

# CREATIVE WAYS TO RESOLVE DISPUTES BETWEEN PTAB AND DISTRICT COURT PROCEEDINGS



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November 4, 2021

## The Audience

- All Litigants Except
  - Those philosophically opposed to settlement
  - Those who perceive themselves as having nothing to lose



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# The Problem – Multiple Jurisdictions

- District Court Litigation

- Infringement
- Validity
- Damages
- Injunction

- PTAB

- Validity
- Prosecution History
- Estoppel



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# The Problem – The “Parties”

- Patent Owner / Plaintiff
- Accused Infringer / Defendant
- Wild Cards

- Third Party Initiator of IPR
- Real Party in Interest



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## The Problem – The Lawyers and Others

- Outside Counsel / Law Firms
- Prosecution Counsel
- Inhouse Counsel
- Inhouse Business Interests



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## The Problem – Motivations

- Outside Counsel / Law Firms
  - \$\$\$\$\$
- Prosecution Counsel
  - Claim Scope
  - Winning Percentage
- Inhouse Counsel
  - Client Relationship
  - Internal Negotiations
  - Job Security
- Inhouse Business Side
  - Create Opportunities / Revenue
  - Resolution
  - Minimize Risk & Disruption



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## Title search: Creative Ways to Resolve Disputes Between PTAB and District Courts

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

"Creative Ways to Resolve Disputes Between PTAB and District Courts"