



Training Academy Session # 20

An Introduction to Patent Litigation

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Session Overview

1. Overview of U.S. patent litigation (Slides 3)
2. Jurisdiction and venue considerations (Slides 4-10)
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1. Overview of U.S. patent litigation

- U.S. District Court actions
 - Patent infringement
 - Declaratory judgment (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)

2. Jurisdiction and venue concerns

- Subject Matter Jurisdiction
 - 28 U.S.C. §1338(a)
 - Federal District Courts have subject matter jurisdiction for any case relating to patents
 - 28 U.S.C. §1367
 - Courts can exercise supplemental jurisdiction over state law claims arising from the same facts

2. Jurisdiction and venue concerns

- Venue
 - Patent infringement cases 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 (28 U.S. Code § 1400(b)).
 - *TC Heartland LLC v. Kraft Foods Group Brands LLC* (U.S. 2017)
 - A corporation “resides” only in the district where it is **incorporated**
 - Greatly reduces a plaintiff’s ability to forum shop, as now venue is only proper where defendant is incorporated or physically located
- Personal Jurisdiction
 - Likely not a factor where venue considerations are met

2. Jurisdiction and venue concerns

- Patent owner generally chooses forum
 - Some US courts known for speed (Western District of Texas)
 - Some US courts known for pro-plaintiff awards (Eastern and Western District of Texas)
 - Others known as somewhat pro-defendant (North District of California)
 - Many districts have detailed local patent rules (District of New Jersey, District of Delaware)
- Choice must be within requirements of jurisdiction and venue rules for defendant(s)

2. Jurisdiction and venue concerns

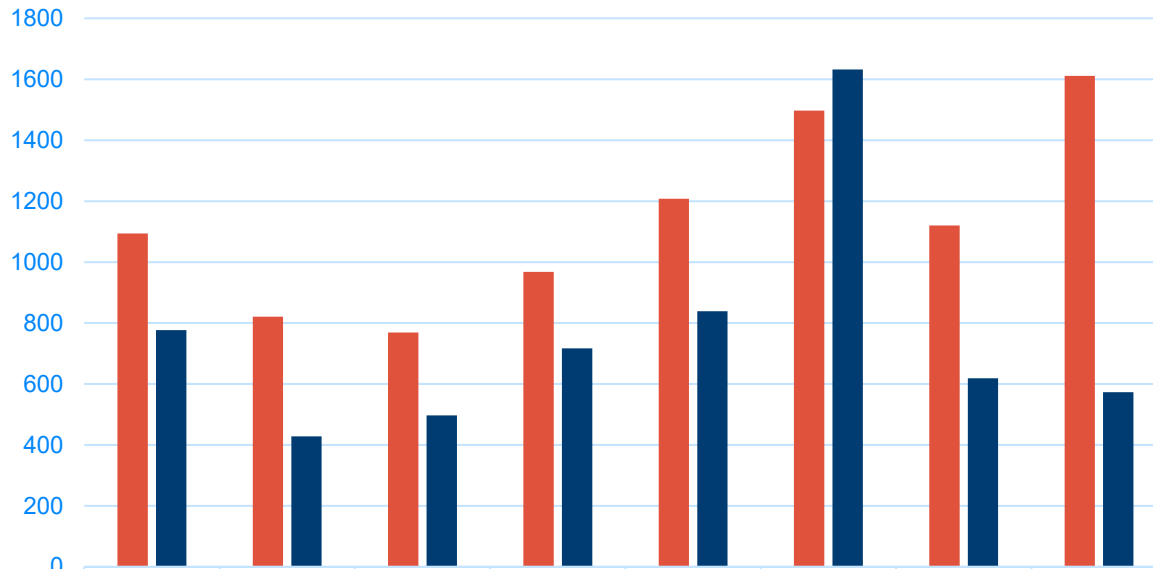
- International Trade Commission (ITC)
 - Section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337)
 - In rem jurisdiction over products imported into the U.S. (or exported to the U.S.)
 - Jurisdiction extends to “any case in which ‘some nexus’ is found between the activities of the respondent and a jurisdictional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

2. Jurisdiction and venue concerns

- Local Patent Rules
 - Initial disclosure of technical information and sales
 - Disclosure of contentions (sometimes a response as well)
 - 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

- Most Common Jurisdictions [2022, *Docket Navigator*]
 - W.D. Texas (23%), D. Delaware (17%), E.D. Texas (12%), C.D. California (6%), N.D. Illinois (6%)
- Speed can vary across districts [*data 2018-present*]



■ Average Days To Trial	1094	821	769	968	1208	1497	1120	1611
■ Average Days To Claim Construction	777	428	497	717	839	1632	619	573

2. Jurisdiction and venue concerns

- Venue Transfer
 - Defendants often seek to transfer case to a venue of their choosing
 - *In re Juniper Networks, Inc.*, Case No. 21-160 (Fed. Cir. 2021)
 - 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 maximized if owner practices the patent
 - Investigate Payment of Maintenance 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

3. Complaints, defenses, and preliminary motions

- Patent Owner Pre-Litigation Investigation (cont.)
 - Purchase Infringing Product and Gather Infringement Evidence
 - Detailed Review of Asserted Patent File History
 - Prepare Detailed Claim Chart
 - Infringer's patents or potential counterclaims
 - Prepare Complaint or cease-and-desist letter
 - Courts will allow pleading on "information and belief" if not reasonably accessible to patent owner

3. Complaints, defenses, and preliminary motions

- Accused Infringer Pre-Litigation Investigation
 - Monitor Competitor and/or Industry Patent Activity with an Automatic Patent Watch
 - Competitors
 - Technology Area
 - Inventor(s)
 - Conduct Patent Searches for New Products/Methods and Product/Method Redesigns
 - Freedom to operate opinions - noninfringement and invalidity
 - Redesign Product/Method Based on Potential Infringement
 - Monitor Industry Patent Litigation for Non-Practicing Entity Activity
- Upon being sued
 - Analyze patent and prosecution history
 - Search for close prior art
 - Get experts!

3. Complaints, defenses, and preliminary motions

- Common Patent Infringement Complaint Elements
 - Nature of the Action – Infringement of US Patent
 - Parties – Identification of Patent Owner and Accused Infringer
 - Jurisdiction and Venue (required)
 - Facts – Patent
 - Patent Infringement Count(s) – Claim Chart (required)
 - Prayer for Relief – Injunction/Damages (required)

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. (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 (35 U.S.C. § 271(e))
 - Divided infringement - joint actors infringe

3. Complaints, defenses, and preliminary motions

- Indirect Patent Infringement
 - Inducement to Infringe (35 U.S.C. § 271(b))
 - Must have **direct infringement** and inducer becomes liable for encouraging, aiding, or otherwise causing another person to infringe a patent
 - Contributory Infringement (35 U.S.C. § 271(c))
 - Must have **direct infringement** and alleged contributory infringer sells or imports a component for use in a patented combination, knowing the component to be especially made or adapted for that patented combination
- Patent owner bears burden of proving infringement by a ***preponderance of the evidence***
 - Must also prove the defendant knew of the patent

3. Complaints, defenses, and preliminary motions

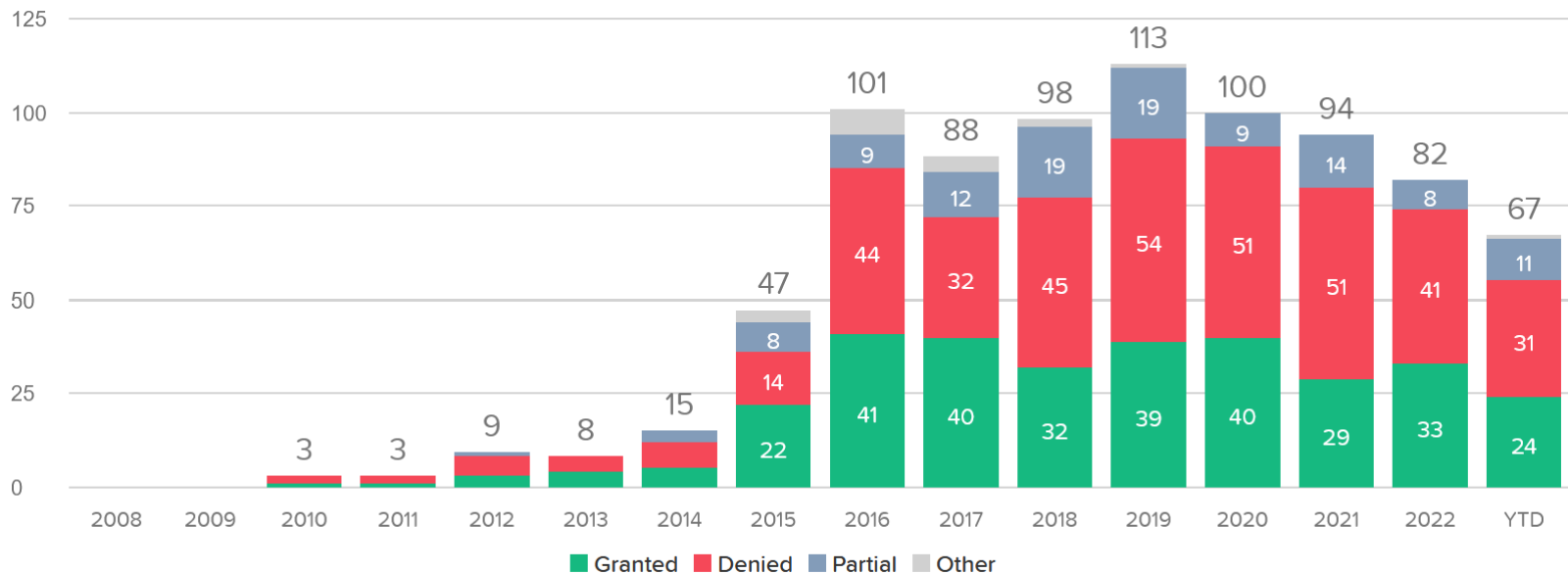
- Major defenses to patent infringement
 - Noninfringement
 - Invalidity (burden on the alleged infringer under the ***clear and convincing standard*** because patents are presumed valid (35 U.S.C. § 282))
 - Unpatentable subject matter (§ 101)
 - Lack of novelty/anticipation (§ 102)
 - Obviousness (§ 103)
 - Failures of the specification (§ 112)
 - Lack of enablement, failure of written description, indefiniteness, or improper dependent claiming
 - Unenforceability defenses such as inequitable conduct and patent misuse
 - Damages (e.g., failure to mark eliminates pre-filing damages)

3. Complaints, defenses, and preliminary motions

- Motions to Dismiss a Complaint FRCP 12(b)
 - 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



- 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

- 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
 - 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

- Many patent validity challenges can be brought at the PTAB
- PTAB challenges are an attractive option to accused infringers because of lower burden and limited discovery
 - PTAB *preponderance* standard lighter than District Court *clear and convincing evidence* standard
 - No presumption of validity at the PTAB
 - PTAB generally cheaper because of limited discovery
 - Often faster than proceeding through District Court trial
- PTAB and District Court actions can proceed in parallel unless District Court is stayed, or PTAB is discretionarily denied

4. Interplay with PTAB proceedings

District Court Stays

- Court looks at equitable factors in deciding whether to stay case
- 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 District Court (or other forum, e.g., ITC) will reach a decision sooner

- Governed by *Fintiv* factors (PTAB precedential decision):
 1. District Court action stayed or likely to be stayed
 2. District Court trial date vs. PTAB statutory deadline
 3. Investment in District Court 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

Estoppel – 35 U.S.C. § 315(e)

- If an IPR results in a Final Written Decision, the petitioner and those in privity may not assert in District Court or ITC an invalidity defense that was ***raised or reasonably could have been raised*** during the IPR
- This includes “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).
- Parties often dispute whether grounds “could have been raised”

4. Interplay with PTAB proceedings

Protective Orders and Discovery

- PTAB requires a PO for confidential discovery
 - PTAB Trial Practice Guide has default PO
- In parallel proceedings, some District Court 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 – i.e., contention interrogatories
 - 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 cross-examination at trial
- Rule 30(b)(6) deposition
 - Company designates individual(s) to respond for the company
 - Duty to prepare on party to ensure representative has the company’s knowledge

5. Discovery

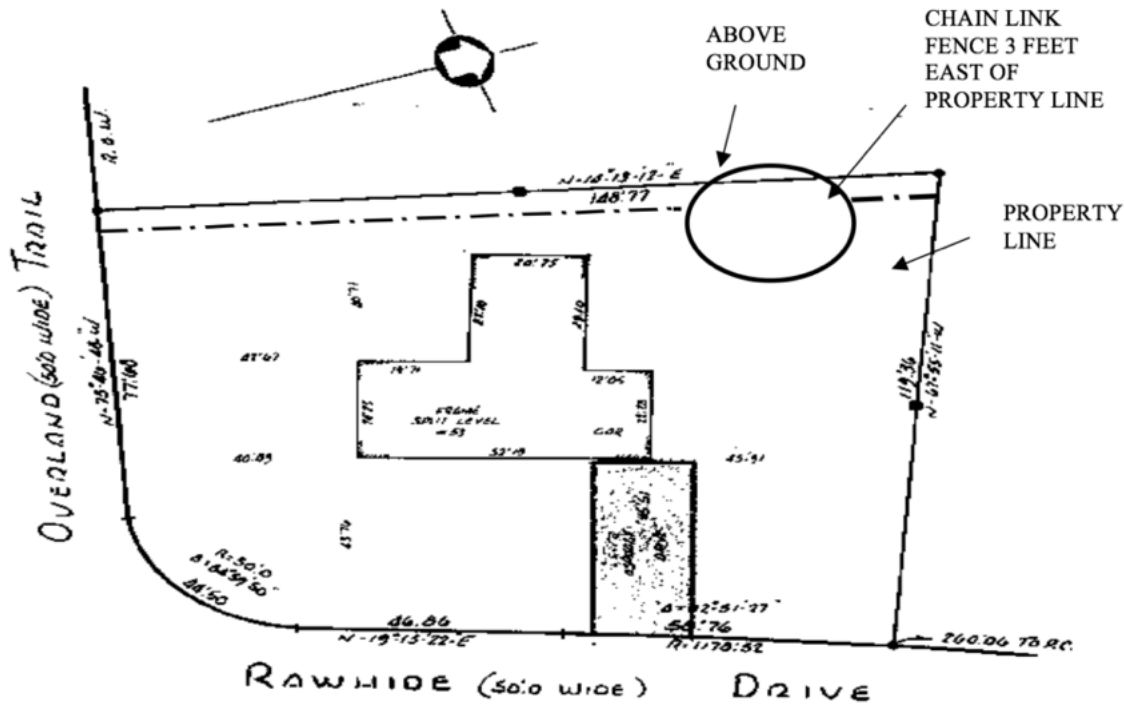
- Confidentiality protections
 - Protective orders or discovery confidentiality orders
 - Tailored to the needs of the case
 - Many jurisdictions have model orders
 - Prosecution bars to protect highly confidential materials from influencing future prosecution

6. Claim Construction

- Fundamental issue in patent litigation.
- The Court must determine the scope and meaning of the claims of the patent
- The meaning of any claim terms disputed by the parties must be construed by the Court.
- Claim construction is a question of law reserved for the Court, not a question of fact left to the factfinder (*Markman v Westview Instruments*, 517 U.S. 370 (1996)).

6. Claim Construction

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



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

- Canons of claim construction (*Phillips v. AWH Corp.*, 415 F.3d 1303 (2005) (*en banc*))
 - Claims must be construed at the time of the invention
 - Terms are construed to have their “ordinary meaning”
 - Intrinsic evidence is of primary importance – patent & file history
 - Extrinsic evidence, such as dictionaries, treatises, encyclopedias, uncited prior art, and expert testimony may be utilized
 - Claim differentiation: presume a different meaning and scope when different words are used in separate claims
 - Limitations from the specification are not read into the claims
 - Do not 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

- 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 proposed 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
 - Otherwise limit disputes and complication
 - Disputed Claim Terms remaining are Briefed for a Markman Hearing

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
- Damages Experts
 - Accountant or economist
 - Assumes liability

7. Experts

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

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 (no juries) 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 judgment as a matter of law 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) - limited to six years prior to filing of complaint
 - Reasonable royalty (35 U.S.C. § 284)
 - Hypothetical negotiation guided by *Georgia Pacific* factors
 - Analytical approach – damages based on infringer's internal profit projections
 - Established Royalty
 - Lost Profits – usually requires direct competition
 - Price Erosion – patent owner lowered prices due to infringer
 - Convoyed Sales
 - Disgorgement of profits in design patent cases (35 U.S.C. § 289)
 - Everybody in the chain of distribution

8. Trial/hearing and relief

- Injunctive relief (35 U.S.C. § 283)
 - Court decides based on traditional four-factor test (*eBay, Inc. v. MercExchange LLC*, 547 U.S. 388 (2006))
- Willfulness (35 U.S.C. § 284)
 - Jury issue - generally reserved for egregious cases of culpable behavior under a preponderance standard

9. Post-trial papers and appeals

- Post-trial papers are typically made to seek a directed verdict and/or to preserve issues for appeal
- Motion for judgment as a matter of law (JMOL) – Rule 50
 - Standard - reasonable jury would not have a legally sufficient evidentiary basis to find for the party
 - Must move before close of trial and renew 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

- Other issues to be decided by judge, not jury:
 - Motion for prejudgment and/or post-judgment interest
 - Exceptional case awards (35 U.S.C. § 285) (*Octane Fitness*, 572 U.S. 545 (2014))
 - Attorneys’ fees can be awarded if the case “is one that stands out from the others with respect to the substantive strength of a party’s litigating position ... or the manner in which the case was litigated”
 - Enhanced damages (*Halo*, 136 S.Ct. 1923 (2016))
 - Up to treble (3x) damages can be awarded for “egregious” infringement
 - Often stems from willful infringement, but not required even where jury finds willfulness

9. Post-trial papers and appeals

- District Court 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 District Court can direct entry of judgment by certifying there is no just reason to delay – allows for appeal (FRCP 54(b))

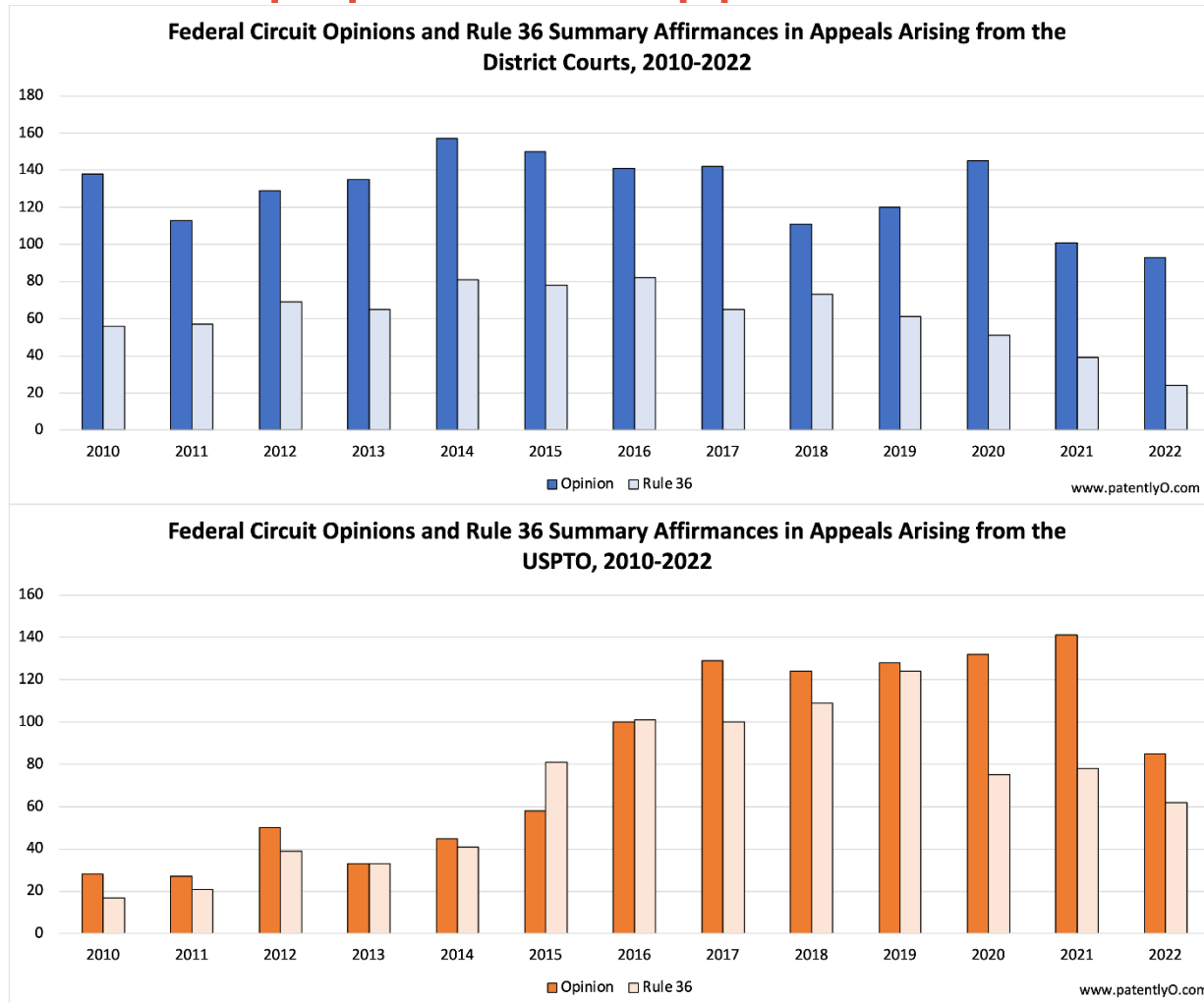
9. Post-trial papers and appeals

- 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 40% in 2022

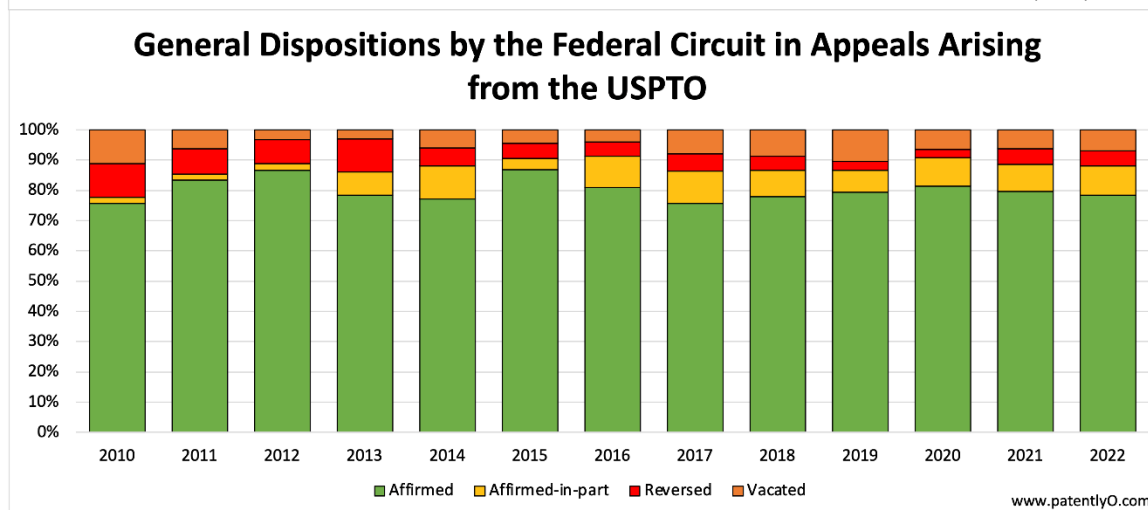
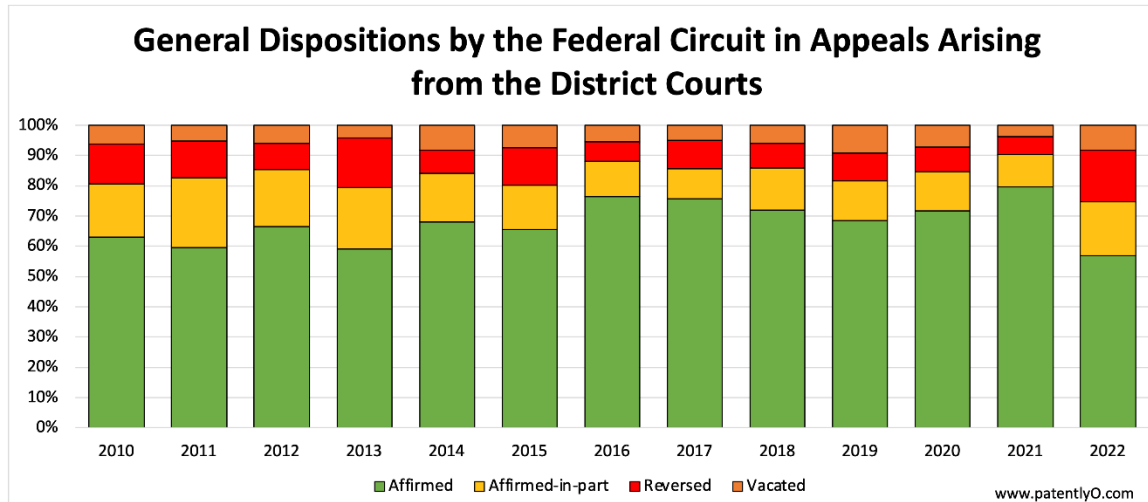
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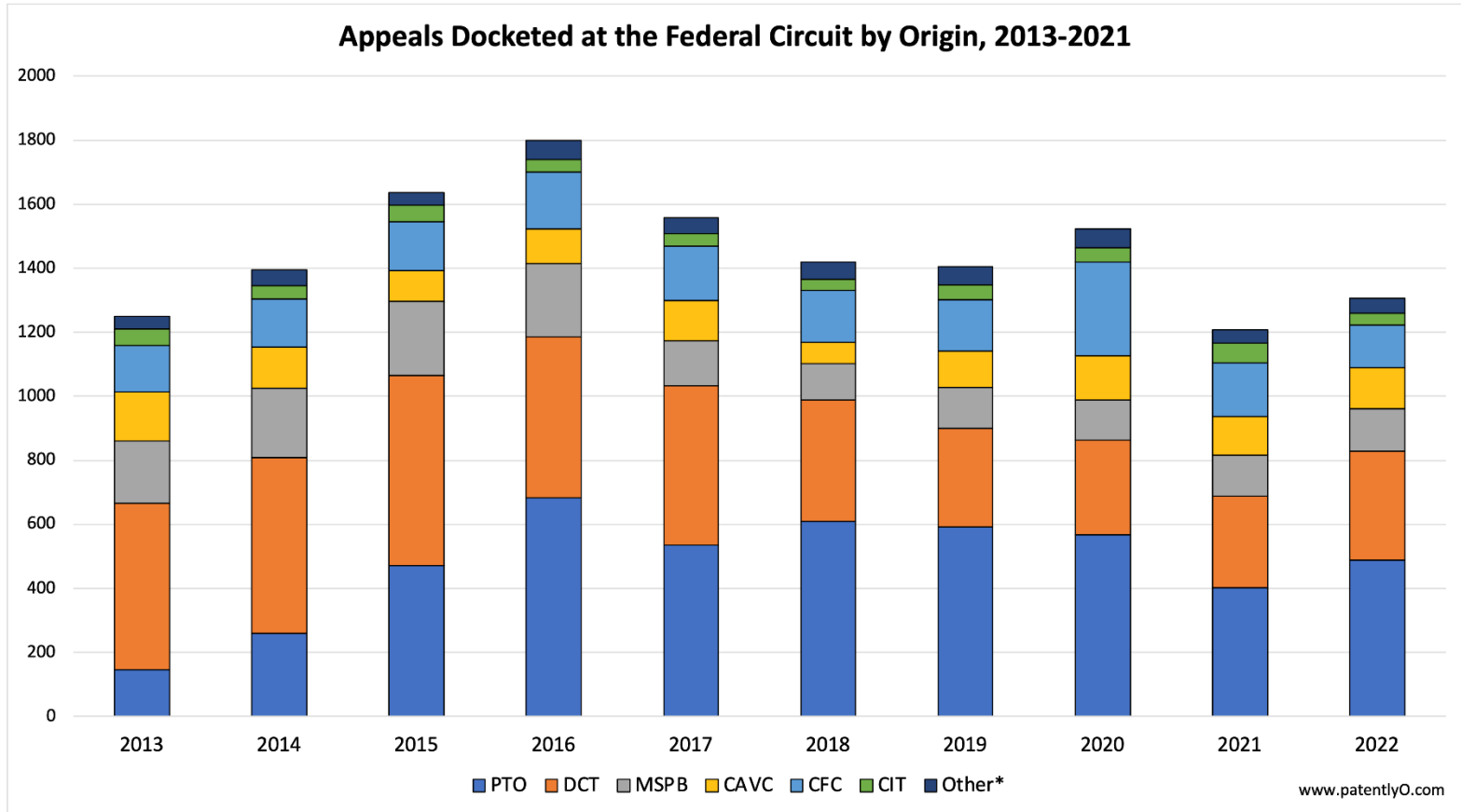
9. Post-trial papers and appeals

- Affirmance Rates at the Federal Circuit:
 - PTAB affirmed ~78% of the time, affirmed-in-part ~7%
 - Holding steady over past ~10 years
 - District Courts affirmed ~57% of the time, affirmed-in-part ~18%
 - Had been steady at a higher affirmance rate, but dropped in 2022

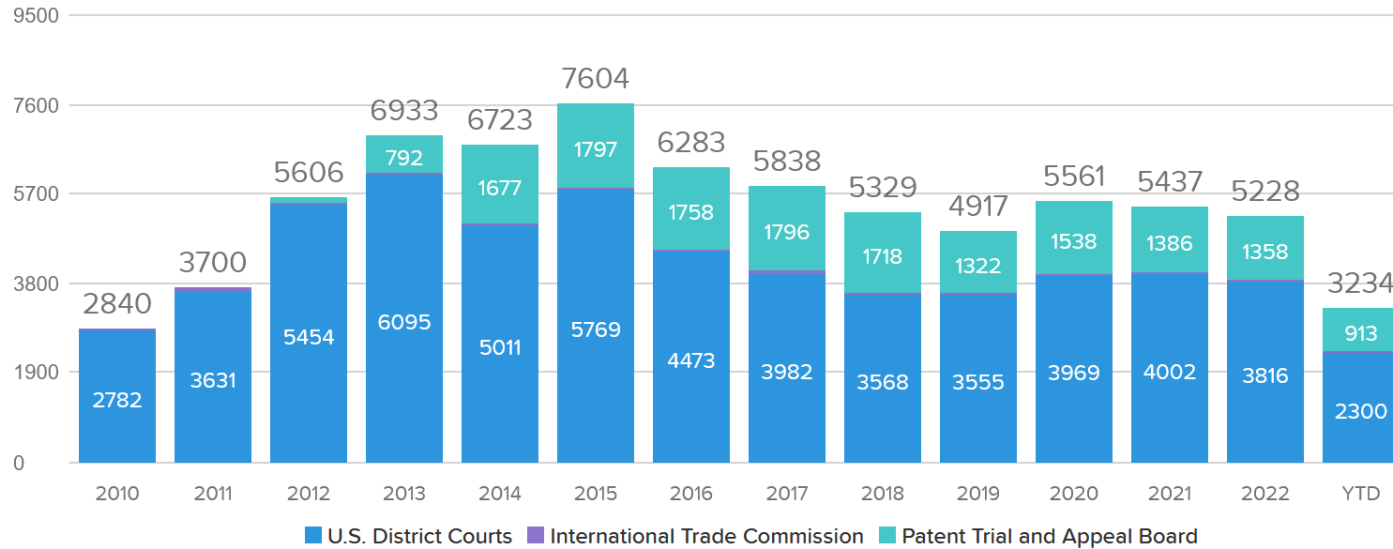
9. Post-trial papers and appeals



9. Post-trial papers and appeals



10. Statistics



Cases by Year

	2010	2011	2012	2013	2014	2015	2016	2017	2018	2019	2020	2021	2022	YTD
U.S. District Courts	2782	3631	5454	6095	5011	5769	4473	3982	3568	3555	3969	4002	3816	2300
International Trade Commission	58	69	41	46	35	38	52	60	43	40	54	49	54	21
Patent Trial and Appeal Board	0	0	111	792	1677	1797	1758	1796	1718	1322	1538	1386	1358	913
Total	2840	3700	5606	6933	6723	7604	6283	5838	5329	4917	5561	5437	5228	3234

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
- Fees can be shifted for:
 - Exceptional case under 35 U.S.C. § 285 and *Octane Fitness v. ICON Health*
 - an exceptional case could include any situation that stands out from another
 - 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, types vary by jurisdiction
 - Deposition fees if used at trial
 - Copying (e.g., 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.

Speakers



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