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Timeline for a Post-Grant Review

Petition for post-grant review has to be filed no later than 9 months after issue/reissue date. AIA §6

- Has to specify grounds for invalidity. 77 Fed. Reg. 48729-30 (Aug. 14, 2012) (codified at 37 C.F.R. § 42.204).
- Must be served on patent owner and filed with a fee to be accorded a filing date. *Id.* (codified at 37 C.F.R. § 42.204, 206). Only for patents filed under first-to-file.

Optional Preliminary Response to Petition

- No more than 3 months after petition. *Id.* (codified at 37 C.F.R. § 42.207).
- Can expedite proceeding by not responding.

Institution of Post-Grant Review (no more than 5 months after petition)

- Will proceed only if it is more than likely that at least one of the claims is unpatentable or raises a novel or unsettled question of law. *Id.* (codified at 37 C.F.R. § 42.208).
- Initiated within 3 months of the preliminary response or the last day on which such a response could have been filed. AIA § 6 (codifying 35 U.S.C. § 324(c)).

Patent Owner Response

- Optional response to petition addressing any grounds not already denied.
- Due either as specified in board order or three months after institution of review. 77 Fed. Reg. 48730(codified at 37 C.F.R. § 42.220).

Motion to amend patent; one motion available by right.

Id. (codified at 37 C.F.R. § 42.221).

Discovery

Limited directly to factual assertions advanced by the parties. 77 Fed. Reg. 48731 (codified at 37 C.F.R. § 42.224).

Filing Supplemental Information

Petitioner may file supplemental information. *Id.* (codified at 37 C.F.R. § 42.223).

Final determination no more than 1 year after institution of review

(Extendable by no more than 6 months) AIA § 6 (codifying 35 U.S.C. § 326).

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