

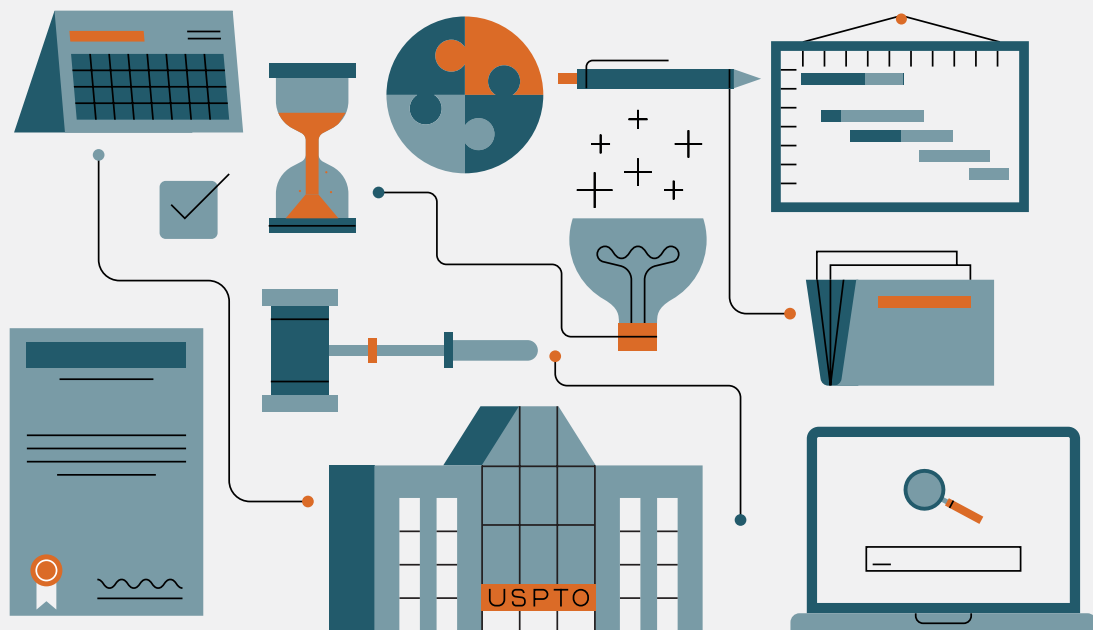


THE
GLOBAL IP
AWARDS

Key Insights from
IP Leaders **2020**

Presented by **iam** and **WTR**

Interplay of PTAB & litigation—game changing when it comes to strategy



Finnegan is one of the most experienced post-grant firms in the country. Since leading—and winning—one of the first Patent Trial and Appeal Board (PTAB) trials at the U.S. Patent and Trademark Office (USPTO), the firm has maintained its position as a leader in PTAB trial practice. Finnegan has handled nearly 900 post-grant proceedings on behalf of both petitioners and patent owners, and our PTAB experience spans not only volume, but also variety, having represented more than 175 clients across industries and with varying strategic goals. Finnegan’s 50+ years of litigating patents and prosecuting applications at the USPTO makes the firm particularly well suited for handling PTAB cases, leading to *Intellectual Asset Management (IAM)* presenting Finnegan with the “U.S. Post-Grant Firm of the Year” award at the 2020 Global IP Awards and our repeated recognition by *Managing Intellectual Property* as a top law firm for PTAB litigation and as the “2019 PTAB Firm of the Year.”

For more information, please visit www.finnegan.com.

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US Post-grant Firm of the Year

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP



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US Post-grant Firm of the Year

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HENDERSON,
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DUNNER LLP

By Joshua Goldberg, Erika Arner
and Benjamin Saidman

Q: Can you tell us about your team (eg, size, key individuals and industry focus)?

A: We have approximately 350 IP professionals, including attorneys, student associates, technical specialists and patent agents. We offer full-service IP legal and technical experience in virtually every industry and technology — from electrical and computer technology, industrial manufacturing, consumer products, medical devices and biotechnology to pharmaceuticals, chemicals and clean energy. Since leading — and winning — one of the first PTAB trials at the USPTO, we have maintained our position as a leader in PTAB trial practice. Finnegan has handled nearly 900 post-grant proceedings on behalf of both petitioners and patent owners, representing more than 175 clients across industries and with varying strategic goals. Accepting the award for Finnegan, Anthony Tridico and Clare Cornell represent the experience that we bring to European IP practice. For EPO oppositions and appeals, we regularly defend clients' patents, including against multiple opponents, while also

helping them to establish freedom to operate by challenging patents at the EPO before both the Opposition Division and the Boards of Appeal.

Q: From a post-grant perspective, what was your highlight of 2019?

A: In *Fidelity Information Services, LLC v Mirror Imaging LLC*, we represented petitioner Fidelity Information Services in four covered business method reviews, successfully obtaining unpatentability holdings of all the claims of patent owner Mirror Imaging's patents related to electronic financial document storage (CBM2017-00064, -00065, -00066, -00067, PTAB, Judges Arbes, Easthom, Elluru).

In *Google, Inc v Uniloc USA*, we also represented petitioner Google in a series of *inter partes* reviews challenging Uniloc's patents on systems and methods for initiating conference calls, successfully securing the institution and cancellation of all challenged claims in each proceeding (IPR2017-01683, -01684, -01685, PTAB, Judges Barrett, Chung, Easthom, Smith).

Finally, in *Toyota Motor Corp v Intellectual Ventures II LLC*, we represented petitioner Toyota in nine *inter partes* reviews challenging Intellectual Venture's patents. After preparing and filing the petitions within only weeks of Intellectual Ventures asserting the patents against Toyota before the International Trade Commission, we successfully secured the institution and cancellation of all claims asserted against our client (IPR2017-01494, -01495, -01497, -01498, 01536, 01537, -01538, -01539, -01631).

Q: There have been numerous changes at the PTAB over the past couple of years – what have been some of the most influential?

A: PTAB practice continues to evolve, as changes from the Supreme Court, Federal Circuit and USPTO alter the best strategies for success before the board. The Supreme Court's decision in *SAS Institute Inc*



Joshua Goldberg, partner, PTAB section leader

v lancu (138 S Ct 1348 (2018)), for example, has had a significant impact on the PTAB's approach to institution decisions. Rather than deciding whether to institute on a ground-by-ground or claim-by-claim basis, the Supreme Court held that the PTAB must either institute all claims and all grounds or deny institution. Since *SAS Institute*, the PTAB has responded by increasingly relying on discretion under 35 USC §§314(a) and 325(d) as a basis for denying institution and, in doing so, has altered the practice for both petitioners and patent owners.

Q: How have these changes affected your practice?

A: The increase in discretionary denials has resulted in additional complexity for petitioners and patent

“The increase in discretionary denials has resulted in additional complexity for petitioners and patent owners alike”



Erika Arner, partner



Benjamin Saidman, associate

owners alike. For petitioners, more strategic considerations come into play when filing a petition. They now have a litany of factors to consider that extend beyond proving invalidity in a clear and concise fashion, such as how the prior art in the petition compares to prior art previously considered by the USPTO and the timing of the petition relative to any related litigation. Likewise, the options available to patent owners in responding to a petition prior to institution have changed. Before *SAS*, many patent owners could avoid institution on select dependent claims by showing failures in the petition specific to those claims. Although partial institution is no longer possible, a patent owner has more procedural defects that it can identify in a petition to obtain a discretionary denial.

Q: What major trends do you think will shape the PTAB in the next five years?

A: The relationship between litigation and post-grant proceedings is evolving. With lower institution rates, the number of district court litigations are likely to rise, as patent owners feel more confident in their ability to navigate the PTAB. The use of discretionary denials presents additional complexities that arise in instances of parallel litigation. For example, discretionary denials are often the result of serial petitions by different petitioners against the same patent. This may in turn lead to more cooperation among members of joint defence groups in preparing and filing post-grant petitions. The timing of petitions relative to the trial dates in parallel litigation is now also a factor in the PTAB's decision to institute, and petitioners may experience increased pressure to file earlier to avoid the risk of a discretionary denial.

Q: What are the key factors to success when representing a petitioner in an *inter partes* review?

A: First and foremost, it is important to clearly establish the invalidity of the challenged patent, including the public accessibility of the prior art. But this is no longer enough. Petitioners must now balance a variety of factors, including:

- whether (and when) other petitions were filed against the same patent;
- the timing of the claim construction and trial in any co-pending litigation relative to the schedule in the post-grant procedure; and
- the differences between the prior art in the petition and the prior art already considered by the USPTO during prosecution.

Petitioners should also evaluate whether they will ultimately have Article III standing to appeal any final written decision to the Federal Circuit.

Q: What are the important areas to focus on when representing a patent owner in an *inter partes* review?

A: The PTAB's exercise of discretion has expanded the number of avenues to a denial of institution and patent owners now have a variety of options for finding vulnerabilities in a petition. Each of the considerations outlined above for a petitioner present vulnerabilities, and patent owners should consider whether these factors were properly addressed by the petitioner. They should also consider whether a strategic claim disclaimer can help to achieve a denial of institution by eliminating vulnerable claims and

focusing the PTAB on the remaining deficiencies in the petition. Patent owners should assess whether a focused expert declaration can be effective in addressing substantive holes in a petition.

Q: This is an extremely competitive practice area – how do you ensure that you stand out to prospective clients?

A: We are one of the leading firms handling trials before the PTAB. Since winning the first such trial, we have maintained our position as a leader in PTAB trial practice. Finnegan has consistently been recognised as one of the top firms with experience representing both petitioners and patent owners. We have been involved in nearly 900 PTAB proceedings and our victories in both challenging and defending patents are significant. Our PTAB experience spans not only volume, but also variety, as we have represented more than 175 clients across different industries and with varying strategic goals.

Q: Finnegan is one of the largest IP specialist firms in the market. What are the advantages of working in an outfit that is focused on intellectual property?

A: With our practice centered on IP law, we can create economies of scale and focus all our resources on providing the best tools, practices and procedures for our clients' IP matters. Many general practice firms offering IP services simply do not have the infrastructure to provide the sophisticated IP-related legal representation and counselling that global

companies require today. Our practice covers all aspects of patent, trademark, copyright and trade secret law, including counselling, prosecution, licensing and litigation. We also represent clients on IP issues related to international trade, portfolio management, the Internet, e-commerce, government contracts, antitrust and unfair competition.

Q: Finally, if you could make one change to PTAB practice, what would it be?

A: Increased predictability would benefit both patent owners and petitioners. The USPTO continues to make strides with respect to predictability through updates to the trial practice guide, designation of precedential and informative decisions, and the use of precedential opinion panels. We would like to see this continue. The PTAB's recent precedential opinion panel decision in *Hulu LLC v Sound View Innovations LLC* (IPR2018-01039) is a good example of the USPTO's efforts. The level of proof required to prove public accessibility often varies by panel and this decision should help to establish a uniform standard for all proceedings. We look forward to seeing more precedential opinion panel decisions in the future.

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