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PTAB HIGHLIGHTS

New developments in post-issuance proceedings

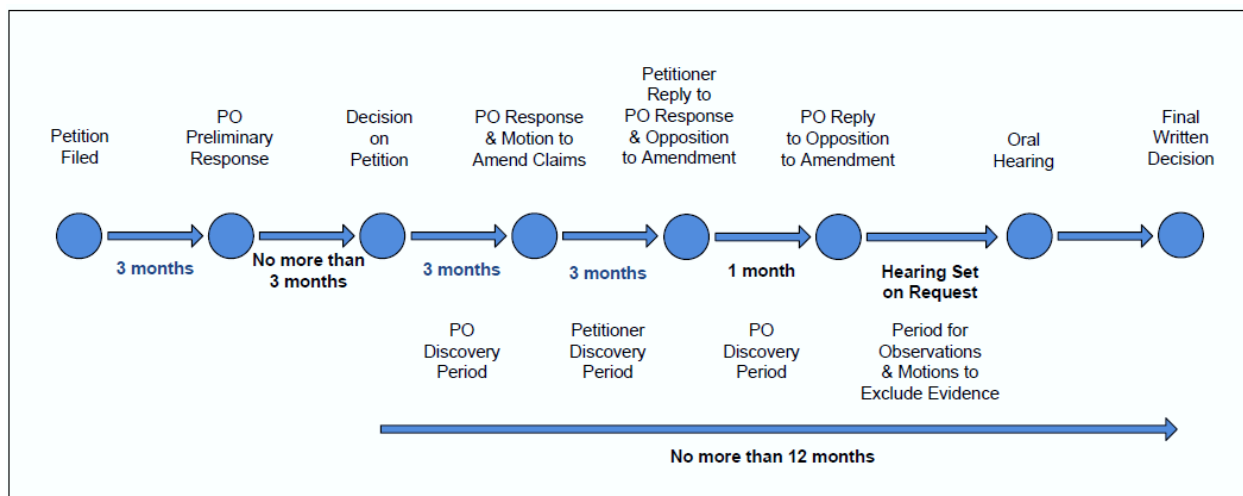
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How Many Days in Three Months? 90? 91? 92? Not At The PTAB In IPRs

By Charles W. Shifley

May 11, 2017 — With the common calendar, February can be 28 days, but with January and March’s 62 days, the three months of January through March is 90 days (except for leap years). Three months for other calendar months can be up to 92 days. But is there always something in the range of 90 to 92 days in three months at the Patent Trial and Appeal Board (PTAB) in *inter partes* reviews (IPRs)? No. With them, the range can be from 90 to 120 days and more. Don’t believe it? Read on.

For many years, the PTAB was out on the road with a roadshow, selling to its audience a graphic like the one below. Look at the period for a “PO Preliminary Response,” that is a patent owner’s preliminary response period. Three months, right? In fact, “3 months” from “Petition Filed,” right? So it would seem. Three months is three months, 90 to 92 days.



But the PTAB sold its IPRs so well that it recently has had more IPR petitions than it seems to be able to handle. In the **first half of its fiscal year 2017**, the PTAB received 1,044 IPR, covered business method (CBM) and post grant review (PGR) petitions, a pace that if continued through the full year would see 2,088 IPR, CBM, and PGR petitions. That would be hundreds more than past years' annual totals, and specifically, hundreds more than the 1,683 proceedings of 2016.

The upshot apparently has been at times an overwhelmed PTAB staff. Consider, for example, IPR2017-00860, at random. A notice confirming the filing date of the petition listed a date of February 7, 2017. But the date of the notice was March 9, 2017.

What difference does it make that it took more than a month for a notice to issue that the petition was according a filing date for the date it was actually filed? It makes a difference — the difference is whether the patent owner preliminary response is due by a date like May 7, 2017, or a date like June 9, 2017, a difference of 33 days, more than a month. That 33 days kicks back every following due date in an IPR an equal number of days. The institution decision deadline goes back 33 days, for example.

Each “Notice of Accord Filing Date” entered at the PTAB, as in IPR2017-00860, states the following: “Patent Owner may file a preliminary response to the petition no later than three months from the date of *this notice*” (emphasis added). That’s right, the patent owner is routinely given three months from the date of the notice — a notice that could have taken 30 or more days to issue — to file a patent owner preliminary response, not three months from the date of the petition being filed.

Compare the passage of time for the notice in IPR2017-00860 to the passage of time in IPR2017-00001. In the earlier IPR case, the notice took, from the petition filing date of October 1, 2016, to the notice date of October 4, 2016, three days.

With the graphic above having been touted by the PTAB, is the notice issued “Notice of Accord Filing Date” legal in setting the patent owner preliminary response date? The patent law of IPRs provides that the period for a patent owner preliminary response is “a time period set by the Director [of the USPTO].” 35 U.S.C. §313. The director, by regulations, sets this time period: “The preliminary response must be filed no later than three months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date.” 37 C.F.R. §42.107. Answer, it’s legal: the patent owner preliminary response can be filed three months after the date of a “Notice of Accord Filing Date,” not the sooner three months from the filing of the petition.

So friends, in the PTAB in IPRs, how many days can there be in three months, 90, 91, 92? The calendar says yes. The U.S. Patent and Trademark Office graphic says yes. But the IPR law says no, there can be as many as three months plus the number of days, however many, it takes the PTAB staff after receipt of an IPR petition to issue a “Notice of Accord Filing Date.” By example, three months can be at least a calendar’s maximum 92 days plus another 33 days, meaning 125 days — a total that is more than a month beyond three months. Petitioners, take note, calculate your schedule based on the workload at the PTAB. And avoid reliance on USPTO graphics.

Could this be a matter of some petitions challenging many claims, having many grounds, relying on many exhibits, or using the full word count allowed, 14,000? Do such petitions take longer to review and accord their filing date? In IPR2017-00863, two claims were challenged on one ground with 20 exhibits and a word count of 8,221 words. Review took from filing on February 9, 2017, to according the filing date on March 6, 2017. By this example, it isn’t complexity that is slowing down reviews. Could it be poor organization of some petitions? Not from the petitions referenced here; they are well organized. Could it be the PTAB is slow-rolling its workload, especially for computer-related technologies, allowing its judges a better chance to keep up? IPR2017-00863 was on computer network

packet processing. A petition filed April 4, 2017, that received its notice April 12, 2017, IPR2017-1100, was on biotechnology. Or it could be that PTAB staff has just been backed up.

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The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office's Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer frequent summaries of the board's significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.



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