

Practical Issues in U.S. IP Litigation for Transnational Disputes

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U.S. Considerations for Patent Cases

- U.S. District Courts
 - Effect and Applications of *TC Heartland* and need for a “regular and established place of business” for U.S. (not foreign) corporations
- International Trade Commission (“ITC”)
 - Differences in remedy and speed
 - Presidential review
- Interactions between District Court and ITC proceedings
 - Patent v. non-patent issues

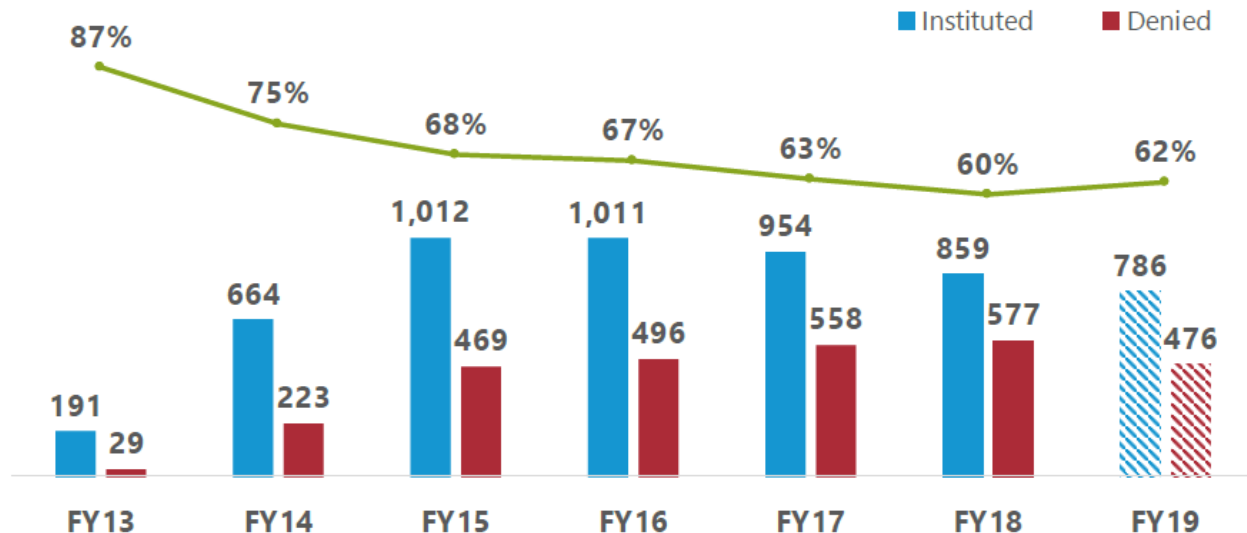
Another U.S. Patent Forum: IPRs

- Inter partes review (“IPR”) in the U.S. Patent Trial and Appeal Board (“PTAB”)
 - No presumption of validity
 - Now the same claim construction standard (*Phillips*)
 - Stays of District Court proceedings
 - Discretion to deny institution based on other proceedings (*NHK Spring, Valve Corp.*) or original prosecution (*Becton Dickinson*).

IPR Institution Rates Over Time

Institution Rates

(FY13 to FY19: Oct. 1, 2012 to Aug. 31, 2019)



Institution rate for each fiscal year is calculated by dividing petitions instituted by decisions on institution (i.e., petitions instituted plus petitions denied). The outcomes of decisions on institution responsive to requests for rehearing are excluded.



IPR Results After Institution

- For petitions instituted, most claims invalidated 2012-2019
 - 62% all claims
 - 18% some claims
 - 20% no claims
- Effects of Final Written Decisions (“FWDs”)
 - Preclusion as to prior art that could have been raised
 - Conflicts in results between courts and PTAB

U.S. Trade Secret Claim Issues

- State courts in the U.S.
 - Discovery can depend on trade secret designations, e.g., California CCP §2019.210
 - Differences re inevitable disclosure
- U.S. Federal courts: Protect Trade Secrets Act
 - Civil seizure procedure: rarely invoked
 - Inevitable disclosure claim not available
 - Can apply to a U.S. person if theft outside U.S.
- ITC: State law and PTSA can be used
 - *Tianrui*: Jurisdiction over misappropriations outside the United States
- U.S. and China
 - Civil discovery procedures
 - Criminal enforcement