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AIA trials FAQ

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▼ Petitions

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

A. 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.

- [Precedential and informative decisions](#)
- [Link to trial practice guide](#)

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

A. 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 be sued for infringement before filing a petition. To file a petition for a covered business method review (CBM), the petitioner must be sued for infringement before filing a petition.[[AIA Trial Types](#)]

▼ Q. Is there a timing deadline to file a petition?

A. 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: (1) nine months after the grant of the patent; or (2) 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 9 months of the patent grant. A CBM may be filed any time after the patent grant, except during the PGR window (within 9 months of the patent grant).

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

A. 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.

▼ **Q. What information must a petitioner include in a petition?**

A. By USPTO rule, a petition has certain required information. A petitioner must certify that the patent or application is available for review and that the petitioner is not barred or estopped 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. Further, 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.

▼ **Q. Is there a word count limit for the petition?**

A. 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.

▼ **Q. Can I submit more than one petition?**

A. 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. See the [Trial Practice Guide](#) for more information.

▼ **Q. How much does it cost to file a petition?**

A. To request an IPR of up to 20 claims, the filing fees is \$15,500. To request IPR of 20 or more claims, there is an additional fee of \$300 per claim for each claim in excess of 20. To request a PGR or CBM of up to 20 claims, the filing fees is \$16,000. To request a PGR or CBM of 20 or more claims, there is an additional fee of \$375 per claim for each claim in excess of 20.

These fees are the same for small and micro entities. [USPTO Fee Schedule](#)

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

A. A petitioner 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.

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

A. 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.

▼ **Institution Phase**

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

A. No. A patent owner is not required to file a preliminary response to a petition. However, a patent owner may file a preliminary response to argue that the Board should not institute an AIA trial. If the Board does not institute an AIA trial, then the proceeding is over. The patent owner preliminary response is an opportunity for a patent owner to point out if he or she believes that the petition's evidence or reasoning is insufficient or mistaken, to point out if the petitioner is too late (has a "time bar"), or to argue that the Board should not institute an AIA trial based on discretionary factors. Even if the patent owner does not file a preliminary response, a patent owner may file a response to the petition after institution (in the event that the Board institutes an AIA trial). If a patent

owner does not file a preliminary response, the Board will access the petition to determine whether a trial should be instituted.

▼ **Q. When is the patent owner preliminary response due?**

A. If a petitioner files a petition, and if the Board staff accepts the petition's filing, the Board will issue a notice according the petition a filing date. The patent owner preliminary response is due within 3 months from the date that the Board issues this notice.

▼ **Q. What happens if the patent owner does not file a preliminary response?**

A. A patent owner is not required to file a response to a petition. If a patent owner does not 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 the patent owner does not file a preliminary response, a patent owner may file a response after institution (in the event that the Board institutes an AIA trial).

▼ **Q. Who bears the burden of proof at the institution phase?**

A. 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.

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

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

▼ **Trial Phase**

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

A. 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 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.

▼ Q. Can a patent owner amend the claims that have been instituted?

A. Yes, a patent owner may amend the claims in a patent after a trial is instituted, subject to certain requirements. Those requirements are specified in 37 C.F.R. §§ 121 and 221. The motion to amend pilot program has been made permanent through rules published in the Federal Register. These rules provide that a patent owner has two options in connection with motions to amend. First, a patent owner may choose to receive preliminary guidance from the Board on its motion to amend. Second, a patent owner may choose to file a revised motion to amend after receiving petitioner's opposition to the original motion to amend and/or after receiving the PTAB's preliminary guidance (if requested). A patent owner need not exercise either of these options in connection with filing a motion to amend. A patent owner also has the option to seek amendments through reexamination and reissue. For more information about reexamination and reissue, please see our Federal Register Notice.

▼ Q. What does the institution decision include?

A. In instituting a trial, the Board will either (1) institute on all claims challenged in the petition and on all grounds in the petition, or (2) institute on no claims and deny institution. The Board will not institute on fewer than all claims or all challenges raised in a petition.

▼ Q. Can the parties settle and conclude the trial?

A. Yes, the parties may enter into a settlement agreement, and the Board expects that a proceeding will terminate after the filing of a settlement agreement. However, depending on the status of the proceeding, the Board may proceed to a final written decision.

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

A. 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 provide 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.

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

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

▼ Derivations

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

A petitioner must have a patent application on file directed to a derived invention. The petitioner also must set forth with particularity in the petition the basis for finding that an inventor named in the earlier application derived the claimed invention from an inventor named in petitioner's application and, without authorization, the earlier application was filed. The petitioner must (i) identify which earlier filed application or patent is disputed; and (ii) provide substantial evidence to show (a) that petitioner's inventor conceived of and communicated the claimed invention and (b) that respondent's inventor lacked authorization for filing the earlier application.

▼ Q. Is there a deadline for filing a derivation petition?

A. 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.

▼ Q. When will a decision on institution be made?

A. Generally, the Board will not make a decision on 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 respondent's earlier prior art being applied against the petitioner's later application. The parties are encouraged to let the Board know when these conditions are met as soon as possible.

▼ Q. When will a final decision be made?

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

▼ Q. How are derivation proceedings different from other AIA proceedings?

A. Derivation proceedings are different from other AIA proceedings in several ways. First, derivations involve questions of inventorship whereas other AIA proceedings involve questions of patentability. Second, a derivation proceeding has a particular timing

requirement that must be satisfied for the Board to institute the proceeding. That is, 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. Third, 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. Finally, 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. By contrast, an AIA trial will be instituted if the petitioner establishes that 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 PGR or CBM.

▼ **Q. Can the parties to a derivation proceeding settle the issues?**

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

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

A. A petitioner 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 filing confidential information with the petition may file a motion to seal with the petition.

▼ **Patent Trial and Appeal Case Tracking System (P-TACTS)**

▼ **Q. How do I file papers in an AIA trial?**

A. Parties file papers in AIA trial proceedings using the PTAB's electronic filing system called **Patent Trial and Appeal Case Tracking System (P-TACTS)**. There is an [electronic filing guide for P-TACTS](#).

▼ **Q. Who do I call if I have a question about filing papers?**

A. The parties may contact the Board Assistance telephone at 571-272-9797.

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