



[Home](#) > [Patents](#) > [PTAB](#) > [FAQS](#) > [Patent Trial and Appeal Board \(PTAB\) FAQs](#)

Patent Trial and Appeal Board (PTAB) FAQs

Work is underway to consolidate all PTAB FAQs on the list below. In the meantime, you can find other PTAB FAQs at: [Ex parte appeals](#), [AIA trials](#), and [Hearings](#).

Appeals - Patent help – NEW - Applying for patents - Appeal and review

▾ What is an appeal?

In general, a patent applicant can file a notice of appeal after any one of the pending claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. 37 C.F.R. § 41.31. These appeals are decided by the Patent Trial and Appeal Board (PTAB), and more information can be found on the [PTAB FAQs page](#) of the USPTO website.

Appeals

▾ Where can I find the Board's opinions?

- Board precedential and informative opinions are available at the following link: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/precedential-informative-decisions>.
 - Board decisions are available at the following link: <https://developer.uspto.gov/ptab-web/#/search/decisions>.
 - Board AIA Review decisions are available at the following link: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/decisions/aia-review-decisions>.
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▼ Can I contact the judges for help with an appeal?

No, you may not try to contact a judge for help with an appeal. Other than during a hearing, judges will not discuss a particular appeal with you. Judges will rely on the written record, including a your brief(s), to decide the appeal.

If you have questions about preparing or filing documents on appeal, you can contact the examiner for the application or the Pro Se Assistance Program at 1-866-767-3848.

If you have questions about a docketed appeal, i.e., the appeal has been assigned an appeal number, you may contact the Board's Appeals Division at 571-272-9797 or by mail at the following address:

Appeal Related Matters
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

▼ If at least one of the claims in a patent application is rejected for the second time but not finally rejected in a non-final Office action, can applicant appeal the rejections set forth in the non-final Office action by filing a notice of appeal?

Yes, § 41.31 provides that an applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period for reply provided in the non-final Office action.

▼ How do I file a notice of appeal?

An applicant must follow the requirements set forth in [37 CFR § 41.31](#) which require that a notice be filed within the time allowed for response from the examiner's last office action, and also pay a fee. See Section [1204](#) of the Manual of Patent Examining Procedure. The notice of appeal and appropriate fee may be filed up to 6 months from the date of the Office action from which the appeal was taken, so long as an appropriate petition and fee for an extension of time under [37 CFR 1.136\(a\)](#) is filed either prior to or with the notice of appeal. A sample form can be found at <http://www.uspto.gov/web/forms/sb0031.pdf>. If certificate of mailing procedures under [37 CFR § 1.8](#) are used, see [MPEP 512](#). The actual receipt date of the Notice of Appeal will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, [37 CFR § 41.37](#) gives an appellant 2 months from the receipt date of the notice of appeal to file an appeal brief. If the last day to reply to a final Office action was January 10, 2011, and applicant deposited a Notice of Appeal with fee in the U.S. mail on January 10, 2011, and so certified using a certificate of mailing, that appeal is timely even if it is not received in the U.S.

Patent and Trademark Office until January 16, 2011. Since the date of receipt of the notice of appeal is January 16, 2011, this date will be used to calculate the time at which the brief is due, and thus the brief will be due on March 16, 2011. This is 2 months after the date of receipt of the notice of appeal.

- ▼ When may an appellant request that prosecution be reopened pursuant to § 41.50(a)(2) in response to a supplemental examiner's answer?

Appellant may request to reopen prosecution only if (1) a supplemental examiner's answer is written in response to a remand by the Board; (2) the remand is for further consideration of a rejection; and (3) the remand is on or after the effective date. If the Board does not remand the application to the examiner or the remand is for another reason (e.g., for consideration of a new issue raised in a reply brief), the appellant cannot request that prosecution be reopened under § 41.50(a)(2) in response to a supplemental examiner's answer.

- ▼ What are some examples of a new issue raised in a reply brief which would provide the examiner the option to file a supplemental examiner's answer?

Example 1: The rejection under 35 USC 103 over A in view of B. The brief argues that element 4 of reference B cannot be combined with reference A as it would destroy the function performed by reference A. The reply brief argues that B is nonanalogous and therefore the two references cannot be combined.

Example 2: Same rejection as Example 1. The brief argues only that the pump means of claim 1 is not taught in the applied prior art. The reply brief argues that the particular retaining means of claim 1 is not taught in the prior art.

- ▼ Does the examiner have to enter a reply brief that is filed in compliance with § 41.41?

Yes, § 41.43 provides that the primary examiner must acknowledge receipt and entry of the reply brief (which is the same procedure as in the former § 1.193(b)(1)). A reply brief that is not filed in compliance with § 41.41(a) (e.g., the reply brief is not timely filed within two months from the date of the examiner's answer or it includes a new or non-entered amendment), however, will not be considered. The examiner will notify the appellant that the reply brief is non-compliant.

- ▼ If a reply brief is filed in response to an examiner's answer that includes a new ground of rejection, can the examiner provide a supplemental examiner's answer to respond to any new issue raised in the reply brief? Can the appellant request that prosecut

The examiner may provide a supplemental examiner's answer, with the Technology Center Director's or his or her designee's approval, to respond to the new issue(s) raised in the reply brief. The appellant cannot request that prosecution be reopened after such a supplemental examiner's answer. The appellant may file another reply brief under [§ 41.41](#) to any supplemental examiner's answer within 2 months from the date of the supplemental examiner's answer. [37 CFR 41.4\(3\)\(b\)](#). Extensions of time under § 1.136(a) are not applicable.

- ▼ How does a Technology Center Director, or his or her designee, indicate approval of a new ground of rejection (or a supplemental examiner's answer)?

The Technology Center Director, or his or her designee would indicate approval of a new ground of rejection (or a supplemental examiner's answer) by stamping or writing "New Ground of Rejection Approved" on the first page of the examiner's answer (or a supplemental examiner's answer) along with the approving person's printed name, signature and the date, or by providing a similar clear indication on the examiner's answer (or a supplemental examiner's answer) that the action has been approved.

- ▼ If all of the claims under appeal are subject to the new ground of rejection provided in the examiner's answer and appellant fails to file a reply in compliance under § 1.111 or a reply brief within the time period set forth in § 41.39(b),

Yes, the entire appeal will be dismissed if all of the claims under appeal are subject to the new ground of rejection. The examiner should follow the procedure set forth in MPEP 1215, e.g., if there are no allowed claims, the application would be abandoned.

- ▼ If appellant alleges that a rejection in an examiner's answer is a new ground of rejection, but the examiner did not designate the rejection as a new ground of rejection, can the appellant file a petition under § 1.181 for the TC Director's supervisory

Yes, appellant may file a petition under § 1.181 within two months from the mailing of the examiner's answer (see § 1.181(f)). The petition should include reasons why the rejection should be designated as a new ground of rejection. No petition fee is required. Any allegation that an examiner's answer contains a new ground of rejection but not designated as such is waived if not timely (§ 1.181(f)) raised by way of a petition under § 1.181(a). See MPEP 1208.01.

The filing of the petition does not toll any time period running, therefore if appellant wishes to present arguments to address the rejection in the examiner's answer, appellant must also file a reply brief to an examiner's answer within two months from the mailing date of the examiner's answer. If the TC Director or designee decides that the rejection is considered a new ground of

rejection, the examiner would be required to send a corrected examiner's answer that identifies the rejection as a new ground of rejection in a separate heading in the "Grounds of Rejection to be Reviewed on Appeal" and "Grounds of Rejection" sections of the examiner's answer and include the approval of the TC Director or designee. The appellant may then file a request that the prosecution be reopened by filing a reply under § 1.111, or a request that the appeal be maintained by filing a reply brief or resubmitting the previously-filed reply brief, within two months from the mailing of the corrected examiner answer.

▼ How do I know which judges will decide my appeal?

Judges are assigned to appeals according to a PTAB [standard operating procedure](#) based upon considerations such as their educational background, experience, workload, and conflicts.

▼ Can the examiner make a new rejection in their answer?

An examiner can make a new ground of rejection on appeal. The examiner must, however, clearly designate in the examiner's answer that the answer contains a new ground of rejection, and they must provide the appellant with the option to either maintain the appeal or reopen prosecution.

If you believe an examiner's answer includes an undesignated new ground of rejection, and you want to reopen prosecution to enter an amendment, affidavit, or evidence in response, then you may file a petition seeking to designate the examiner's answer as containing a new ground of rejection. The filing of this petition will put the appeal on hold until the petition is decided.

If your petition is granted, the appeal is terminated and prosecution is reopened. If your petition is denied, then the appeal continues, and you have the option to file a reply brief.

[Examiner's answer]

▼ Can I have an interview with the examiner after filing a notice of appeal?

Except in unusual situations, interviews are not permitted after the appeal brief is filed.

If you have filed a notice of appeal but have not filed an appeal brief, you normally may have one interview with the examiner.

[After notice of appeal]

▼ Do I have to file a reply brief?

You are not required to file a reply brief in response to an examiner's answer unless the examiner's answer includes a new ground of rejection. When the examiner's answer includes a new ground of rejection, you must either file a reply brief to maintain the appeal or file a reply to reopen prosecution.

If you fail to respond to an examiner's answer containing a new ground of rejection, the appeal may be dismissed regarding the claims subject to the new grounds of rejection. When all appealed claims are subject to the new grounds of rejection, the entire appeal may be dismissed.

[After notice of appeal]

▼ If I do not file a reply brief, is there anything else I must do before my appeal is submitted to the Board?

Yes. Even if no reply brief is filed, the appeal forwarding fee must be paid before the period of time for filing a reply brief expires. If the forwarding fee is not paid, the appeal will be dismissed.

If you wish to request an oral hearing, you must also make that request by the due date for the reply brief.

[After notice of appeal]

▼ What happens if I lose on appeal?

If your appeal is unsuccessful, you may continue to prosecute the application before the examiner, request rehearing by the Board, or seek judicial review by the federal courts.

[Appeal outcome]

▼ Can the Board raise new grounds of rejection in an appeal decision?

Yes, the Board may raise new grounds of rejection in an appeal decision. In such cases, the Board will designate the new grounds of rejection under a subheading that says “NEW GROUNDS OF REJECTION.”

[Appeal outcome]

▼ How long do I have to file a reply brief?

You should file a reply brief within two months of either:

- The date of the examiner’s answer, or
- A decision refusing to grant a petition to designate a new ground of rejection in an examiner’s answer

Extensions of time are generally not permitted, but may be granted when a reply cannot be filed within two months. In such cases, the period for submitting a reply brief will be extended for sufficient cause and for a reasonable time specified. The request for an extension must be filed by the date the reply brief is due. Filing a request for an extension does not mean the extension has been granted.

[After notice of appeal]

▼ If I win on appeal, do I get a patent immediately?

No. The Board does not have the authority to issue a patent. If an appellant is successful on appeal, the application is returned to the examiner, who will decide whether to issue a patent for the application or to make a new rejection.

▼ Can I appeal an objection?

No, examiner's objections are not appealable to the Patent Trial and Appeal Board. The Board's jurisdiction is limited primarily to review of examiner's rejections based on unpatentability.

The Board also does not review matters of examiner procedure, such as a requirement for restriction or election of species, finality of a rejection, non-entry of claim amendments, and holdings of abandonment. Applicants can seek review of these matters by filing a petition to the Director of the U.S. Patent and Trademark Office.

[Appeal filing]

Appeals - Filing

▼ How should the examiner treat a request to reopen prosecution under § 41.39(b)(1) that is accompanied by a non-responsive reply?

If the reply is not fully responsive to the new ground of rejection, but the reply is bona fide, examiner should provide a 30-day or 1-month time period, whichever is longer, for appellant to complete the reply pursuant to § 1.135(c). If the reply is non-bona fide (e.g., does not address the new ground of rejection by presenting a new argument or amended claims), examiner must sua sponte dismiss the appeal as to the claims subject to the new ground of rejection if the two month time period to reply to the examiner's answer has expired. The examiner should notify the appellant that they have the balance of any remaining time period to correct the non-bona fide reply. Extensions of time under § 1.136(a) are not applicable. [37 CFR 41.39\(c\)](#) . It would be improper for the examiner to sua sponte dismiss the appeal until the time period for reply has expired.

▼ What happens if the applicant does make a showing that there is good and sufficient reasons for entry of an affidavit or other evidence filed after a notice of appeal but prior to the appeal brief, but the affidavit or other evidence only removes one of t

Such an affidavit or other evidence will not be entered for purposes of appeal since it does not overcome **all** rejections under appeal. 37 CFR 41.33(d)(1).

- ▼ If appellant files an amendment, a notice of appeal and an appeal brief on the same date after the mailing of a final action, which rule applies to determine whether such an amendment may be admitted?

Section 1.116 applies in this situation. Such an amendment filed after a final action is not entered as a matter of right. It may be admitted if it cancels claims or complies with any requirement of form expressly set forth in a previous Office action; presents rejected claims in better form for consideration on appeal; or amends the specification, including claims, upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

- ▼ Do I file documents for an appeal with the Board?

No, appeal documents are not filed with the Board. You are encouraged to file appeal documents online via the [Patent Center](#).

Appeal documents can also be faxed to 571-272-8300 or mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

- ▼ How do I know the Board received my appeal?

When the Board assumes jurisdiction of an appeal, it will issue a docketing notice to you that includes the application number for the appeal and an appeal number. This docketing notice verifies that the Board received the appeal.

- ▼ When can I file an appeal?

You may appeal a patent application after any claim has been twice rejected (i.e., two non-final rejections) or after the claim is subject to a final rejection.

Appeals - Timing

- ▼ Will extensions of time be available for filing an appeal brief, a reply in response to a new ground of rejection in an examiner's answer, and a reply brief for a patent

application?

Document	Time period for filing	Are extensions of time under § 1.136(a) available for patent applications	Are extensions of time under § 1.136(b) available for patent applications?	Are extensions of time under § 1.550(c) available for ex parte reexamination proceedings?
Appeal brief	Two (2) months from the receipt date of a notice of appeal (see § 41.37(a)(1)).	Yes, up to five (5) months after the two month time period for filing the brief (see § 41.37(e)).	Yes (see § 41.37(e)).	Yes (see § 41.37(e)).
Amended appeal brief filed in response to a notice of non-compliant appeal brief	Thirty (30) days or one (1) month, whichever is longer, from the date of mailing a notice of non-compliant appeal brief (see § 41.37(d)).	Yes, up to five (5) months after the 30 days or 1 month time period for filing the amended brief (see § 41.37(e)).	Yes (see § 41.37(e)).	Yes (see § 41.37(e)).
A reply under §1.111 or a reply brief in response to a new ground of rejection in an examiner's answer	Two (2) months from the date of mailing of the examiner's answer (see § 41.39(b)).	No (see § 41.39(c)).	Yes (see § 41.39(c)).	Yes (see § 41.39(c)).
A reply brief under §41.41 or §41.43	Two (2) months from the date of mailing of the examiner's answer (see § 41.41(a)(1) or § 41.43(b)).	No (see § 41.41(c) or § 41.43(c)).	Yes (see § 41.41(c) or §41.43(c))	Yes(see § 41.41(c) or §41.43(c))
A reply under §1.111 or a reply brief in response to a supplemental examiner's answer written in response to a remand by the	Two (2) months from the date of mailing of the supplemental examiner's answer (see § 41.50(a)(2)).	No (see § 41.50(f)).	Yes (see § 41.50(f)).	Yes (see § 41.50(f)).

Document	Time period for filing	Are extensions of time under § 1.136(a) available for patent applications	Are extensions of time under § 1.136(b) available for patent applications?	Are extensions of time under § 1.550(c) available for ex parte reexamination proceedings?
Board for further consideration of a rejection under §41.50(a)(2).				

37 CFR 1.136(b) provides that when a reply cannot be filed within the time period set for such reply and § 1.136(a) is not available, the period for reply will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time under § 1.136(b) must be filed on or before the day on which such reply is due, but the mere filing of such a request will not effect any extension.

37 CFR 1.550(c) provides that the time for taking any action by a patent owner in an ex parte reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for an extension of time must be filed on or before the day on which such reply is due, but the mere filing of such a request will not effect any extension.

Patent Trial and Appeal Board (PTAB) - Appeals

- ▼ I filed a request for rehearing of the Board's decision. Can I file a Request for Continued Examination (RCE) before the decision on my Request for Rehearing?

Yes. However, the filing of an RCE after a timely filed Request for Rehearing and prior to the Board's decision on the Request for Rehearing will result in a dismissal of the Request for Rehearing. See also [MPEP § 706.07\(h\)](#) and [37 CFR § 1.114\(a\)\(3\)](#) for procedures for filing an RCE after a Board decision and before an appeal to a court.

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- ▼ How can I withdraw my appeal?

A request to withdraw an appeal may be filed any time before the decision is rendered. Withdrawal of an appeal may result in the abandonment of some or all claims. See [MPEP §§ 1215.01, 1215.02, 1215.03](#). Appellant should file the request by facsimile transmission to 571-273-8300 or through

online filing using Patent Center. Information about Patent Center can be found at <https://www.uspto.gov/patents/apply/patent-center>.

▼ What is a docketing notice?

A docketing notice is a notice issued by the Board assigning an appeal number to your appeal.

▼ How can I file an appeal?

A notice of appeal may be filed after any of the claims has been twice rejected in applications for patent, including reissue or in an ex parte reexam based on a request filed before November 29, 1999. The limitation of "twice rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant can choose to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application. Applicant cannot file an appeal in a continuing application, or after filing a request for continued examination (RCE) under [37 CFR 1.114](#), until the application is under a rejection. For ex parte reexaminations based on requests filed on/after November 29, 1999, the claims must be finally rejected - see [37 CFR § 41.31\(a\)\(3\)](#). To appeal, an applicant must file a notice of appeal followed by an appeal brief.

▼ How do I file an appeal?

After receiving a second rejection of a claim, **you, as an applicant**, have six months to file a notice of appeal. After filing a notice of appeal and paying the appropriate fees, you must file an appeal brief within two months.

All requirements of the appeal brief are in [37 CFR § 41.37](#). Per those requirements, **an appeal brief must include at least:**

- An identification of the real party in interest; an identification of related appeals, interferences, and trials
- A summary of claimed subject matter
- Arguments as to why the examiner's rejection was in error, and
- A listing of the claims subject to appeal.

If you submit a brief lacking one of the above sections, the Office will notify you of the reasons for non-compliance and give you a time period to file an amended brief. If you do not file an amended brief that overcomes the reasons for non-compliance within the set time period, your appeal will be dismissed.

▼ How long does an appeal take and can it be expedited?

You can find the latest information about the average length of appeal pendency on our [Statistics](#) page.

You, as an appellant, can request an expedited appeal under the [Fast-Track Appeals Pilot Program](#). Under the Fast-Track Appeals Pilot Program, you simply file a petition to request fast-track review of your ex parte appeal and pay a \$420 petition fee. The Board has set a target of issuing a decision within six months from the date the petition is granted, and the ex parte appeal is entered into the pilot program.

▼ Can I file a Request for Continued Examination (RCE) during my appeal?

Yes. If you, as the appellant, file an RCE with appropriate fees before a decision from the Board, you should advise the Board of the RCE, and the appeal will be dismissed and prosecution reopened. If you file an RCE after a decision from the Board, then you can file an RCE to reopen prosecution subject to the requirements of Manual of Patent Examining Procedure 706.07.

▼ Can an applicant file more than one appeal?

Yes, an applicant can file more than one notice of appeal.

If the second notice of appeal is filed before the Board issues a written decision on the first notice of appeal (e.g., after reopening of prosecution in response to a new ground of rejection in the Examiner's Answer), then the applicant must file a second notice of appeal and a second appeal brief but does not need to pay any previously paid appeal fees unless the appeal fees have increased since the previous payment, in which case the appellant must pay the difference between the current fee(s) and the amount previously paid.

If the second notice of appeal is filed after the Board has issued a written decision on the first appeal, any subsequent prosecution resulting in a new appeal would require the payment of all appeal fees.

▼ What happens if the appellant fails to respond to a new ground of rejection in the Examiner's Answer?

If the Appellant fails to respond to the new ground(s) of rejection, the Examiner will dismiss the appeal as to any claims that are subject to the new ground(s) of rejection. If all of the claims under appeal are subject to the new ground(s) of rejection, the entire appeal will be dismissed pursuant to Manual of Patent Examining Procedure 1215. If only some of the claims under appeal are subject to the new ground(s) of rejection, the Examiner will notify the appellant that the appeal is dismissed

as to those claims, that those claims are canceled, and that the appeal will proceed as to all other claims.

▼ What are appellant's options if the Examiner's Answer includes new grounds of rejection?

An Examiner is permitted to make new grounds of rejection on appeal. When doing so, the Examiner is expected to clearly designate the new ground of rejection as such.

If the Examiner makes a new ground of rejection and designates it as such, the Appellant can either file a reply under 37 CFR § 1.111 requesting that prosecution be reopened or a reply brief under 37 CFR § 41.41 addressing the new rejection on the merits. If the Appellant requests that prosecution be reopened, the Appellant can file claim amendments, affidavits, or evidence responsive to the new grounds of rejection. If the reply brief addresses the new rejection on the merits, it must address each new ground of rejection but cannot include any claim amendments, affidavits, or other evidence.

If Appellant believes that the Examiner's Answer includes a new ground, but the Examiner did not designate it as such, the Appellant can either file a petition under 37 CFR § 1.181 seeking to designate the Examiner's Answer as a new ground of rejection or file a reply brief under 37 CFR § 41.41 addressing the new rejection on the merits. A petition must be filed within two months from the mailing of the Examiner's Answer and must explain why the rejection should be designated as a new ground of rejection. If the TC Director or designee decides that the rejection is a new ground of rejection, the Examiner will be required to send a corrected Examiner's Answer identifying the rejection as such. The Appellant may then either file a reply under 37 CFR § 1.111 requesting that prosecution be reopened or file a reply brief under 37 CFR § 41.41 requesting that the appeal be maintained and addressing the new ground of rejection on the merits.

The Examiner cannot deny a request to reopen prosecution if Appellant files a reply in compliance with 37 CFR § 1.111 in response to a new ground of rejection in an Examiner's Answer that has been designated as such.

▼ If an amendment is filed with a notice of appeal after a second non-final Office action (and not a final rejection), which rule applies to the amendment?

37 CFR 1.111 would apply to such an amendment. 37 CFR 1.116 would not apply since it is limited to amendments and affidavits or other evidence filed after final action and prior to or with any appeal. If the amendment were filed after a notice of appeal, 37 CFR 41.33 would apply.

If a notice of appeal is filed on or after the effective date of September 13, 2004, would extensions of time under § 1.136(a) be required when a Request for Continued Examination (RCE) under § 1.114 or an amendment is filed after two months from the da

Yes, extensions of time under § 1.136(a) are required for filing an RCE or amendment after two months from the filing of the notice of appeal, even if the RCE or amendment is filed within the three months from the mailing of the action from which the appeal was taken.

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- ▼ If there is a recent decision made public after the brief is filed, how can I notify the Board about it?

Appellant can notify the Board of recent decisions by filing a communication listing the caption of the case, proceeding number and decision date and including a copy of the decision. An example of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief or reply brief was filed. If you need further information, contact either Dale Shaw or Kimberly Jordan at 571-272-9797.

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- ▼ Whom do I contact concerning questions regarding a "Notice of Non-Compliance" regarding an appeal brief?

If you received a Notice of Non-Compliance regarding your appeal brief, the relevant contact information for the paralegal or supervisory paralegal is included on the Notice. If you are unable to contact either, contact Merrell Cashion at 571-272-9797. For reexamination appeal briefs, please contact Merrell Cashion.

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- ▼ If there is a change in the real party in interest after the brief is filed, how can I notify the Board about it?

Appellant must notify the Board of changes in the real party in interest by filing a communication indicating the new real party in interest as well as when the change took effect. The identification of the real party in interest allows members of the Board to comply with ethics regulations associated with working in matters in which the member has a financial interest to avoid any potential conflict of interest. If you need further information, contact either Dale Shaw or Kimberly Jordan at 571-272-9797.

- ▼ When submitting an email request to participate in LEAP, is a certain format or content required?

To request LEAP participation, please complete a LEAP Practitioner Request for Oral Hearing Participation and Verification Form, available at the LEAP website, www.uspto.gov/leap.

The Verification Form requires you, as a LEAP practitioner, to affirm your eligibility for the program, and must include your name, email, telephone, firm name (if applicable), address, scheduled hearing date, and signature. The Request for Oral Hearing Participation must include the scheduled hearing date, your name, email, telephone, firm (if applicable), address, and signature.

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- ▼ What does the LEAP eligibility requirement of fewer than three “substantive” oral argument appearances in a federal tribunal mean?

Substantive oral argument appearances, in the context of the Patent Trial and Appeal Board, generally include substantive oral arguments made during an ex parte appeal hearing or oral hearing for a post grant proceeding, wherein the arguments go to the merits of the case.

In a federal tribunal, such as a U.S. district court or a U.S. court of appeals, substantive oral argument appearances generally include substantive oral arguments that go to the merits of the case, rather than to ancillary issues that arise, such as during status conferences or during discovery disputes.

If you doubt as to whether an appearance qualifies as a substantive oral argument for purposes of determining LEAP eligibility, you can email LEAP@USPTO.gov

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- ▼ What is the purpose of LEAP?

We have two main goals for our Leap into Experience Advancement Program (LEAP):

- The intellectual property (IP) law community needs highly skilled practitioners, and the United States Patent and Trademark Office heavily invests in the success of America’s IP law community. LEAP helps train junior practitioners who will become the next generation of IP lawyers.
- It can be difficult for practitioners to gain court experience, especially for underrepresented groups such as women and minorities. LEAP provides unique access and training opportunities for every demographic.

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- ▼ How can I obtain a LEAP Practitioner Request for Oral Hearing Participation and Verification Form?

Please visit the LEAP website, www.uspto.gov/leap, to obtain a LEAP Practitioner Request for Oral Hearing Participation and Verification Form.

- ▼ Are conference calls that I handled in front of the PTAB “substantive” oral arguments when determining LEAP eligibility?

No, a conference call where you addressed the PTAB does not count as a substantive oral argument for purposes of determining LEAP eligibility.

- ▼ Do judges presume anything about the importance of an issue based on a party’s decision to use a LEAP practitioner?

No, the Patent Trial and Appeal Board does not draw any inference about the importance of an issue, or the merits of the party’s arguments regarding that issue, from the party’s decision to have (or not to have) a LEAP practitioner argue.

- ▼ I practiced law in a non-patent field for 10 years, then switched to patent law and became a registered patent attorney. Does the 7 years start on the day I began practicing law or the day I registered with the patent bar?

The seven years started on the date you first became licensed or registered, whichever occurred earlier. In this case, the seven-year eligibility period started the day you first became licensed to practice law, i.e., when you were admitted to a U.S. state or District of Columbia Bar, 10 years ago.

- ▼ Where should I file my LEAP Practitioner Request for Oral Hearing Participation and Verification Form?

Please email your completed Verification Form and Request for Oral Hearing Participation to PTABHearings@uspto.gov.

- ▼ How can LEAP practitioners participate in other aspects of cases beyond oral hearings?

LEAP practitioners may participate in conference calls, pre-hearing conferences, and depositions. We encourage LEAP practitioners to participate in all aspects of PTAB proceedings as part of our

commitment to fostering the next generation of IP lawyers.

- ▼ How long is a LEAP Verification Form and Request for Oral Hearing Participation valid? Must a new form and request be submitted for each requested LEAP argument?

A LEAP Practitioner Request for Oral Hearing Participation and Verification Form must be completed for each individual proceeding in which LEAP participation is desired. You remain eligible for LEAP as long as you have seven or fewer years of experience and three or fewer prior substantive oral arguments.

Requiring a new Request and Verification Form for each proceeding ensures that you confirm your eligibility and continue to meet these requirements.

- ▼ I am admitted to practice before the USPTO pro hac vice. Am I eligible to be a LEAP practitioner?

Maybe. If you are permitted to argue at an oral hearing — e.g., you are admitted pro hac vice as backup counsel and lead counsel is present at the hearing — and you otherwise meet the requirements for LEAP eligibility, then you may argue as a LEAP practitioner.

- ▼ How is the LEAP eligibility criteria of “seven or fewer years of experience as a licensed attorney or registered agent” interpreted?

On the day of their LEAP request, a practitioner must have seven or fewer years of experience as a licensed attorney or registered agent. Seven years begins on the date the practitioner is first licensed or registered, meaning the date the practitioner is admitted to a U.S. state or District of Columbia Bar or becomes a registered patent agent at the United States Patent and Trademark Office, whichever occurs earlier.

- ▼ May I request additional oral argument time in an AIA proceeding if the opposing party has a LEAP practitioner involved in the oral hearing, but I do not?

The purpose of LEAP is to encourage parties to utilize the skills of practitioners without extensive oral advocacy experience. If a party does not have an eligible LEAP practitioner, then this program is not available to that party, and additional oral argument time may not be requested on that basis.

However, at the start of the oral hearing, you may inform the panel of judges if there are issues you believe requires additional oral argument time, beyond the amount previously allocated.

- ▼ I am law student, but not licensed with the patent bar or as an attorney. Am I eligible to participate in the LEAP program?

No. You may qualify as a LEAP practitioner only if you are otherwise eligible to practice before the PTAB. A law student who is not registered with the USPTO or admitted as an attorney to a U.S. state or District of Columbia bar is not eligible to practice before the PTAB, and thus, cannot qualify as a LEAP practitioner.

- ▼ Is there a minimum amount of time for which the LEAP practitioner must speak in order to receive the extra 15 minutes of argument time?

There is no minimum amount of time for which a LEAP practitioner must speak to receive the additional 15 minutes of argument time, as long as the LEAP practitioner has a substantive role in the argument. It is up to the party to decide how to apportion the argument time between the LEAP practitioner and other counsel.

- ▼ When should a practitioner submit a LEAP request?

A practitioner may submit a LEAP request after the date for oral hearing has been set. If a practitioner submits a LEAP request before the hearing date is set, the Board will decline the request as premature and ask the practitioner to resubmit the request once a hearing date is available.

- ▼ Will the USPTO consider any exceptions to the requirements for LEAP eligibility?

No. We are not allowing for exceptions to the LEAP eligibility requirements at this time. However, the Board encourages participation and involvement in oral arguments even if the practitioner does not qualify as a LEAP practitioner.

A practitioner may request to share oral argument time as well as confer with more experienced counsel during the argument. Additionally, the Board encourages other forms of participation in Board proceedings, including handling conference calls and sharing cross examination of a witness with other counsel upon agreement by the other party.

- ▼ Can a LEAP practitioner participate in an oral hearing for an appeal that is part of the Fast-Track Appeals Pilot Program?

Yes, LEAP practitioners may argue at hearings for appeals that are part of the Fast-Track Appeals Pilot Program.

P-TACTS

- ▼ How do I receive notifications to a shared docketing email address?

Lead counsel in a case can go to the Case Viewer for a case and click Add Notification Email button in the Counsel section for their party to add any email address, including a shared docketing email address, just as long as it is not already used for any of the counsel. After completion, all notifications from P-TACTS to the Lead Counsel's party will also be sent to the Notification Email. However, the Notification Email cannot be used to gain full access to and management of a case. Full access and management of a case is still reserved only for Lead Counsel, with full access and only limited management still provided to Backup Counsel and Staff.

See [P-TACTS User Guide](#) [Filing Other Documents G7]

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- ▼ Will P-TACTS collect and report statistics on the proceedings?

Yes. PTAB publishes performance benchmarks for dispositions, pendency, inventory, and other tracking measures on the [USPTO PTAB Statistics webpage](#).

See [P-TACTS User Guide](#) [Searching and reviewing documents B3]

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- ▼ After I file a petition, how do I file a follow-on document (e.g., a motion to expunge)?

You must use the lead counsel's email address user ID or first backup counsel email address user ID to submit any document in the proceeding, even if a different email address user ID was used to file the petition. To upload the document, see [How do I file other documents \(e.g., a motion to seal or proposed protective order\)?](#)

See [P-TACTS User Guide](#), Filing a petition, D5.

▼ How do I file papers in an AIA trial?

You can file papers in America Invents Act trial proceedings by using [Patent Trial and Appeal Case Tracking System \(P-TACTS\)](#), the electronic filing system for the Patent Trial and Appeal Board. You can review the [electronic filing guide for P-TACTS](#) for more information.

▼ Can I pay the fees in P-TACTS using multiple forms of payment?

You must pay the full amount in Financial Manager using one form of payment. As a petitioner, if you need to use multiple forms of payment (for example, direct deposit account and credit card) to pay the fees for a single IPR or PGR, call the Board at 571-272-7822. You must provide written authorization to charge the requested forms of payment. The transfer will occur as soon as possible. The date when transfer is completed will be used to accord a filing date to the petition.

See the [P-TACTS User Guide](#), Fees, E1.

▼ How can I check whether I filed a document properly?

Without logging in:

You may search for the AIA Review case number by using the "Search P-TACTS" tool and selecting the "View documents" button to see if your public documents were uploaded as you intended.

Alternatively, for cases where the petition has already been submitted, locate your AIA Review Number from your case docket or through the "Search P-TACTS" tool and open the Case Viewer to review all papers and exhibits within the documents listing.

When logged in and:

Initiating a petition

1. Upload a paper in the proper format (i.e., PDF) and exhibits in one of the proper formats (e.g., PDF, video/mp4, video/x-m4v, etc.).
2. Select the "Add to list" button.
3. Your document will be displayed in the "List of documents" table with an upload date and timestamp when the document was successfully uploaded to the Create New Petition Wizard. Note that these documents will not be filed until the petition has been successfully submitted.

Returning to an initiated petition before submission

1. The AIA Review case number is accessible from the external user's "My Docket - Unsubmitted petitions" tab.

2. In this tab, you have the option to select "Continue in the Action" column and view previously added document content and information, including the date and times of addition.
3. Upon petition submission, you will receive an email with a "Patent Review Petition Filing" receipt.

Filing an Initial Appearance as a patent owner or respondent

1. The user that submitted the Initial PO Mandatory Notice will receive an email confirmation of a Patent Owner Mandatory Notice Submission.
2. Once the PO Mandatory Notice has been approved, the case will be displayed on patent owner's docket in the "Pending AIA reviews" tab, the "All AIA reviews" tab, and Case Viewer.

Filing a document (other than Initial PO Mandatory Notice) after the petition has been submitted and you are a party to the case

1. The AIA Review case number is accessible from the party's "My Docket/Pending AIA reviews" tab, the "All AIA reviews" tab, and the Case Viewer.
2. Once the Case Viewer is displayed, all previously added document content and information is shown, including the document date and time of addition.
3. When you file the document, an email confirmation is sent with a listing of the filed documents.

See [P-TACTS User Guide](#), System availability and general information, A12.

▼ How do I submit additional documents with a petition?

You can access various screens in P-TACTS to submit a petition, including Patent Verification, Petition Information, Claims Challenged, Petition Documents, Required Information, Real Party, Additional Real Party, Counsel Information, and Review Petition.

A petition, all exhibits, and any other documents accompanying the petition (for example, Power of Attorney or Motion), should be uploaded using the Create New Petition Wizard.

See [P-TACTS User Guide](#), Filing a petition, D11.

▼ When are uploaded documents available to parties of the AIA Review case?

You can view documents after the payment of the petition is confirmed. After the petition is filed, the documents are available once they are uploaded into P-TACTS.

See the [P-TACTS User Guide](#), Filing a petition, D15.

▼ As a petitioner for a derivation proceeding, should I file my application in P-TACTS?

No, the petitioner's patent application must be filed with the USPTO like any other application through Patent Center. P-TACTS should only be used to file the petition for a derivation proceeding with the Board. A petitioner should, however, file a copy of its application as an exhibit to the petition.

See [P-TACTS user guide](#), Derivation proceedings, H3.

▼ Who can register?

Anyone can register to use P-TACTS and create a user ID with their email address via MyUSPTO. This includes pro se patent owners and attorneys who are not registered to practice before the USPTO under 37 C.F.R. § 11.6.

See [P-TACTS User Guide](#), Registering as a P-TACTS user, C1.

▼ What information is required to register?

In order to have a P-TACTS account, you must have a MyUSPTO account. To register for a MyUSPTO account, you must enter your name, phone number, and email address and create a password. To log in to your P-TACTS account, you must enter your MyUSPTO credentials using your registered email and password.

See [P-TACTS User Guide](#), Registering as a P-TACTS user, C2.

▼ How can I associate my USPTO registration number with my P-TACTS account?

You can associate your USPTO registration number when you enter a case as a patent owner or petitioner. When the user is added as counsel, the user will be prompted to enter their USPTO registration number. P-TACTS will then save the registration number with the associated account for future use.

Note: This information is not captured when you register for a MyUSPTO account.

See [P-TACTS User Guide](#) Registering as a P-TACTS user, C3.

▼ How do I file other documents (e.g., a motion to seal or proposed protective order)?

After you log into MyUSPTO and access the P-TACTS system, please file the 'Other Documents' by following these steps:

To file a document, after the petition has been submitted, not including a motion or rehearing request:

- Log into P-TACTS
- Go to My Docket
- Select the AIA review case number to open Case Viewer
- Select the “Add” button and select “File other documents” from the menu option

To file a motion, after the petition has been submitted:

- Log into P-TACTS
- Go to My Docket
- Select the AIA review case number to open Case Viewer
- Select the “Add” button and select “File a motion” from the menu option
- Select the sub-menu option: File a motion, File an opposition, or File a reply

To file a rehearing request, after a decision has been entered:

- Log into P-TACTS
- Go to My Docket
- Select the AIA review case number to open Case Viewer
- Select the “Add” button and select “File a rehearing request” from the menu option

See [P-TACTS User Guide](#) [Filing Other Documents G1]

▼ How do I waive a patent owner preliminary response in P-TACTS?

- Log into P-TACTS
- Go to My Docket
- Select the AIA review case number to open Case Viewer
- Select the “Add” button and File a Preliminary Response menu option
- Enter information into all required fields marked by a red asterisk beginning with Paper type
- Select POPR: waived

See [P-TACTS User Guide](#) [Submission of patent owner/respondent information and preliminary response F4]

- ▼ If I am filing two petitions challenging the same patent, should I use the same exhibit numbers in both cases?

No. If a petitioner files multiple petitions challenging the same patent, the petitioner should number the exhibits uniquely for both cases, such as 1001-1099 for case #1 and 1101-1199 for case #2. See 37 C.F.R. § 42.63(c).

Similarly, the patent owner in this situation should number the exhibits uniquely for both cases, such as 2001-2099 for case #1 and 2101-2199 for case #2. Therefore, if the Board consolidates the cases, the exhibits will be uniquely numbered in the consolidated AIA reviews.

See [P-TACTS User Guide](#), Filing a petition, D9.

- ▼ If the wrong document is submitted, can it be deleted through the P-TACTS interface?

If a document is mistakenly filed, please contact PTAB AIA Trials at 571-272-7822 or at trials@uspto.gov.

See [P-TACTS User Guide](#) [System availability and general information A13]

- ▼ How do I log on to P-TACTS for the first time?

P-TACTS is only compatible with Google Chrome (version 91.0.4472.77 or higher) browser or Microsoft Edge (102.0.1245.39 and higher) browser. Other browsers, such as Firefox, are not supported. We highly encourage using Google Chrome as your browser. Additionally, display resolution settings at 1600 pixels are recommended for viewing the search window and results table.

To sign in for the first time, go to the [USPTO website](#) and create an account in [MyUSPTO](#).

1. Click on “[MyUSPTO](#)”
2. Click on “Create a USPTO.gov account”
3. Enter the required information in [MyUSPTO](#).

After your account has been successfully verified, access the PTAB P-TACTS system link and sign in with your same MyUSPTO account information. The next time you log into the P-TACTS system, you will be automatically logged in if you have previously logged into your MyUSPTO account.

If cases are not displayed in your My Docket interface, please contact the Patent Trial and Appeal Board (PTAB or Board) at 571-272-9797 or PTABP-TACTSAdmin@uspto.gov and request a docket transfer for your MyUSPTO registered email address.

See [P-TACTS User Guide](#) [System availability and general information A2]

▼ How do I file a petition for a derivation proceeding in P-TACTS?

1. Select "Initiate New Petitions" to access the Create New Petition Wizard.
2. Select "DER - Derivation Proceeding" on the following screen and enter the information for the petition.

See the [P-TACTS User Guide](#), Derivation proceedings, H1.

▼ How do I file a confidential settlement agreement?

You must file a motion for confidential settlement agreement by following these steps:

1. Log into P-TACTS
2. Go to My Docket
3. Select the AIA review case number to open Case Viewer
4. Select the "Add" button and "File a motion" menu option
5. Select the motion type from the menu option: Motion type
6. Enter the required information
7. Click on "Add to list" button
8. Click on "Submit" button

See the [P-TACTS User Guide](#), Filing Other Documents, G2.

▼ What payment system is P-TACTS connected to?

P-TACTS links to Financial Management Systems, Fee Processing Next Generation (FPNG) for payment of America Invents Act Review cases.

See [P-TACTS User Guide](#) [Fees E8]

▼ Does metadata remain in a file after it is uploaded to P-TACTS?

Yes. A PDF or MPEG file uploaded to P-TACTS maintains its original form, meaning it will include any metadata in the original file. Only the content of the file itself is part of the record, however, not the metadata. Parties may remove metadata from files prior to uploading.

See the [P-TACTS User Guide](#), Filing Other Documents, G6.

▼ How does an attorney appear in a proceeding as backup counsel after being recognized pro hac vice?

An attorney admitted to appear pro hac vice in a proceeding is not automatically designated as backup counsel. To do so, the interested party uses P-TACTS to file a notice updating its Mandatory Notice information to designate the attorney as backup counsel, include a new power of attorney (unless the power of attorney filed previously includes the attorney), file a Motion to appear Pro Hac Vice, and pay the fee. See 37 C.F.R. §§ 42.8(b)(3), 42.10(c), 42.15(e). The party should also contact PTAB at 571-272-7822 and request to have their counsel information updated in P-TACTS.

See [P-TACTS User Guide](#) [Submission of patent owner/respondent information and preliminary response F5]

▼ Can a petitioner file mandatory notices in a separate document?

No. The petitioner's mandatory notices must be filed as part of the petition itself. See 37 C.F.R. §§ 42.8(a)(1), 42.104, 42.204, 42.304, and 42.405.

See [P-TACTS User Guide](#), Filing a petition, D8.

▼ If a petition is incomplete, how much time do I get to complete it?

The USPTO will provide the petitioner one month from the Notice of Incomplete Petition to correct the petition. Please see 37 C.F.R. §§ 42.106(b), 42.206(b), and 42.407(b), and the P-TACTS User Guide, FAQ, section D3.

See [P-TACTS User Guide](#), Filing a petition, D6.

▼ If the correspondence address of record for the subject patent or application is not up to date, can the petitioner serve the petition on the patent owner at a different address?

Yes, the petition and supporting evidence must be served on the patent owner at the correspondence address of record for the subject matter, but the petition and supporting evidence may also be served on the patent owner at any other address known to the petitioner as likely to effect service under §§ 42.105(a), 42.205(a), and 42.406(a).

See [P-TACTS User Guide](#), Filing a petition, D4.

▼ Is full text document search available in P-TACTS?

No, it is not.

See [P-TACTS User Guide](#), Searching and reviewing documents, B4.

▼ Can I use P-TACTS to search for a proceeding without registering?

Yes. All public AIA Review cases can be searched in P-TACTS without registering. All public documents associated with the public cases can be viewed. Please be aware that: 1) scanned PDF documents are not converted to an optical character recognition (OCR) PDF and any text contained in a scanned PDF document is not searchable; and 2) nonpublic documents will be listed when conducting a case search, but the document contents will not be viewable.

See [P-TACTS User Guide](#) [Searching and reviewing documents B1]

▼ Where can I access P-TACTS?

You can access P-TACTS at <https://ptacts.uspto.gov/ptacts/ui/home>.

See [P-TACTS User Guide](#) [System availability and general information A1]

▼ How do I update my P-TACTS email address?

You must update your MyUSPTO email address first. Once your new email address is verified, access the PTAB P-TACTS system link and sign in using your MyUSPTO account information. The next time you log into the P-TACTS system, you will be automatically logged in if you have previously logged into your MyUSPTO account.

To transfer your P-TACTS case docket or particular AIA Review cases, contact PTAB P-TACTS Admin at PTABP-TACTSAdmin@uspto.gov and request a docket transfer for your MyUSPTO registered email address.

See [P-TACTS User Guide](#), System availability and general information A4

▼ If P-TACTS is down, may I file a petition or other documents via email or mail?

Please call the Board at 571-272-9797 if you are unable to access the system.

If P-TACTS is unavailable, parties may notify the Board of the service of petitions or other associated documents by email, copying opposing counsel, at Trials@uspto.gov. The email notification to the Board should NOT include attachments.

Notification to the Board of petitions served via email must include:

- Name of point of contact
- Email address of point of contact
- Patent number to which the petition corresponds (or application number in the case of a derivation proceeding)
- Application number of the patent
- Petitioner's application number (in the case of a derivation proceeding)
- Number of claims challenged
- Type of trial proceeding
- Power of attorney
- Fee (e.g., a deposit account authorization)

In addition, if a petition or document is served on another party via email or other means, it must be followed by a later-filed motion requesting acceptance of the submission once P-TACTS is available. The petition or document will be accorded the date on the certificate of service as the identified filing date. 37 C.F.R. § 42.6(b).

It is important to note that a petition will not be accorded a filing date unless it is accompanied by a payment of the appropriate fees (e.g., a deposit account authorization).

Paper filing via overnight delivery is authorized only if both P-TACTS and the Board's email address at Trials@uspto.gov are unavailable.

The mailing address is:

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

For hand delivery or delivery via FEDEX, UPS, etc.:

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
Madison Building (East)
600 Dulany St.
Alexandria, Virginia 22313

See [P-TACTS User Guide](#) [System availability and general information A6]

▼ What is the megabyte limit for a document upload?

A single file may not exceed 25 megabytes in size when uploading.

If you need to file a document and it exceeds 25 megabytes, please follow the instructions below to reduce the file size.

- Split a large file into multiple smaller files; and/or
- Convert Microsoft Word documents into searchable PDF files, rather than printing documents and scanning them as flat PDF files.

See [P-TACTS User Guide](#) [System availability and general information A8]

▼ Is there a limit to the number of documents that can be uploaded per filing?

No. However, only certain document types are allowed to be uploaded during a specialized process, such as initiating a new petition or entering an appearance as patent owner or respondent.

See [P-TACTS User Guide](#), System availability and general information, A9.

▼ How do I transfer my docket to a new email address?

You must update your MyUSPTO email address. Once your new email address is verified, access the PTAB P-TACTS system link and sign in with your same MyUSPTO account information. The next time you log into the P-TACTS system, you will be automatically logged in if you have previously logged into your MyUSPTO account. To transfer your P-TACTS case docket or particular AIA Review cases, contact PTAB P-TACTS Admin at PTABP-TACTSAdmin@uspto.gov and request a docket transfer for your MyUSPTO registered email address.

Please note, inactive cases will not be transferred to your new account. If you need full access to any of the inactive cases not transferred, contact PTAB P-TACTS Admin at PTABP-TACTSAdmin@uspto.gov.

See [P-TACTS User Guide](#) [System availability and general information A5]

▼ Are there any naming conventions for documents or character restrictions?

There are no special naming conventions for documents, but document names must be 75 characters or less. Use the name that will appear in the docket listing. It should be simple and descriptive, such as "Jones Motion to Amend" or "Second Declaration of Dr. Smith."

See [P-TACTS User Guide](#) [System availability and general information A10]

▼ For a challenged patent, will Patent Center show whether a petition has been filed or a decision on the petition has been granted?

Yes, for example, Patent Center will have entries for the following:

- Petition Requesting Trial
- Request for Trial Granted
- Request for Trial Denied
- Request for Trial Dismissed
- Trial Termination or Final Written Decision
- Trial Review Certificate Issued

See [P-TACTS User Guide](#) [System availability and general information A15]

▼ Is there any application programming interface (API) access to PTAB?

Yes, we provide API access to the P-TACTS data through the Open Data Portal. To access the PTAB API, visit the [USPTO API Catalog](#).

See [P-TACTS User Guide](#) [System availability and general information A16]

▼ Can I download information in bulk from P-TACTS?

P-TACTS is intended for the general public. Due to limitations of equipment and bandwidth, P-TACTS is not intended to be a source for bulk downloads of USPTO data. Individuals, companies, IP addresses, or blocks of IP addresses who, in effect, deny service to the general public by generating unusually high numbers of daily P-TACTS accesses (e.g., searches, pages, document retrievals), whether manually or in an automated fashion, may be denied access to P-TACTS without notice.

For a single AIA Review case number, all proceeding documents may be downloaded in bulk by accessing the [USPTO PTAB Decisions portal](#).

See [P-TACTS User Guide](#) [System availability and general information A17]

▼ How do I enter a foreign address in P-TACTS?

To enter a foreign address, input values in the address fields. Address Line 1, Address Line 2, City, and Postal Code (Zip) fields are not required.

See [P-TACTS User Guide](#) [System availability and general information A18]

▼ Will the USPTO provide all forms for filing documents in a proceeding?

P-TACTS provides screens for the parties to enter certain information, such as lead and backup counsel and real party in interest. However, the USPTO does not have forms beyond those P-TACTS fillable screens.

See [P-TACTS User Guide](#), System availability and general information, A11.

▼ How do I view the status of submitted motions or rehearing requests?

The My Docket portal provides a Motions tab and a Rehearing Requests tab that show content across all of your cases. Within each of these tabs, three groupings of Pending, All, and Unsubmitted are provided for quickly locating the document for an America Invents Act (AIA) Review case.

Additionally, Case Viewer includes the same Motions tab and Rehearing Requests tab but is AIA Review case number specific.

See [P-TACTS User Guide](#), System availability and general information, A24

▼ Can I share my user ID with my paralegals or other attorneys in my organization?

Yes, a single user ID may be shared among a working group. It is important to keep in mind, however, that P-TACTS docket display is based on the user ID. Therefore, the registered user must ensure that sharing his or her user ID would not violate any protective order.

P-TACTS - User Roles and Privileges

▼ What are the privileges and responsibilities for each user role?

For a particular AIA Trials Review case, any registered P-TACTS user account can be one of the four types of user roles:

- **Submitter role** – The user can submit a petition or enter an appearance as a patent owner, and designate counsel within these processes for the associated AIA Review number. The submitter role is not a party to the AIA Review case unless designated as counsel or real party pro se.
- **Lead Counsel role** – The user designated as Lead Counsel for an AIA Review case can view and submit documents, and add, delete, or make updates to the new staff role.
- **Backup Counsel role** – For a party to a PTAB Trial case, all counsel that are not Lead Counsel must be designated as Backup Counsel. There is no longer a separate role for a First Backup Counsel. Users designated as Backup Counsel for an AIA Review case can view and submit documents but will *not* have the ability to add, delete, or make updates to the new staff role.
- **Staff role** – This new role allows a user to view and submit documents for an AIA Review case. This role is only visible to the party who submitted the staff role for the particular AIA Review

case.

See [P-TACTS User Guide](#), System availability and general information, A3.

P-TACTS - Initiate Petition

- ▼ How long will an initiated petition be saved for future filing?

Initiated petitions are saved for 45 days in your docket. After 45 days of inactivity, an initiated petition will be deleted.

See the [P-TACTS User Guide](#), Filing a petition, D12.

P-TACTS - My Docket view

- ▼ How many cases can I view on My Docket?

The default view is 25 cases. To view more cases, you can change the page quantity selection on the bottom right of the My Docket interface.

See [P-TACTS User Guide](#), System availability and general information, A23

Patent Trial and Appeal Board (PTAB) - P-TACTS

- ▼ Can I include claim charts in my petition?

Yes, you can include claim charts in your petition. Ensure your claim charts are presented in a readable format so readers (e.g., the patent owner or a deciding official) can locate the disputed claim limitations and the relied-upon portions of the prior art quickly. Present your claim limitations in a separate column (e.g., claim limitations in the left column and prior art teachings in the right column), and present each claim in a separate chart. To promote efficiency, claim charts must be presented in portrait orientation and cannot be in landscape orientation.

- ▼ Will the Office check the patent owner/respondent's real party in interest information and power of attorney against the assignment recorded in the Office?

Yes, when the patent owner/respondent identifies its real party in interest or files a power of attorney, the Board will check the information with the assignment record (if any) to verify that the information is correct and that the paper is signed properly, if the patent or application has been assigned. Therefore, patent owners/respondents are encouraged to keep assignment records up to date.

▼ How can I search for AIA proceedings?

You can search for AIA trial proceedings by using [P-TACTS](#). You can search for proceedings by AIA Review Number, Patent Number, Application Number, Party Name, and/or Tech Center.

▼ Is a patent owner required to file a preliminary response to a petition?

You, as a patent owner, are not required to file a response to a petition. If you don't file a preliminary response, the Board will issue a decision on institution based upon the petition and the evidence cited in the petition. Even if you don't file a preliminary response, you may file a response after institution (in case the Board institutes an AIA trial).

▼ How do I file or waive a patent owner preliminary response?

1. Log into P-TACTS
 2. Go to "My Docket"
 3. Select the AIA review case number to open Case Viewer
 4. Select the "Add" button and File a Preliminary Response menu option
 5. Enter information into all required fields marked by a red asterisk beginning with Paper type
 6. Select "POPR: waived" if waiving a preliminary response or "POPR: filed" if filing a preliminary response
-

▼ Will I lose my data if I am automatically logged out of P-TACTS?

After 30 minutes of continuous inactivity, you will be logged out of P-TACTS. If this happens, any information entered on the page will be lost unless the information has been uploaded using the

“Save” button (in the case of motions documents) or “Add to list” button (in the case of petition documents).

▼ How should I number exhibits?

The system will generate the next available exhibit number; however, you can override the exhibit number with a number within a range based on the party you represent.

Petitioner: 1000-1999

Patent Owner: 2000-2999

If an exhibit has multiple parts, you can override the automatically generated numbering to give all exhibit parts the same exhibit number.

▼ Can I pay the fees in P-TACTS using multiple forms of payment?

You must pay the full amount in Financial Manager using one form of payment.

As a petitioner, if you need to use multiple forms of payment (for example, direct deposit account and credit card) to pay the fees for a single IPR or PGR, call the Board at 571-272-7822. You must provide written authorization to charge the requested forms of payment. The transfer will occur as soon as possible. The date when the transfer is completed will be used to accord a filing date to the petition. Note, however, that Treasury Department regulations limit credit card payments to a maximum of \$24,999.99 per day transaction.

▼ What email addresses receive notifications when something happens in a case?

The email addresses of all counsel listed on the "Counsel" screen for a case receive email notifications when something happens (e.g., a document is filed) in a case. Thus, parties should make sure all appropriate counsel are listed and their email addresses are correct.

Hearings

▼ Will the examiner be at the hearing in an ex parte appeal?

Although an examiner can attend a hearing, it is rare that an examiner appears. If the examiner will appear at the hearing, the Board will notify the appellant in advance.

▼ Is there a hearing in every trial?

The Board will typically hold a hearing if at least one party requests it.

▼ Can I bring a witness to a hearing?

Witnesses are generally not permitted in appeal hearings. Witnesses may be permitted in an AIA trial hearing subject to authorization by the Board.

▼ Can a hearing be rescheduled?

Yes, if an appellant finds it absolutely necessary to request a hearing be rescheduled, then the appellant may respond to a Notice of Hearing by confirming attendance for the originally scheduled hearing and submitting a request to reschedule the date of the hearing.

The rescheduling request may be submitted either simultaneously with the response to the Notice of Hearing, or subsequently. Rescheduling and postponement requests are, however, discouraged.

▼ Will a written transcript of the hearing be available?

Yes, the Board provides court reporters for all hearings. Transcripts are available to parties, usually within four weeks of the hearing.

▼ How do I request a hearing?

You must file a written request for an oral hearing within two months of the date of the examiner's answer or the date of filing a reply brief, whichever is earlier. The written request must be in a separate paper captioned "REQUEST FOR ORAL HEARING." The request must be filed with the appropriate fee.

▼ Who can attend the hearing?

Most hearings are open to the public and anyone may attend as long as there is space in the hearing room. Some hearings may be designated non-public, with only parties associated with the case allowed to observe.

▼ Will a hearing be held in an ex parte appeal if requested?

If an appellant requests a hearing, then the Board typically honors that request and schedules a hearing. However, in the unusual circumstance that the Board decides that a hearing is not necessary, the Board will notify the appellant. For example, an oral hearing may not be necessary if the Board has become convinced, prior to a hearing, that the examiner's position cannot be sustained.

▼ Can an oral hearing fee be refunded?

No, pursuant to [37 CFR § 1.26\(a\)](#), a change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. See [37 CFR § 1.26\(a\)](#). Refunds.

▼ Can I present an oral argument (oral hearing) for my appeal?

Yes. A request for oral hearing must be filed as a separate paper (i.e. not within the notice or any other paper), and the required fee must be paid, in accordance with [37 CFR § 41.47](#) within 2 months from the date of the examiner's answer or supplemental examiner's answer. See also [Section 1209 of the Manual of Patent Examining Procedure](#) for additional guidance. A PTO Form can be found at <http://www.uspto.gov/web/forms/sb0032.pdf>. In due course the Board will send a notice of hearing indicating when the oral hearing is scheduled. Further hearing information can be found at http://www.uspto.gov/ip/boards/public_hearing_info.jsp

▼ Can I request a video or telephonic hearing?

Yes. A written request for a telephonic or video hearing must be filed with the Board. This can be part of the hearing request, or filed upon receipt of the Board's notice of hearing. The request should be sent by facsimile transmission at 571-273-0299, if sent in response to the notice of hearing.

Patent Trial and Appeal Board (PTAB) - Hearings

▼ When and where will my hearing take place?

The date and location of your hearing will be set in a Notice of Oral Hearing. If you have not received one, one will be issued in due course.

Hearings may be held in-person at USPTO headquarters in Alexandria, Virginia, or at any of the USPTO regional outreach offices located in Detroit, Denver, Dallas, and San Jose, California.

▼ Can I present a PowerPoint presentation at the hearing?

Yes, hearing rooms are outfitted with audiovisual equipment for presenting slides. Appellants must request the audiovisual equipment in writing and provide the slides at least five days in advance of their scheduled hearing. No new evidence is permitted.

Trials - Patent help – NEW - Managing patents - Appeal and review

▼ Can my patent be challenged after it is issued?

Yes. During the first nine months after its issue or reissue, a patent can be challenged in post-grant review (PGR). After this nine-month period has ended and after any PGR challenge has been terminated, the patent can be challenged in an inter partes review (IPR). 35 U.S.C. § 311(c). These proceedings are filed with — and decided by — the Patent Trial and Appeal Board (PTAB), and more information can be found on the [PTAB FAQs page](#) of the USPTO website.

Trials

▼ May a party request rehearing of the final written decision?

Yes, either 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 in the petition.

▼ If I filed an IPR petition may I request a refund of the post-institution fee paid if the Board decides not to institute a review?

Yes, in such a situation, you may file a request in P-TACTS for a refund of any post-institution fee paid. You should specify in the request what amount you believe should be refunded and why.

- ▼ When the USPTO notifies me of a fee deficiency for excess claims, can I file a corrected petition without excess claims rather than paying the excess claims fees, so that the petition will be entitled to a filing date as of the original submission date?

Yes, you must file the corrected petition within the time period set forth in the notice. Such a corrected petition must merely delete the portions related to the excess claims and not add new substantive arguments or make other substantive changes (e.g., new grounds). The original submission date of the petition will be accorded as the filing date.

See [P-TACTS User Guide](#) [Fees E5]

- ▼ When is the appropriate time to object to evidence submitted during a preliminary proceeding?

Any objection to evidence submitted during a preliminary proceeding (e.g., evidence submitted with a petition or a preliminary response) must be served on the opposing party within ten business days of the institution of the trial. 37 C.F.R. § 42.64(b)(1). The objection must identify the grounds for the objection with sufficient particularity to allow correction in the form of supplemental evidence. Id. The party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days service of the objection. 37 C.F.R. § 42.64(b)(2).

- ▼ How do I file a Notice of Appeal?

A Notice of Appeal document may be filed for an America Invents Act (AIA) Review case after the Board has filed a Final Written Decision or Termination decision. To file a Notice of Appeal:

1. Locate the AIA Review case number and open Case Viewer.
2. Select the "Add" button and the "File a notice of appeal" menu option. The add document modal will be displayed.
3. Enter information for all required fields marked by a red asterisk beginning with "Date appeal filed."
4. Select "Availability" and enter the document name.
5. Select the file to upload and the "Add to list" button.

6. File the Notice of Appeal by selecting the “Submit” button. Your filed Notice of Appeal will be displayed on the "My Docket, AIA reviews on appeal" tab.

See [P-TACTS User Guide](#), System availability and general information, A25.

▼ Is there a timing deadline to file a petition?

Yes, there are timing deadlines to file a petition set by statute, and the deadlines vary depending on the type of AIA trial proceeding.

For an IPR, the petition cannot be filed until the later of either:

- Nine months after the grant of the patent; or
- If a post-grant review is instituted, after the end of the post-grant review proceeding.

Additionally for an IPR, if the petitioner, a real party in interest, or a privy of the petitioner is served with a complaint alleging infringement of the patent, the party must file the petition within one year of being served with the complaint.

For a PGR, the petition must be filed within nine months of the patent grant.

▼ When will my petition be accorded a filing date?

Once the USPTO reviews the petition and determines whether the petition is complete and the appropriate fees have been paid, the USPTO will send a notice to the petitioner and patent owner.

If the petition complies with all of the statutory and regulatory requirements, the original submission date of the petition will be accorded as the filing date.

Conversely, in a situation where a petition does not comply with all the statutory requirements, no filing date will be accorded.

In the situation where a petition complies with all of the statutory requirements but contains only regulatory defects, the USPTO will accord the filing date of the original submission and notify the petitioner of the defects. The regulatory defects must then be corrected within the time period set forth in the notice.

See [P-TACTS User Guide](#), Filing a petition, D1.

▼ What is the Patent Trial and Appeal Board doing to provide a level playing field in their trials involving independent inventors and small companies?

During rulemaking, the Board received and took into account comments from the public, including independent inventors and small companies. The Board's proceedings are intended to provide a quicker, less expensive alternative to district court patent litigation. Discovery is limited and deadlines are established for the completion of trials. The Board believes this is to the benefit of all parties, including independent inventors and small companies.

▼ May a patent owner challenge the standing of a petitioner in the preliminary response?

Yes, a patent holder may challenge the standing of a petitioner in the preliminary response. For example, a patent holder may provide evidence that the petitioner has filed a civil action challenging patentability prior to filing the petition or that the petitioner otherwise is estopped from challenging the patent owner's claims.

▼ May a party submit supplemental information after one month from institution?

A party may be authorized to file a motion to submit supplemental information belatedly. A party will not be permitted to submit supplemental information belatedly except upon a showing that the information could not have been earlier presented and that it is in the interests of justice for the Board to consider the information.

▼ How does the Patent Trial and Appeal Board handle conflicting case law?

The Board considers and applies the precedent of the Federal Circuit and the Supreme Court to the facts of the particular cases before it. The Board strives to decide cases following the closest precedent. The Board looks for guidance from Supreme Court precedent when Federal Circuit decisions do not provide guidance on a particular issue.

▼ May I include merely the instituted grounds in my petition with a motion for joinder?

Yes, the petition accompanied by a motion for joinder may include merely the instituted grounds or, alternatively, a new ground of patentability.

▼ May an attorney who is not designated as lead or back-up counsel take a deposition of a witness or represent a witness at a deposition in an AIA proceeding? (new - July 25, 2013)

Yes, the attorney, however, must be a registered patent practitioner or recognized by the Board to appear pro hac vice in the proceeding under 37 C.F.R. § 42.10(c).

- ▼ When is the appropriate time to object to evidence submitted after a trial has been instituted?

Any objection to evidence submitted after a trial has been instituted (e.g., evidence submitted with a patent owner response or a reply) must be served on the opposing party within five business days of service of evidence to which the objection is directed. 37 C.F.R § 42.64(b)(1).

- ▼ If the patent owner/respondent's real party in interest is different than the assignee of record in the subject patent or application, can the patent owner/respondent submit the new assignment with the identification of the real party in interest?

Yes, when the patent owner/respondent identifies the real party in interest in PRPS, the patent owner/respondent may upload a file (in PDF format) that contains the new assignment. The patent owner/respondent should also file a copy of the new assignment with the Office's Assignment Recordation Branch.

- ▼ Will the Office terminate the proceeding if I filed a complete petition that contains regulatory defects and failed to correct the defects within the time period set forth in the notice?

Once the time period for correcting regulatory defects has expired, the petition will be forwarded to a Board judge who may initiate a conference call and/or issue an Order to show cause. If the petitioner fails to respond to such an Order appropriately, the proceeding may be terminated. It is important to note that the petitioner will not be entitled to a refund of any fees paid because the petition was in compliance with the statutory requirements for a filing date. For petitions filed on or after March 19, 2013, however, the petitioner may file a request for a refund of any post-institution fees paid.

- ▼ How are derivation proceedings different from other AIA proceedings?

There are several ways derivation proceedings differ from other America Invents Act (AIA) proceedings:

Content: Derivation proceedings involve questions of inventorship, whereas other AIA proceedings involve questions of patentability.

Timing: A derivation proceeding has a timing requirement that must be satisfied for the Board to institute the proceeding. A petition with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application or contained in an earlier application, must be filed during the one-year period following the date on which the patent was granted or the earlier application was published, whichever is earlier.

Preliminary response: The respondent in a derivation proceeding is not permitted to file a preliminary response, whereas a patent owner in an AIA trial is permitted to file a preliminary response.

Triggering a derivation: The standards to trigger a derivation are different than the standards to trigger an AIA trial. Specifically, a derivation proceeds only if the petitioner provides substantial evidence in the petition that the earlier claimed invention was derived. In contrast, an AIA trial will be instituted if the petitioner establishes either a reasonable likelihood that at least one challenged claim is unpatentable for an IPR or that it is more likely than not that at least one claim is unpatentable for a post-grant review or Covered Business Method.

▼ How do I indicate that the record of a derivation proceeding should not be available to the public?

As a petitioner, you should inform the Board in the petition when an involved patent application is not available to the public. Derivation proceedings involving unpublished applications are kept confidential until reviewed by the Board. Also, a petitioner who files confidential information with the petition may file a motion to seal with the petition.

▼ What happens to a petition for a derivation proceeding after it is filed?

Once a petition for a derivation proceeding has been reviewed and accorded a filing date, the Board may enter an order returning jurisdiction to the examiner of the parties' application(s) until the parties' claims are in condition for allowance (absent the derivation proceeding). Once the claims are in condition for allowance, the Board may determine whether to institute the derivation proceeding.

See [P-TACTS User Guide](#) [Derivation proceedings H2]

▼ When may I file a motion for joinder?

Any request for joinder must be filed, as a motion under 37 C.F.R. § 42.22, no later than one month after the institution date of any inter partes review or post-grant review for which joinder is

requested. See 37 C.F.R. §§ 42.122(b) and 42.222(b).

- ▼ How do I request a consolidation of multiple proceedings involving the same patent (e.g., a reexamination and an inter partes review) ? (revised - May 28, 2013)

A party seeking authorization to file a request for consolidation should contact the Board and request a conference call with the other party or parties and the judge assigned to the Board proceeding. If authorized, a request for consolidation must be filed as a motion. See 37 C.F.R. §§ 42.20 and 42.22.

- ▼ Does the one-year statutory bar under 35 U.S.C. 315(b) apply if I file a request for joinder with an inter partes review petition?

No, the second sentence of 35 U.S.C. § 315(c) provides that the time limitation set forth in the first sentence of 35 U.S.C. § 315(c) does not apply to a request for joinder.

- ▼ What font size should I use in my documents?

Petitions and other documents created for a proceeding must be in either (A) a proportional font that is 14-point or larger, or (B) a monospaced font that does not contain more than four characters per centimeter (ten characters per inch). See 37 C.F.R. § 42.6(a)(2)(ii). Certain 14-point proportional fonts are so narrow that they cannot be read easily. When using a 14-point proportional font, parties should select a font of sufficient width that the words can be read easily (e.g., Times New Roman).

- ▼ What heading should I use on the first page of papers filed in a case?

Parties are encouraged to use the heading appearing on papers entered by the Board in the case, which includes the name of the petitioner(s), name of the patient owner/respondent, case number, patent number, and title of the paper. A sample heading is provided [here](#).

- ▼ How do I add additional counsel when there are multiple petitioners for the same proceeding?

If you are a user who is designated as lead counsel or backup counsel, you should call the Patent Trial and Appeal Board (PTAB) at 571-272-7822 after the mandatory notice has been approved and request that the PTAB update their counsel information.

- ▼ May I submit a redacted version of a document that contains non-useful personal confidential information?

Yes, evidence and other documents should not include non-useful personal confidential information, such as social security or taxpayer-identification numbers, dates of birth, names of minor children, financial account numbers, or full driving record. The Office will accept a redacted version and the submission should be accompanied by a paper noting the reasons for the redaction. See IPR2012-00001, Paper 36, pages 6-8.

- ▼ How do I seek a waiver of the 15-page limit for a request for rehearing?

A party may contact the Board to seek a waiver of the 15-page page limit. Please note that any prior authorization to extend the page limit on a motion does not apply to a request for rehearing on the decision of that motion.

- ▼ What is the page limit on a request for rehearing?

For the purpose of page limits, a request for rehearing of a decision under 37 CFR § 42.71(d) must be filed in the form of a motion, which is limited to 15 pages (see 37 CFR § 42.24(a)(v)).

- ▼ When the Office notifies me of a fee deficiency for excess claims, can I file a corrected petition without excess claims rather than paying the excess claims fees, so that the petition will be entitled to a filing date as the original submission date?

Yes, the corrected petition must be filed within the time period set forth in the notice. Such a corrected petition must merely delete the portions related to the excess claims, and not add new arguments or make other substantive changes (e.g., new grounds). The original submission date of the petition will be accorded as the filing date.

- ▼ If I filed an incomplete petition with a payment of the appropriate fees and decided not to correct the petition, can I request a refund of the fees?

A petitioner may file a request for a refund of the petition fees when the petition is not accorded a filing date for a failure to meet a statutory requirement. The request will be considered by the

Board.

See [P-TACTS User Guide](#) [Fees E3]

- ▼ Should I list in my petition other related inter partes reviews, post-grant reviews, or covered business method patent reviews? (new - May 28, 2013)

Yes, the petitioner should list other related review proceedings, as related matters, including those that are being filed concurrently or subsequently. This will promote administrative efficiency as the Board may assign the same panel to all related review proceedings.

- ▼ Why have the prefixes of trial proceeding numbers changed from "2012" to "2013" (e.g., IPR2012 to IPR2013)?

The prefixes of trial proceeding numbers track the fiscal year. Fiscal year 2013 started on October 1, 2012. Thus, any petitions filed between October 1, 2012 and September 30, 2013 will receive a trial proceeding number with a prefix of "2013" (e.g., IPR2013 or CBM2013).

- ▼ Can I file a petition seeking an inter partes review of a plant patent?

Yes, 35 U.S.C. § 311(a) provides that, subject to certain requirements, "a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent." This provision is not limited to utility patents.

- ▼ Can claim charts include claim constructions, arguments, and explanations as to how the claims are unpatentable? (revised - February 11, 2014)

No. Extensive usage of claim charts in a petition is discouraged.

The rules require that a petition identify how the challenged claims are to be construed and how the claims are unpatentable under the statutory grounds raised. This information is to be provided pursuant to the page limit requirements, which require double spacing. Additionally, the rules require that the petition specify where each element of a challenged claim is to be found in the prior art. The element by element showing may be provided in a claim chart, which is permitted to be written with single spacing. See § 42.6(a)(2)(iii). Placing one's argument and claim construction in a

claim chart to circumvent the double spacing requirement is not permitted, and any such argument or claim construction may not be considered by the Board.

The Board previously accepted a few petitions with claim charts that included claim constructions, arguments, and explanations as to how the claim is unpatentable because the procedure for filing AIA petitions was new. However, correction is now required when a petition includes improper usage of claim charts.

▼ Can an organization (e.g., corporation) appear pro se as the patent owner/respondent in a proceeding?

No, organizations must be represented by counsel. The party's mandatory notice information should specify both lead and back-up counsel. See 37 C.F.R. § 42.8(b)(3).

▼ Can an inventor appear pro se as the patent owner/respondent in a proceeding?

Yes, an inventor may appear pro se if he or she is the owner of the challenged patent (or application in the case of a derivation proceeding).

▼ Can a power of attorney using a customer number be submitted in a proceeding?

Yes, a party may file a power of attorney using a customer number, and identify a specific registered patent practitioner that is associated with the customer number as lead or backppup counsel. See § 1.32.

Note that the party is required to identify a specific registered practitioner as lead counsel in a proceeding. § 42.10. Further, the party must ensure that using a customer number in a power of attorney would not violate any protective order because all of the registered patent practitioners that are associated with the customer number may have access to the file records of the proceeding.

▼ Can a patent owner/respondent identify the attorney of record in the subject patent or application as the lead or back-up counsel in the proceeding?

Yes, the patent owner/respondent may designate the attorney of record in the subject patent or application as the lead or back-up counsel. See § 42.8(b)(3). Therefore, the attorney of record in the

subject patent or application, acting as a representative of the patent owner/respondent, may logon to PRPS and designate himself or herself as lead or back-up counsel for the proceeding.

- ▼ Can a patent owner/respondent file a power of attorney appointing a new attorney in a proceeding?

Yes, if the patent owner/respondent wishes to designate a lead counsel or a back-up counsel who is not already counsel of record in the subject patent, a power of attorney must be filed with the designation of counsel. See § 42.10. The power of attorney must be signed properly, such as signed by the assignee of the entire interest of the patent (see §1.32(b)), and uploaded as a PDF file.

- ▼ What is inter partes review and when is it available?

Inter partes review replaces inter partes reexamination as an avenue for a third party's patentability challenge and the provision in the AIA for inter partes review is effective on September 16, 2012.

- ▼ How much time does a patent owner have to file a response and/or amendment after review is instituted?

The schedule for each proceeding will be set by the Board. Ordinarily, a patent owner will have three months to file a response and/or amendment.

- ▼ Will extensions of time be available?

If P-TACTS is down during normal business hours, a party may contact the Board and request a one-day extension of time for due dates that are set by rule or orders of the Board, according to [37 C.F.R. § 42.5\(c\)\(2\)](#) .

In the unlikely event that an administrative patent judge is not available to rule on the extension, the Board may grant an extension the day after the paper is due. However, no extensions of time will be granted for any statutory time period.

See [P-TACTS User Guide](#), System availability and general information, A7.

- ▼ I just became aware of a related court proceeding/appeal/interference, how can I notify the Board?

Appellant can notify the Board of recent related court proceeding/appeal/interference by filing a communication listing the caption of the case, proceeding number and decision date and including a copy of the decision. If you need further information, contact PTAB at 571-272-9797.

▼ Why are there gaps between trial proceeding numbers?

A trial proceeding will be listed in the search results only when the (multi-step) process of submitting a petition for instituting a trial proceeding via P-TACTS has been successfully completed. If the process of filing a petition is not yet completed or was never completed, a trial number will be provided but it will not be listed in the search results.

Trials - AIA

▼ What are the sources of authority that apply to AIA trials?

AIA trials are governed by statutes, rules, and case law. The U.S. Supreme Court as well as the United States Court of Appeals for the Federal Circuit issue decisions that apply to AIA trials. The PTAB also has precedential and informative decisions regarding AIA trials. Lastly, the PTAB publishes a Trial Practice Guide that answers many questions about AIA trials.

Learn more about the sources of authority for AIA trials:

- [Statutes and rules](#)
 - [Precedential and informative decisions](#)
 - [Trial Practice Guide](#)
-

▼ How does a patent owner inform the Board that they want to participate in an AIA Review proceeding and provide mandatory notice information under § 42.8?

The patent owner must first register with a MyUSPTO account.

After logging into P-TACTS and using the email address (user ID), the patent owner clicks on the “Enter Appearance As Patent Owner/Respondent” link to begin the process within the Mandatory Notice Wizard. P-TACTS will provide a screen to search for the proceeding by America Invents Act (AIA) review case number, patent number, or application number, and enter mandatory notice information (e.g., identifying the real party in interest, lead and backup counsel, and related matters).

Once the patent owner submits the mandatory notice information and a Board paralegal verifies the information, the patent owner will receive an approval email. The patent owner may then upload documents (e.g., preliminary response, motions).

The "Enter Appearance As Patent Owner/Respondent" option should only be used to begin participating in a proceeding as the patent owner. Once a patent owner has been verified and is participating in a proceeding, the verification process should not be used again. Instead, the patent owner should upload any documents, including any subsequent mandatory notices, from the AIA case viewer.

See [P-TACTS User Guide](#) [Submission of patent owner/respondent information and preliminary response F1]

Trials - Derivations

▼ Is there a deadline for filing a derivation petition?

Yes, a derivation petition must be filed during the one-year period following the date on which the respondent's claim was granted or published in a published application, whichever is earlier.

▼ When will a decision on institution be made?

Generally, the Board will not decide whether to institute a derivation proceeding until the respondent's case is either:

- In condition for allowance, or
- Patented and the petitioner's application is in condition for allowance but for the respondent's earlier prior art being applied against the petitioner's later application.

We encourage parties to let the Board know when these conditions are met as soon as possible.

▼ When will a final decision be made?

Though not required by statute, the Board generally follows the same timing for derivation proceedings as other America Invents Act trials, with a goal of issuing a final written decision within one year from a decision to institute.

▼ Can the parties to a derivation proceeding settle the issues?

We always encourage parties to a derivation to meet and confer for the purposes of settlement. The Board will accept a settlement in a derivation proceeding unless it is inconsistent with the evidence of record. Also, the parties to a derivation proceeding may resort to binding arbitration to determine inventorship.

▼ What are the requirements for filing a petition for a derivation proceeding?

As the petitioner, you must have a patent application on file directed to a derived invention. Your petition must set forth with particularity the basis for finding that an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner's application and, without authorization, the earlier application was filed.

As the petitioner, you must:

- Identify which earlier-filed application or patent is disputed; and
 - Provide substantial evidence to show that the petitioner's inventor conceived of and communicated the claimed invention, and the respondent's inventor lacked authorization for filing the earlier application
-

Trials - Petitions

▼ Who can file a petition for an AIA trial? Do I need to be sued for infringement before filing?

Anyone except the government and the patent owner can file a petition for an AIA trial.

To file a petition for an inter partes review (IPR) or post grant review (PGR), the petitioner does not need to have been sued for infringement.

To file a petition for a covered business method review (CBM), the petitioner must be sued for infringement before filing a petition.

See [AIA Trial Types](#).

▼ What statutory bases can be asserted in each AIA proceeding?

The statutory basis that can be asserted in the AIA trial proceeding are set by statute and specific to the type of proceeding.

For an IPR, a petition can assert grounds of invalidity only under [35 U.S.C. §§ 102](#) and [103](#) and must be based on patents or printed publications.

For a CBM and PGR, a petition can assert grounds of invalidity under [35 U.S.C §§ 101](#) , [102](#) , [103](#) , and [112](#) (except "best mode") and also must be based on patents and printed publications.

▼ Is there a word count limit for the petition?

Yes. A word count limit applies to petitions, patent owner preliminary responses, patent owner responses, petitioner replies to patent owner responses, and any sur-replies filed in AIA trial proceedings. For all other briefing, a page limit applies.

The rules set a limit of 14,000 words for petitions requesting IPR and derivation proceedings, and a limit of 18,700 words for petitions requesting PGR and CBM proceedings.

▼ Can I submit more than one petition?

Based on the Board's experience, one petition is typically sufficient to challenge the claims of a patent in most situations. The Board recognizes, however, that there may be circumstances in which more than one petition may be necessary. For more information about multiple petitions, see the [Trial Practice Guide](#).

▼ If my petition is already filed, how do I fix an error?

You may file a motion to correct a clerical or typographical mistake in a petition. A substitution of new analysis for the analysis provided in the original petition is not an acceptable correction.

▼ After I file a petition, how much time passes before I learn if a trial is instituted? How much time until I learn the results of a trial?

After a petition has been filed, the Board has three months from the date that a patent owner files a preliminary response, if any, to decide whether to institute a trial. If a trial is instituted, the Board has twelve months to issue a final written decision, subject to an extension of up to six months for good cause.

If a patent owner does not file a preliminary response, the Board has three months from the due date for the preliminary response to decide whether to institute a trial.

These deadlines are set by statute.

▼ What information must a petitioner include in a petition?

By USPTO rule, a petitioner must certify the patent or application is available for review and the petitioner is not barred or stopped from seeking the proceeding. Additionally, a petitioner must identify each claim that is challenged and the specific statutory grounds on which each challenge is based, provide a claim construction for the challenged claims, and state the relevance of the evidence to the issues raised. Furthermore, a petitioner must identify how the construed claim is unpatentable over the relevant evidence. Our [Trial Practice Guide](#) provides more details about the required content of a petition.

▼ If I paid the base petition fee for a petition that challenges 25 patent claims but failed to pay the excess claims fees upon filing, will the petition be accorded a filing date?

An excess claims fee is required for each claim in excess of 20 claims as of October 2, 2020. The United States Patent and Trademark Office (USPTO) will notify you, as the petitioner, of any fee deficiencies. When you pay the required excess claims fees within the time period set forth in the notice, the USPTO will accord the date on which the fees are paid as the filing date.

See [P-TACTS User Guide](#) [Fees E4]

Trials - Institution Phase

▼ Who bears the burden of proof at the institution phase?

For an IPR trial to be instituted, the petitioner bears the burden of proof to show a reasonable likelihood that one or more of the challenged claims are unpatentable. For a PGR or CBM trial to be instituted, the petitioner bears the burden of proof to show that it is more likely than not that at least one challenged claim is unpatentable.

▼ If the Board institutes a trial, will all challenged claims and grounds asserted in the petition be at issue?

Yes. If the Board institutes a trial, then all of the challenged claims and grounds will be at issue in the trial.

Trials - Trial Phase

▼ How do I know when to file other briefs (after institution of a trial)?

If the Board institutes an AIA trial, the Board will issue a Scheduling Order. The Scheduling Order will set due dates for taking action, including filing briefs.

The parties may request changes to the due dates by requesting a conference call with the Board, and they may talk to each other and agree to different dates as long as they notify the Board of these changes.

The Board may also issue a revised Scheduling Order as the trial progresses, for example, if a patent owner files a revised motion to amend under the Motion to Amend Pilot Program.

▼ What does the institution decision include?

In instituting a trial, the Board will either institute on all claims challenged in the petition and on all grounds in the petition, or institute on no claims and deny institution.

The Board will not institute on fewer than all claims or all challenges raised in a petition.

▼ What happens if the parties disagree on the conduct of the AIA trial?

If the parties disagree on the conduct of the AIA trial or seek to file a motion, the parties must consult with each other before contacting the Board. The parties should jointly contact the Board by sending an email to trials@uspto.gov. The email should explain whether the parties disagree, the nature of the disagreement, and the times that are mutually agreeable for a conference call.

In these situations, the Board may have a conference call with the parties to resolve an issue that arises during an AIA trial. On the conference call, the Board may resolve the issue or may choose instead to issue an order after the conference call. The Board may also resolve the issue by email or order without conducting a conference call.

▼ Who bears the burden of proof at the trial phase?

At the trial phase, the petitioner must establish the unpatentability of the instituted claims by a preponderance of the evidence.

Patent Trial and Appeal Board (PTAB) - Trials

▼ What are the fees for filing a petition?

For both IPRs and PGRs, there is a **request fee** and a **post-institution fee**.

- For an IPR, the request fee is \$23,750 and the post-institution fee is \$28,125.
- For a PGR, the request fee is \$25,000 and the post-institution fee is \$34,375.
- Petitions challenging more than 20 claims will also be subject to additional request fees and post-institution fees for each challenged claim in excess of 20.

Both the request fees and the post-institution fees must be paid when the petition is filed, but the petitioner can request a refund of any post-institution fees if institution is denied.

▼ When can I submit amendments, affidavits, or new evidence after a final rejection?

The timeline to submit amendments, affidavits, or new evidence after a final rejection depends on what you are submitting and if you have already filed a final rejection, a notice of appeal, or an appeal brief.

Category	Filed after a final rejection, but before or on the date of filing a notice of appeal	Filed after the date of filing a notice of appeal, but prior to the date of filing an appeal brief	Filed on or after the date of filing an appeal brief
Amendments	May be admitted only to: • Cancel claims • Comply with any requirement of form expressly set forth in a previous action • Present rejected claims in better form for consideration on appeal • Amend the specification or claims upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. See § 1.116(b) .	May be admitted as provided in § 1.116(b) . See § 41.33(a) and previous column.	May be admitted only to: • Cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding • Rewrite dependent claims into independent form. See § 41.33(b) .
Affidavits or other	May be admitted upon a showing of good and sufficient	May be admitted if it:	Affidavits or other evidence may not be

Category	Filed after a final rejection, but before or on the date of filing a notice of appeal	Filed after the date of filing a notice of appeal, but prior to the date of filing an appeal brief	Filed on or after the date of filing an appeal brief
evidence	reasons why the affidavit or other evidence is necessary and was not earlier presented. See §1.116(e) .	- Overcomes all rejections under appeal; and - Upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See § 41.33(d)(1) .	admitted. See § 41.3 .

▼ How do I request a joinder?

If you wish to join an inter partes review or post-grant review, you should file a petition accompanied by a motion for joinder. The motion must comply with the requirements of CFR 42.22 and must be filed no later than one month after the institution date of the IPR or PGR for which joinder is requested. See [35 U.S.C. §§ 315\(c\)](#) and [325\(c\)](#) , and [37 C.F.R. §§ 42.122\(b\)](#) and [42.222\(b\)](#) .

Your motion should address the reasons why joinder is appropriate, identify any new ground(s) of unpatentability asserted in the petition, and explain what impact (if any) joinder would have on the schedule for the existing review. No prior authorization is required for filing the motion for joinder with the petition. However, you are encouraged to contact the Board in advance of filing to arrange a conference call with the parties and Board to discuss the joinder request.

▼ Can the parties settle and conclude the trial?

Yes, the parties may enter into a settlement agreement. To do so, the parties should request a conference call and seek authorization to file a joint motion to terminate the proceeding. See [37 C.F.R. §§ 42.72](#) , [42.74](#) . The motion will need to be accompanied by a true copy of the settlement agreement, which can be filed confidentially in P-TACTS. See [37 C.F.R. § 42.74\(b\)](#) .

The proceeding may terminate after a settlement agreement is filed, but, depending upon the status of the proceeding, the Board may issue a final written decision after the parties settle.

If the proceeding is terminated before institution, the petitioner may file a request for a refund of the post-institution fee paid. The request for a refund should be e-filed separately in [P-TACTS](#) after the proceeding is terminated.

▼ When is the patent owner preliminary response due?

The three-month time period for filing a patent owner preliminary response begins when the Board enters a Notice of Filing Date Accorded to Petition. If the patent owner wishes to file a preliminary response or elect to waive the preliminary response, the patent owner must do so within the three-month time period.

▼ How will the Board review petitions for statutory and regulatory compliance?

Once a petition is submitted, the Board will review the petition for statutory and regulatory compliance. If any statutory requirement is not met, the petition is incomplete. If any regulatory requirement is not met, the petition is defective.

Here is a non-exhaustive list of statutory requirements the Board will look for in inter partes review (IPR) and post grant review (PGR) petitions:

- Appropriate fee successfully paid
- Identification of the patent and the specific claim(s) being challenged
- Identification of the real party in interest
- Copies of the patents and printed publications relied upon in the petition
- Certificate of service that a copy of the petition was provided to the patent owner

Here is a non-exhaustive list of regulatory requirements the Board will look for in IPR and PGR petitions:

- Claim construction section setting forth claim construction of disputed or important claim terms
 - Exhibits listed in an Exhibit List and sequentially numbered in the 1001-1999 range
 - Identification of related matters or a statement that there are no related matters
 - Identification of lead or backup counsel as required by 37 C.F.R. §§ 42.8 and 42.10
 - Margins 1 inch as required by 37 C.F.R. § 42.6(a)
 - Certification that the petitioner is not barred or estopped from requesting a review as required by 37 C.F.R. § 42.104(a) or § 42.204(a)
 - Proof that the petition and supporting documents have, on the filing date of the petition, been served on the patent owner at an address that is not the correspondence address of record for the subject patent as required by 37 C.F.R. § 42.105(a) or § 42.205(a)
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