

Concurrent Proceedings Before PTAB and District Court

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Discussion Topics

- Decision to File at PTAB
- Multi-Defendant Litigation
- District Court Stay
- Estoppel for Petitioners
- Evidence Across Proceedings
- Finality of Judicial Decisions

Administration Comments on PTAB Proceedings

"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

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Decision to File at PTAB

- 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?

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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?

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Multi-Defendant Litigation

- **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?

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