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Kilpatrick Townsend Attorneys Share Winning Formula for PTAB Success

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Kilpatrick Townsend's patent prosecutors and litigators are a formidable team when it comes to post-grant proceedings in the Patent Trial and Appeal Board (PTAB) at the U.S. Patent and Trademark Office. In the last five years, the firm has taken on nearly 200 cases, representing both patent owners and petitioners. The firm won 47 out of 82 cases for patent owners for an overall win percentage of 57%. And 50% of those 82 cases were denied institution or dismissed at the preliminary stage.

Within these impressive statistics, there's an even more remarkable story – the story of the Denver Office's Chemistry & Life Sciences (CLS) team, comprised primarily of **Partners Justin Krieger** and **Nicki Kennedy**, and **Counsel Troy Petersen**. With an ***overall win rate of 91%***, representing both patent owners and petitioners, the team's track record far exceeds the PTAB's statistical averages.

CLS Team's Win Percentages for Patent Owners	CLS Team's Win Percentages for Petitioners
Overall **93.3%** Win at Institution Stage **60%**	Overall **87.5%** Win at Institution Stage **85.7%**

The team attributes its success to a two-prong approach: (1) learning the technology at issue in minute detail; and (2) deploying savvy litigation strategies in tandem with effective patent prosecution.
First, the team notes that a thorough understanding of the technology in each case is imperative because PTAB proceedings are frequently highly technical in nature. Proving or rebutting whether a prior art reference expressly or inherently discloses a claim feature often depends on the attorney's understanding of the underlying technology.

Second, like all adversarial proceedings, winning PTAB cases requires a litigator's finesse, skill, and sophistication, and the ability to candidly assess the strengths and weaknesses of each matter. This assessment must inform the decision of whether to proceed with a PTAB case in the first place as a Petitioner or

whether to stay before the PTAB as a Patent Owner. Because prior art may be more easily and efficiently overcome during *ex parte* prosecution, for example, a Patent Owner may have greater success by taking the patent back into prosecution through reissue or by addressing newly found prior art in a pending continuation application rather than in an IPR. Thus, in some instances it may be prudent for a Patent Owner to take steps to terminate the IPR, and pursue slightly narrower claims in a different forum. In this way, the team ensures its clients have the best chance of obtaining a desirable outcome.

Once a PTAB proceeding is deemed to be the best approach, it is imperative to understand the strategies and tactics that work in this forum. In IPRs, for example, depositions are key. Cases frequently rise or fall on the testimony of expert or fact witnesses. Therefore, a skilled and confident deposing attorney who can elicit helpful testimony on cross-examination is often a significant factor in chalking up a win.

Other tactics to consider include Motions to Amend (MTAs) and additional briefing, from which many attorneys shy away, but which can provide significant benefits. Although MTAs have a relatively low grant rate, the PTAB's MTA Pilot Program can be a great mechanism to feel the Board out on a possible alternative claim strategy with little downside. In fact, MTAs can give patent owners a free bite at the apple for a possible claim amendment strategy. If successful, the amended claims may be insulated from attack should litigation ensue, providing a valuable benefit to patent owners. Similarly, while the PTAB rules prescribe a strict schedule of briefing, in practice, the PTAB is generally lenient in permitting additional briefing and such briefing can ensure a party's arguments are properly heard and that the Board fully understands its viewpoint.

Finally, having prosecution savvy IPR counsel is essential, especially for large portfolios, in order to track arguments made and strengthen the ultimately issued claims. Disclosing IPR papers and citing art in pending related applications will help contest institution in later cases where patents from the same family are challenged on similar grounds.

In case after case, the Denver Office's CLS team is proving that their approach to PTAB proceedings is extraordinarily effective, to their clients' great advantage.