

**PRESENTED AT**

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**Concurrent Proceedings  
Before PTAB and District Court**

**Panelists:**

**Anthony J. Fitzpatrick, Duane Morris LLP, Boston, MA**

**Monica Grewal, Wilmer Cutler Pickering Hale and Dorr, Boston, MA**

**Chris Lewis, FLIR Systems, Portland, OR**

**Rachel MacGuire, Oracle Corporation, Denver, CO**

**David L. McCombs, Haynes and Boone LLP, Dallas, TX**

## **Concurrent Proceedings before PTAB and District Court**

Interplay between PTAB and District Court proceedings is the new reality in patent cases, with trends and lessons continually emerging for both patent owners and challengers. Practitioners provide their insights regarding case management and tactical considerations that arise with concurrent proceedings.

- Anthony J. Fitzpatrick, Duane Morris LLP, Boston, MA
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- Rachel MacGuire, Oracle Corporation, Denver, CO
- David L. McCombs, Haynes and Boone, LLP, Dallas, TX (Moderator)

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## **Panel Discussion Topics**

### **1. Decision to file at PTAB**

We have heard much today about post grant proceedings, including statistics on success rates and a recognition that over 85% of IPRs involve co-pending district court litigation. Yet, the Office emphasizes neutrality among patent owners and petitioners, and recent outcomes show a downward trend in claim cancellation rate at the PTAB.

*"I wouldn't read too much into any apparent trends in rulings. The one and only one job of the Patent Trial and Appeal Board is to call the shots neutrally and accurately based on the facts and the case law. The board has no agenda, and the rulings fall where they may."*

USPTO Director Michelle K. Lee's remarks at AIPLA Mid-Winter Meeting, January 30, 2014

- **From a trial lawyer's perspective, and in-house perspective, what are the factors that tip your decision either for, or against, filing an IPR?**
- **Has the PTAB made resolution of patent disputes more or less efficient? How has this impacted your case management strategies? What percentage of your defensive caseload involves your filing post-grant proceedings?**

## 2. Multi-Defendant Litigation

**Real Party-in-Interest:** An IPR must name all real-parties-in-interest, and risk of denial or termination exists if not cured within one year of the petitioner or RPI being served with an infringement complaint. *See, Zoll Lifecor Corp. v. Philips Elecs. N. Amer. Corp. & Koninklijke Philips N.V., Paper 15, Decision Denying Institution, Mar. 20, 2014 (IPR2013-00609).*

- **In what ways are joint defense groups likely to operate so as to mitigate the unintended expansion of ‘real-party-in-interest’ or ‘privy’ designations to co-defendants?**

**Joint and Multiple Proceedings:** Section 325(d) provides the PTAB with broad discretion to reject a petition in the case of multiple proceedings on the same patent, where the same art or arguments were previously presented.

- **Should I do a joint filing with other defendants, or go it alone? Should I ever seek joinder with an existing IPR?**
- **When should I time my filing relative to my co-defendants or relative to existing filings against the same patent?**
- **In balancing the “right of the petitioner to be heard” versus “harassment of the patent owner,” what are the factors the Board considers in exercising its discretion to grant/deny a second petition?**

## 3. District Court Stay

Views on stay range from “strategic gamesmanship masquerading as a case management request” to “an effective tool for simplification of issues with a low likelihood of prejudice to the patentee in view of statutory time limits.”

- **What are the current trends on stay pending PTAB review?**
- **What are some examples of judicially imposed estoppels required in exchange for stay?**
- **When might a stay be undesirable for a petitioner? Desirable for a patent owner?**

## 4. Estoppel for Petitioners – Can There Be a Second Bite at the Apple?

Estoppel from asserting invalidity before the courts or the PTAB on any ground that the petitioner raised or reasonably could have raised during a failed IPR, is intended to prevent patent challengers from getting a second bite at the apple. Recent case law sheds some

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