31(a)(1), however, is unclear as to whether “twice rejected” requires two rejections of a claim having exactly the same wording. In other words, would amending a claim after an initial rejection prevent an applicant from filing a notice of appeal after receiving a subsequent rejection of the amended claim? As will be discussed below, the answer to that question is no. There is no “exactness requirement” in the “twice rejected” rule (See [MPEP §1204](#)).



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The controlling case on the “twice rejected” rule is [Ex Parte Lemoine](#), 46 USPQ2d 1420 (Bd. Pat. App. & Inter. 1994). In *Ex Parte Lemoine*, an applicant received an Office Action, finally rejecting all of the pending claims in an application under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103. The applicant responded by filing a continuation application, and made some preliminary amendments to the claims, which included the addition of five new claims. The applicant then received a non-final rejection of the continuation application, which essentially repeated the previous grounds of rejection made in the parent application. The applicant then filed a notice of appeal. In response, the Examiner held the application to be abandoned, stating that the notice of appeal was improper at that particular stage of prosecution (*Ex Parte Lemoine*, 46 USPQ2d at 1420-22). The appeal was eventually forwarded to the Board of Patent Appeals and Interferences (now the PTAB).

Upon review of the appeal, the Board decided that the applicant had a right to appeal the non-final rejection of the claims. Specifically, the Board stated that the term “claims” as used in 35 U.S.C. §134 is “used in a more general sense to refer to claims ‘**for a patent**’ ... the word is synonymous with a request or demand for a patent” (*Ex Parte Lemoine*, 46 USPQ2d at 1423 (emphasis added)). The Board further stated that “[u]nder our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed” (*Ex Parte Lemoine*, 46 USPQ2d 1423).

In view of the Board’s decision, an applicant is allowed to initiate an appeal as long as the applicant has twice been denied a patent. The “twice rejected” rule of 37 CFR §41.31(a)(1), therefore, does not contain an “exactness requirement,” i.e., a requirement that a claim having the same exact wording be rejected twice. To the contrary, in *Ex Parte Lemoine* the Board concluded that the applicant has a right to appeal the rejection even though the applicant amended the claims. To confirm this understanding of the “twice rejected” rule, we reached out to a representative from the Office of Patent Legal Administration and several paralegals at the PTAB, all of whom were able to confirm that the “twice rejected” rule of 37 CFR §41.31(a)(1) does not contain an “exactness requirement.”

Another important aspect for practitioners to keep in mind is that “[a] notice of appeal may be filed after any of

the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected” (See MPEP §1204). The filing of a notice of appeal, therefore, does not depend on the finality of the rejection, meaning that a notice of appeal can be filed after either a non-final or a final rejection of a claim, so long as the claim has been “twice rejected.”

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