

# HARNESSING PATENT OFFICE LITIGATION



VOLUME XII

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



9|16|2012 to 12|16|2015

**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,

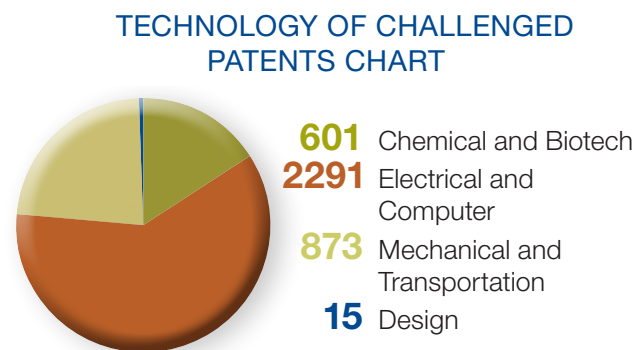
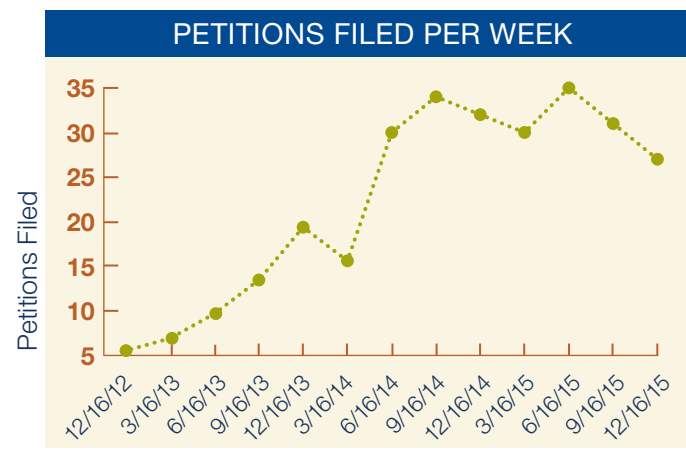
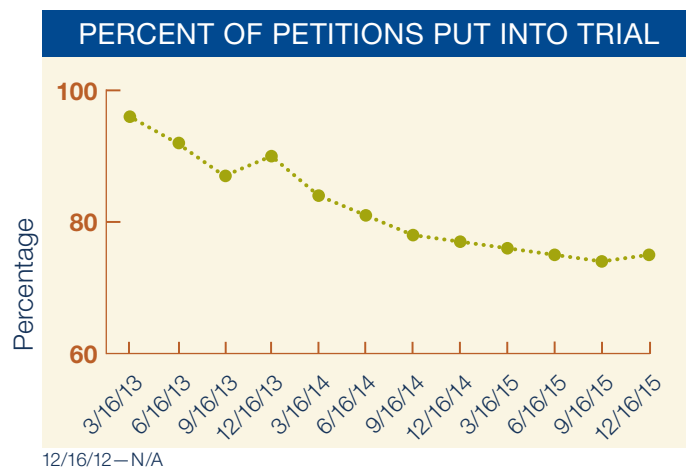
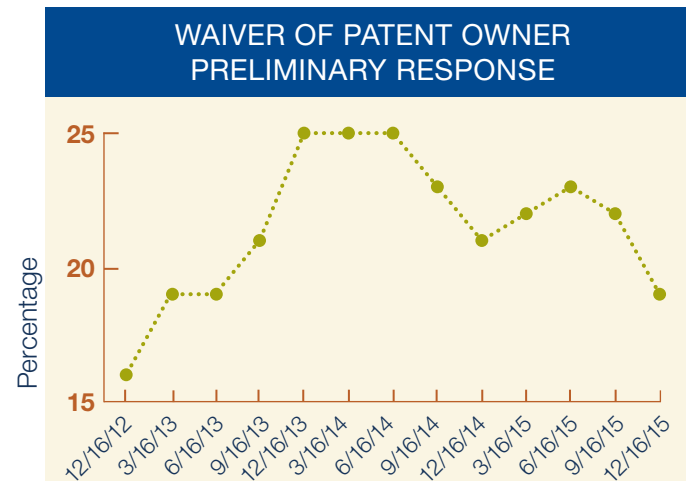
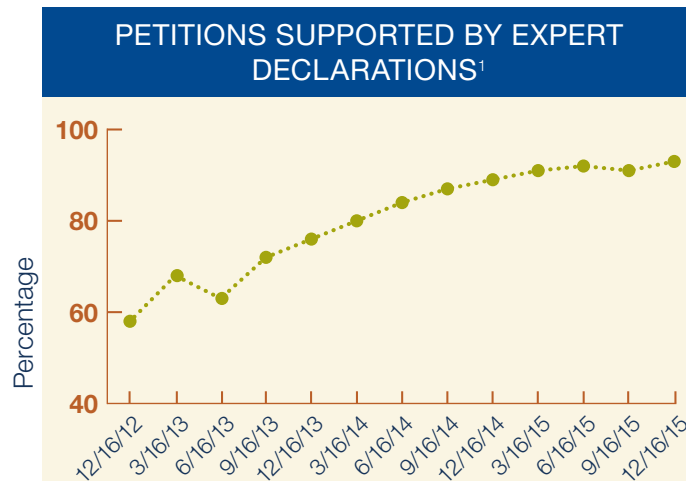
means that there may be no greater opportunity and true reform to come from the America Invents Act than these post-grant proceedings. Our periodic Report will provide insight based on the over 100 characteristics of these proceedings that we are tracking.

## 84.2%

### CLAIMS CANCELED IN FINAL WRITTEN DECISION

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 84.2%. 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 of expensive District Court litigation.

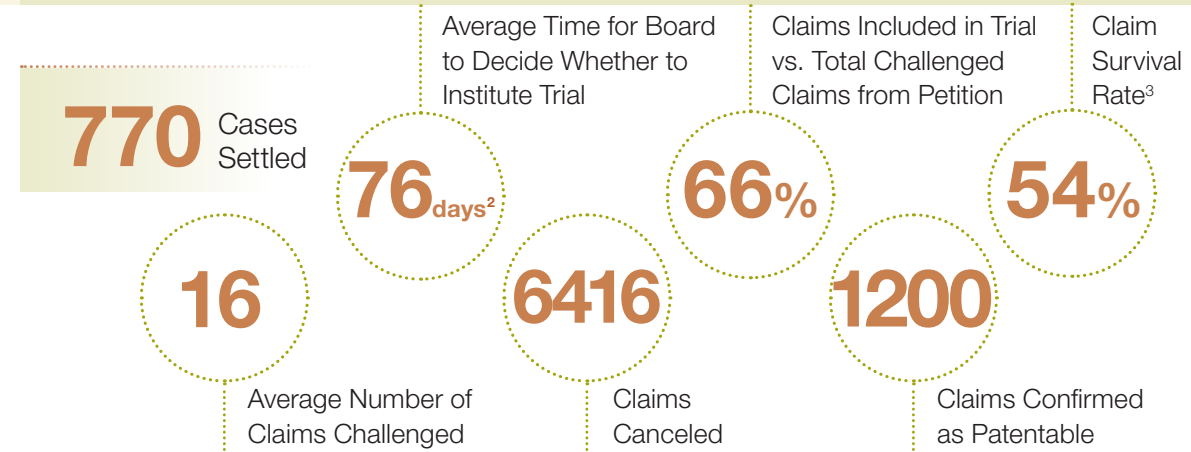
## PRELIMINARY STAGE Preliminary Stage of the Proceedings (Petition Filing through PTAB Trial Initiation Decision)



### TOP 6 IPR FILERS

184	80
114	73
85	51

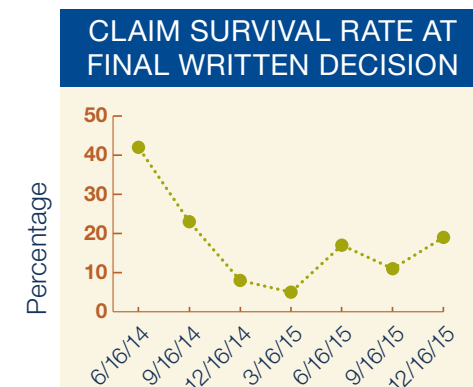
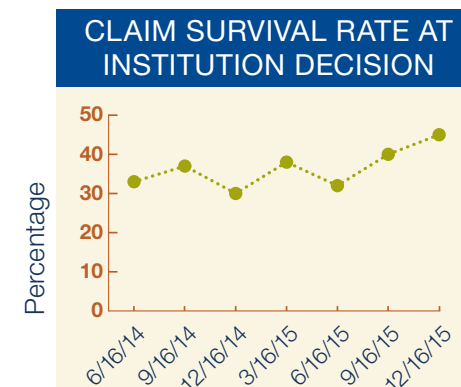
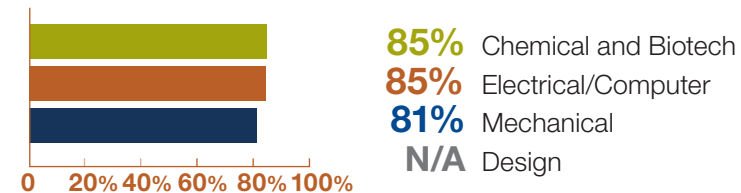
## TRIAL STAGE Trial Stage of the Proceedings (PTAB Trial Initiation Decision through Final Written Decision)



### Final Written Decisions



### CLAIMS CANCELED IN FINAL WRITTEN DECISION BY SUBJECT MATTER

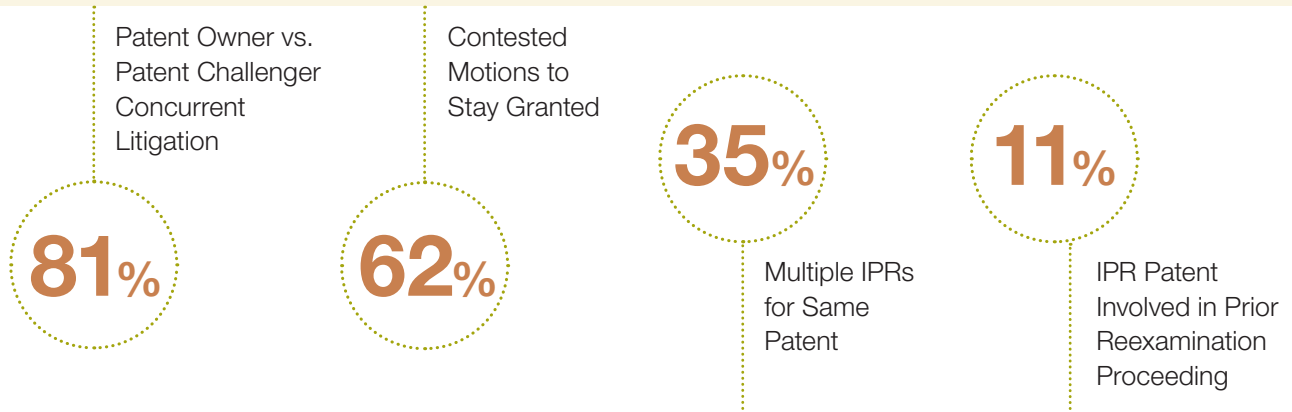


<sup>1</sup> Over time, Petitioners have come to recognize that their Petitions must be supported by hard evidence in the form of expert testimony.  
<sup>2</sup> As the PTAB's workload has steadily increased, the time to a Decision to Initiate has gradually climbed, as well. While the Board has statutorily 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>3</sup> Percent of claims that were confirmed as patentable in a Decision to Institute or Final Written Decision.  
<sup>4</sup> A total of six motions to amend have been granted through December 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>5</sup>

DISTRICT OF UTAH	100%
EASTERN DISTRICT OF VIRGINIA	94%
NORTHERN DISTRICT OF GEORGIA	83%
SOUTHERN DISTRICT OF MISSISSIPPI	83%
WESTERN DISTRICT OF TENNESSEE	77%

## COURTS WITH LOWEST WIN RATE FOR MOTIONS TO STAY<sup>5</sup>

EASTERN DISTRICT OF TEXAS	23%
EASTERN DISTRICT OF WISCONSIN	39%
EASTERN DISTRICT OF MICHIGAN	39%
DISTRICT OF MASSACHUSETTS	47%
MIDDLE DISTRICT OF FLORIDA	47%

<sup>5</sup> For district courts with six or more decisions on motions to stay

## HARNESS DICKEY SABERMETRICS

### We offer an Unmatched and Unique Statistical Advantage.

Harness Dickey clients benefit from the Firm's expansive and ongoing statistical analysis of IPR decisions. We have analyzed the reasons why a Petition has not succeeded (either at the Decision to Institute or Final Written Decision stage). In this way, as a Petitioner, we can "pressure test" a draft Petition against this data to ensure the highest possible level of success. As a Patent Owner, we evaluate a Petition against this data to determine the best avenues for attacking the Petition, including the identification of key cases that support our argument. In an advanced analysis, we can learn by judge or by subject matter what are the most common mistakes made in Petitions. In short, Harness Dickey clients take advantage of enhanced metrics to give them the highest chance of success in *Inter Partes* review proceedings. Please contact us for more details. – IPR-PGR@hdp.com.



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).