

HARNESSING PATENT OFFICE LITIGATION



VOLUME XIV

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



9|16|2012 to 6|16|2016



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,

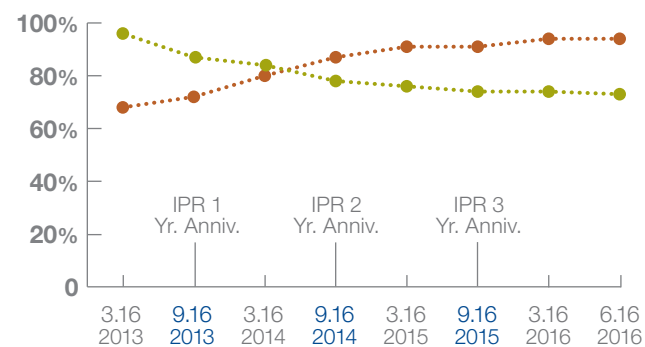
means that there may be no greater opportunity and true reform to come from the America Invents Act than these post-grant proceedings. Our periodic Report will provide insight based on the over 100 characteristics of these proceedings that we are tracking. Our analysis can also be followed at IPR-PGR.com.

82%

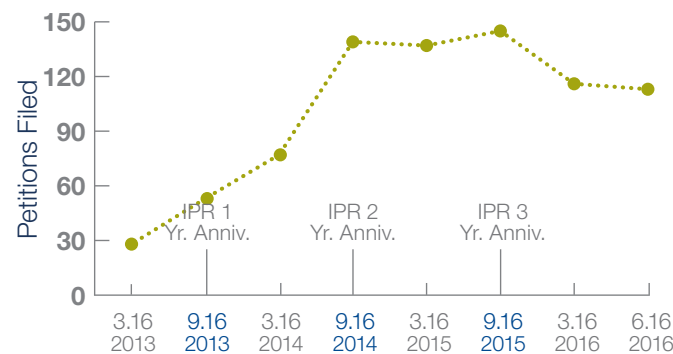
**CLAIMS
CANCELED IN
FINAL WRITTEN
DECISION**

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 82%. 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.

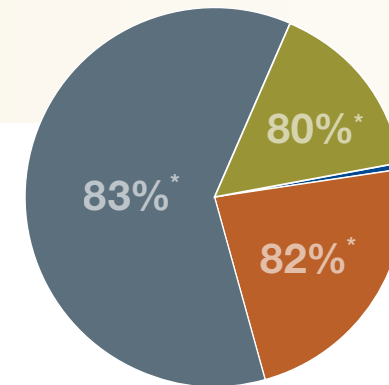
PRELIMINARY STAGE Preliminary Stage of the Proceedings
(Petition Filing through PTAB Trial Initiation Decision)



● PERCENT OF PETITIONS PUT INTO TRIAL
● PETITIONS SUPPORTED BY EXPERT DECLARATIONS¹



● PETITIONS FILED PER MONTH



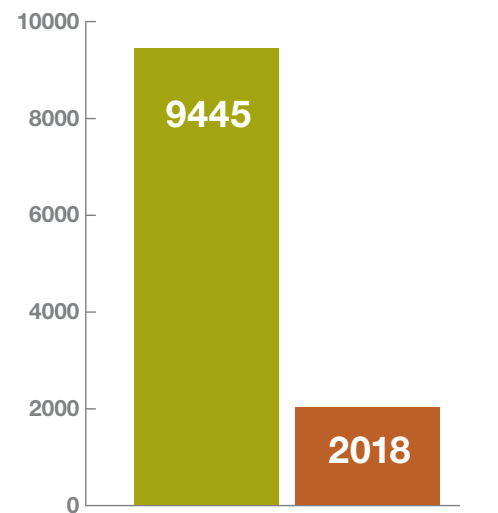
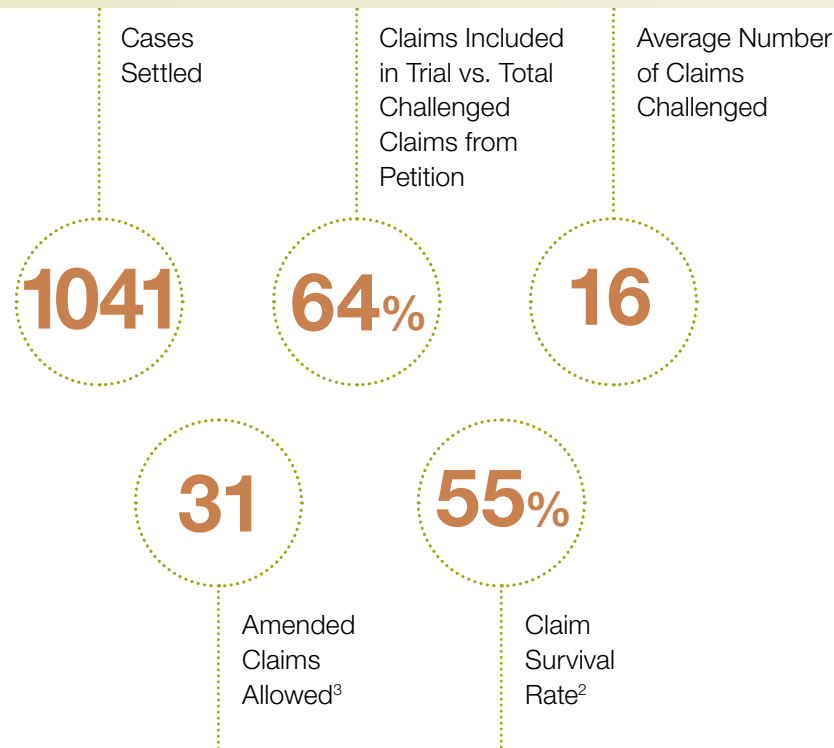
TECHNOLOGY OF CHALLENGED PATENTS CHART

- 703 Chemical and Biotech
- 21 Design
- 1021 Mechanical and Transportation
- 2725 Electrical and Computer

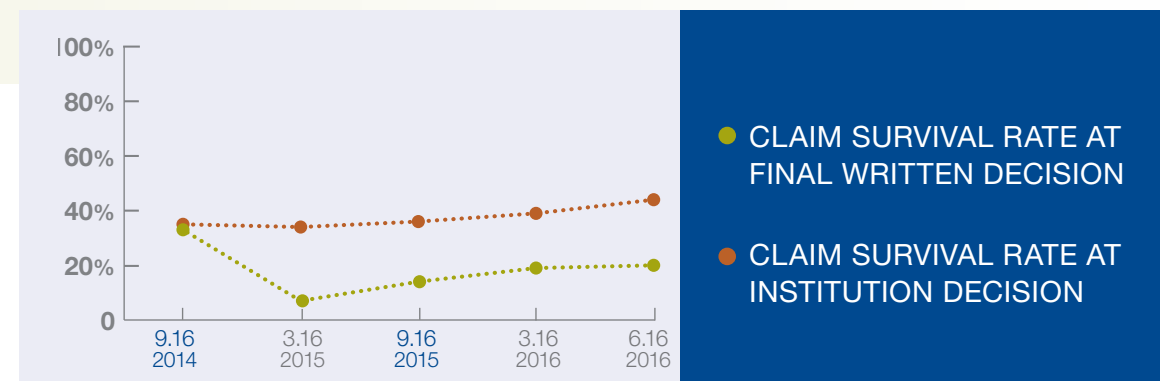
TOP 6 IPR FILERS

208	
127	
88	
86	
81	
58	

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



● CLAIMS CANCELED AT FINAL WRITTEN DECISION
● CLAIMS CONFIRMED AS PATENTABLE



● CLAIM SURVIVAL RATE AT FINAL WRITTEN DECISION
● CLAIM SURVIVAL RATE AT INSTITUTION DECISION

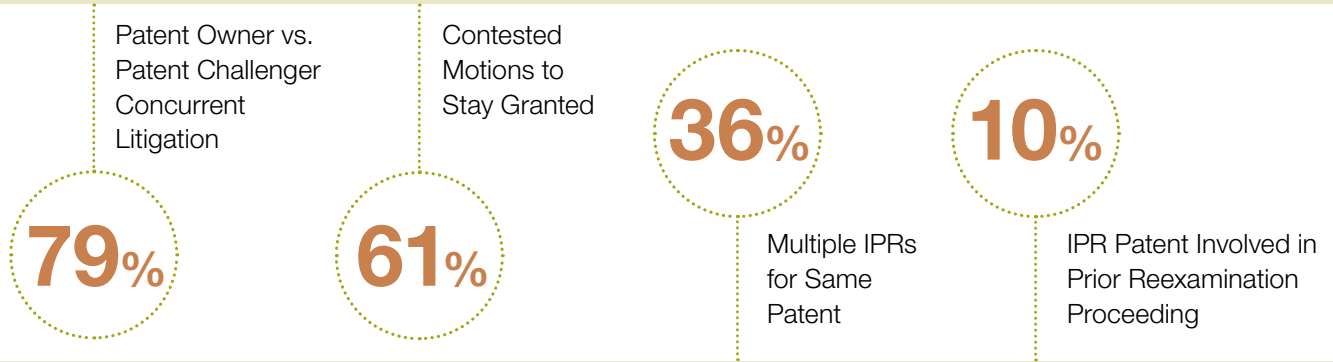
PETITION FILING	DECISION TO INSTITUTE	FINAL WRITTEN DECISION
Average Time for Board to Decide Whether to Institute Trial	5.6 months	Time from Decision to Institute to Final Written Decision
Time from Petition Filing to Final Written Decision		16.7 months

¹ Over time, Petitioners have come to recognize that their Petitions must be supported by hard evidence in the form of expert testimony.
² Percent of claims that were confirmed as patentable in a Decision to Institute or Final Written Decision.

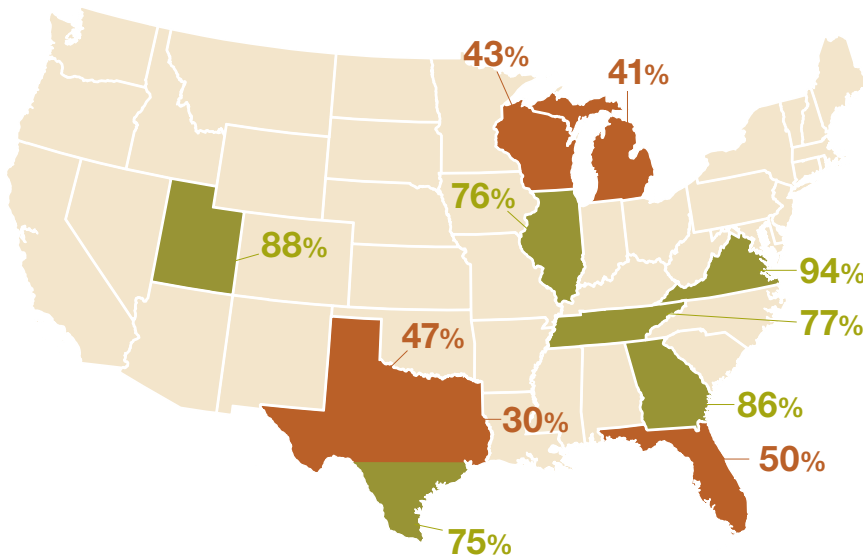
³ A total of six motions to amend have been granted through June 16, 2016.
* Claims Canceled in Final Written Decision

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 ⁴

Eastern District of Virginia	94%
District of Utah	88%
Northern District of Georgia	86%
Western District of Tennessee	77%
Southern District of Texas	75%

COURTS WITH LOWEST WIN RATE FOR MOTIONS TO STAY ⁴

Eastern District of Texas	30%
Eastern District of Michigan	41%
Eastern District of Wisconsin	43%
Northern District of Texas	47%
Middle District of Florida	50%

⁴ For district courts with eight or more decisions on motions to stay

MONEYBALL FOR IPRS

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.

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