



**PANITCH TRAINING ACADEMY**  
Insights From Leaders In IP Law

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Training Academy Session #6

# U.S. Patent Litigation

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## Session Overview

1. Overview of the process and timing of U.S. patent litigation (Slides 3-8)
2. Jurisdiction and venue considerations (Slides 9-14)
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# 1. Overview of the process and timing of U.S. patent litigation

- U.S. District Court actions
  - Patent infringement
  - Declaratory judgment actions (alleged infringer's action for non-infringement or invalidity)
- International Trade Commission (action for exclusion order)
- Patent and Trademark Office (post-grant proceedings)
- Non-judicial fora
  - Arbitration (AAA, IAA, etc.)
  - Private (Amazon)

# 1. Overview of the process and timing of U.S. patent litigation

- Patent owner
  - Close review of the patent and claims
  - Assure ownership of patent (i.e., standing)
  - Review of the prosecution history
  - Review of known prior art
  - Analysis of infringing conduct
    - Courts look to accessibility of information
    - Require close analysis if accessible
    - Allow “information and belief” if “black box” or “behind closed doors” technology

# 1. Overview of the process and timing of U.S. patent litigation

- Patent owner generally chooses forum
  - Some US courts known for speed (Eastern District of Virginia, Western District of Wisconsin)
  - Some US courts known for pro-plaintiff awards (Eastern and Western District of Texas)
  - 14 districts designated “Patent Pilot Project”
  - Many districts have detailed local patent rules

# 1. Overview of the process and timing of U.S. patent litigation

- Patent owner should place rights with practicing entity if maximizing damages is a goal
- Patent owner should seek experts in advance

# 1. Overview of the process and timing of U.S. patent litigation

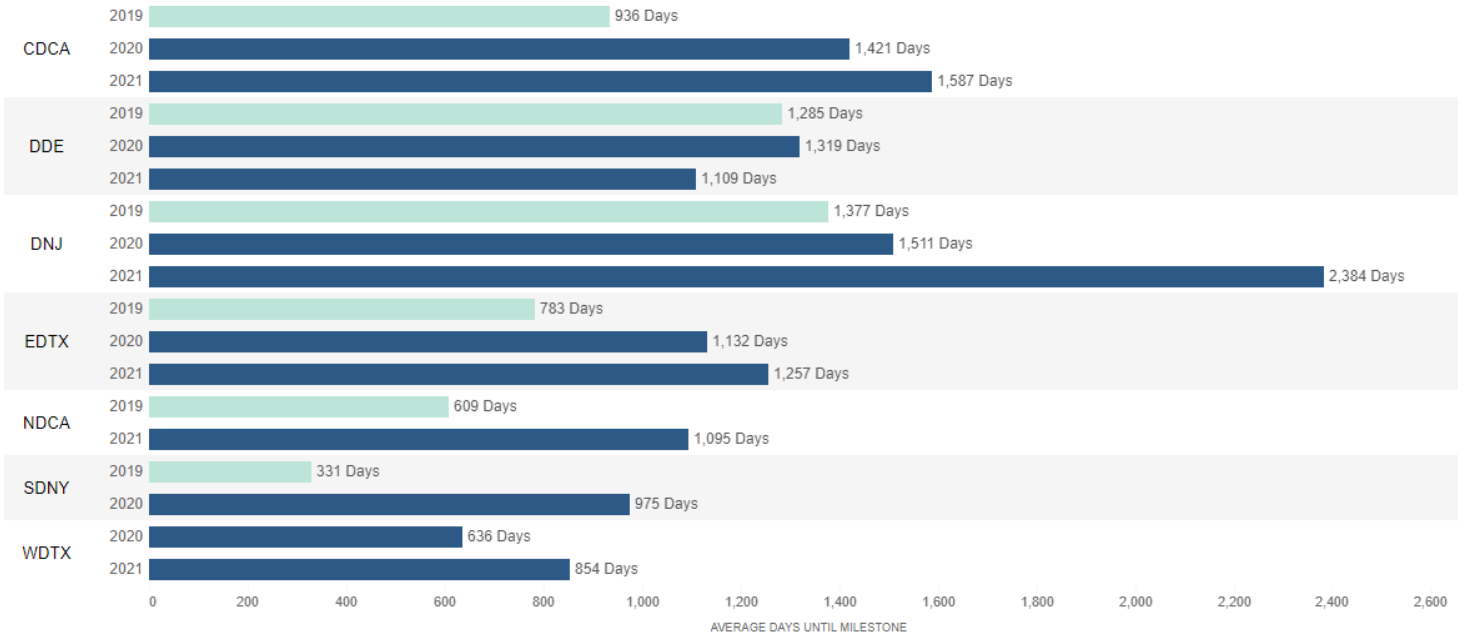
- Alleged infringer
  - Market participant may launch product/use method
    - Freedom to operate opinions
    - Possible notice of patent through marking
    - Possible notice via patent owner pursuit of customers
  - Like patent owner
    - Analyze patent and prosecution history
    - Determine close prior art
  - Get expert(s)

# 1. Overview of the process and timing of U.S. patent litigation

- Timing depends on forum (source Docket Navigator)

## Time to Trials

This chart shows how quickly Patent Cases reach the selected Milestones when litigated before the selected courts. Hover over the chart to see average statistics.





## 2. Jurisdiction and venue concerns

- Jurisdiction
  - 28 U.S.C. §§ 1331
    - The district courts shall have original jurisdiction of all civil actions arising under the **Constitution**, laws, or treaties of the United States.
  - 28 U.S.C. §1338(a)
    - The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to **patents...**
  - 28 U.S.C. §1367
    - Supplemental jurisdiction

## 2. Jurisdiction and venue concerns

- Venue
  - 28 U.S. Code § 1400(b)
    - Any civil action for patent infringement may be brought in the judicial district **where the defendant resides**, or **where the defendant has committed acts of infringement** and has a **regular and established place of business**.
  - *TC Heartland LLC v. Kraft Foods Group Brands LLC* (U.S. 2017)
    - patent infringement cases must be heard in the district within which the defendant is **incorporated**

## 2. Jurisdiction and venue concerns

- International Trade Commission (ITC)
  - Section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337)
  - In rem jurisdiction over products imported into the U.S. (or exported to the U.S.)
  - Jurisdiction extends to “any case in which ‘some nexus’ is found between the activities of the respondent and a jurisdictional element of section 337(a)(1).” *Certain Intraoral Scanner and Related Hardware and Software*, Inv. No. 337-TA-1091, Init. Det. (Apr. 26, 2019)

## 2. Jurisdiction and venue concerns

- Local Patent Rules
  - Initial disclosure of technical information and sales
  - Disclosure of contentions
    - Infringement
    - Invalidity
    - Document production for contentions
  - Claim construction
    - Exchange of terms
    - Exchange of proposed constructions
    - Joint claim construction
  - Limitations on number of claims and/or invalidity references

## 2. Jurisdiction and venue concerns

- Choosing a Jurisdiction
  - Western District of Texas (24%)
  - District of Delaware (22%)
  - Eastern District of Texas (11%)
  - Central District of California (6%)
  - Northern District of California (4%)

*[2021 Year in Review, Docket Navigator]*

## 2. Jurisdiction and venue concerns

- Venue Transfer
  - *In re Juniper Networks, Inc.*, Case No. 21-160 (Fed. Cir. 2021)
    - Found clear error in not transferring from WDTX to NDCA
    - motion to transfer under § 1404(a) should be granted if “the movant demonstrates that the transferee venue is clearly more convenient.”

## 3. Complaints, defenses, and preliminary motions

- Patent Owner Pre-Litigation Investigation
  - Ownership of Patent
    - Assignments
    - Entity that Owns the Patent - Damages
  - Investigate Payment of Maint. Fees & Term of Patent
  - Marking – Your Products and Licensees
  - Identify Infringer and Infringing Products/Methods
  - Calculate the Amount of Potential Damages and Damage Theories
  - Identify and Engage Expert(s) Early
  - Validity Searching
    - Outside the US, depending on Technology
    - Non-Patent Literature Searching
  - Purchase Infringing Product and Gather Infringement Evidence
  - Detailed Review of Asserted Patent File History
  - Prepare Detailed Claim Chart
  - Infringer's patents or potential counterclaims

## 3. Complaints, defenses, and preliminary motions

- Accused Infringer Pre-Litigation Investigation
  - Monitor Competitor and/or Industry Patent Activity with an Automatic Patent Watch
    - Competitor Assignee(s)
    - Technology Area
    - Inventor(s)
    - Beware “Electronic” Mail
  - Conduct Patent Searches for New Products/Methods and Product/Method Redesigns
    - Non-Infringement and Invalidity Opinions
    - Redesign Product/Method Based on Potential Infringement
  - Monitor Industry Patent Litigation for Non-Practicing Entity Activity



## 3. Complaints, defenses, and preliminary motions

- Patent Infringement Complaint (FRCP 8(a)):
  - a short and plain statement of the grounds for the court's jurisdiction;
  - a short and plain statement of the claim showing that the patent owner is entitled to relief;
    - Claim Chart
  - a demand for the relief sought, which may include relief in the alternative or different types of relief
- Common Patent Infringement Complaint Elements
  - Nature of the Action – Infringement of US Patent
  - Parties – Identification of Patent Owner and Accused Infringer
  - Jurisdiction and Venue
  - Facts – Patent
  - Patent Infringement Count(s) – Claim Chart
  - Prayer for Relief – Injunction/Damages

## 3. Complaints, defenses, and preliminary motions

- Direct Patent Infringement
  - Whoever makes, uses, offers to sell or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent. (35 U.S.C. § 271(a))
  - Using, selling, offering for sale or importing a product made by a process patented in the United States. (35 U.S.C. § 271(g))
  - Exporting non-patented components for combination outside the U.S. which, if combined in the U.S., would infringe ( 35 U.S.C. § 271(f))
  - Specialized direct infringement – Hatch-Waxman and BPCIA
  - Divided direct infringement liability arises where joint actors infringe

## 3. Complaints, defenses, and preliminary motions

- Indirect Patent Infringement
  - Inducement to Infringe (35 U.S.C. § 271(b))
    - Whoever actively induces infringement of a patent shall be liable as an infringer
    - Must be direct infringement and infringer encourages, aids, or otherwise causes another person to infringe a patent
  - Contributory Infringement (35 U.S.C. § 271(c))
    - Whoever sells or imports a component for use in practicing a patented process knowing the same to be especially made or adapted for an infringement of a patent
- Patent owner bears burden of proving infringement by a ***preponderance of the evidence***

## 3. Complaints, defenses, and preliminary motions

- Defenses to patent infringement
  - Patents are presumed valid (35 U.S.C. § 282)
  - Burden on the alleged infringer under the ***clear and convincing standard***
  - Major defenses:
    - Noninfringement
    - Unpatentable subject matter (§ 101)
    - Lack of novelty/anticipation (§ 102)
    - Obviousness (§ 103)
    - Failures of the specification (§ 112)
      - Lack of enablement
      - Failure of written description
      - Indefiniteness
      - Improper dependent claiming
    - Unenforceability defenses such as inequitable conduct and patent misuse

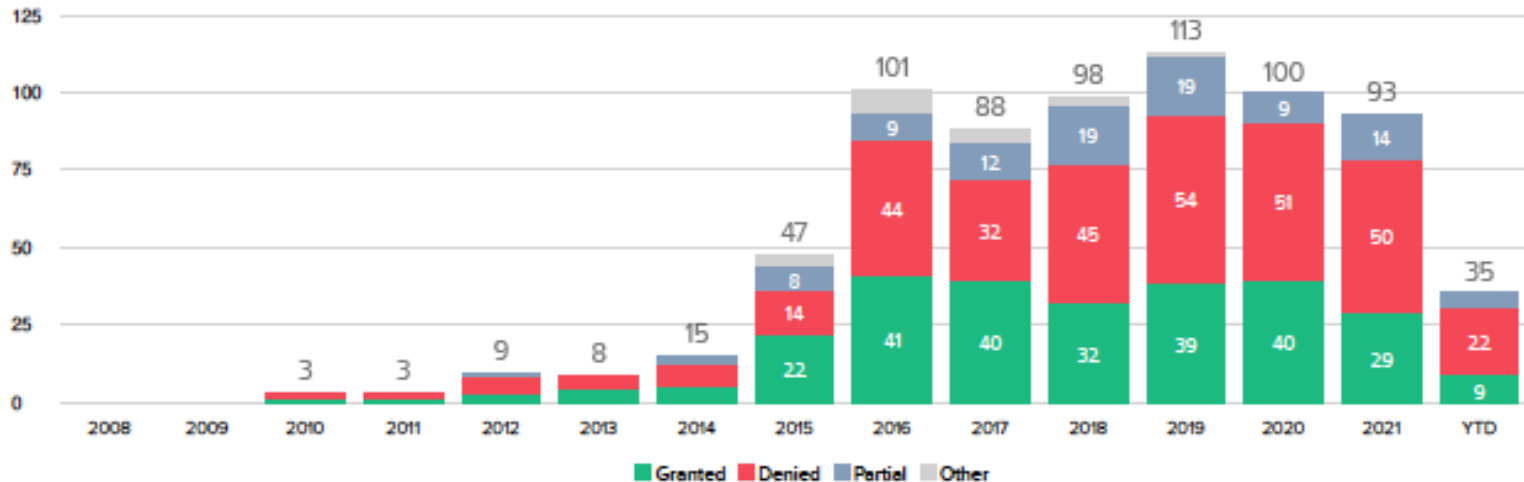
## 3. Complaints, defenses, and preliminary motions

- Motions to Dismiss a Complaint FRCP 12
  - 1) Lack of subject-matter jurisdiction;
  - 2) Lack of personal jurisdiction;
  - 3) Improper venue;
  - 4) Insufficient process;
  - 5) Insufficient service of process;
  - 6) Failure to state a claim upon which relief can be granted; and
  - 7) Failure to join a necessary party
- FRCP 12(b)(6) Motions are the most Common:
  - Does the Complaint make a facially plausible – not probable – claim for relief
  - Does the Complaint plausibly indicate that the accused product(s) meets each of the claim limitations – claim chart

## 3. Complaints, defenses, and preliminary motions

- Motions to Dismiss § 101 – Non-Patentable Subject Matter

Motion Success by Year



- Alice v CLS Bank decided June 19, 2014
- Success varies based on District Court Location – CA, TX & DE

(Source: Docket Navigator)

## 3. Complaints, defenses, and preliminary motions

- Motions to Dismiss – 35 U.S.C. § 101
  - Delaware District Court Section 101 Days
    - Important Claims;
    - Need for Claim Construction;
    - Factual Disputes?;
    - Extrinsic Evidence;
    - Applicable Precedent;
    - Whether to Push the Decision to Summary Judgment.
- Section 101 Days Initiated by Judges Stark and Burke
  - Judge Stark recently elevated to US Court of Appeals for the Federal Circuit
  - Judges Noreika and Burke remain at the Delaware District Court and will presumably retain Section 101 Days

## 3. Complaints, defenses, and preliminary motions

- Motion for Preliminary Injunction
  - Patent Cases typically take years to litigate through trial and judgment
  - Preliminary Injunction Motion Factors:
    - Patent Owner’s likelihood of success on the merits
    - Immediate irreparable harm
    - Balance of Hardships favors the patent owner
    - Public Interest is not harmed if a preliminary injunction is granted
- Patent Owner must balance the benefits of success versus the harm of denial before file a preliminary injunction motion.



## 4. Interplay with PTAB proceedings

- Patent validity challenges can be brought at the PTAB based on patents and printed publications
  - IPRs allow 102/103 challenges
  - PGRs allow 102/103/112 challenges
- PTAB challenges are an attractive option to accused infringers because of lower burden and limited discovery
  - PTAB *preponderance* standard lighter than DCT *clear and convincing evidence* standard
  - No presumption of validity at the PTAB
  - PTAB generally cheaper because of limited discovery
- PTAB and DCT actions can proceed in parallel unless DCT is stayed, or PTAB is discretionarily denied

## 4. Interplay with PTAB proceedings

- DCT Stays

- Court look at equitable factors in deciding whether to stay case
- Inherent DCT power to manage its own docket
- Accused infringer / petitioner typically informs DCT about PTAB petition or intent to file petition
- District court will likely want to know:
  - Whether all asserted claims are involved
  - Whether all codefendants have joined or will join the PTAB proceedings and, if not, whether they at least agree to be estopped
  - Whether the parties agree that a stay of the district court proceeding is in the interests of both parties
- Stay more likely after PTAB institutes the proceeding
- Stays are very rare in Hatch-Waxman (pharma) litigation, more common elsewhere

## 4. Interplay with PTAB proceedings

- PTAB Discretionary denial
  - PTAB *may* deny institution of petition if DCT (or other forum, e.g., ITC) will reach a decision sooner
  - Governed by ***Fintiv*** factors (PTAB precedential decision):
    1. DCT action stayed or likely to be stayed
    2. DCT trial date vs. PTAB statutory deadline
    3. Investment in DCT proceeding (discovery, claim construction, etc.)
    4. Overlap of issues (grounds, claims, arguments)
    5. Overlap of parties
    6. Other circumstances (merits of case)
  - Discretionary denials have increased over the years

## 4. Interplay with PTAB proceedings

### **35 U.S.C. 315(e) ESTOPPEL.—**

(2) Civil actions and other proceedings.— The petitioner in an inter partes review ... that **results in a final written decision** ... or the real party in interest or privy of the petitioner, may not assert either in a **civil action** ... or in a proceeding before the **International Trade Commission** ... that the claim is invalid on any ground that the petitioner **raised or reasonably could have raised** during that inter partes review.

- “estoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all **grounds not stated in the petition** but which reasonably could have been included against the claims included.”

*Calif. Inst. of Tech. v. Broadcom Ltd.*, 2020-2222 (Fed. Cir. Feb. 4, 2022) overruling *Shaw Indus. Grp. v. Automated Creel Sys.*, 817 F.3d 1293, 1296 (Fed. Cir. 2016).

## 4. Interplay with PTAB proceedings

### • **Protective Orders and Discovery**

- Similar to DCT, the PTAB requires a PO for confidential discovery
- PTAB Trial Practice Guide has default PO
- In parallel proceedings, some DCT discovery can be brought into PTAB as routine or additional discovery
  - e.g., as evidence of “inconsistent statements”
  - but patent owner would argue that petitioner’s case is weak because it needs to rely on more than just patents and publications to show invalidity
- Managing parallel proceedings may involve dueling discovery, multiple experts, different claim constructions, updating invalidity contentions to match PTAB arguments, etc.

## 5. Discovery

- Broad discovery rights in district court (and ITC)
  - Information relevant to any party's claim or defense and proportional to the needs of the case
- Initial disclosures (witnesses, document sources, initial damages calculation, applicable insurance)
- Discovery tools
  - Document requests (Rule 34)
  - Interrogatories (i.e., written questions) (Rule 33)
  - Requests to admit (Rule 36)
  - Depositions (oral testimony) (Rule 30)
- Document holds must be put in place
- Subpoenas to take discovery of third parties – testimony and documents

## 5. Discovery

- Expensive
  - Often the most expensive part of a patent litigation
  - Paper documents
  - Electronically stored information
- Proportionality arguments very important

## 5. Discovery

- Document requests or requests for production, discovery of things, inspection
  - Paper documents
  - Electronically stored information
  - Emails, texts
  - Things
  - Inspections (e.g., for methods)
  - Directed to information relevant to a party's claims or defenses



## 5. Discovery

- Interrogatories
  - Written questions to parties
  - Interrogatories seeking factual and support for claims or defenses
  - Seeking witnesses
  - Seeking claims construction
  - Duty to supplement runs throughout the litigation

## 5. Discovery

- Requests for Admissions
  - Elicit responses regarding fact issues that a party seeks for the party's claims or defenses
  - An admission acts as proof of the fact for purposes of the case
  - Can be used with documents – to admit that they are authentic and/or business records

## 5. Discovery

- Depositions of parties (and subpoenaed testimony of non-parties)
  - Live testimony “as if” before the Court
  - Allows attorney to investigate and explore memory and refresh memory
  - Usually after documents produced
  - Useful for eventual cross-examination at trial
- Rule 30(b)(6) deposition
  - Company designates individual(s) to respond for the company as admissions
  - Duty to prepare rests on party to ensure representative has the company’s knowledge

## 5. Discovery

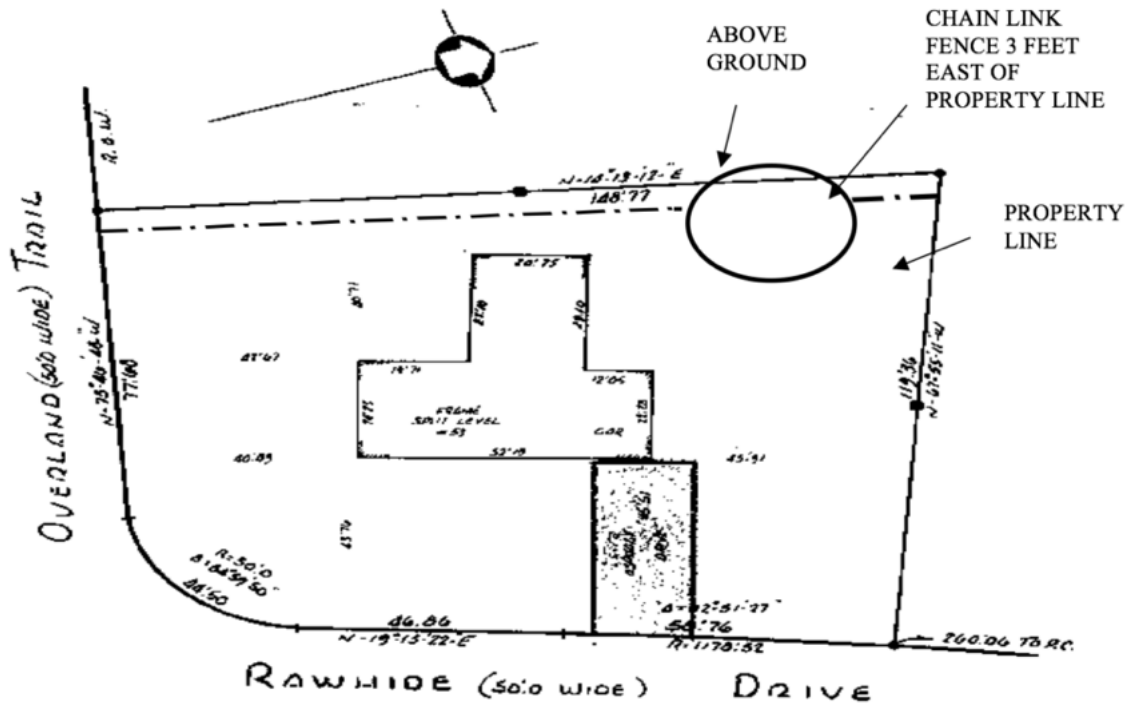
- Confidentiality protections
  - Protective orders or Discovery confidentiality orders
  - Tailored to the needs of the case
  - Many jurisdictions have model orders
  - Prosecution bars to protect highly confidential materials from influencing future prosecution

## 6. Claim Construction

- Claim Construction is a fundamental issue in patent infringement litigation. The Court must determine the scope and meaning of the claims of the patent and the meaning of any words, terms or phrases disputed by the Patent Owner and the Accused Infringer must be construed by the Court.
- The Supreme Court in *Markman v Westview Instruments* 517 U.S. 370 (1996) determined claim construction is a question of law reserved for the Court, not a question of fact left to the factfinder.

## 6. Claim Construction

- The claims determine the scope of a patent, much like a description in a deed for real property



## 6. Claim Construction

- Claims are Interpreted Under the Phillips Standard (*Phillips v. AWH Corp.*, 415 F.3d 1303 (2005))
  - Claims should be given their ordinary meaning in the context of the four corners of the patent, as interpreted by a person of ordinary skill in the art to which the patent pertains.
  - Heavy reliance on Intrinsic Record:
    - Claim Language;
    - Patent Specification;
    - File History; and
    - Patentee Acting as Own Lexicographer.
  - May also look to Extrinsic Evidence:
    - Dictionaries;
    - Declarations; and
    - Testimony.

## 6. Claim Construction

- Claim Construction often involves a technology tutorial for the judge
  - Written submissions from the Patentee and Accused Infringer;
  - Video submissions to the Court from both parties or an agreed submission;
  - Live Testimony from Inventors/Experts or one having ordinary skill in the art to explain the technology at issue to the judge.



## 6. Claim Construction

- Courts may have specific timing and procedures for Claim Construction:
  - Parties Exchange terms/phrases potentially in dispute;
  - Parties meet and confer to agree/identify disputes;
  - Terms in dispute and constructions are submitted to Court
  - Court may intervene to:
    - Limit the number terms/phrases in dispute;
    - Limit the number of claims that may be asserted;
    - Focus disputes on exemplary claims or products; and
    - Otherwise limit disputes and complication.
  - Disputed Claim Terms remaining are Briefed for a Markman Hearing

## 6. Claim Construction

- Canons of Claim Construction
  - Claims must be construed at the time of the invention;
  - Terms/phrases are construed to have their “ordinary meaning”;
  - Intrinsic evidence is of primary importance – patent & file history;
  - Extrinsic evidence, such as dictionaries, treatises and encyclopedias may be utilized for construction;
  - Extrinsic evidence, such as uncited prior art and expert testimony may also be considered;
  - Claim differentiation applies presuming a different meaning and scope when different words are used in separate claims;
  - Limitations from the specification are not read into the claims;
  - Claims may not be construed to read limitations out of the claims;
  - Claims should be construed to cover preferred embodiments;
  - Claims should be interpreted to maintain validity;
  - Dependent claims have a narrower scope than independent.

## 6. Claim Construction

- Potential Claim Construction Briefing Process:
  - Patent Owner Opening Claim Construction Brief;
  - Accused Infringer Answering Claim Construction Brief;
  - Patent Owner Reply Brief;
  - Accused Infringer Sur-Reply Brief;
  - Joint Claim Construction Brief Filed with Court.
- Markman or Claim Construction Hearing
  - Argument in Court regarding Disputed terms;
  - May include expert testimony;
  - Court may decide some disputes based on briefing and hear argument on other disputed terms/phrases;
  - Claim Construction Order provides definitions for terms/phrases;

## 7. Experts

- Fed. Rule of Evidence 702

A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if:

**(a)** the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue...

## 7. Experts

- Expert Disclosures
  - Protective order normally provides for exchange of information on experts for **conflicts**
    - Prior cases
    - Prior publications
    - Prior testimony
  - Agree to be bound by the protective order
  - Prosecution bar

## 7. Experts

- Selecting Experts
  - Expert witness search firms
  - Professional testifying expert v. expert in the field
    - Report writing experience
    - Deposition experience
    - Trial testimony experience
    - Patent infringement experience
    - Any Daubert issues in prior cases

## 7. Experts

- Technical Experts
  - Person of ordinary skill in the Art (POSITA)
    - Level of ordinary skill for the case
  - Infringement / non-infringement
  - Invalidity / rebuttal
    - Secondary considerations of non-obviousness
- Damages Experts
  - Accountant or economist
  - Support team
  - Assumes liability

## 7. Experts

- Types of Damages
  - Reasonable royalty (35 U.S.C. § 284)
    - *Georgia Pacific* Factors
    - hypothetical negotiation
  - Lost Profits
    - Non-infringing substitutes
  - Price Erosion
  - Convoyed Sales
  - Disgorgement of profits in design patent cases
    - Everybody in the chain of distribution



## 7. Experts

- *Daubert* Motions
  - Motions to strike or limit testimony
  - Judge acts as the “gatekeeper”
  - Whether the testimony is based on scientifically valid reasoning
  - Whether it has attracted widespread acceptance within a relevant scientific community

## 8. Trial/hearing and relief

- Trial: the culmination of district court patent litigation
- Patent claims are typically tried to a jury, with issues of law reserved to the court
- Jury panel may be from 6 to 12 people with no special training
- Jury is empaneled by the court after *voir dire* (questions to investigate possible bias)
- Bench trials are the rule for Hatch Waxman generic drug litigations and other actions in which only injunctive relief is sought

## 8. Trial/hearing and relief

- Opening statements
  - Opportunity for lawyers to influence the jury
  - Provide an outline of the case and the evidence
  - Provide a theme
- Direct case
  - Affirmative evidence/testimony to support position
- At end of direct case, defending party may move for directed verdict if claimant failed to support its case
  - Removes the case from the jury

## 8. Trial/hearing and relief

- Defensive case
  - Party opposing claim may present evidence in defense
- Charging conference
  - Parties and court deliberate on the instructions the court will read to the jury
- Closing arguments
  - Last opportunity for the lawyers to present the evidence
  - Emphasize the theme
  - Demonstrate how the evidence supports the party's position
- Jury instruction (“charging the jury”)
- Jury deliberation and verdict

## 8. Trial/hearing and relief

- Damages (35 U.S.C. § § 284, 286)
  - Lost profits, reasonable royalty, price diminution, etc.
  - Limited to six years prior to notice or filing of complaint
- Injunctive relief (35 U.S.C. § 283)
  - Court decides whether to impose injunction based on traditional four-factor test (*eBay, Inc. v. MercExchange LLC*, 547 U.S. 388 (2006))
- Willfulness (35 U.S.C. § 284) (*Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S.Ct. 1923 (2016))
  - Discretionary and generally reserved for egregious cases of culpable behavior under a preponderance standard
- Exceptional case awards (35 U.S.C. § 285) (*Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545 (2014))
  - Discretionary and based on whether the case “is one that stands out from the others with respect to the substantive strength of a party’s litigating position (considering the law and the facts) or the manner in which the case was litigated

## 9. Post-trial papers and appeals

- Post-trial papers are typically made to seek a directed verdict and/or to preserve issues for appeal
  - Papers will reference the trial record including witness/expert testimony and exhibits entered into evidence
  - Focus on key issues from the trial
- **Motion for judgment as a matter of law (JMOL) – Rule 50**
  - Made after a party has been fully heard
  - Standard - reasonable jury would not have a legally sufficient evidentiary basis to find for the party
  - Can renew the motion after trial to set aside jury verdict
- In bench trials, courts often require **proposed findings of fact and conclusions of law**
  - No jury, so judge is the fact finder

## 9. Post-trial papers and appeals

- DCT must set out most judgments in a **separate document** (FRCP 58)
- **Entry of judgment triggers the time to appeal**
  - Notice of Appeal due **30 days** from entry of judgment or order being appealed from (FRAP 4)
- **Interlocutory appeals**
  - Immediate appeals permitted for orders on injunctive relief, patent infringement decisions that are final but for an accounting, etc. (28 U.S.C. § 1292)
  - When an order resolves less than all claims/issues/parties, the DCT can direct entry of judgment by certifying there is no just reason to delay – allows for appeal (FRCP 54(b))

## 9. Post-trial papers and appeals

- Federal Circuit has exclusive jurisdiction for appeals “arising under” the patent laws
- Standards of Review:
  1. **De novo review** (no deference to lower court) on questions of law
  2. “**Clearly erroneous**” standard when DCT judge finds facts (bench trial)
    - entire record leaves the reviewing court with a definite and firm conviction that a mistake was made
  3. “**Substantial evidence**” standard for jury and PTAB factual findings
    - such relevant evidence as a reasonable mind might accept as adequate to support a conclusion
  4. “**Abuse of discretion**” for equitable rulings by lower court

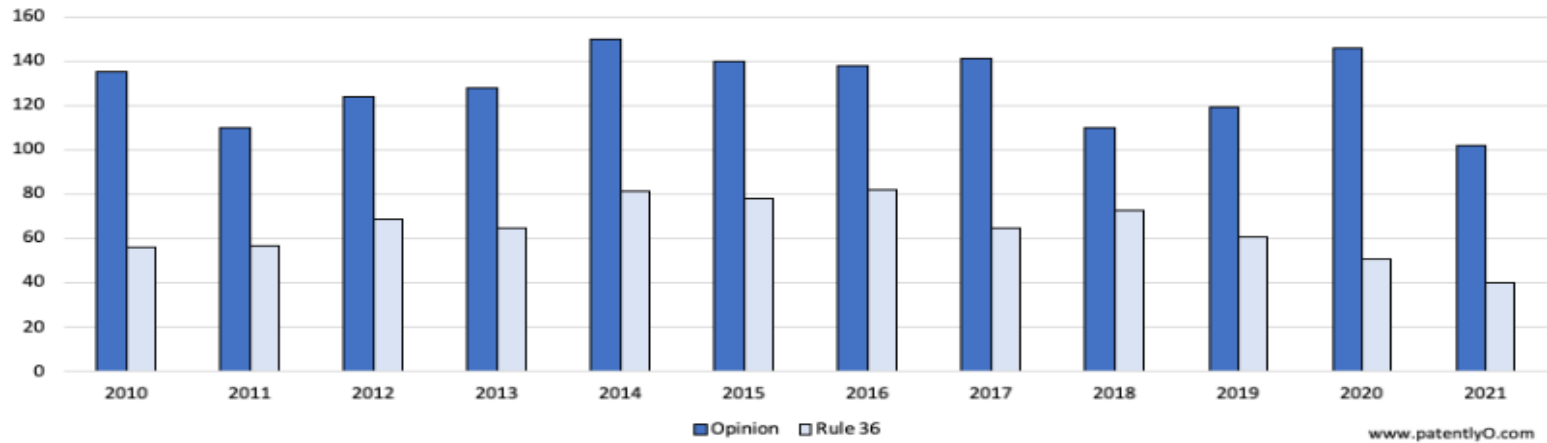


## 9. Post-trial papers and appeals

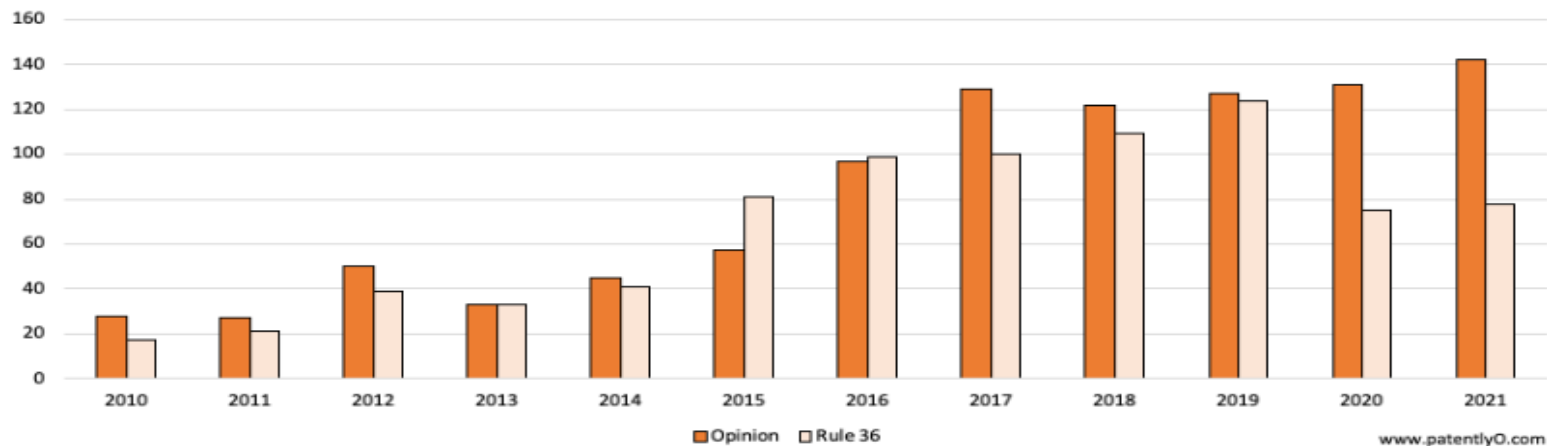
- Federal Circuit may affirm a decision without an opinion – “Rule 36” affirmances – done more frequently for appeals from PTAB
  - Use of Rule 36 affirmances is dropping – from almost 50% of PTAB decisions in 2019 to around 35% in 2021

## 9. Post-trial papers and appeals

**Federal Circuit Opinions and Rule 36 Summary Affirmances in Appeals Arising from the District Courts, 2010-2021**



**Federal Circuit Opinions and Rule 36 Summary Affirmances in Appeals Arising from the USPTO, 2010-2021**

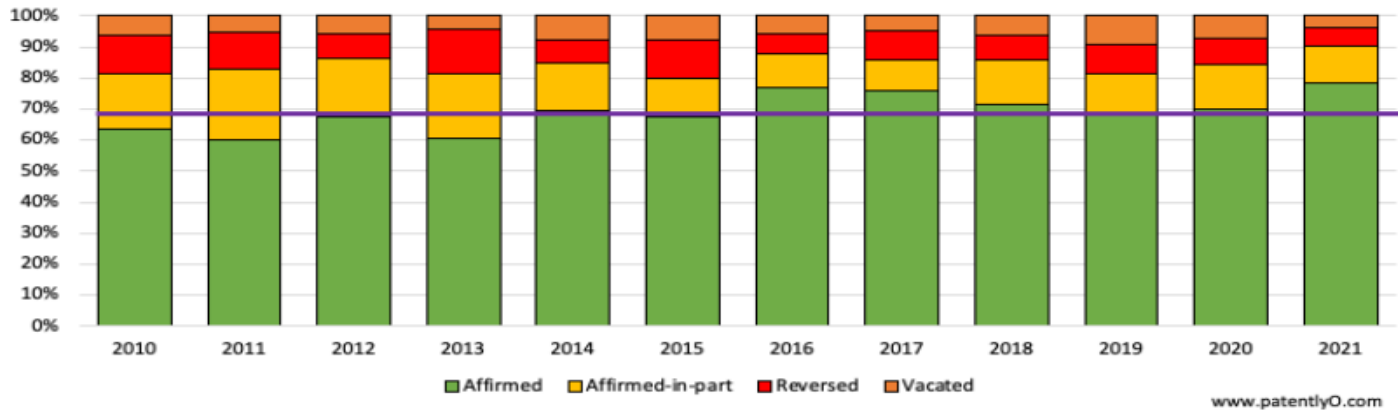


## 9. Post-trial papers and appeals

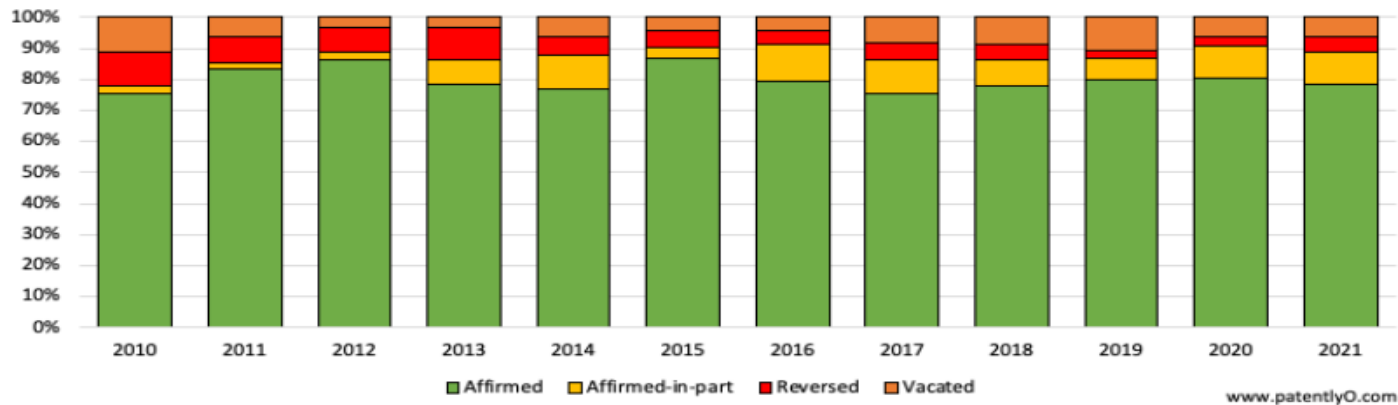
- Affirmance Rates at the Federal Circuit:
  - PTAB affirmed ~80% of the time, affirmed-in-part ~7%
  - DCTs affirmed ~70% of the time, affirmed-in-part ~13%

## 9. Post-trial papers and appeals

**General Dispositions by the Federal Circuit in Appeals Arising from the District Courts**

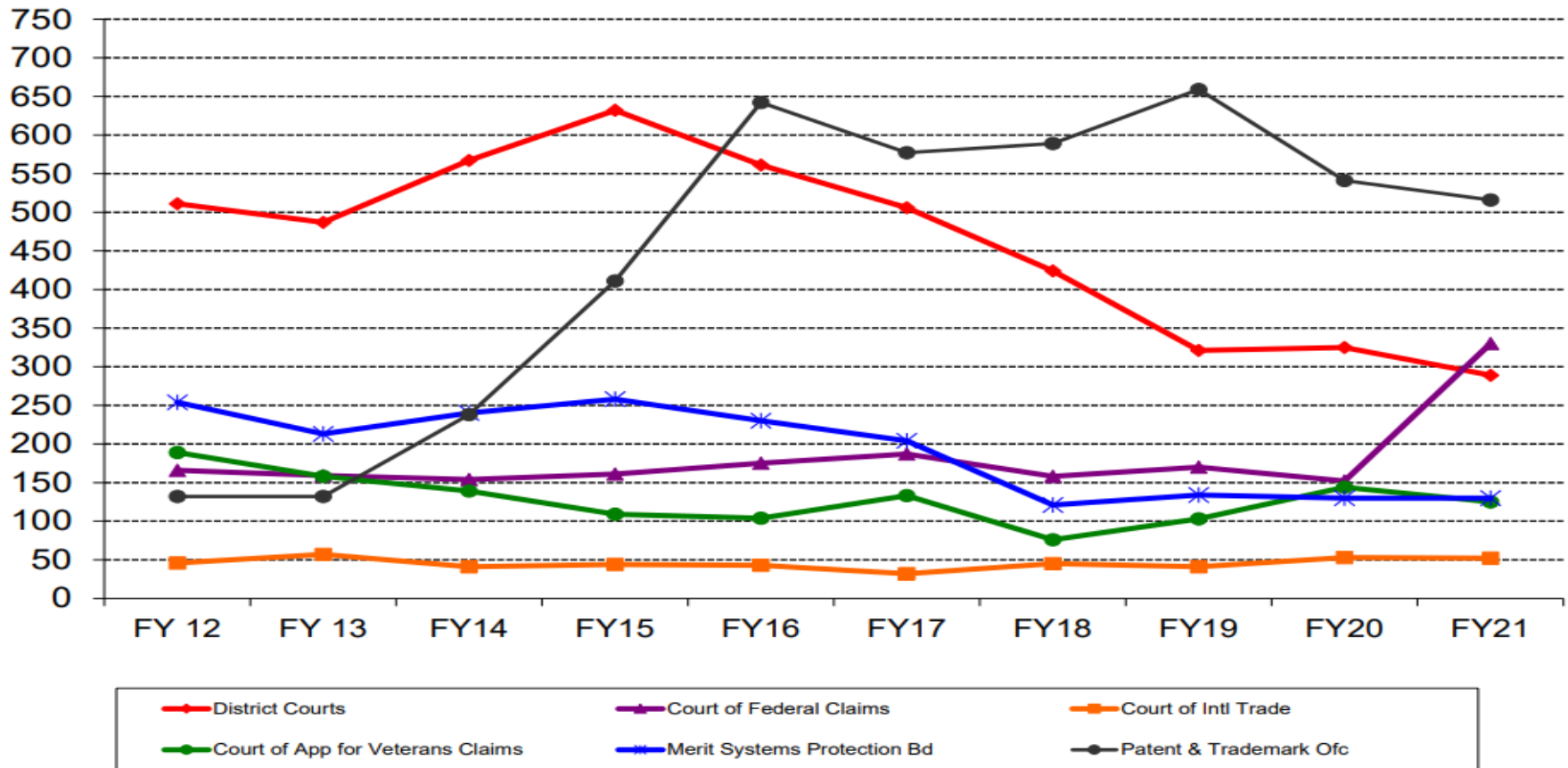


**General Dispositions by the Federal Circuit in Appeals Arising from the USPTO**

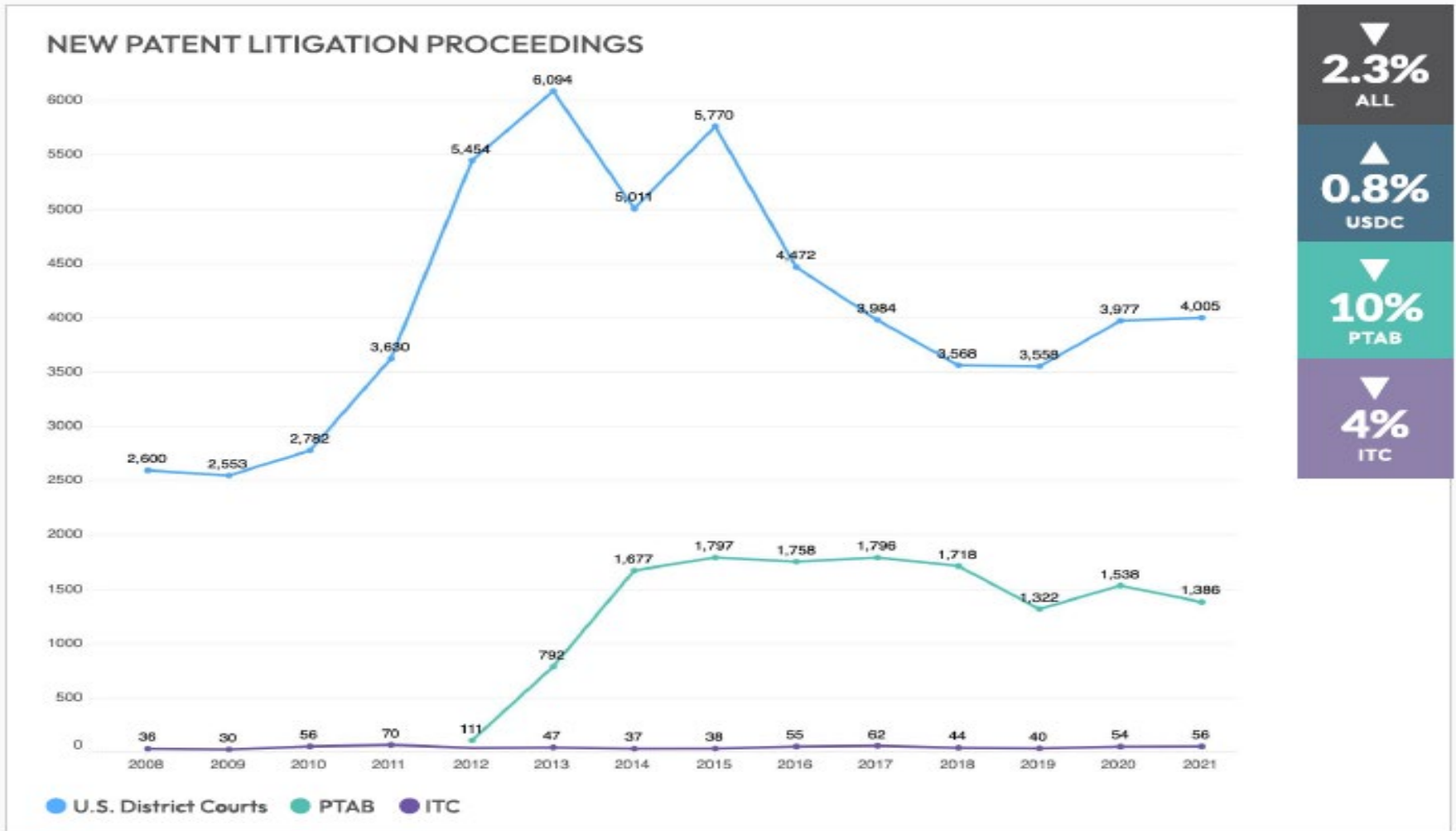


## 9. Post-trial papers and appeals

**United States Court of Appeals for the Federal Circuit**  
**Appeals Filed in Major Origins**



# 10. Statistics



## 11. Fees and costs

- Attorney's Fees for a typical patent case
    - Case where the amount in controversy is \$10MM to \$25MM
      - Attorney's fees through appeal \$4MM
    - Case where the amount in controversy is > \$25MM
      - Attorney's fees through appeal \$8.5MM
- [AIPLA 2021 Report of Economic Survey]*

## 11. Fees and costs

- Attorney's Fees
  - American rule – each party bears its own
  - An exceptional case under 35 U.S.C. § 285
    - an exceptional case could include any situation that stands out from another
    - *Octane Fitness v. ICON Health*
  - 28 U.S. Code § 1927 - Counsel's liability for excessive costs
    - multiplies the proceedings in any case unreasonably and vexatiously



## 11. Fees and costs

- Costs
  - Typically awarded to prevailing party
    - Taxable costs vary by jurisdiction
    - Deposition fees if used at trial
    - Copying (like exhibits for trial)
    - Translations
    - Interpreters
  - Rule 60 Offer of Judgment
    - if the judgment that the offeree finally obtains is not more favorable than the unaccepted offer, the offeree must pay the costs incurred after the offer was made.

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