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America Invents Act (AIA) - Inter Partes Review - Other

- ▼ How will the Board handle multiple proceedings such as two or more inter partes reviews on the same patent?

Where another matter involving the same patent is before the Office during the pendency of the inter partes review, the Board may enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter. Joinder may be requested by a patent owner or petitioner.

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- ▼ Can the parties to an inter partes review settle?

The AIA permits the parties to an inter partes review to settle. A settlement terminates the proceeding with respect to the petitioner, and the Board may terminate the proceeding or issue a final written decision.

▼ Can a party to an inter partes review be sanctioned?

Yes, then AIA requires the Office to prescribe sanctions for abuse of discovery, abuse of process, or any other improper use of an inter partes review, such as to harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.

▼ Does the Board track the percentage of IPRs that identify concurrent litigation? If so, what is the percentage?

The Board does not currently track the percentage of IPRs that identify concurrent litigation.

▼ How will the Board conclude an inter partes review?

The AIA provides that where an inter partes review is instituted and not dismissed, the Board shall issue a final written decision. The decision shall address the patentability of any challenged patent claim and any new claim added via amendment during the inter partes review.

▼ After the Board renders a final decision in an inter partes review, do any estoppels apply against the petitioner?

Yes, a petitioner in an inter partes review may not request or maintain a subsequent proceeding before the Office with respect to any challenged patent claim on any ground that was raised or reasonably could have been raised in the inter partes review. Similarly, a petitioner in an inter partes review may not assert in a subsequent district court or ITC action that a claim is invalid on any ground that the petitioner raised or reasonably could have been raised in the inter partes review.

▼ After the Board renders a final decision in an inter partes review, do any estoppels apply against the patent owner?

Yes, a patent owner is estopped from taking action inconsistent with any adverse judgment including obtaining in a patent a claim that is patentably indistinct from a finally refused or cancelled claim or amending its specification or drawing in a way that it was denied during the proceeding.

▼ Can a party to an inter partes review appeal the Board's final decision?

Yes, a party dissatisfied with the final written decision in an inter partes review may appeal to the Federal Circuit.

▼ During an inter partes review, how can a party seek relief?

The AIA provides that a party may request relief during an inter partes review by filing a motion. In addition, the use of conference calls to raise and resolve issues in an expedited manner is encouraged. A party seeking relief may contact the Board and request a conference call, explaining why the call is needed. The Office envisions that most of the procedural issues arising during a proceeding will be handled during a conference call or shortly thereafter, i.e., in a matter of days.

▼ May a party file a motion seeking relief at any time during the inter partes review proceeding?

A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability, e.g., a scheduling order entered at the start of the trial, or during the proceeding after conferring with the Board.

▼ Is an oral hearing permitted during an inter partes review?

Yes, the AIA permits either party to a inter partes review to request an oral hearing.

▼ How long will an inter partes review take?

An inter partes review is statutorily required to be complete within one year of institution, except that the time may be extended up to six months for good cause.

▼ What prosecution bars could arise in an IPR?

Prosecution bars sometimes arise in IPRs as a result of a protective order entered in concurrent district court litigation. The enforcement of such bars, including whether particular activities are covered, is left to the district court that entered the order. The Patent Trial Practice Guide provides that counsel for a party who receives confidential information in a proceeding will not be restricted

by the Board from representing that party in any other proceeding or matter before the Office. See 77 Fed. Reg. 48756, 48771, para. (h) (Aug. 14, 2012).

▼ Is discovery permitted during an inter partes review?

The AIA authorizes the Office to set standards and procedures for the taking of discovery during an inter partes review, including that discovery be limited the depositions of witnesses submitting affidavits or declarations and what is otherwise necessary in the interest of justice.

▼ What type of discovery is permitted during an inter partes review?

Routine discovery includes cited documents, cross-examination of declaration testimony, and information inconsistent with positions advanced during the proceeding. The parties may agree mutually to provide additional discovery or either party may file an authorized motion seeking additional discovery.

▼ What are the requirements to meet the "interest of justice" standard for discretionary discovery in an IPR and are there any Federal Circuit case citations that would be helpful to review when deciding whether to invoke this standard?

The "interests-of-justice" standard is discussed in the "umbrella" Rules of Practice for Trials Before the Patent Trial and Appeal Board, appearing at 77 Fed. Reg. 48612, 48622 (Aug. 14, 2012). The Board's decision in IPR2012-00001, Paper No. 26, also provides guidance on the factors to consider when moving for additional discovery. This decision is available in the Representative Orders, Decisions, and Notices section of the Board's web site (http://www.uspto.gov/ip/boards/bpai/representative_orders_and_opinions.jsp).

▼ If an inter partes review is instituted, can the patent owner respond during the review?

Yes, a patent owner may file a response after the institution of an inter partes review.

▼ If an inter partes review is instituted, can the patent owner amend the claims during the review?

A patent owner may file one motion to amend the challenged patent claims, subject to the standards and procedures set by the Office, during an inter partes review. Amendments may cancel

any challenged patent claim and/or propose a reasonable number of substitute claims.

▼ If an inter partes review is instituted, can the petitioner file additional information?

Yes, a petitioner may supplement information provided in the petition for inter partes review by filing motion within one month of the date trial is instituted.

▼ How can a party to an inter partes review protect confidential information?

The AIA provides that the file of an inter partes review is open to the public, except that a party may seek to have a document sealed by filing a motion to seal. The AIA also provides for protective orders to govern the exchange and submission of confidential information.

▼ If a patent owner asserts new claims in litigation over one year after the initial complaint for infringing other claims of the same patent, can a petitioner file for inter partes review of those newly asserted claims if petitioned within one year of the

For an IPR, the applicable statute is 35 U.S.C. § 315(b), which states that an IPR may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party-in-interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The statute is clear that the bar is with respect to "the patent" and not specific claims of the patent. The bar does not apply to a request for joinder under subsection (c) of 35 U.S.C. 315.

▼ What is the standard for instituting an inter partes review and who will decide whether the standard is met?

The petitioner must demonstrate that there is a reasonable likelihood that he/she would prevail as to at least one of the claims challenged to trigger an inter partes review. The Patent Trial and Appeal Board will decide petitions for inter partes review and conduct any ensuing reviews. In instituting a review, the Board may take into account whether, and reject the petition or request because, the same or substantially same prior art or arguments previously were presented to the Office.

▼ Can a party request rehearing of the Board's decision denying its petition?

Yes, a party may request rehearing of the Board's decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed.

▼ Can a party appeal the Board's decision whether to institute an inter partes review?

No, a party is statutorily precluded from appealing the Board's decision whether to institute an inter partes review.

▼ What is the fee for filing an inter partes review petition?

The AIA requires the Director to set the fee for a post grant review in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review. For petitions filed prior to March 19, 2013, the fee for filing a petition challenging the patentability of up to 20 claims is \$27,200. For each additional claim challenged, there is a fee of \$600.00. For petitions filed on or after March 19, 2013, the request fee is \$9,000 plus a fee of \$200.00 for each claim over 20, and the post-institution fee is \$14,000 plus a fee of \$400.00 for each claim over 15.

▼ How does a party request an inter partes review?

To initiate an inter partes review, a party must file a petition establishing certain statutory requirements.

▼ What statutory and regulatory requirements must a petitioner meet in a petition for an inter partes review?

In a petition for an inter partes review, the petitioner must by statute (i) identify all real parties in interest; (ii) identify all claims challenged and all grounds on which the challenge to each claim is based; and (iii) provide copies of evidence relied upon. The petition must be accompanied by a fee. In addition, the petitioner must by rule (i) identify the grounds for standing; (ii) provide a claim construction for each challenged claim; (iii) specifically explain the grounds for unpatentability; and (iv) specifically explain the relevance of evidence relied upon.

▼ Can a patent owner respond to a petition for an inter partes review?

Yes, a patent owner may file a preliminary response to the petition to provide reasons why no inter partes review should be instituted.

▼ What patents are eligible for an inter partes review?

All patents issuing from applications subject to first-inventor-to-file provisions of the AIA as well as those patents issuing from applications subject to the first-to-invent provisions in current Title 35.

▼ On what grounds may a petitioner challenge a patent in an inter partes review?

A petitioner for inter partes review may request to cancel as unpatentable one or more claims of a patent on a ground that could be raised under 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

▼ Who may file for an inter partes review?

A person who is not the patent owner and has not previously filed a civil action challenging the validity of a claim of the patent may petition for an inter partes review of the patent.

▼ When can a petitioner bring an inter partes review for a patent?

A petition for inter partes review cannot be filed until after the later of:

- (i) 9 months after the grant of a patent or
 - (ii) the date of termination of any post-grant review of the patent.
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▼ What is the effective date for the inter partes review provision in the AIA?

The effective date for the inter partes review provision in the AIA is September 16, 2012.

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