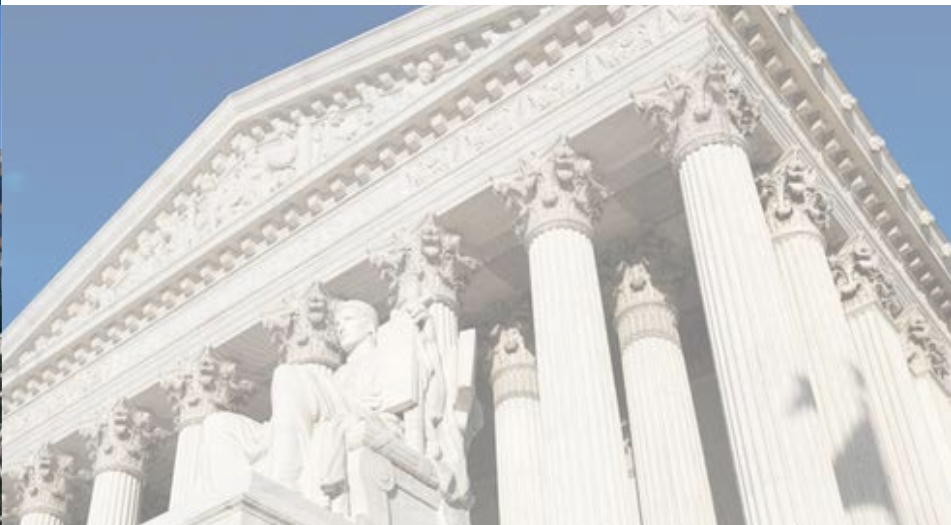


# HARNESSING PATENT OFFICE LITIGATION



VOLUME V

A Look at Eighteen Months  
of *Inter Partes* Review  
Proceedings Before the  
United States Patent and  
Trademark Office



9|16|2012 to 3|16|2014

**HARNESS**  
**DICKEY**

Welcome to **Harness Dickey's** Report on Litigation Practice before the United States Patent Office. Created by the America Invents Act, *Inter Partes* Review proceedings have already changed the face of patent litigation. Lower cost, lower burden of proof to invalidate, broader claim scope, among other advantages to patent

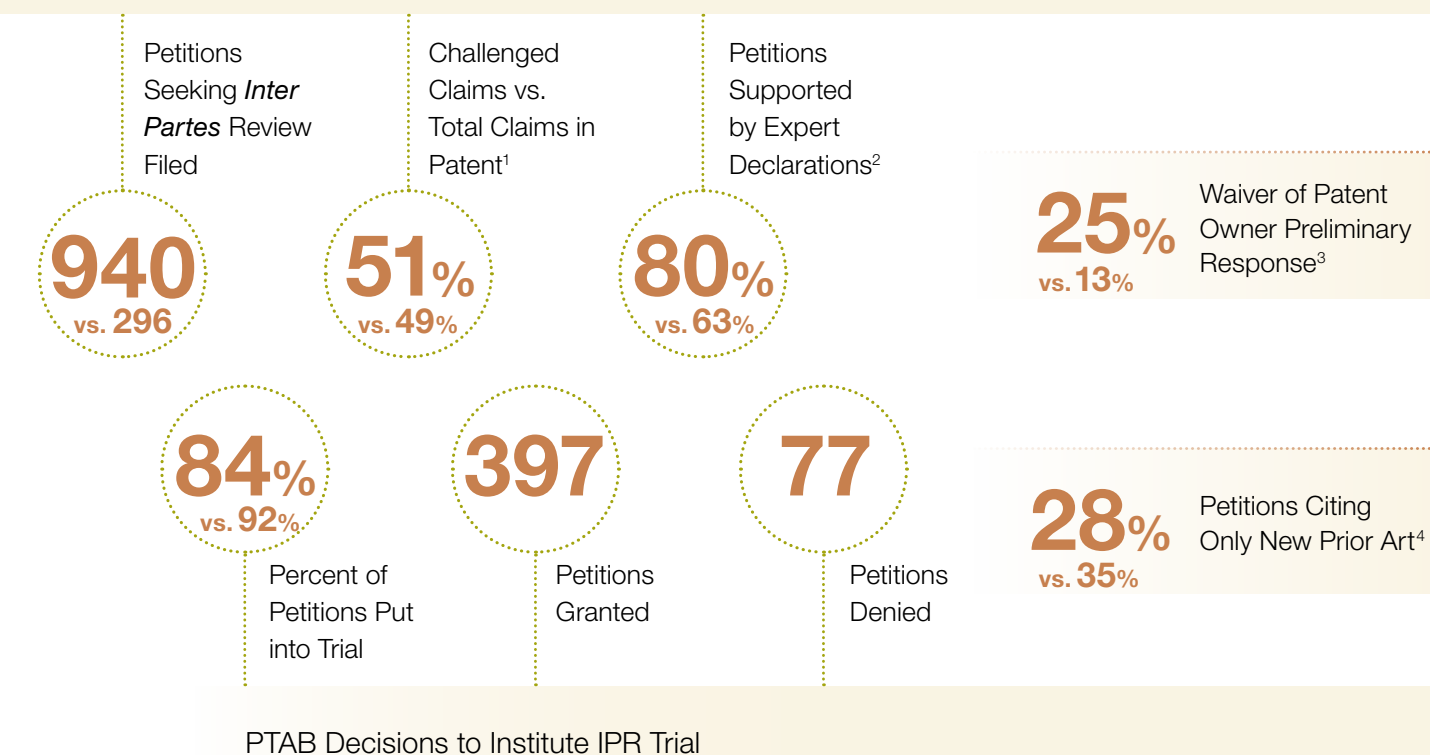
challengers, means that there may be no greater opportunity and true reform to come from the America Invents Act than these post-grant proceedings. Our periodic Report will provide insight based on the over 100 characteristics of these proceedings that we are tracking.

**96.4%**

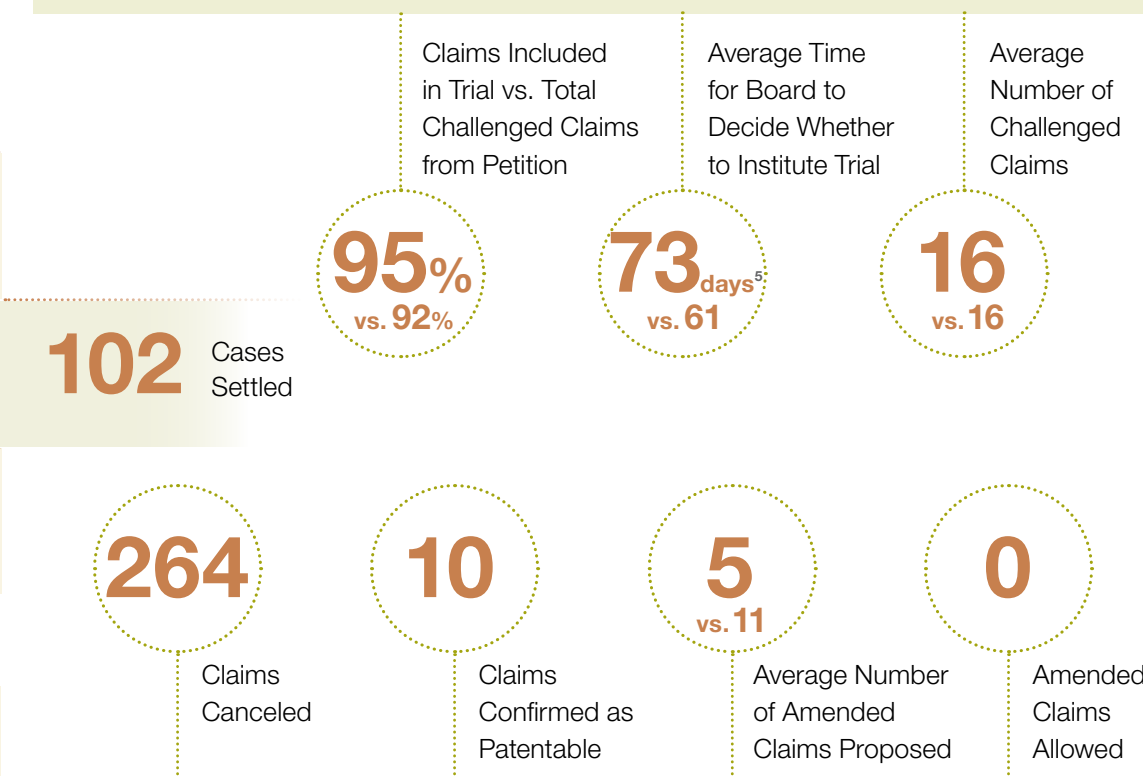
**CLAIMS  
CANCELED IN  
FINAL WRITTEN  
DECISIONS**

From the Decision to Initiate, the PTAB is given a statutory deadline of 12 months within which it must provide a Final Written Decision. As we cross the 18 month anniversary date of *Inter Partes* Review practice, it is no surprise that the first Final Written Decisions have come in. In 19 Final Written Decisions, all challenged claims have been canceled. In only 2 decisions, one or more challenged claims were confirmed as patentable. Even in these two cases, though, less than half (10 out of 24) of the challenged claims were confirmed as patentable.

**PRELIMINARY STAGE** Preliminary Stage of the Proceedings (Petition Filing Through PTAB Trial Initiation Decision)

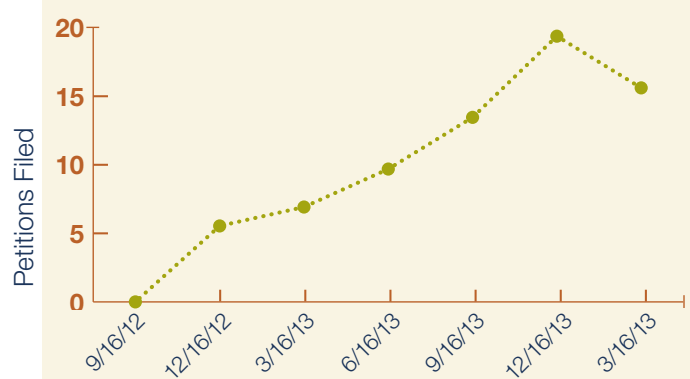


**TRIAL STAGE** Trial Stage of the Proceedings (PTAB Trial Initiation Decision through Final Written Decision)

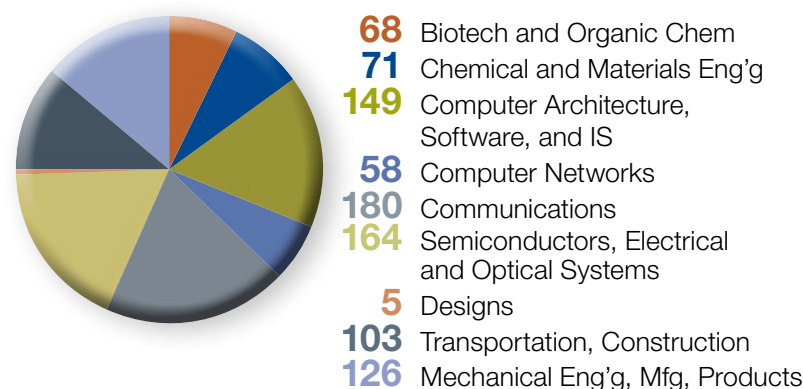


The Results are in from the First Set of Final Written Decisions

**PETITIONS FILED PER WEEK**



**TECHNOLOGY OF CHALLENGED PATENT CHART**



**SUCCESS RATE OF VARIOUS IPR MOTIONS<sup>6</sup>**



\*\* The statistics in this Report are provided along with a reference to the statistics through 9 months of IPR practice. In this way, trends can be identified regarding practice through the first 9 months as compared to the full 18 months.

<sup>1</sup> Space considerations, cost considerations, and limiting the ability of Patent Owners to present alternative claims, have all combined to cause Petitioners to challenge only about 1/2 of the claims of any challenged patent.

<sup>2</sup> Over time, Petitioners have come to recognize that their Petitions must be supported by hard evidence in the form of expert testimony.

<sup>3</sup> As Patent Owners have come to realize that substantive attacks on a Petition are less successful without expert testimony, they have waived the Preliminary Patent Owner Response in increasing numbers.

<sup>4</sup> Patent challengers are not giving up on old art that was considered in view of the challenged patent – about 1/4 of petitions rely solely on new prior art.

<sup>5</sup> As the PTAB's workload has steadily increased, the time to a Decision to Initiate has gradually climbed, as well. While the Board has statutorily been provided with 3 months to make that decision, it is taking about three weeks less than the full statutory allotment to come to a Decision to Initiate.

<sup>6</sup> Where the parties to a particular motion are involved in multiple IPR proceedings, and the motion was decided in each of those proceedings, the motion was only counted once for the purpose of determining the success rate.

# CONCURRENT PROCEEDINGS

Litigation and Other Administrative Proceedings Involving the Patent-At-Issue



## HARNESS DICKEY HAS DEMONSTRATED EXPERTISE IN PATENT OFFICE LITIGATION

Harness Dickey has developed the expertise to handle the specialized *Inter Partes* Review (and, soon, Post Grant Review) proceedings. That expertise shows in the results we are achieving for our clients. Each of the numerous Petitions that we have prepared have led to decisions to institute against all challenged claims (though none has made it to Final Written Decision, to date). Further, of the three Final Written Decisions in which at least one claim has

survived the PTAB's scrutiny, Harness Dickey was counsel for Patent Owner on 2 occasions. Those surviving claims have litigation value that will soon lead to the reinstatement of stayed litigation. Please contact us at [ipr-pgr@hdp.com](mailto:ipr-pgr@hdp.com) with any questions or to discuss our expertise, including a more complete array of statistics than presented here.

**HARNESS**  
**DICKEY**

We have traveled the world to provide seminars regarding *Inter Partes* Review proceedings to companies, law firms, and other organizations. Interested in having us visit for a presentation? Please email us at [ipr-pgr@hdp.com](mailto:ipr-pgr@hdp.com).