



# Patent Trial and Appeal Case Tracking System

## Frequently Asked Question (FAQs)

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## A. System availability and general information

### A1. Where can I access P-TACTS?

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

### A2. How do I log on to P-TACTS for the first time?

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

To sign in, go to the [www.uspto.gov](http://www.uspto.gov) website and create an account in MyUSPTO.



1. Click on "MyUSPTO"
2. Click on "Create a USPTO.gov account"

Enter the required information in MyUSPTO.

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

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

### A3. What are the privileges and responsibilities for user role and type?

Any registered P-TACTS user account can be one of the four types of user roles for a particular AIA Trials Review case.

1. **Submitter role** – Users can submit a petition or enter an appearance as a patent owner, and designate counsel within these processes for the associated AIA Review number. The Submitter user role is not a party to the AIA Review case unless designated as counsel or real party pro se.
2. **Lead Counsel** – Users designated as Lead Counsel for an AIA Review case can view and submit documents, and add, delete, or make updates to the new Staff role.
3. **Backup Counsel** – For a party to a PTAB Trial case, all counsel that are not Lead Counsel must be designated as Backup Counsel. There is no longer a separate role for a First

Backup Counsel. Users designated as Backup Counsel for an AIA Review case can view and submit documents but will NOT have the ability to add, delete, or make updates to the new Staff role.

4. **Staff role** – This is a new role where users can view and submit documents for an AIA Review case where Lead Counsel has added the Staff role user. This role is only visible to the party who submitted the Staff role for the particular AIA Review case.

#### A4. How do I update my P-TACTS email address?

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

#### A5. How do I transfer my docket to a new email address?

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

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

#### A6. If P-TACTS is down, may I file a petition or other documents via email or mail?

Please call the Board at 571-272-9797 if you are unable to access the system. If P-TACTS is unavailable, parties may notify the Board of the service of petitions and/or other associated documents by email, copying opposing counsel, at [Trials@uspto.gov](mailto:Trials@uspto.gov). The email notification to the Board should NOT include attachments.

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

Name of point of contact

Email address of point of contact

Patent number to which the petition corresponds (or application number in the case of a derivation proceeding)

Application number of the patent

Petitioner's application number (in the case of a derivation proceeding)

Number of claims challenged  
Type of trial proceeding  
Power of attorney  
Fee (e.g., a deposit account authorization)

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

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

Paper filing via overnight delivery is authorized only if both P-TACTS and the Board's email address (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

## A7. Will extensions of time be available?

If P-TACTS is down during normal business hours, a party may contact the Board and request a one-day extension of time for due dates that are set by rule or orders of the Board. 37 C.F.R. § 42.5(c)(2). In the unlikely event that an administrative patent judge is not available to rule on the extension, the Board may grant an extension the day after the paper is due. However, no extensions of time will be granted for any statutory time period.

## A8. What is the megabyte limit for a document upload?

A single uploaded file may not exceed 25 megabytes in size.

If you need to file a document that exceeds 25 megabytes, please follow the instructions below.



You can reduce the file size by:

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

### A9. Is there a limit to the number of documents that can be uploaded per filing?

No. However, only certain document types are allowed to be uploaded during a specialized process. (i.e., Initiating a new petition or entering an appearance as patent owner/respondent)

### A10. 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. Use the name that will appear in the docket listing. It should be simple and descriptive, such as "Jones Motion to Amend" or "Second Declaration of Dr. Smith." Document names must be 75 characters or less.

### A11. Will the USPTO provide forms (e.g., power of attorney or IPR transmittal) for filing documents in a proceeding?

P-TACTS provides screens for the parties to enter certain information (e.g., lead and back-up counsel and real party in interest). However, the USPTO does not have forms beyond those P-TACTS fillable screens.

### A12. How can I check whether I filed a document properly?

Without logging in, you may search for the AIA Review case number by using the Search P-TACTS tool and select the "View documents" button to see if your public documents were uploaded as you intended. Alternatively, for cases where the petition has already been submitted, locate your AIA Review Number from your case docket or through the Search P-TACTS tool and open Case Viewer to review all papers and exhibits within the documents listing.

Or:

- 1) When initiating a petition:  
Upload a paper in the proper format (i.e., PDF) and exhibits in one of the proper formats (e.g., pdf, video/mp4, video/x-m4v, etc.).

Select the "Add to list" button.

Your document will be displayed in the List of documents table with an upload date and timestamp when the document has been successfully uploaded to the Create New Petition Wizard. Note that these documents will not be filed until the petition has been successfully submitted.

- 2) When returning to an initiated petition before petition submission:  
AIA Review case number is accessible from the external user's My docket - Unsubmitted petitions tab with the option to select Continue in the Action column and view previously added document content and information, including date and timestamp of addition. Upon petition submission, user will receive an email Patent Review Petition Filing receipt.
- 3) When filing an Initial Appearance as a Patent Owner/Respondent:  
The user that submitted the Initial PO Mandatory Notice will receive an email confirmation of a Patent Owner Mandatory Notice Submission. Once the PO Mandatory Notice has been approved, the case will be displayed on patent owner's docket in Pending AIA reviews tab, the All AIA reviews tab, and Case Viewer.
- 4) When filing a document (other than Initial PO Mandatory Notice) after the petitions has been submitted and you are a party to the case:  
The AIA Review case number is accessible from party's My docket/Pending AIA reviews tab, the All AIA reviews tab, and Case Viewer. Once the Case Viewer is displayed, all previously added document content and information is shown, including document date and timestamp of addition. When a user files the document(s), an email confirmation is sent with a listing of the filed document(s).

For additional details regarding how to file a document or a petition, please refer to the P-TACTS External User Guide ([P-TACTS External User Training Resources | USPTO](#))

### A13. If the wrong document is submitted, can it be deleted through the P-TACTS interface?

If a document is mistakenly filed, please contact PTAB AIA Trials at: 571-272-7822 or at [trials@uspto.gov](mailto:trials@uspto.gov).

### A14. Can more than one person work on a case at the same time?

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

### A15. Will [Patent Center](#) for the challenged patent show whether a petition has been filed or a decision on the petition has been granted?

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

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

## A16. Is there any application programming interface (API) access to PTAB?

Yes, we provide API access to the P-TACTS data through the Open Data Portal. To access the PTAB API, click on the [USPTO API Catalog](https://developer.uspto.gov/api-catalog) (<https://developer.uspto.gov/api-catalog>).

## A17. Can I download information in bulk from P-TACTS?

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

For a single AIA Review case number, all proceeding documents may be downloaded in bulk by accessing the USPTO [PTAB Decisions portal](https://developer.uspto.gov/ptab-web/#/search/proceedings) (<https://developer.uspto.gov/ptab-web/#/search/proceedings>).

## A18. How do I enter a foreign address in P-TACTS?

To enter a foreign address:

Input values in the address fields; Address Line 1, Address Line 2, City, and Postal Code (Zip) fields are not required.

## A19. If I am idle in P-TACTS for less than 25 minutes, what will happen?

As long as the idle time during your session is within 30 minutes, you are not required to remain active. After the 30-minute time limit has been reached after continuous inactivity, you will be logged out of MyUSPTO and P-TACTS and will be required to log back into the system. To remain active, any key stroke, clicks, mouse movement, etc., will maintain your current working session.

## A20. If I am idle in P-TACTS for 25 minutes or more, will I lose any of the completed document uploads from the timed-out session if I clicked on the "Add to list" or "Submit" button?

When initiating a new petition, any document uploaded in the Create New Petition Wizard with the "Add to list" button clicked on the Petition documents section will be saved and may be accessed at a later time from the List of documents table.

For motions and rehearing requests, you must click "Save documents" button within the file a motion or rehearing request modal to save uploaded documents. You can access saved documents from the motions and/or rehearing tabs.

All other documents do not currently have a save option within the file other documents modal and must be resubmitted.

## A21. If I am idle in P-TACTS for 25 minutes or more, will I lose any of the data entered during the timed-out session if I did not select Submit?

Any information entered on the current page will be lost unless the "Save" or "Add" button has been selected.

## A22. What will happen if I am idle for 25 minutes, how do I get back into my session?

You must log in again to access your account within the P-TACTS website. Once you have logged back in, access My docket to locate a particular AIA Review case number, and open Case Viewer to resume your work.

## A23. How many cases can I view on My docket?

The default view is 25 cases; to view more cases, change the pagination quantity selection on the bottom right of the My docket interface.

## A24. How do I view the status of submitted motions or rehearing requests?

The My docket portal provides a Motions tab and a Rehearing requests tab that show content across all of your cases. Within each of these tabs, three groupings of Pending, All, and Unsubmitted are provided for quickly locating the document for an AIA Review case. Additionally, Case Viewer includes the same Motions tab and Rehearing requests tab but is AIA Review case number specific.

## A25. How do I file a Notice of Appeal?

A Notice of Appeal document may be filed for an AIA Review case after the Board has filed a Final Written Decision or Termination decision. To file a Notice of Appeal, locate the AIA Review case number and open Case Viewer. Select the "Add" button and the File a notice of appeal menu option. The add document modal will be displayed. Enter information for all required fields marked by a red asterisk beginning with Date appeal filed. Next, select Availability and enter the Document name. Then, select the file to upload and the "Add to list" button, and file the Notice of Appeal by selecting the "Submit" button. Your filed Notice of Appeal will be displayed on the My docket, AIA reviews on appeal tab.

## **B. Searching and reviewing documents**

### B1. Can I use P-TACTS to search for a proceeding without registering?

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

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

Yes, you can search for an AIA Review by the AIA Review case number, Party Name, AIA Review/Case type, Patent Number, Application Number, or Technology Center.

## B3. Will P-TACTS collect and report statistics on the proceedings?

Yes. PTAB publishes performance benchmarks for dispositions, pendency, inventory, and other tracking measures on the USPTO PTAB Statistics website (<https://www.uspto.gov/patents/ptab/statistics>).

## B4. Is full text document search available in P-TACTS?

No, it is not.

## C. Registering as a P-TACTS User

### C1. Who can register?

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

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

In order to have a P-TACTS account, all user must have a MyUSPTO account. To register for a MyUSPTO account, you must enter your name, a phone number, a unique email address, and create a password for MyUSPTO registration. To log in to your P-TACTS account, you must enter your MyUSPTO credentials which include email and password.

### C3. How can I associate my USPTO registration number with my P-TACTS account?

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

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

## D. Filing a petition

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

Once the USPTO reviews the petition and determines whether the petition is complete and the appropriate fees have been paid, the USPTO will send a notice to the petitioner and patent owner. The submission date of the compliant petition will be accorded as the filing date. If the petition complies with all of the statutory and regulatory requirements, the original submission date of the petition will be accorded as the filing date. Conversely, in a situation where a petition does not comply with all the statutory requirements, no filing date will be accorded. In the

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

## D2. Will the USPTO 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 panel 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 this FAQs document, section E7.

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

Once a petition is submitted, a PTAB paralegal will review the petition for statutory and regulatory compliance. There are certain statutory requirements 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 *inter partes* review (IPR) and post grant review (PGR) petitions:

1. Appropriate fee successfully paid
2. Identification of the patent and the specific claim(s) being challenged
3. Identification of the real party in interest
4. Copies of the patents and printed publications relied upon in the petition,
5. 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 will contact the Board panel assigned to the case and let the panel determine the appropriate remedy. If the deficiency is not corrected within a time period set by the panel, the panel may dismiss the petition.

There also are certain regulatory requirements in Part 42 of Title 37, Code of Federal Regulations, that must be met (e.g., word count, 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 counsel of record for the petitioner will receive notification by email. Although 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 panel who may initiate a

conference call and/or issue an Order to Show Cause, and terminate the petition 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.

#### 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 effect service under §§ 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 this FAQs document, section G1.

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

The USPTO will provide the petitioner one month from the Notice of Incomplete Petition to correct the petition. Please see 37 C.F.R. §§ 42.106(b), 42.206(b), and 42.407(b), and FAQ section 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. 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 37 C.F.R. § 42.1(b) and the practice set forth in 37 C.F.R. § 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 37 C.F.R. §§ 42.8(a)(1), 42.104, 42.204, 42.304, and 42.405.

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

No. If a petitioner files multiple petitions challenging the same patent, the petitioner should number its exhibits uniquely for both cases, such as 1001-1099 for case #1 and 1101-1199 for case #2. See 37 C.F.R. § 42.63(c). Similarly, the patent owner in 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 consolidates the cases, the exhibits will be uniquely numbered in the consolidated AIA Reviews.

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

The following are common errors:

1. Failure to set forth claim construction of disputed or important claim terms expressly in a claim construction section
2. Exhibits do not match the documents listed in the Exhibit List
3. Failure to identify related matters or provide a statement that there are no related matters
4. Exhibits are not sequentially numbered in the 1001-1999 range
5. Failure to identify lead or back-up counsel as required by 37 C.F.R. §§ 42.8 and 42.10
6. Margins less than 1 inch as required by 37 C.F.R. § 42.6(a)
7. Failure to certify that the petitioner is not barred or estopped from requesting a review as required by 37 C.F.R. § 42.104(a) or § 42.204(a)
8. 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 37 C.F.R. § 42.105(a) or § 42.205(a)
9. The petition and supporting documents are served on the patent owner later than the filing of the petition

## D11. How do I submit additional documents along with a petition?

Various screens are provided in P-TACTS 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.

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

## D12. How long will an initiated petition be saved for future filing?

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



### D13. What if my exhibit has multiple parts? Can I 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 selecting the “Add to list” button.

### D14. Can I enter any exhibit number when uploading an exhibit?

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

- Petitioner – 1000-1999
- Patent Owner – 2000-2999

### D15. Are uploaded documents immediately available to parties of the AIA Review case or only after submission of the petition?

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

## E. Fees

### E1. Can I pay the fees in P-TACTS 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 or PGR, petition should contact the Board at 571-272-7822. Petitioners must 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 this FAQs document, section D1.

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

No, only one credit/debit card may be used. Treasury Department regulations limit a credit card payment to a maximum of \$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?

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

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?

An excess claims fee is required for each claim in excess of 20 claims as of October 2, 2020. The USPTO 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 USPTO will accord the date on which the fees are paid as the filing date.

E5. When the USPTO notifies me of a fee deficiency for excess claims, can I file a corrected petition without excess claims rather than paying the excess claims fees, so that the petition will be entitled to a filing date as of the original submission date?

Yes, 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 substantive arguments or make other substantive changes (e.g., new grounds). The original submission date of the petition will be accorded as the filing date.

E6. Do I need to pay both the request fee and the post-institution fee when I file an IPR or PGR review petition?

On filing a petition for IPR or a PGR, payment of both the request fee and post-institution fee 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 20 claims. A filing date would not be accorded unless the required fees are paid.

E7. If I filed an IPR or a PGR petition may I request a refund of the post-institution fee paid if the Board decides not to institute a review?

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

E8. If the Board decides to institute my IPR or PGR petition, are there any circumstances under which I can get a refund of any post-institution fee paid.

No. Once a review is instituted, the petitioner is not entitled to a refund of any post-institution fee paid. *See, e.g., Setting and Adjusting Patent Fees, Fed. Reg. 4233-5 (Jan. 18, 2013).*

## E9. What payment system is P-TACTS connected to?

P-TACTS is linked with Financial Management Systems, Fee Processing Next Generation (FPNG) for payment of AIA Review cases.

## F. Submission of patent owner/respondent information and preliminary response

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

The patent owner must first have registered with MyUSPTO account. After logging into P-TACTS, using the email address (user ID), the patent owner should click on the "Enter Appearance As Patent Owner/Respondent" link to begin the process within the Mandatory Notice Wizard. P-TACTS will provide screen to search for the proceeding by AIA review case number, patent number, 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 approval email and the patent owner may then upload documents (e.g., preliminary response, motions). The "Enter Appearance As Patent Owner/Respondent" option should only be used to begin participating in a proceeding as the patent owner. Once a patent owner has been verified and is participating in a proceeding, the verification process should not be used again. Instead, the patent owner should upload any documents, including any subsequent mandatory notices, from the AIA case viewer.

### F2. Will the USPTO check the patent owner's real party in interest information and power of attorney against the assignment recorded in the USPTO?

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 and whether the patent or application has been assigned. Therefore, patent owners are encouraged to keep assignment records up to date.

### F3. How do I file a patent owner preliminary response in P-TACTS?

Log into P-TACTS

Go to My Docket

Select the AIA review case number to open Case Viewer

Select the "Add" button and File a Preliminary Response from the menu option

Enter information into all required fields marked by a red asterisk beginning with Paper type

Select POPR: filed

#### F4. How do I waive a patent owner preliminary response in P-TACTS?

Log into P-TACTS

Go to My Docket

Select the AIA review case number to open Case Viewer

Select the "Add" button and File a Preliminary Response menu option

Enter information into all required fields marked by a red asterisk beginning with Paper type

Select POPR: waived

#### F5. 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 automatically designated as back-up counsel. To do so, the interested party use P-TACTS to file a notice updating its Mandatory Notice information to designate the attorney as back-up counsel, include a new power of attorney (unless the power of attorney filed previously includes the attorney), file a Motion to appear Pro Hac Vice, and pay the appropriate fee. See 37 C.F.R. §§ 42.8(b)(3), 42.10(c), 42.15(e). The party should also contact PTAB at 571-272-7822 and request that their counsel information be updated in P-TACTS.

#### F6. Can I utilize a non patent owner preliminary response paper type to file a patent owner preliminary response in P-TACTS?

No. P-TACTS will not recognize the document you have uploaded as a preliminary response because the correct paper type must be used, and P-TACTS 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.

#### F7. What happens if I incorrectly file a patent owner preliminary response in P-TACTS using the document edit icon?

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 U.S.C. §§ 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 log into MyUSPTO and access the P-TACTS system, please file the 'other documents' by following the steps below.

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

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

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

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

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

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

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

You must file a motion for confidential settlement agreement by following the steps below.

- Log into P-TACTS
- Go to My Docket
- Select the AIA review case number to open Case Viewer
- Select the "Add" button and File a motion menu option
- Then select the sub-menu option: File a motion

### G3. How do I add additional counsel when there are multiple petitioners for the same proceeding?

The user designated as lead counsel or back-up counsel should contact PTAB at 571-272-7822 after their mandatory notice has been approved requesting that PTAB update their counsel information.

### G4. What heading should I use on the first page of papers filed in a case?

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. This is a sample heading.

### G5. 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 all newly filed AIA Review cases in P-TACTS, the counsel's email address (their email user ID) will receive notifications from P-TACTS.

### G6. Does metadata remain in a file after it is uploaded to P-TACTS?

Yes. A PDF or MPEG file uploaded to P-TACTS 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.

### G7. How do I receive notifications to a shared docketing email address?

P-TACTS 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 to a shared email address.

## H. Derivation proceedings

### H1. How do I file a petition for a derivation proceeding in P-TACTS?

Select Initiate New Petitions to access the Create New Petition Wizard.

Select DER - Derivation Proceeding on the following screen and enter the information for the petition. For further information, see the P-TACTS External User Guide [P-TACTS External User Training Resources | USPTO](#).

### H2. What happens to a petition for a derivation proceeding after it is filed?

Once a petition for a derivation proceeding has been reviewed and accorded a filing date, the Board may enter an order returning jurisdiction to the examiner of the parties' application(s)

until such time as the parties' claims are in condition for allowance (absent the derivation proceeding). Once the claims are in condition for allowance, the Board may determine whether to institute the derivation proceeding.

### H3. As a petitioner for a derivation proceeding, should I file my application in P-TACTS?

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