

PTAB Trials Time Line and Docketing Assistant

By, Richard Neifeld, Neifeld IP Law, PC¹

The following time lines for activities relating to PTAB trials merges the Guide,² case law, and the Guide's Scheduling Orders. This time line applies to IPRs; PGRs; CBMs; and DERs. Y=Year; M= Month; W=Week; BD= Business Day; D=Day; SE=Supplemental Evidence

APPROXIMATE RUNNING TIME FROM PETITION FILING DATE	SCHEDULING ORDER DUE DATES, RUNNING FROM TRIAL INSTITUTION DATE	TIME FROM SPECIFIED DATE	WHAT IS DUE
			Original patent or reissue patent granted.
		< 9M	Petition to institute a PGR filed within 9M after original patent grant. Petition to institute a PGR filed within 9M of broadening reissue patent grant for broadened claims. 42.202(a); Guide II.B.
		> 9M	Petition to institute an IPR can only be filed after both (1) 9M after original patent or reissue patent granted and (2) any PGR is terminated. 42.102(a); Guide II.B.
		> 9M and < 9/16/2020	Petition for a CBM can only be filed after all of (1) 9M after original patent or reissue patent granted and (2) any PGR is terminated; the patentee has charged infringement; and the petition is granted a filing date before 9/16/2020. 42.303; 42.302(a); 42.200(c).
			DATE PETITION FILED AND SERVED
		0	Petitioner must comply with 42.8(a)(1)/(b) mandatory notices in the petition (real party in interest; related matters; counsel; service information)
		+ 21D	Patent owner 42.8(a)(2)/(b) mandatory notices (real party in interest; related matters; counsel; service information)
		> 21D	Begin time period for filing of <i>pro hac vice</i> motions. (Opposition authorized and due not later than 1 week after motion filed; no reply authorized). <u>Motorola Mobility LLC v. Michael Arouse</u> , IPR2013-00010, notice 8, internally identified as paper 6, (PTAB 10/15/2012)(expanded panel, informative opinion); order of general applicability normally attached to Notice granting a filing date.

0		DATE THAT BOARD ISSUES A NOTICE GRANTING A FILING DATE TO A PETITION. 42.106(IPRs); 42.206 (PGRs, and CBMs via 42.300(a)); Guide II.B.	
3M		+ 3M	Patent owner optional preliminary response. 42.107 (IPRs); 42.207(PGRs, and CBMs via 42.300(a)); Guide II.C. (Testimonial evidence prohibited. 42.107(c); 42.207(c). Patent amendment prohibited. 42.107(d).)
		DATE THE PATENT OWNER OPTIONAL PRELIMINARY RESPONSE FILED, OR IF NOT FILED, THE LAST DAY IT COULD HAVE BEEN FILED.	
6M	T=0	+3M	Board institutes or denies trial. Board has 3M to determine whether to institute a trial. 35 USC 314(b); 35 USC 324(c); 42.4(a); Guide II.D.
		DATE THE BOARD INSTITUTES OR DENIES TRIAL	
		+10BD	Both parties serve objections to pre trial evidence within 10BD of trial institution date. 42.64(b)(1)
		+14D	Petitioner's request for rehearing on grounds for which the Petition was not granted, if petition was granted in part. 42.71(d)(1)
		+ 30D	Petitioner's request for rehearing for Petition denied. 42.71(d)(1)
		+ 45D	Both parties motions to expunge confidential information to avoid public disclosure due within 45 days from denied petition; and from judgment (final written decision or termination) in a trial. Guide, at E.6., 77 FR 48761; 42.56; 42.2.
		DATE OF SERVICE OF OBJECTIONS TO PRE TRIAL EVIDENCE	
		0BD	Period for Patent owner to Notice depositions of Petitioner's Petition witnesses begins. Guide, Appendix A-1's scheduling order section B.1. (Section B.1 specifies that cross-examination period begins after date SE is due. SE due 10BD from date of service of objections. 42.64(b)(2). Notice due at least 10 BD before deposition. 42.53(d)(4).)
		+ 10BD	Service by both parties of SE within 10BD of objections. 42.64(b)(2). Period for both parties to Notice depositions of SE witnesses begins. Guide, Appendix A-1's scheduling order section B.1.
		+1M - 2D	Both parties filing and service of List of Proposed Motions. Guide section II.E. (See 42.21)

7M		+ 1M	Conference call: Hearing on proposed motions and scheduling. Guide section II.E.
9M	DUE DATE 1: 3M	Patent owner's Response and motion to amend. Guide, Appendix A-1's scheduling order Due Date Appendix; Guide II.F-G.	
		DATE OF PATENT OWNER'S RESPONSE (AND MOTION TO AMEND)	
		- (10BD + 1W)	End of period for Patent owner to Notice deposition of Petitioner's Petition witnesses. End of period for both parties to Notice deposition of SE witnesses. Appendix A-1's scheduling order section B.2.; 42.53(d)(4).
		- 1W	End of period for Patent owner to depose Petitioner's Petition witnesses. End of period for both parties to depose SE witnesses. Guide, Appendix A-1's scheduling order Section B.2.
		+ 5BD	Petitioner's service of objections to Patent owner's Response evidence. 42.64(b)(1).
		DATE OF PETITIONER'S SERVICE OF OBJECTIONS TO PATENT OWNER RESPONSE EVIDENCE	
		+ 0	Begin period for Petitioner to Notice depositions of Patent owner's Response witnesses. Guide, Appendix A-1's scheduling order section B.1. (Section B.1 specifies that cross-examination period begins after date SE is due. SE due 10BD from date of service of objections. 42.64(b)(2). Notice due at least 10 BD before deposition. 42.53(d)(4).)
		+ 10BD	Patent owner's service of SE. 42.64(b)(2). Period for Petitioner to Notice depositions of SE witnesses begins. Guide, Appendix A-1's scheduling order section B.1.
12M	DUE DATE 2: 6M	Petitioner's reply to the Patent owner's Response; and Petitioner's opposition to the Patent Owner's motion to amend. Guide, Appendix A-1's scheduling order Due Date Appendix; Guide, II.H-I.	
		DATE OF PETITIONER'S REPLY TO THE PATENT OWNER'S RESPONSE AND PETITIONER'S OPPOSITION TO THE PATENT OWNER'S MOTION TO AMEND	
		- (10BD + 1W)	End period for Petitioner to Notice depositions of Patent owner's patent owner response witnesses. Appendix A-1's scheduling order section B.2; 42.53(d)(4).

		- 1W	End period for Petitioner to depose Patent owner's Response witnesses. Appendix A-1, scheduling order, Section B.2.
		+ 5BD	Patent owner's service of objections to Petitioner's Reply evidence due. 42.64(b)(1). Begin period for Patent owner to Notice depositions of Petitioner's reply witnesses. Guide, Appendix A-1's scheduling order section B.1. (Section B.1 specifies that cross-examination period begins after date SE is due. SE due 10BD from date of service of objections. 42.64(b)(2). Notice due at least 10 BD before deposition. 42.53(d)(4).)
		DATE OF PATENT OWNER'S SERVICE OF OBJECTIONS TO PETITIONER'S REPLY EVIDENCE	
		+ 10 BD	Petitioner's service of SE. 42.64(b)(2). Period for Patent Owner to Notice depositions of SE witnesses begins. Guide, Appendix A-1's scheduling order section B.1.
13M	DUE DATE 3: 7M	Patent owner's reply to Petitioner's opposition to Patent owner's motion to amend. Guide, Appendix A-1's scheduling order Due Date Appendix.; Guide II.F-G.	
		DATE OF PATENT OWNER'S REPLY TO THE PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO AMEND	
		- (10D+1W)	End period for Patent owner to Notice depositions of Petitioner's reply witnesses. Guide, Appendix A-1's scheduling order section B.2; 42.53(d)(4).
		- 1W	End period for Patent owner to depose Petitioner's reply witnesses. Guide, Appendix A-1's scheduling order section B.2.
		+ 5BD	Petitioner's service of objections to evidence due. 42.64(b)(1). Begin period for Petitioner to Notice depositions of Patent owner's reply witnesses Guide, Appendix A-1's scheduling order section B.1. (Section B.1 specifies that cross-examination period begins after date SE is due. SE due 10BD from date of service of objections. 42.64(b)(2). Notice due at least 10 BD before deposition. 42.53(d)(4).)
		DATE OF PETITIONER'S SERVICE OF OBJECTIONS TO PATENT OWNER REPLY EVIDENCE	

			Patent owner service of SE. 42.64(b)(2) . Period for Petitioner to Notice depositions of SE witnesses begins. Guide, Appendix A-1's scheduling order section B.1.
13M+3W	DUE DATE 4: 7M+3W	Petitioner's motion for an observation on the cross-examination testimony of a reply witness. Both parties' motions to exclude evidence (see 42.64(c)) Both parties's requests for oral argument (see 42.70(a)) Guide, Appendix A-1's scheduling order Due Date Appendix; Guide II.I-M.	
		- (10D+1W)	End period for Petitioner owner to Notice depositions of Patent owner reply witnesses. Guide, Appendix A-1's scheduling order section B.2; 42.53(d)(4).
		- 1W	End period for Petitioner to depose Patent owner reply witnesses. Guide, Appendix A-1's scheduling order section B.2.
14M+1W	DUE DATE 5: 8M+1W	Patent owner's response to petitioner's observation on cross-examination testimony. Both parties' oppositions to motions to exclude evidence. Guide, Appendix A-1's scheduling order Due Date Appendix.	
14M+2W	DUE DATE 6: 8M+2W	Replies to oppositions to motions to exclude evidence. Guide, Appendix A-1's scheduling order Due Date Appendix.	
	DUE DATE 7:	NOT SPECIFIED	Oral argument to be set upon request.
1Y+6M	FINAL DETERMINATION DEADLINE: 1Y	Statutory deadline for a final determination or termination. 35 USC 316(a)(11), as amended; new 35 USC 326(a)(11)(extendable by 6 months for good cause).	
	+ 45D	Both parties motions to expunge confidential information to avoid public disclosure due within 45 days from denied petition; and from judgment (final written decision or termination) in a trial. Guide, at E.6., 77 FR 48761; 42.56; 42.2.	
	+ 63D	Deadline to file for Appellate review for IPRs; PGRs; CBM (35 USC 141 appeals); or appellate review or civil action for DERs (35 USC 141 and 146). 37 CFR Part 90, rule 90.3 (63 days from date of "final Board decision.")	

1. I can be reached via telephone at 1-703-415-0012 or via the firm website: Neifeld.com.

2. The "Office Patent Trial Guide" 37 CFR Part 42.