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5 KEY TAKEAWAYS

Litigating in Parallel with the PTAB: Do's and Don'ts for Concurrent ITC and District Court Litigation

With the same claim construction standards now applied across all forums, what pitfalls await an unsuspecting petitioner or Patent Owner? Kilpatrick Townsend's Aarti Shah joined other distinguished panelists discussing leveraging parallel records before the agency, motions to stay, judicial estoppel, and issue preclusion along with best practices for fighting on two fronts. The event, "Litigating in Parallel with the PTAB: Do's and Don'ts for Concurrent ITC and District Court Litigation," was presented by *IP Watchdog*.

Ms. Shah provides five key takeaways from the discussion:

1. There are multiple benefits for ITC respondents to filing an IPR, even if the IPR will not reach Final Written Decision prior to the ITC's decision, including possible suspension of the exclusion order pending appeal of the Final Written Decision.

2. When there are parallel ITC investigations and IPRs, parties often make inconsistent statements or admissions that can be leveraged by opposing counsel in the other proceeding. To avoid this, it is essential that IPR counsel and ITC counsel, particularly those addressing invalidity, work closely together.

3. It is also essential for respondents to move with speed, as in all things ITC — do not delay in selecting counsel or filing an IPR. Filing later reduces the possible benefits of filing the IPR.

4. If an ITC respondent is estopped from raising certain prior art due to an IPR, OUII Staff may be able to raise and assert the prior art in the ITC proceeding.

5. The ITC has not yet stayed a case due to an instituted IPR, and it is unlikely they will do so in the future given their statutory mandate to complete investigations in 16 months.

For more information, please contact:
Aarti Shah: ashah@kilpatricktownsend.com

www.kilpatricktownsend.com

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Aarti Shah
t 202.481.9937
ashah@ktslaw.com