

# HARNESSING PATENT OFFICE LITIGATION



VOLUME VI

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



9|16|2012 to 6|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.

**68.7%**

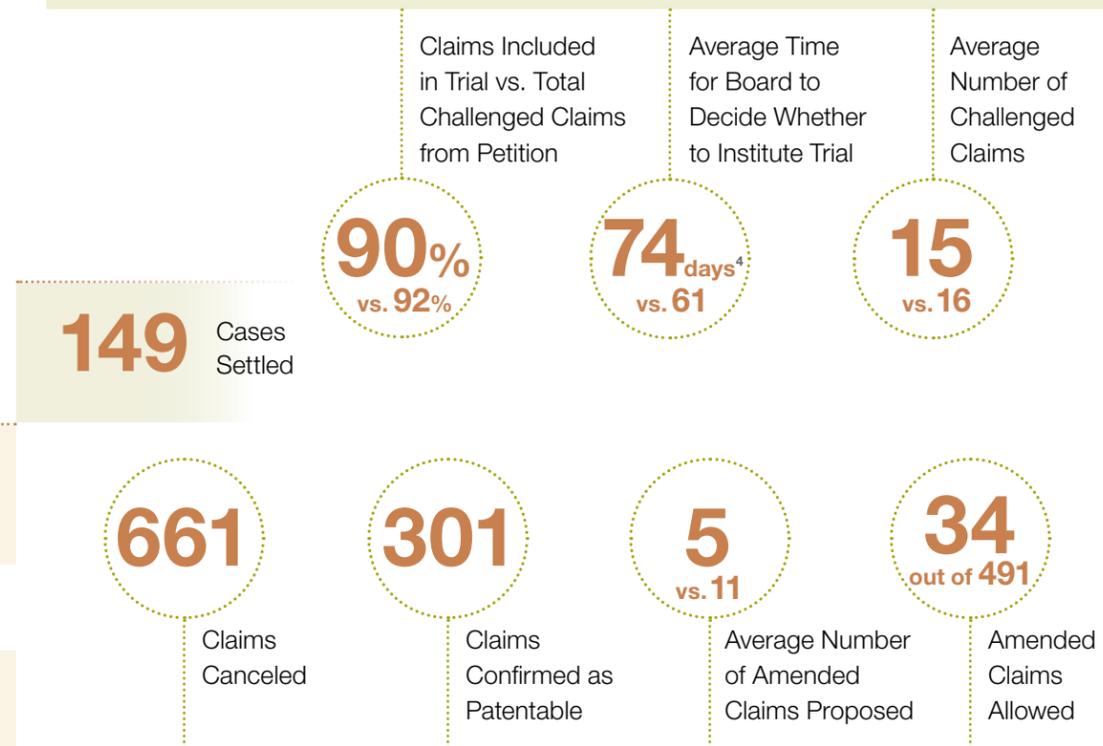
**CLAIMS CANCELED IN FINAL WRITTEN DECISION**

While the initial Final Written Decisions were decided 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 68.7%. 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)

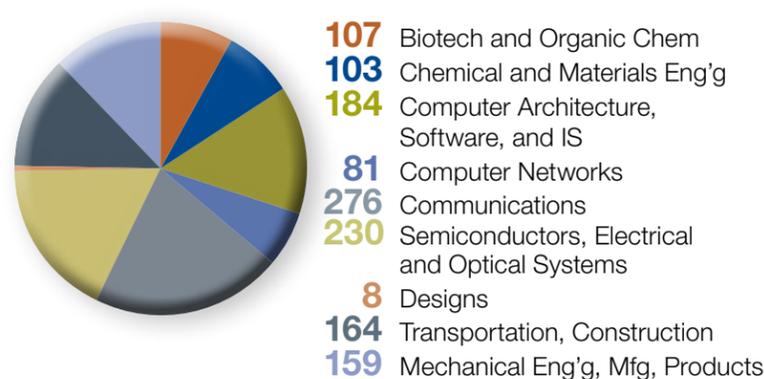


The Results are in from the First Set of Final Written Decisions

**PETITIONS FILED PER WEEK**



**TECHNOLOGY OF CHALLENGED PATENT CHART**



**SUCCESS RATE OF VARIOUS IPR MOTIONS<sup>5</sup>**



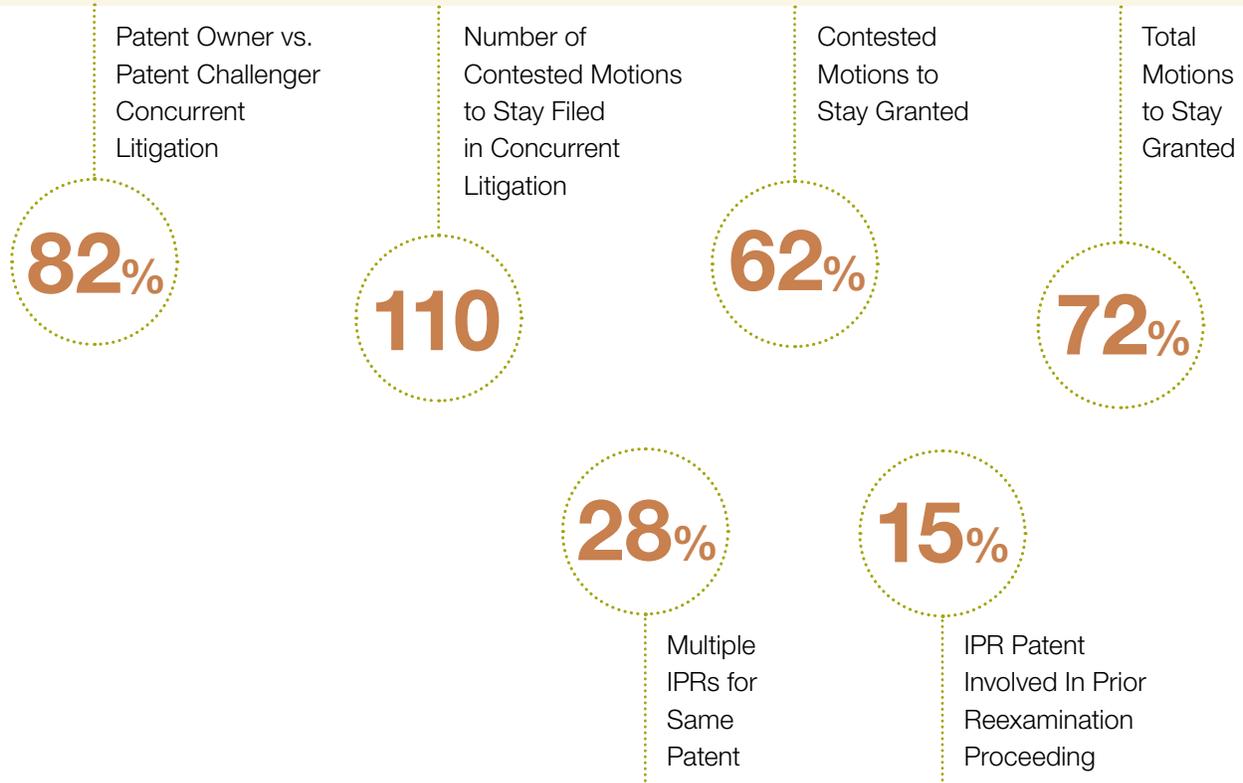
\*\* The statistics in this Report are provided along with a reference to the statistics through 9 months of IPR practice. In this way, trends can be identified regarding practice through the first 21 months of IPR practice.

<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> 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>5</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



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

**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. 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).