

## Contents

Frequently Asked Questions (FAQs) .....	6
A. System Availability and General Information .....	6
A1. How do I log on to PTAB E2E? .....	6
A2. If PTAB E2E is down during normal business hours or other unscheduled outage periods, may I file a petition or other documents via email or mail? .....	6
A3. Will extensions of time be available? .....	7
A4. What is the megabyte limit for a document upload? .....	7
A5. Is there a limit to the number of documents that can be uploaded per filing? No .....	8
A6. Are there any naming conventions for documents or character restrictions? .....	8
A7. Will the Office provide forms (e.g., power of attorney or IPR transmittal) for filing documents in a proceeding? .....	8
A8. How can I check whether I filed a document properly? .....	8
A9. If the wrong document is submitted, can it be deleted through the PTAB E2E interface? ..	9
A10. Can more than one person work on a case at the same time? .....	9
A11. Will the PAIR record for the challenged patent show whether a petition has been filed or a decision on the petition has been granted? .....	9
A12. Is there any application programming interface (API) access to PTAB? .....	10
A13. Can I download information in bulk from PTAB E2E? .....	10
A14. How do I enter a foreign address in PTAB E2E? .....	10
A15. If I am idle in PTAB E2E for less than 30 minutes, what will happen? .....	10
A16. If I am idle in PTAB E2E for 30 minutes or more, will I lose any of the completed uploads or activities from the timed-out session if I clicked on the “Done” or “Submit” button? .....	10
A17. If I am idle in PTAB E2E for 30 minutes or more, will I lose any of the data entered from the timed-out session if I did not click on the “Done” or “Submit” button? .....	11
A18. What will happen if I am idle for 30 minutes, how do I get back into my session? .....	11
A19. How many cases can I view on “My Docket”? .....	11
B. Searching and Reviewing Documents .....	11
B1. Can I use PTAB E2E to search for a proceeding without registering? .....	11

B3. Will PTAB E2E collect and report statistics on the proceedings? ..... 11

B4. Why are there gaps between trial AIA Review numbers? ..... 12

B5. Why have the prefixes of trial AIA Review numbers changed from "2012" to "2013" (e.g., IPR2012 to IPR2013)? ..... 12

B6. Why are there gaps between paper numbers in some AIA Reviews? ..... 12

B7. Is full text document search available in PTAB E2E? ..... 12

C. Registering as a PTAB E2E User ..... 12

    C1. Who can register?..... 12

    C2. What information is required to register? ..... 12

    C3. Can I share my email address user ID with my paralegals or other attorneys in my organization?..... 13

    C4. Do I need a registration number to create an account in PTAB E2E? ..... 13

D. Filing a Petition ..... 13

    D1. When will my petition be accorded a filing date? ..... 13

    D2. 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?..... 13

    D3. How will the Board review petitions for statutory and regulatory compliance? ..... 13

    D4. 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? ..... 14

    D5. After I file a petition, how do I file a follow-on document (e.g., a motion to expunge)?..... 15

    D6. If a petition is incomplete, how much time do I get to complete it?..... 15

    D7. Can I present claim charts and arguments in landscape orientation?..... 15

    D8. Can a petitioner file mandatory notices in a separate document? ..... 15

    D9. If I am filing two petitions challenging the same patent, should I use the same exhibit numbers in both cases? ..... 15

    D10. What are the most common errors found in petitions? ..... 15

    D11. Can I file a petition seeking an inter partes review of a plant patent?..... 16

    D12. Can claim charts include claim constructions, arguments, and explanations as to how the claims are unpatentable? ..... 16

    D13. What is the preferred format for claim charts? ..... 17

D14. How do I submit additional documents along with a petition? ..... 17

D15. Should I list in my petition other related inter partes reviews, post-grant reviews, or covered business method patent reviews? ..... 17

D16. What is the current patent number format for Design, Plants and Reissues? ..... 17

D17. How can I remove an IPR case from “My Docket” if it was incorrectly created? ..... 18

D18. How long will petition initiated be saved for future filing? ..... 18

D19. What if your exhibit has multiple parts? Will you be able to manually edit the automatically generated exhibit number?..... 18

D.20 Are the documents immediately available or after submission of the petition? ..... 18

D21. How many statutory grounds can be entered for an IPR, CBM or PGR? How many references can be entered for each ground?..... 18

E. Fees..... 18

E1. Can I pay the fees in PTAB E2E using multiple forms of payment? ..... 18

E2. Can I pay the fees using multiple credit cards for one transaction? ..... 19

E3. 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?..... 19

E4. 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? ..... 19

E5. 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 of the original submission date? ..... 19

E6. Do I need to pay both the request fee and the post-institution fee when I file an inter partes review petition on or after March 19, 2013? ..... 19

E7. If I filed an inter partes review petition on or after March 19, 2013, may I request a refund of the post-institution fee paid if the Board decides not to institute a review?..... 20

E8. What payment system is PTAB E2E connected to?..... 20

F. Submission of Patent Owner Information and Preliminary Response ..... 20

F1. How does a patent owner inform the Board that I want to participate in an AIA Review proceeding and provide mandatory notice information under § 42.8?..... 20

F2. Can a patent owner file a power of attorney appointing a new attorney in a proceeding? 21

F3. Can a patent owner identify the attorney of record in the subject patent or application as the lead or back-up counsel in the proceeding?..... 21

F4. Can a power of attorney using a customer number be submitted in a proceeding? ..... 21

F5. Will the Office check the patent owner’s real party in interest information and power of attorney against the assignment recorded in the Office?..... 22

F6. If the patent owner's real party in interest is different than the assignee of record in the subject patent or application, can the patent owner submit the new assignment with the identification of the real party in interest? ..... 22

F7. When can I file a patent owner preliminary response? ..... 22


F8. How do I file a patent owner preliminary response in PTAB E2E? ..... 22

F9. How do I waive a patent owner preliminary response in PTAB E2E? ..... 24

F10. Can an inventor appear pro se as the patent owner in an AIA Review proceeding? ..... 24

F11. Can an organization (e.g., corporation) appear pro se as the patent owner in an AIA Review proceeding? ..... 24

F12. How does an attorney appear in a proceeding as back-up counsel after being recognized pro hac vice? ..... 24

F13. Can I use the document edit icon  next to the Documents tab to file a patent owner preliminary response in PTAB E2E? ..... 24

F14. What happens if I incorrectly file a patent owner preliminary response in PTAB E2E using the document edit icon? ..... 25

G. Filing Other Documents ..... 25

G1. How do I file other documents (e.g., a motion to seal or proposed protective order)? ..... 25

G2. How do I file a confidential settlement agreement?..... 25

G3. When is the appropriate time to object to evidence submitted during a preliminary proceeding? ..... 26

G4. When is the appropriate time to object to evidence submitted after a trial has been instituted? ..... 26

G5. What is the page limit on a request for rehearing? ..... 26

G6. How do I seek a waiver of the 15-page limit for a request for rehearing? ..... 26

G7. May I submit a redacted version of a document that contains non-useful personal confidential information? ..... 26

G8. How do I add additional counsel when there are multiple petitioners for the same proceeding? ..... 27

G9. What heading should I use on the first page of papers filed in a case?..... 27

G10. How do I notify the Board that the parties have settled and request that the proceeding be terminated? ..... 27

G11. 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? ..... 27

G12. What font size should I use in my documents? ..... 27

G13. What email addresses receive email notifications when something happens in a case? ..... 28

G14. Does metadata remain in a file after it is uploaded to PTAB E2E? ..... 28

G15. How do I receive notifications to a shared docketing email address? ..... 28

H. Joinder and Consolidation ..... 28

    H1. How do I request a joinder? ..... 28

    H2. 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? ..... 28

    H3. How do I request a consolidation of multiple proceedings involving the same patent (e.g., a reexamination and an inter partes review)? ..... 29

    H4. When may I file a motion for joinder? ..... 29

    H5. Do I need to file a petition with a motion for joinder? ..... 29

    H6. May I include merely the instituted grounds in my petition with a motion for joinder? ..... 29

I. Derivation Proceedings ..... 29

    I1. How do I file a petition for a derivation proceeding in PTAB E2E? ..... 29

    I2. What happens to a petition for a derivation proceeding after it is filed? ..... 29

    I3. How do I indicate that the record of a derivation proceeding should not be available to the public? ..... 30

    I4. As a petitioner for a derivation proceeding, should I file my application in PTAB E2E? ..... 30

    I5. How are derivation proceedings different from other AIA proceedings? ..... 30

## Frequently Asked Questions (FAQs)

### A. System Availability and General Information

#### A1. How do I log on to PTAB E2E?

\*We highly encourage using Chrome as your browser\*

Go to <https://ptab.uspto.gov/> Select "Create an Account". This link will then take you to a sign-up screen where you will register for a PTAB E2E account using your personal information. Once you have verified all the Captcha images, you will then click the "Register" button. You will be asked to validate that your account has been created. In order to validate your new account, you will need to go to the email you used to register with, and you should see a hyperlink to click on the email in order to validate your new account." In the email, you should have received an email containing the verification code. Click on the hyperlink and a new browser window will open. If Chrome is your default browser, click on the "Submit" button. If the hyperlink opens in a different browser, then copy and paste the hyperlink from the email to a Chrome browser and click on the 'Submit' button. Your account will be activated afterwards.

#### A2. If PTAB E2E is down during normal business hours or other unscheduled outage periods, may I file a petition or other documents via email or mail?

If you have any difficulties with PTAB E2E, please call the Board at (571) 272-7822. However, if PTAB E2E is unavailable during normal business hours, petitions (and other documents) may be submitted to the Board via email: [Trials@uspto.gov](mailto:Trials@uspto.gov).

Petitions submitted 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; and
- \* fee, e.g., a deposit account authorization.

In addition, a petition or document submitted via email or other means must:

- (1) be accompanied by a motion requesting acceptance of the submission, and
- (2) identify a date of transmission where a party seeks a filing date other than the date of receipt at the Board. 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 EXPRESS MAIL® (or by means at least as fast and reliable as EXPRESS MAIL®) is authorized only if both PTAB E2E and the Board's email address ([Trials@uspto.gov](mailto: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 Street  
Alexandria, Virginia 22313

### A3. Will extensions of time be available?

If PTAB E2E 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. 37 C.F.R. § 42.5. 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.

### A4. What is the megabyte limit for a document upload?

A single uploaded file may not exceed **25** megabytes in size. For technical reasons, PTAB E2E is unable to accept files over **25** megabytes at this time. USPTO expects to be able to increase the limit in future releases.

If you need to file a document that exceeds **25** megabytes, please call PTAB at (571) 272-7822. Users are encouraged to reduce the file size by:

1. splitting a large file into multiple smaller files; and/or
2. converting MS Word® documents into PDF files, rather than printing documents and scanning them in as PDF files.

#### A5. Is there a limit to the number of documents that can be uploaded per filing?

No

#### A6. Are there any naming conventions for documents or character restrictions?

There are no special naming conventions for documents, but the number of characters is limited. The user will be prompted to provide a name that will appear in the docket listing. This name should be simple and descriptive, such as "Jones Motion to Amend" or "Second Declaration of Dr. Smith." Document names must be less than **75** characters

#### A7. Will the Office provide forms (e.g., power of attorney or IPR transmittal) for filing documents in a proceeding?

PTAB E2E provides screens for the parties to enter certain information (e.g., lead and back-up counsel and real party in interest). However, the Office does not have forms beyond those PTAB E2E fillable screens. While forms may become available with future releases, most filings will be part of motion practice rather than pre-defined forms.

#### A8. How can I check whether I filed a document properly? (revised August 9, 2017)

You can check to see if your document is properly uploaded, by searching for the AIA review case without logging in with your user id and password and then opening the case to see if your documents were properly uploaded.



1. When filing a petition:

After you upload a document in the proper format (i.e., PDF or MPEG for exhibits and PDF for all other documents) and click the "Add" button, you will receive an acknowledgement on the screen in PTAB E2E in the upper right. A green check indicates the desired documents are attached. While the red x indicates they are not attached, the system will allow you to proceed to the next section of the petition filing wizard of Real Party but it will not have your document(s).

2. When filing a document after the petition is submitted:

- a. When filing a document uploaded via the "AIA Review Actions" menu – File a Preliminary Response, File a Motion, View a Motion (and then select View Details), File a Rehearing or File an Appeal (for Notice of Appeal), you will enter the relevant information and click on the "Add" button after each document is uploaded one at a time. You will receive an acknowledgement on the screen in PTAB E2E in the upper right. When you have added all your documents click on the "Submit" button. Once the documents are submitted, then you will receive an email notification with a list of your documents filed.
- b. To upload a document, OTHER THAN a Preliminary Response, Motion, Rehearing Request, or Notice of Appeal, click on the edit icon next to the



Documents tab  – select the paper type, and enter the relevant data and chose one document to be uploaded, then click on the “Add” button. You will receive an acknowledgement in the upper right of the screen. When you are finished adding all your documents, you must click on the “Done” button to receive your email notification with a list of your documents filed. It is important NOT to upload a Preliminary Response, Motion, Rehearing Request, or Notice of Appeal using the document edit icon . Instead, a Preliminary Response, Motion, Rehearing Request, or Notice of Appeal must be uploaded using the AIA Review Actions menu as described in the previous paragraph.

If you received an error message “There is an issue saving document” in red in the upper right after you add your document, please refresh your screen and try to add your document again until you receive a successful document upload.

If you did not receive an acknowledgement on the screen or a filing receipt via email, the document most likely has not been uploaded properly and you should contact PTAB at (571) 272-7822. You may also check whether the document is listed in the file contents of the AIA Review.

#### A9. If the wrong document is submitted, can it be deleted through the PTAB E2E interface?

Yes, depending upon whether the document has not yet been added or submitted. When uploading a document, users should ensure that the correct file has been selected before clicking the "Add" button. If the wrong document is uploaded but the "Add" button has not yet been clicked, you may delete the document by clicking the trash can icon shown on the screen.

If the wrong document was uploaded and the "Add" button was clicked, you should file the correct document and a motion to expunge the wrong document as soon as possible. Any motion to expunge filed on the same day as the wrong document will generally be granted.

You will need to file a motion to expunge by clicking on the “AIA Review Actions” menu, select File a Motion and upload the appropriate request and click on the “Add” button and then the “Submit” button.

#### A10. Can more than one person work on a case at the same time?

Yes, more than one person may review documents or upload documents in a proceeding at the same time, even if they are sharing an email user ID.

#### A11. Will the PAIR record for the challenged patent show whether a petition has been filed or a decision on the petition has been granted?

Yes, for example, PAIR will have entries for the following:

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

## A12. Is there any application programming interface (API) access to PTAB?

(revised August 9, 2017)

Yes, API access to PTAB E2E data is permitted at this time. The link to access the API is <https://developer.uspto.gov/api-catalog/ptab-api>.

## A13. Can I download information in bulk from PTAB E2E?

PTAB E2E is intended for use by the general public. Due to limitations of equipment and bandwidth, PTAB E2E 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 PTAB E2E accesses (e.g., searches, pages, document retrievals), whether generated manually or in an automated fashion, may be denied access to PTAB E2E without notice.

## A14. How do I enter a foreign address in PTAB E2E?

Certain screens in PTAB E2E allow for the entering of address information (e.g., for a petitioner or patent owner's real party in interest). In the case of a foreign address, users should select the appropriate country in the "Country" field, select the blank "-" entry in the "State" field, and then input the next three lines of the foreign address in the "Address Line 1," "City," and "Postal Code" fields.

## A15. If I am idle in PTAB E2E for less than 30 minutes, what will happen?

Nothing as long as you are active - key strokes, clicks, etc., you can continue to work as you normally do.

## A16. If I am idle in PTAB E2E for 30 minutes or more, will I lose any of the completed uploads or activities from the timed-out session if I clicked on the "Done" or "Submit" button?

No. If you enter some data fields, uploaded the documents and clicked on the "Add" button, and either the "Done" or "Submit" button to complete the activities, the documents will be uploaded into PTAB E2E and notifications will be sent before the session timed out. All uploaded documents will not be lost when you are timed out.

During the Petition submission process, the documents are saved once you add the documents and get the green check mark on the left navigation pane in the petition filing wizard.

#### A17. If I am idle in PTAB E2E for 30 minutes or more, will I lose any of the data entered from the timed-out session if I did not click on the “Done” or “Submit” button?

You will lose any data entered on the last screen in which you were active before becoming idle. For example, if you entered some data, uploaded the document, and did not click on the “Add” button to complete the activities, but did not finish and your system was idle for 30 minutes or more, the data entered on that page would be lost.

#### A18. What will happen if I am idle for 30 minutes, how do I get back into my session?

You will have to login to access the PTAB E2E website. You can open the case again from “My Docket” and select “View My Docket” and locate the hyperlink under “All AIA Reviews” to open the case to continue working on the case.

#### A19. How many cases can I view on “My Docket”?

The default view is 10 cases and you will need to click on the vertical scroll bar to view additional cases on your docket. This default view cannot be changed.

## B. Searching and Reviewing Documents

#### B1. Can I use PTAB E2E to search for a proceeding without registering?

Yes, a non-registered user may search for a proceeding and review documents related to a proceeding. All AIA Reviews can be searched in PTAB E2E.

However, if you want to file a document or submit a fee payment in an AIA Review, you must be a registered PTAB E2E user.

#### B2. Can I search for an AIA Review by the patent owner?

Yes, you may search for an AIA Review by the party name, an AIA Review/Case type, patent number, or application number.

#### B3. Will PTAB E2E collect and report statistics on the proceedings?

Yes, PTAB E2E will collect and report statistics about the new proceedings. Currently, users may search the proceedings based on a particular AIA Review/Case type, party name, patent number, and application number.

#### B4. Why are there gaps between trial AIA Review numbers?

An AIA Review number will be listed in the search results only when the (multi-step) process of submitting a petition for instituting a trial proceeding via PTAB E2E has been successfully completed. If the process of filing a petition is not yet completed or was never completed, an AIA Review number will be provided but it will not be listed in the search results.

#### B5. Why have the prefixes of trial AIA Review numbers changed from "2012" to "2013" (e.g., IPR2012 to IPR2013)?

The prefixes of the AIA Review 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 an AIA Review number with a prefix of "2013" (e.g., IPR2013 or CBM2013.)

#### B6. Why are there gaps between paper numbers in some AIA Reviews?

In some previous versions of the Patent Review Processing System (PRPS) before PTAB E2E, PRPS assigned a sequential number (Paper 1, 2, 3, etc.) to a paper immediately when the paper was uploaded. Thus, if a user uploaded a paper but then deleted it before submitting, the assigned number was not reassigned, causing a gap in the numbering of papers in that AIA Review. The data from PRPS for IPR, CBM, PGR and DER cases have all been migrated to PTAB E2E. In PTAB E2E, papers are assigned a number only when the submission process is completed, so there are no gaps in paper numbers.

#### B7. Is full text document search available in PTAB E2E?

No, full text document search is not available.

### C. Registering as a PTAB E2E User

#### C1. Who can register?

Anyone can register to use PTAB E2E and create an email user ID with their email address, such as a pro se patent owner or an attorney who is not registered to practice before the Office under 37 C.F.R. § 11.6.

#### C2. What information is required to register?

When you are registering to use PTAB E2E, you have to enter your name, a phone number, a unique email address and a password. If you are a USPTO registered practitioner, you must enter your registration number.

### C3. Can I share my email address user ID with my paralegals or other attorneys in my organization?

Yes, a single email user ID may be shared among a working group. It is important to keep in mind, however, that the PTAB E2E docket display is based on the email address user ID. Therefore, the registered user must ensure that sharing his or her email address user ID would not violate any protective order.

### C4. Do I need a registration number to create an account in PTAB E2E?

No, you do not need a registration number to create an account in PTAB E2E. You would leave the

## D. Filing a Petition

### D1. When will my petition be accorded a filing date?

Once the Office reviews the petition and determines whether the petition is complete and the appropriate fees have been paid, the Office will send a notice to the petitioner and patent owner. The submission date of the compliant petition will be accorded as the filing date.

If the petition complies with all of the statutory requirements (see 35 U.S.C. §§ 135, 312, and 322), the original submission date of the petition will be accorded as the filing date. Conversely, no filing date will be accorded if a statutory requirement is not satisfied. For example, for fee deficiencies, the Office will accord the later submission date when all appropriate fees have been paid because the fees are required by statute. See, e.g., 35 U.S.C. § 312(a)(1).

In the situation where a petition complies with all of the statutory requirements but contains only regulatory defects, the Office 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.

### D2. 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 fee paid. See FAQ E7.

### D3. How will the Board review petitions for statutory and regulatory compliance?

Once a petition is submitted via PTAB E2E, a PTAB paralegal will review the petition for statutory and regulatory compliance.

First, there are certain statutory requirements in 35 U.S.C. §§ 135(a), 312(a), and 322(a) that must be met for a petition to be accorded a filing date. The following is a list of the "top 5" things the paralegal will be looking for in IPR, PGR, and CBM 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, and
- Evidence (e.g., certificate of service) that a copy of the petition was provided to the patent owner.

If any statutory requirement is not met, the petition is incomplete.

- The paralegal may call the individual who filed the petition and explain the deficiency.
- The paralegal will enter a Notice of Incomplete Petition and the individual who filed the petition will receive notification by email.
- The deficiency may be corrected within one month and the petition will be accorded the filing date of the NEW submission.
- If the deficiency is not corrected within one month, the petition will be dismissed. One exception is when the petitioner challenges more than 20 claims (15 beginning March 19, 2013) but does not pay the excess claims fees - the petitioner will receive notification and can file a request to have the Board review just the first 20 challenged claims (15 beginning March 19, 2013).

Second, there are certain regulatory requirements in part 42 of 37 C.F.R. that must be met (e.g., page limits, font size, signature, identification of lead and back-up counsel).

If any regulatory requirement is not met, the petition is defective.

- The paralegal may call the individual who filed the petition and explain the defect.
- The paralegal will enter a Notice of Filing Date Accorded to Petition and the individual who filed the petition will receive notification by email.
- While the petition will be accorded the filing date of the ORIGINAL submission, the defect must be corrected within one week.
- If the defect is not corrected within one week, the petition will be forwarded to a Board judge who may initiate a conference call and/or issue an Order to show cause, and terminated if the petitioner fails to respond to such an Order.

If there are no statutory or regulatory errors with the petition, the paralegal will enter a Notice of Filing Date Accorded to Petition, the petitioner will receive notification by email, and the patent owner will receive a copy via regular mail.

#### D4. 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. The petitioner may additionally serve the petition and supporting

evidence on the patent owner at any other address known to the petitioner as likely to affect service. See §§ 42.105(a), 42.205(a), and 42.406(a).

#### D5. 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 back up counsel email address user ID to submit any document in the proceeding, even when you used a different email address user ID to file the petition. To upload the document, see FAQ G1.

#### D6. If a petition is incomplete, how much time do I get to complete it?

The Office 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 FAQ D3.

#### D7. Can I present claim charts and arguments in landscape orientation?

No. All documents, other than drawings, must be written in portrait orientation including claim charts and arguments. The Board previously accepted a few petitions with claim charts written in landscape orientation because the procedure for filing AIA petitions is new.

Switching from portrait orientation to landscape orientation within a document (e.g., a petition) creates inefficiency for the reviewing officials at the Board. Therefore, correction is now required when a document or portions thereof (e.g., claim charts) are written in landscape orientation. This is consistent with the policy set forth in § 42.1(b) and the practice set forth in § 1.52(a)(1)(iii) for filing papers that are to become a part of the permanent record in the application or patent files within the USPTO.

#### D8. 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 §§ 42.8(a)(1), 42.104, 42.204, 42.304, and 42.405. The Board previously accepted a few improper mandatory notices because the procedure for filing AIA petitions is new. However, correction is now required when a petitioner's mandatory notices are not filed as part of the petition.

#### D9. If I am filing two petitions challenging the same patent, should I use the same exhibit numbers in both cases?

No. In the situation where a petitioner files multiple petitions challenging the same patent, the petitioner should number its exhibits uniquely for both cases, such as 1001-1099 for case #1 and 1101-1199 for case #2. See § 42.63(c). Similarly, the patent owner in such situation should number its exhibits uniquely for both cases, such as 2001-2099 for case #1 and 2101-2199 for case #2. Therefore, if the Board decides to consolidate the cases, the exhibits would continue to be uniquely numbered in the consolidated AIA Reviews.

#### D10. What are the most common errors found in petitions? (revised - February 11, 2014)

The following are the top 10 common errors:

1. Improper usage of claim charts by including arguments, claim construction, and/or legal analysis in a claim chart (see FAQ D12);
2. Failure to set forth claim construction of disputed or important claim terms expressly in a claim construction section;
3. Exhibits do not match the documents listed in the Exhibit List;
4. Failure to identify related matters or provide a statement that there are no related matters;
5. Exhibits are not sequentially numbered in the 1001-1999 range;
6. Failure to identify lead or back-up counsel as required by §§ 42.8 and 42.10;
7. Margins less than 1 inch as required by § 42.06;
8. Failure to certify that the petitioner is not barred or estopped from requesting a review as required by §42.104(a) or § 42.204(a);
9. The petition and supporting documents are served on the patent owner at an address that is not the correspondence address of record for the subject patent as required by § 42.105(a) or § 42.205(a); and
10. The petition and supporting documents are served on the patent owner later than the filing of the petition.

### D11. 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.

### D12. 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.

### D13. What is the preferred format for claim charts?

Claim charts should be presented in a readable format so that a reader (e.g., the patent owner or a deciding official) is able to locate the disputed claim limitations and the relied-upon portions of the prior art quickly. Presenting claim limitations and prior art teachings in a single column format and/or without appropriate spacing creates inefficiency and, at times, appears to circumvent the page limit set forth in 37 C.F.R. § 42.24. Claim limitations should be presented in a separate column (e.g., claim limitations in the left column and prior art teachings in the right column), and each claim should be presented in a separate chart.

### D14. How do I submit additional documents along with a petition?

Various screens are provided in PTAB E2E for submitting a petition, including "Patent Verification", "Petition Information", "Claims Challenged", "Petition Documents," "Required Information", "Real Party", "Additional Real Party", "Counsel Information," and "Review Petition."

- Petition Document

A petition and all exhibits to the petition should be uploaded using the "Petition Documents" screen.

To submit a document accompanying the petition (e.g., a Declaration), click on the "Petition Documents", enter the document information and click the "Add" button.

- File a Motion

To file a motion request document accompanying the petition (e.g., a motion to seal), the petition must be submitted prior to filing a motion request.

To submit a motion request after the petition has been submitted, you can search for the AIA Review case and open the case from the "My Docket", "View My Docket" and select "All AIA Reviews tab".

After locating the AIA Review case, you will click on the "AIA Review Actions" menu, select "File a Motion" and from the Motion Type menu, select "Motion to Seal", upload the appropriate request and click on the "Add" button and then the "Submit" button.

### D15. Should I list in my petition other related inter partes reviews, post-grant reviews, or covered business method patent reviews? (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.

### D16. What is the current patent number format for Design, Plants and Reissues? (Oct 9, 2014)

- Design - D followed by 6 digit number like D123456, d235126 etc.
- Plant - PP followed by 5 digit number like PP12456, pp14728 etc.
- Reissue - RE followed by 5 digit number like RE12345, re78945 etc.

### D17. How can I remove an IPR case from “My Docket” if it was incorrectly created?

If a petition has been “Initiated” but not yet “Submitted”, then you can click on the “Withdraw Petition” button after you open the case.

### D18. How long will petition initiated be saved for future filing?

Initiated petitions will be saved for 30 days on your docket.

### D19. What if your exhibit has multiple parts? Will you be able to manually edit the automatically generated exhibit number?

The next available exhibit number will be listed when you select “Type” as “Exhibits”, however, the exhibit number can be changed before clicking the “Add” button.

### D.20 Are the documents immediately available or after submission of the petition?

Documents are viewable after payment of the petition is filed.

After the petition is filed, the documents are available once they are uploaded into PTAB E2E.

### D21. How many statutory grounds can be entered for an IPR, CBM or PGR? How many references can be entered for each ground?

The number of statutory grounds that can be entered is based upon the trial type.

The number of references entered for each ground is based upon how many references are being used per statutory ground.

For example, claims 1-10 are challenged as being unpatentable under 35 USC 102 to Green et al U.S. Patent # 5,940,854 ('854) or claims 11-20 are challenged as being unpatentable under 35 USC 103 to Green et al. U.S. Patent # 5,940,854 ('854) in view of Evans, US Patent # 5,871,012.

## E. Fees

### E1. Can I pay the fees in PTAB E2E using multiple forms of payment?

No, petitioners must pay the full amount in Financial Manager using one form of payment.

Petitioners with a special need to use multiple forms of payment (e.g., deposit account and credit card) to pay the fees for a single IPR, PGR, or CBM petition should contact the Board at

(571) 272-7822. Petitioners will be asked to provide written authorization to charge the requested forms of payment. Transfer will then occur as soon as practicable. The date when transfer is completed will be used for purposes of according a filing date to the petition. See FAQ D1.

### E2. Can I pay the fees using multiple credit cards for one transaction?

No, only one credit card may be used. Parties may not split payment over multiple credit cards. Further note that Treasury Department regulations limit a credit card payment to a \$24,999.99 per day transaction.

### E3. 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?

Yes, 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.

### E4. 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?

A fee is currently required for each claim in excess of 20 claims. Beginning March 19, 2013, separate fees will be required for each claim in excess of 15 claims and 20 claims, respectively. See <https://www.uspto.gov/patent/laws-and-regulations/america-invents-act-ia/fees-and-budgetary-issues>. The Office will notify the petitioner of any fee deficiencies. When the petitioner pays the required excess claims fees within the time period set forth in the notice, the Office will accord the date on which the fees are paid as the filing date.

### E5. 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 of 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.

### E6. Do I need to pay both the request fee and the post-institution fee when I file an inter partes review petition on or after March 19, 2013?

On filing a petition for inter partes review, payment of both the inter partes request fee (\$9,000) and post-institution fee (\$14,000) are due. In addition, the appropriate request excess claims fee is required on filing if the petition is challenging more than 20 claims, and the appropriate post-

institution excess claims fee is required on filing if the petition is challenging more than 15 claims. A filing date would not be accorded unless the required fees are paid.

For example, for a petition that is challenging 25 claims, the following fees are required on filing:

- The inter partes request fee (§ 41.15(a)(1)): \$9,000
- The inter partes post-institution fee (§ 41.15(a)(2)): \$14,000
- Excess claims fee (\$200 for each claim in excess of 20) for requesting 5 claims in excess of 20 (§ 41.15(a) (3)): \$1,000
- Post-institution excess claims fee (\$400 for each claim in excess of 15) for requesting 10 claims in excess of 15 (§ 41.15(a)(4)): \$4,000
- Total: \$28,000

### E7. If I filed an inter partes review petition on or after March 19, 2013, 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, the petitioner may file in PTAB E2E a request for a refund of any post-institution fee paid. For the example in FAQ E6, a total of \$18,000 (\$14,000 + \$4,000) may be refunded if the petition is denied. The petitioner should specify in the request what amount it believes should be refunded and why.

In the situation where the Board decides to institute a review for fewer claims than requested, the petitioner may request a refund for each denied claim, post-institution excess claims fee paid. For the example in FAQ E6, if the Board decides to institute a review for only 16 claims out of the 25 challenged claims, a total of \$3,600 (\$400 x 9 denied claims, post-institution excess claims fee paid) may be refunded.

### E8. What payment system is PTAB E2E connected to?

PTAB E2E is linked with Financial Manager for payment of AIA Review petitions.

For additional information about [Financial Manager](#).

## F. Submission of Patent Owner Information and Preliminary Response

### F1. How does a patent owner inform the Board that I want to participate in an AIA Review proceeding and provide mandatory notice information under § 42.8?

The patent owner must first register as a PTAB E2E user and get an email address user ID. After logging on to PTAB E2E using the email address user ID, the patent owner should click on the “Enter Appearance As Patent Owner” to begin the process. PTAB E2E will provide screens to search for the proceeding by patent or application number and enter mandatory notice

information (e.g., identifying the real party in interest, lead and back-up 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 email notification and may then upload documents (e.g., preliminary response, motions).

The "Enter Appearance As Patent Owner" 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 access the proceeding from the "My Docket" tab.

## F2. Can a patent owner file a power of attorney appointing a new attorney in a proceeding?

Yes, if the patent owner 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.

If the patent owner is adding counsel after they have been approved to "Enter Appearance As Patent Owner", they must upload their mandatory notice and power of attorney and contact PTAB at 571-272-7822 to request the addition of their counsel to the AIA Review in order to receive future notification in regards to the AIA Review.

\*Currently, counsel is not able to make any edits to their counsel after the petition has been filed and the enter appearance as patent owner has been approved.\*

## F3. Can a patent owner 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 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, may logon to PTAB E2E and designate himself or herself as lead or back-up counsel for the proceeding.

## F4. 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 back-up 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.

#### F5. Will the Office check the patent owner's real party in interest information and power of attorney against the assignment recorded in the Office?

Yes, when the patent owner 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 are encouraged to keep assignment records up to date.

#### F6. If the patent owner's real party in interest is different than the assignee of record in the subject patent or application, can the patent owner submit the new assignment with the identification of the real party in interest?

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

#### F7. When can I file a patent owner preliminary response?

The three-month time period for filing a patent owner preliminary response runs from the date on which 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.

#### F8. How do I file a patent owner preliminary response in PTAB E2E? (revised August 9, 2017)

To file a patent owner preliminary response, open the case in PTAB E2E by: (1) clicking on "My Docket", and under (2) "All AIA Reviews" tab, select and click to (3) open the case (see Figure 1, (steps 1, 2, and 3)). Look for the "AIA Review Actions" dropdown menu and select (4) "File a Preliminary Response" (see Figure 2 (step 4)). On the following screen, select "No" to the question, "Are you uploading a Preliminary Response Waiver at this time?" Select "Choose File" to attach a document, enter the document name, select the availability of the document and click on the "Add" button.

uspto

## Patent Trial and Appeal Board

Dashboard Enter Appearance As Patent Owner/Respondent Initiate New Petition **My Docket** Payments Search

Home > My Docket

### My Docket

All AIA Reviews **1385** Notifications **783** As Patent Owner/Respondent Motions **139** Rehearings **112** AIA Appeals **135**

AIA Review #	Filing Date	Petitioner Application #	Petitioner Patent #	Patent Owner/Respondent Application #	Patent Ow
IPR2015-80714	08/26/2015			08183369	5555555
IPR2015-80719	08/26/2015			06707761	4567211
IPR2015-80720	05/17/2016			08183369	5555555
IPR2015-80744	08/26/2015			08183369	5555555
IPR2015-80763				08183369	5555555
IPR2015-80764				08183369	5555555

Figure 1. My Docket → All AIA Reviews screen

uspto

About Us Careers Contact Us

## Patent Trial and Appeal Board

Dashboard Enter Appearance As Patent Owner/Respondent Initiate New Petition My Docket Payments Search

Home > My Docket > AIA Review IPR2015-80714

### AIA Review IPR2015-80714

Status: **Notice of Filing Date Accorded**

Patent Number: 5555555 Tech Center: 2600 Art Unit: 2606

Claims Documents Original Case

> Statutory Ground 35 U.S.C 102


Challenged Claim Numbers Prior Art

**AIA Review Actions**

- File a Preliminary Response
- File a Motion
- File a Rehearing Request
- View Motions
- View Rehearings
- View Appeals
- Warning History

Figure 2. AIA Review Actions dropdown menu → File a Preliminary Response

Do not click on the "Enter Appearance as Patent Owner" from the menu. That option is only used to begin participating in a proceeding as the patent owner and should not be used once a patent owner is already verified for a proceeding.

Do not use the document edit icon  to file a preliminary response. See F13 below for an explanation.

#### F9. How do I waive a patent owner preliminary response in PTAB E2E?

To waive the filing of a patent owner preliminary response, open the case in PTAB E2E, click on "My Docket", "View My Docket" and "All AIA Reviews" tab, select and open the case. Look for the "AIA Review Actions" menu dropdown and select "File a Preliminary Response". On the following screen, select "Yes" to the question, "Are you uploading a Preliminary Response Waiver at this time?" Select "Choose File" to attach a document, enter the document name, select the availability of the document and click on the "Add" button.

#### F10. Can an inventor appear pro se as the patent owner in an AIA Review proceeding?

Yes, an inventor may appear pro se if he or she is the owner of the challenged patent.


#### F11. Can an organization (e.g., corporation) appear pro se as the patent owner in an AIA Review 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).

#### F12. How does an attorney appear in a proceeding as back-up counsel after being recognized pro hac vice?

An attorney admitted to appear pro hac vice in a proceeding is not designated automatically as back-up counsel in the proceeding. If a party seeks to have an attorney who has been admitted to appear pro hac vice as back-up counsel, the party should file in PTAB E2E a notice updating its mandatory notice information to designate the attorney as back-up counsel and a new power of attorney (unless the power of attorney filed previously includes the attorney) and a "Motion to appear as Pro Hac Vice". See 37 C.F.R. § 42.8(b)(3). The party also should contact PTAB at 571-272-7822 and request that their counsel information be updated in PTAB E2E.

#### F13. Can I use the document edit icon next to the Documents tab to file a patent owner preliminary response in PTAB E2E? (August 9, 2017)

No. Do not use the document edit icon  next to the Documents tab to file a preliminary response. PTAB E2E will not recognize the document you have uploaded as a preliminary response and PTAB E2E will assume that a preliminary response was not filed. This will result in an improper date accorded to the preliminary response for purposes of computing the institution decision date.



## F14. What happens if I incorrectly file a patent owner preliminary response in PTAB E2E using the document edit icon? (August 9, 2017)

The Board will consider such an incorrectly filed preliminary response for purposes of the institution decision. However, if the preliminary response is filed early (i.e., before the last date on which such response may be filed), the incorrectly filed preliminary response will be treated as if it was filed on the last day on which such a response may be filed for purposes of the statutory deadline (i.e., the incorrectly filed preliminary response will be treated as if it was filed 3 months after the last day on which the preliminary response may be filed) (see 35 USC §§ 314(b)(1), 324(c)(1)). 37 C.F.R. §§ 42.5(a), 42.6(b).

## G. Filing Other Documents

### G1. How do I file other documents (e.g., a motion to seal or proposed protective order)?

After you logon to PTAB E2E using your email address user ID, you can check to see if your document is properly uploaded, by searching for the AIA review case without logging in with your user id and password and then opening the case to see if your documents were properly uploaded. When filing a document after the petition is submitted:

1. When filing a document uploaded via the “AIA Review Actions” menu – File a Preliminary Response, File a Motion, View a Motion (and then select View Details), File a Rehearing or File an Appeal (for Notice of Appeal), you will enter the relevant information and click on the “Add” button after each document is uploaded one at a time. You will receive an acknowledgement on the screen in PTAB E2E in the upper right. When you have added all your documents click on the “Submit” button. Once the documents are submitted, then you will receive an email notification with a list of your documents filed.
2. To upload a document, click on the edit icon next to the Documents tab – select the paper type, and enter the relevant data and chose one document to be uploaded, then click on the “Add” button. You will receive an acknowledgement in the upper right of the screen. When you are finished adding all your documents, you must click on the “Done” button to receive your email notification with a list of your documents filed.

### G2. How do I file a confidential settlement agreement?

To file a confidential settlement agreement, a motion must be filed, select the appropriate case from the "My Docket", "View My Docket", "All AIA Reviews" tab and click on the AIA Review number hyperlink, open the case and click on the “AIA Review Actions” menu and select “File a Motion”, then

select a "Motion Type" of either "Motion to Dismiss – Before Institution" or "Motion to Terminate – After Institution". Enter the information for the document. Click on the "Add" button. Next you will enter another document by selecting a "Paper type" of "Other" and upload the confidential settlement agreement, enter the information for the document. In the "Availability" field, enter "Parties and Board Only." Click on the "Add" button and when you are done, click on the "Submit" button. The filer should also upload a request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved patent or application. See 37 C.F.R. § 42.74(c). The party should also mark the settlement agreement confidential.

### G3. 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 of service of the objection. 37 C.F.R. § 42.64(b)(2).

### G4. 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).

### G5. 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)).

### G6. 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.

### G7. 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.

### G8. How do I add additional counsel when there are multiple petitioners for the same proceeding?

The user designated as lead counsel or first backup counsel should contact PTAB at 571-272-7822 after their mandatory notice has been approved to request that PTAB updates their counsel information. Note that lead counsel's user ID must be used to submit documents in the proceeding and that the user ID may be shared. See FAQs C3, D5.

### G9. 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 patent owner, case number, patent number, and title of the paper. A sample heading is provided here

[http://www.uspto.gov/sites/default/files/ip/boards/bpai/sample\\_heading\\_06\\_16\\_2014.pdf](http://www.uspto.gov/sites/default/files/ip/boards/bpai/sample_heading_06_16_2014.pdf).

### G10. How do I notify the Board that the parties have settled and request that the proceeding be terminated?

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 PTAB. See 37 C.F.R. § 42.74(b); FAQ G2. If the proceeding is terminated before institution and the petition was filed on or after March 19, 2013, the petitioner may file a request for a refund of the post-institution fee paid. See FAQ E7. The request for a refund should be filed separately in PTAB E2E after the proceeding is terminated.

### G11. 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? (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).

### G12. What font size should I use in my documents? (November 7, 2013)

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).

### G13. What email addresses receive email notifications when something happens in a case?

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

For cases that were migrated from PRPS, the counsel tab will have the email listed on the counsel tab from PRPS.

For all newly filed AIA Reviews in PTAB E2E, the counsel's email address (their email user ID) will receive notifications from PTAB E2E.

### G14. Does metadata remain in a file after it is uploaded to PTAB E2E? (August 12, 2014)

Yes. A PDF or MPEG file uploaded to PTAB E2E is maintained in its original form (i.e., including metadata if the file originally contained metadata). 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.

### G15. How do I receive notifications to a shared docketing email address?

Currently, PTAB E2E does not permit an additional email address to the case to receive notifications. The individual receiving the email must set up a rule in their mail service to forward the emails received from [PTABE2E\\_System@uspto.gov](mailto:PTABE2E_System@uspto.gov) to a shared email address.

## H. Joinder and Consolidation

### H1. How do I request a joinder?

Any request for joinder must be filed as a motion under § 42.22, no later than one month after the institution date of any 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). To upload a motion using PTAB, see FAQ G1.

Only joinder of like review proceedings of the same patent is permitted. See 35 U.S.C. §§ 315(c) and 325 (c). For example, an instituted IPR may be joined with another IPR, but not with a PGR or reexamination.

### H2. 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.

### H3. How do I request a consolidation of multiple proceedings involving the same patent (e.g., a reexamination and an inter partes review)?

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.

### H4. 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).

### H5. Do I need to file a petition with a motion for joinder?

Yes, a party who wishes to join an inter partes review or post-grant review should file a petition accompanied by a motion for joinder. The 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, the party seeking to join the review is encouraged to contact the Board in advance of filing to arrange a conference call with the parties and Board to discuss the joinder request.

### H6. 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 unpatentability.

## I. Derivation Proceedings

### I1. How do I file a petition for a derivation proceeding in PTAB E2E?

Petitions for derivation proceedings may be filed beginning on March 16, 2013. Click on the "Initiate New Petitions" from the menu and you will be taken to the "Initiate New Petition" wizard. Select "DER - Derivation Proceeding" on the following screen and enter the information for the petition. For further information, see the [PTAB E2E External User Guides](#).

### I2. 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 petitioner's application until such time as the petitioner's 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.

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

A petitioner should inform the Board in the petition when an involved patent application is not available to the public. See 37 C.F.R. § 42.412. Derivation proceedings are kept confidential until reviewed by a Board judge. Also, a petitioner filing confidential information with the petition should file a concurrent motion to seal. See 37 C.F.R. § 42.55.

### 14. As a petitioner for a derivation proceeding, should I file my application in PTAB E2E?

No, the petitioner's patent application must be filed with the Office like any other application. PTAB E2E 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.

### 15. How are derivation proceedings different from other AIA proceedings?

Below are some of the main differences between derivation proceedings (DER) and other AIA proceedings (IPR, PGR, and CBM):

- Petitioner must have a pending application.
- Respondent may have either a pending application or an issued patent.
- 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 (35 U.S.C. § 135(a)(2)).
- Preliminary responses are not permitted.