

## David McCombs, Eugene Goryunov, and Jonathan Bowser in Westlaw Today: ‘IPR Tricks of the Trade: Discretionary Institution When There is Parallel ITC Investigation’

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**PRACTICES** Intellectual Property, Patent Office Trials, Intellectual Property Litigation

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*[David McCombs](#), [Eugene Goryunov](#) and [Jonathan Bowser](#), of Haynes Boone, discuss considerations for the Patent Trial and Appeal Board when deciding whether to deny institution of an inter partes review petition that challenges a patent involved in an International Trade Commission investigation.*

A third party who is not the patent owner may file a petition for inter partes review (IPR) to challenge the validity of an issued patent before the Patent Trial and Appeal Board. IPRs are frequently filed as part of a defense strategy to challenge the validity of an asserted patent. While infringement actions in district court are more common, patent owners are increasingly bringing up infringement allegations in petitions to the International Trade Commission (ITC). If the ITC determines in its investigation that a respondent infringed a valid U.S. patent, the ITC can issue an exclusion order effectively blocking the respondent's infringing product from importation into the U.S.

ITC investigations are expedited compared to most district court actions. The ITC sets a target date of approximately 16 months for the conclusion of most investigations. Within that target date, an Administrative Law Judge (ALJ) of the ITC conducts an evidentiary hearing within nine to 11 months after commencement of the investigation, and then issues an initial determination (ID) within about 11 to 12 months after commencement. The ITC then issues its final determination (FD) by the 16-month target date.

Excerpted from *Westlaw Today*. To read the full article, click [here](#). The article was also featured in [Reuters](#).