

# 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 <sup>th</sup> Percentile	65,000	58,000	56,000
Median (Midpoint)	225,000	120,000	120,000
90 <sup>th</sup> 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

26<sup>th</sup> Annual Advanced Patent Law Institute session

"Interplay of District Court Litigation and the PTAB"