

# HARNESSING PATENT OFFICE LITIGATION



VOLUME XI

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



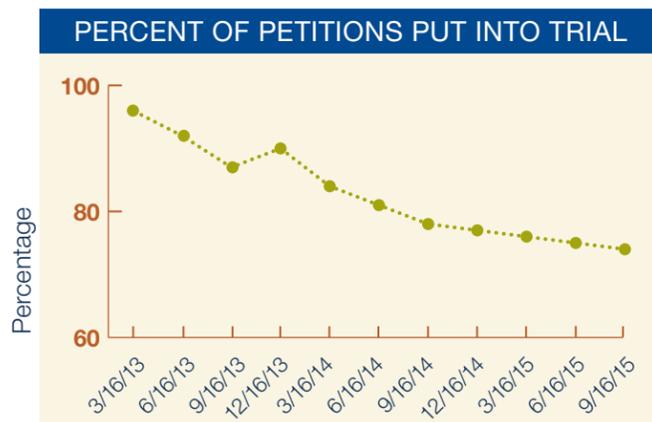
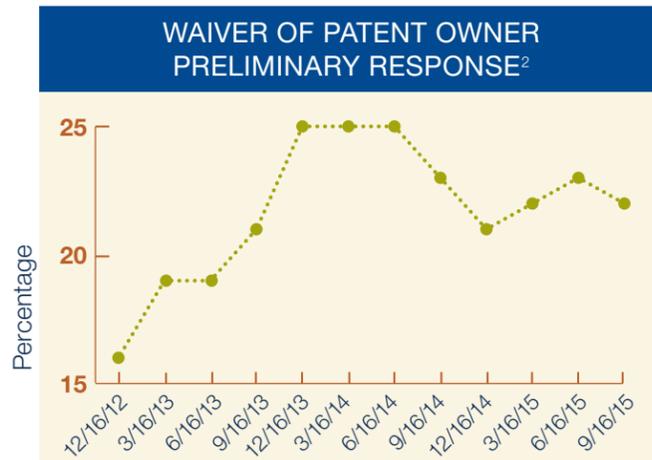
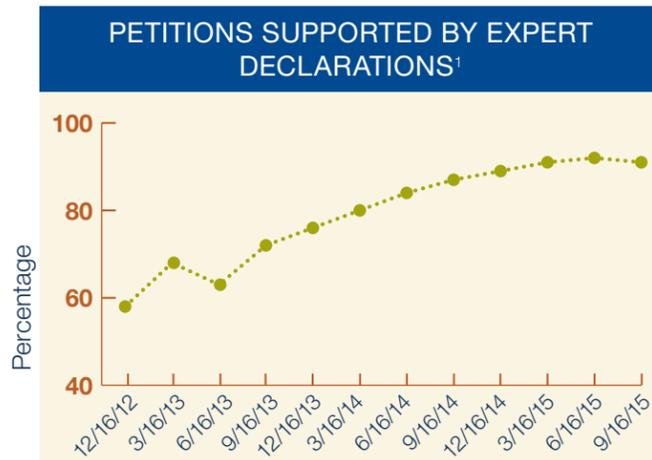
9|16|2012 to 9|16|2015

**HARNESS**  
**DICKEY**

While the initial Final Written Decisions were decidedly in favor of Petitioners (a 96.4% cancellation rate as of March 16, 2014), more recent decisions have increasingly sided with Patent Owners, bringing down the total number of canceled claims to 84.3%. Critics of IPR proceedings try to argue the various ways in which the proceedings are skewed toward Petitioners. It is becoming increasingly clear, however, that the *Inter Partes* Review process has added an efficient and cost-effective avenue to test the patentability of patent claims outside expensive, District Court litigation.

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

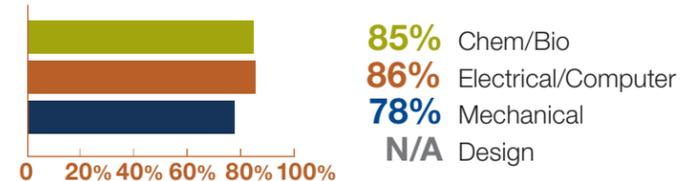
**TRIAL STAGE** Trial Stage of the Proceedings (PTAB Trial Initiation Decision through Final Written Decision)



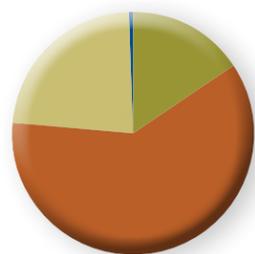
12/16/12—N/A



**CLAIMS CANCELLED IN FINAL WRITTEN DECISION BY SUBJECT MATTER**



**TECHNOLOGY OF CHALLENGED PATENT CHART**

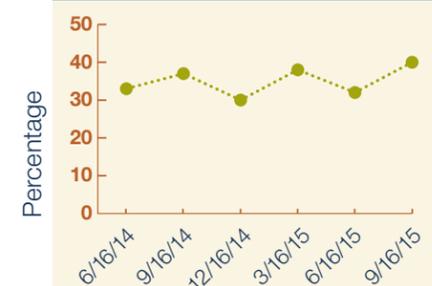


**534** Chemical and Biotech  
**2073** Electrical and Computer  
**787** Mechanical and Transportation  
**14** Design

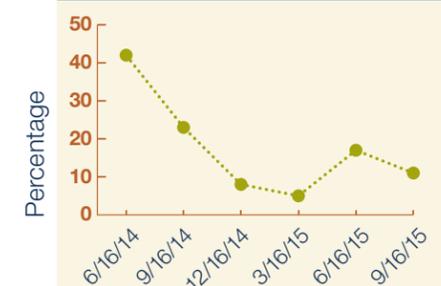
**TOP 6 IPR FILERS**

|            |            |
|------------|------------|
| <b>162</b> | <b>105</b> |
| <b>81</b>  | <b>70</b>  |
| <b>68</b>  | <b>49</b>  |

**CLAIM SURVIVAL RATE AT INSTITUTION DECISION**



**CLAIM SURVIVAL RATE AT FINAL WRITTEN DECISION**



<sup>1</sup> Over time, Petitioners have come to recognize that their Petitions must be supported by hard evidence in the form of expert testimony.

<sup>2</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.

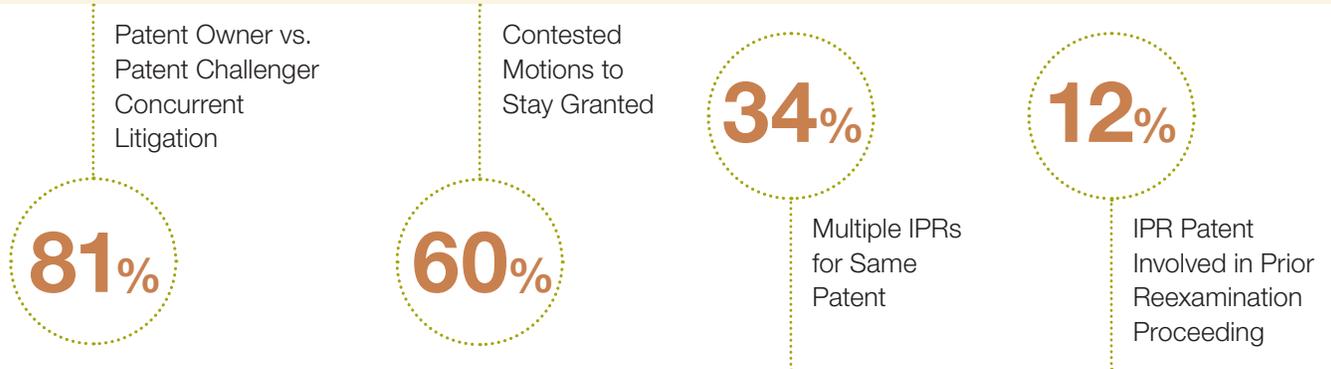
<sup>3</sup> As the PTAB's workload has steadily increased, the time to a Decision to Initiate has gradually climbed, as well. While the Board has statutorily been provided with three months to make that decision, it is taking about two weeks less than the full statutory allotment to come to a Decision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

<sup>4</sup> Percent of claims that were confirmed as patentable in a Decision to Institute or Final Written Decision.

<sup>5</sup> A total of six motions to amend have been granted through September 16, 2015.

# CONCURRENT PROCEEDINGS

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



Increasingly, and to get around the PTAB's onerous Motion to Amend requirements, Patent Owners are filing concurrent reissue or reexamination proceedings to offer a more robust substitute claim set.

## COURTS WITH HIGHEST WIN RATE FOR MOTIONS TO STAY<sup>6</sup>

|                                  |      |
|----------------------------------|------|
| DISTRICT OF UTAH                 | 100% |
| DISTRICT OF MARYLAND             | 100% |
| NORTHERN DISTRICT OF GEORGIA     | 88%  |
| SOUTHERN DISTRICT OF MISSISSIPPI | 83%  |
| NORTHERN DISTRICT OF ILLINOIS    | 81%  |

## COURTS WITH LOWEST WIN RATE FOR MOTIONS TO STAY<sup>6</sup>

|                               |     |
|-------------------------------|-----|
| EASTERN DISTRICT OF WISCONSIN | 11% |
| EASTERN DISTRICT OF TEXAS     | 23% |
| MIDDLE DISTRICT OF FLORIDA    | 36% |
| DISTRICT OF MASSACHUSETTS     | 46% |
| NORTHERN DISTRICT OF TEXAS    | 46% |

<sup>6</sup> For district courts with five or more decisions on motions to stay

## HARNESS DICKEY HAS DEMONSTRATED EXPERTISE IN PATENT OFFICE LITIGATION

we are achieving for our clients. 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 has developed the expertise to handle the specialized *Inter Partes* Review (and Post Grant Review) proceedings. That expertise shows in the results

*Microsoft Corp. v. Proxyconn, Inc.* (IPR2012-00026; IPR2013-00109); *LKQ Corp. v. Clearlamp, LLC* (IPR2013-00020); *Athena Automation Ltd. v. Husky Injection Molding Sys., Ltd.* (IPR2013-00167; IPR2013-00169, IPR2013-00290); *Bomtech Elect. Co., Ltd. v. MT. Derm GmbH* (IPR2014-00137; IPR2014-00138); *Heartland Tanning, Inc. v. Sunless, Inc.* (IPR2014-00018); *Laird Tech., Inc. v. GrafTech Int'l Holdings, Inc.* (IPR2014-00023; IPR2014-00024; IPR2014-00025); *Histologics, LLC v. CDx Diag., Inc.* (IPR2014-00779); *Webasto Roof Sys., Inc. v. UUSI, LLC* (IPR2014-00648; IPR2014-00649; IPR2014-00650); *Brose North Am. V. UUSI, LLC* (IPR2014-00416; IPR2014-00417); *Positec USA, Inc. v. Black & Decker, Inc.* (IPR2013-00502); *Plant Science, Inc. v. The Andersons Agriservices, Inc.* (IPR2014-00939; IPR2014-00940; IPR2014-00941); *HTC Corp. v. FlashPoint Tech., Inc.* (IPR2014-00902; IPR2014-00903; IPR2014-00934; IPR2014-01249; IPR2014-01460); *Fresh Products v. Ed Ramirez* (IPR2015-00475); *Enovate Medical v. Intermetro Industries Corporation* (IPR2015-00301); *Cequent Performance Products v. Hopkins Manufacturing Corporation* (IPR2015-00605); *Victaulic Company v. The Viking Corporation* (IPR2015-00423)



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).