Post-Grant Proceedings

PTAB Powerhouse

Post-grant proceedings provide faster, more cost-effective ways to challenge issued patents before initiating or in parallel with court proceedings. Since the enactment of the America Invents Act, our registered patent attorneys and litigators have successfully handled hundreds of post-grant proceedings — *inter partes* reviews (IPR), covered business method (CBM) reviews, post-grant reviews (PGR), *ex parte* reexaminations, and supplemental examinations — before the Patent Trial and Appeal Board (PTAB) for both petitioners challenging patents and patent owners. Our Post-Grant Proceedings Team draws from our more than 175 registered patent attorneys with specializations across all technologies, and includes patent litigators with extensive experience in post-grant and federal court proceedings. Our success on both sides of the table has earned us national recognition as a top law firm in total IPR institutions for petitioners and as a top firm in blocking institutions of IPRs for patent owners. We also handle similar European opposition proceedings, IPRs involving patents concurrently in litigation, and cross-over patent litigation strategy.

Experience

Celanese v. Daicel (Representing Petitioner): In IPR2019-00313, Kilpatrick Townsend represented Celanese in a petition challenging several claims of Daicel U.S. Patent 9,776,941. In an unorthodox victory, the art cited in the petition caused Daicel to make new arguments in its preliminary response about the claim scope. Believing the new prosecution history was sufficiently clear, Celanese moved to terminate the proceeding, without prejudice. The Board granted the motion on April 12, 2019, resulting in significant savings to the parties.

Elite Performance Footwear v. Reebok (Representing Patent Owner): Kilpatrick Townsend successfully defended all claims in three patents challenged by Elite. Reebok asserted the patents in Federal Court litigation, where they were upheld in final written decisions issued in January 2019. See IPR2017-01676 (U.S. Patent 7,637,035 “Collapsible Shoe”), IPR2017-01680 (U.S. Patent 8,505,221), and IPR2017-01689 (U.S. Patent 8,020,320).

Motorola Mobility v. Arnouse (Representing Petitioner): Kilpatrick Townsend successfully obtained a final holding of invalidity of all claims. Arnouse Digital Devices filed a lawsuit in the District of Vermont, alleging that Motorola infringed a patent related to docking stations for portable computers. Kilpatrick Townsend represented Motorola in the litigation, and also challenged the validity of the asserted patent in one of the first IPRs. The Board instituted the IPR, and on February 11, 2014, it issued a final written decision, canceling every asserted claim under two separate grounds of anticipation under 35 U.S.C. 102. PTAB Case Number IPR2013-00010.

Oracle v. Thought (Representing Petitioner): Kilpatrick Townsend successfully obtained a final holding of invalidity of all challenged claims of three patents on April 13, 2015. Kilpatrick Townsend acted as lead counsel

for Oracle in an IPR proceeding before the USPTO, challenging the validity of U.S. Patent No. 7,167,862 titled, “Session Bean Implementation of a System, Method, and Software for Creating or Maintaining Distributed Transparent Persistence of Complex Data Objects and their Data Relationships.” PTAB Case Numbers IPR2014-00117, IPR2014-00118, and IPR2014-00119.

Medtronic, Inc. v. Dr. Mark A. Barry (Representing Patent Owner): Kilpatrick Townsend represented Patent Owner Dr. Mark A. Barry in a series of IPR petitions, two of which were instituted. The firm replaced initial IPR counsel after the proceedings had already begun and without the benefit of being able to file any preliminary responses. Despite this initial handicap, the IPR Team obtained a total victory after all challenged claims were found to be valid — a rare feat for patent owners in IPR proceedings. According to the Patent Office, there is approximately a five percent chance that a patent challenged in an inter partes review proceeding will emerge with all challenged claims still valid.

Google, Inc. v. Summit 6 LLC (Representing Petitioner): Kilpatrick Townsend prevailed as lead counsel for Google, Inc. in two inter partes reviews, challenging the validity of patents involving processing and transmitting digital content. The PTAB ruled in favor of Google, finding all challenged claims in both proceedings unpatentable. PTAB Case Numbers IPR2015-00806 and IPR2015-00807.

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