

Interplay of District Court Litigation and the PTAB



Juanita DeLoach
Barnes & Thornburg LLP



Hilda C. Galvan
Jones Day

DISCLAIMER

This discussion/presentation is meant for informational purposes only and not meant as a substitute for legal advice.

The views presented do not necessarily reflect the views of any of the law firms or companies represented, any of their individual lawyers, or their clients.

Interplay of District Court Litigation and the PTAB

- Litigation Commenced: To File or Not to File?
- IPR Filed: Now What?
- Post-PTAB Decision: Next Steps?

3

Litigation Commenced: To File or Not to File?

- Evaluate Fintiv Factors
- Estoppel: Non-Petitioned References & Product Prior Art
- Claim Construction: Claim Terms & Inconsistent Positions

4

To File or Not to File: Why it matters

- Evaluate the likelihood that PTAB will deny institution
 - District Court Practices
 - District Court Schedules
 - Available Prior Art
 - Asserted Claims v. All Patent Claims
 - Stipulations
 - Other Lawsuits/PTAB proceedings – Same Patents
- Why it matters?

5

To File or Not to File: Why it matters

PGR/IPR Fees through Filing of Petition

	Life Sciences	Electrical	Mechanical
Mean (Average)	211,000	136,000	134,000
10 th Percentile	65,000	58,000	56,000
Median (Midpoint)	225,000	120,000	120,000
90 th Percentile	425,000	213,000	220,000

Source: AIPLA 2021 Report of the Economic Survey at I-182, I-186, I-190

6

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Interplay of District Court Litigation and the PTAB

Also available as part of the eCourse

[2021 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the

26th Annual Advanced Patent Law Institute session

"Interplay of District Court Litigation and the PTAB"