

Strategic Advantages and Disadvantages of Post Grant Review

Danielle J. (“DJ”) Healey
Partner IP Litigation
Spencer Fane LLP
Austin and Houston
dhealey@spencerfane.com
713.385.6566

1

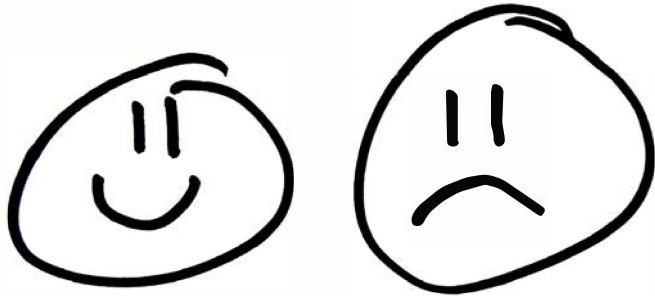
First a disclaimer....

- Slides and talk are for discussion and promotion of ideas among lawyers, they are not representations of how the law should apply in a specific case.
- Slides and talk are not my opinions, or those of my firm or my clients – they are ideas to promote professional growth.
- Nothing in these slides or talk forms an attorney client relationship or is legal advice – **BECAUSE LEGAL ADVICE COSTS MONEY!!!** (*But is well-worth the expense*)

2

Estoppel: Think before you file...

- What is the biggest ramification of an IPR/PGR filing on trial?
- **The STAY**



XXXXXXXXXX

3

3

IPR is best forum for printed publication prior art

- Printed publication prior art is not typically “jury friendly”.
 - Often patents, highly technical documents which jurors and courts must struggle...
 - Require experts to map text at a point in trial where nerves/attention are thin.
 - Conflicting expert declarations make SJ hard and rare.
- Jury friendly prior art such as a prior device or testimony on a method/system remain for trial.
- There is a lack of clarity over when and how other art can be used at trial in combination with a publication (e.g. device and a manual?)

4

IPR is best forum for printed publication prior art

- There is nothing to lose in filing an IPR in terms of giving up jury unfriendly prior art.
- But the *Sotera* stipulation is something of a double-edge sword because of lack of clarity on limits of using a combination of prior art that includes a printed publication.
- The *Sotera* stipulation has to be considered in light of not just *Fintiv*, and *efficiency in a motion to stay*, but *specific prior art combinations that may be precluded at trial*.

But What About Combinations of Art?

Do combinations of published and unpublished materials survive IPR estoppel for trial? UNCLEAR!!!

Google is estopped from using patents and printed publications ... That bar applies whether the patents and printed publications are offered as stand-alone evidence, or in combination with other evidence that could not have been presented at the IPR proceeding. It may not offer that evidence directly (that is, it may not put those patents and publications in evidence). And it may not do indirectly what it cannot do directly [e.g. expert testimony] ... It may, however, generally present other forms of evidence of prior-art systems to support its invalidity claims.

Singular Computing LLC v. Google LLC, --- F.Supp.3d ----, 2023 WL 2839282 (D. Mass. 2023)

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: Strategic Advantages and Disadvantages of Post Grant Review

Also available as part of the eCourse

[2023 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the
28th Annual Advanced Patent Law Institute session

"Strategic Advantages and Disadvantages of Post Grant Review"