



# 2021 PTAB Bar Association Annual Conference

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## **Master Class**

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# Pre-Conference Session Master Class

September 22, 2021

**Panel #1: The Trial**  
**(1:00PM – 2:00PM)**

**Panel #2: The Aftermath**  
**(2:15PM – 3:15PM)**

PLEASE NOTE: This presentation reflects only the present personal considerations, opinions, and/or views of the moderators and panelists, which should not be attributed to any of the moderators' or panelists' current or prior employer(s), including law firm(s) or agency(ies), or former or present clients.

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# **Master Class - Panel 1**

## **The Trial**

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**Panel #1: The Trial**  
**(1:00PM – 2:00PM)**

**Panelists:**

Lori Gordon (Perkins Coie)

Joe Palys (Paul Hastings)

Lisa Mandrusiak (Roku)

Thomas Giannetti (PTAB)

An AIA trial should not be viewed in isolation. A co-pending litigation and the AIA trial are part of a coordinated litigation strategy where each forum presents an opportunity for both parties to improve its overall position. This panel will discuss how the parties can leverage timing to their respective benefit as well as how practical considerations can be the difference between success and failure.

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***Fintiv* Update / Interplay with Co-Pending Litigation**  
**Panel 1 – The Trial**

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## **POLL QUESTION #1**

**If *Fintiv* Factor 2—earlier trial date—weighs in favor of discretionary denial, which of the following other *Fintiv* Factors is most likely to overcome the *Fintiv* bar?**

- Factor 1: A stay has been requested but not yet issued in the parallel proceeding.
- Factor 3: The parallel proceeding is in its early phases.
- Factor 4: Stipulation is made not to pursue the same grounds in the parallel proceeding.

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# **Parallel Petitions**

## **Panel 1 – The Trial**

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## **POLL QUESTION #2**

**One Petitioner files a first IPR petition. A few months later, a second Petitioner files a “follow on” IPR petition challenging claims of the same patent. What type of relationship between the two Petitioners is most likely to convince the PTAB to deny the “follow on” petition?**

- Supplier-Customer.
- Licensor-Licensee.
- Consolidated district court cases.



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# ***Arthrex* Decision and Director Review**

## **Panel 1 – The Trial**

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### **POLL QUESTION #3**

**If you received a FWD that misapplied the law, but one dissenting APJ agreed with your position on how the law should be applied, would you:**

- File a Request for Rehearing.
- File a Request for Director review.
- Immediately file a notice of appeal to the Federal Circuit.

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# **Impact of COVID-19 on PTAB Trial Practice**

## **Panel 1 – The Trial**

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# **Master Class - Panel 2**

## **The Aftermath**

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**Panel #2: The Aftermath**  
**(2:15PM – 3:15PM)**

**Panelists:**

Monica Grewal (WilmerHale)

Dan Girdwood (Samsung)

Lauren Degnan (Fish & Richardson)

Michelle Ankenbrand (PTAB)

The fight does not end with a PTAB FWD. Estoppel and follow-on challenges to other claims present a fertile area for parties to improve their overall litigation positions. Limits on appeals, as well as practical appeal strategies, can further impact the overall value that an AIA trial can bring to the table. This panel will discuss how real-world circumstances can either increase or limit the value of an AIA trial, even one that is successful.

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# **Appeal: Rehearing Request**

## **Panel 2 – The Aftermath**

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## **POLL QUESTION #4**

**The PTAB finds that Petitioner has failed to show that the prior art discloses all elements of the challenged claims. Do you:**

- File a Request for Rehearing.
- File a Request for Director review.
- Immediately file a notice of appeal to the Federal Circuit.

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# **Appeal: Dealing with Multiple Forums**

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# **Appeal: Appeal to the Federal Circuit**

## **Panel 2 – The Aftermath**

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## **POLL QUESTION #5**

**What issues on appeal seem to get the best results for the appellant?**

- Lack of substantial evidence on merits.
- Legal error on merits.
- Claim construction.
- Administrative law issues, e.g., due process.

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# **Dealing with Denial**

## **Panel 2 – The Aftermath**

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## **POLL QUESTION #6**

**How often do you seek *ex parte* reexamination upon denial of IPR institution?**

- Frequently.
- Sometimes but not routinely.
- Never.

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# **IPR/PGR Estoppel Update**

## **Panel 2 – The Aftermath**

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## **POLL QUESTION #7**

**What is the most common ground you have seen or pursued in a PGR, as opposed to IPR?**

- Section 101.
- Section 112.
- Public Use / On Sale.

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**THANK YOU**

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