

**Presented:**  
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## **Concurrent Litigation Strategies After AIA**

**Moderator:**

**Mark E. Patrick, Texas Instruments Incorporated, Dallas, TX**

**Panelists:**

**Bryan Farney, Farney Daniels, Georgetown, TX**

**Hilda C. Galvan, Jones Day, Dallas, TX**

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

**Donald R. McKenna, TSMC, Hsinchu, Taiwan**

**Advanced Patent Law Institute**  
**Four Seasons Hotel, Austin, TX**  
**Thursday, October 31, 2013**  
**2:45 p.m. (1.0 hr)**

**Concurrent Litigation Strategies after AIA**

The panel will review the impact of the AIA on patent litigation and the new opportunities and challenges emerging for both plaintiffs and defendants. Topics will include how the case law is developing in the wake of recent legislative changes and the practical ways in which courts are addressing those changes; the latest tactical developments in venue selection and multi-defendant litigation; changes in the requirements for inducement; the use of parallel PTAB proceedings to contest validity; the interplay between proceedings in the courts and PTAB; and overall case management considerations. The panel will also discuss what the future holds (as best they can tell), including whether new defenses or new legislation will further alter the patent litigation landscape.

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## Panel Discussion Topics

*How is the AIA changing patent litigation strategies for both plaintiffs and defendants? Have the AIA and other reforms really led to a shift in leverage favoring defendants?*

### **1. Developments in venue selection and multi-defendant litigation in view of joinder restrictions**

#### **35 U.S.C. § 299. Joinder of parties**

(a) JOINDER OF ACCUSED INFRINGERS. – With respect to any civil action arising under any Act of Congress relating to patents, other than an action or trial in which an act of infringement under section 271(e)(2) has been pled, parties that are accused infringers may be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, or counterclaim defendants only if –

- (1) any right to relief is asserted against the parties jointly, severally, or in the alternative with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences relating to the making, using, importing into the United States, offering for sale, or selling of the same accused product or process; and
- (2) questions of fact common to all defendants or counterclaim defendants will arise in the action

(b) ALLEGATIONS INSUFFICIENT FOR JOINDER. – For purposes of this subsection, accused infringers may not be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, based solely on allegations that they each have infringed the patent or patents in suit.

- First, has there been any change in which venues patent plaintiffs prefer?
  - Discuss “sophisticated” patent courts (DE; MA; VA; WI; EDTX; NDCAL); “rocket dockets” (VA; WI); “quality of life” courts (MA; DEL’ NDCAL; EDTX).
  - Have the patent pilot program districts had any impact on where plaintiffs are choosing to file patent cases?
- How are plaintiffs adapting their filing practices in response to the joinder restrictions?
- How are different district courts responding?

- When named in a large group of unrelated defendants, what strategies are typically pursued by defense counsel and, among the following, which if any are most effective?
  - Motion to sever;
  - Stay pending the outcome of litigation against another defendant;
  - Consent to consolidation of pre-trial proceedings;
  - Consent to separate trial on validity, before individual trials on infringement.
    - Are there circumstances under which a district court can sever the issue of invalidity in each of several different cases on the same patent and then hold a common trial on invalidity
    - How have the AIA's new joinder rules impacted defendants' strategies regarding motions to transfer?

## **2. PTAB Proceedings**

The AIA establishes a new Patent Trial and Appeal Board and procedures for conducting administrative patent trials on validity. Beginning on September 16, 2012, (1) inter partes review and (2) post grant review for covered business methods became available options for challenging patent validity

### **A. Inter Partes Review**

#### **35 U.S.C. § 311. Inter partes review**

- (a) IN GENERAL. – Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.
- (b) SCOPE.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

- Recent IPR Filings
  - Looking at the petitions filed thus far, who is filing them and why, and what common procedural or legal issues are emerging?
- Interplay Between IPR and District Court/ITC Litigation
  - When does IPR make sense in response to pending patent litigation?
  - What is the likely impact of initiation of an inter partes review proceeding on:
    - Litigation stays (DC/ITC)?
      - Under what circumstances can you get a stay in DC/ITC
      - What factors do courts find most persuasive?

Also available as part of the eCourse

[Patent Litigation Updates: Litigation Strategies after AIA; Post-Grant Proceedings, Strategies, and Practice after AIA; Patent Exhaustion; plus Divided Infringement](#)

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18<sup>th</sup> Annual Advanced Patent Law Institute session  
"Concurrent Litigation Strategies After AIA"