

## POST-ISSUANCE PROCEEDINGS



Husch Blackwell's patent litigation team has represented clients before the Patent Trial and Appeal Board (PTAB) since its inception a decade ago under the America Invents Act (AIA). Our firm secured the PTAB's first final written decision stemming from the AIA's post-grant review process in 2016. Since that time, we have amassed an enviable track record before PTAB, achieving an 86% success rate for petitioners seeking to institute an *inter partes* review (IPR). But we don't stop there; our group also has an exceptional batting average in achieving favorable results for both petitioners and patent owners.

Our team knows PTAB practice in and out. Husch Blackwell attorneys secured a precedential PTAB decision for Sotera Wireless resulting in an industry-wide impact on patent litigation. Following the PTAB's May 2020 *Apple Inc. v. Fintiv, Inc.* decision, which established a six-factor test for denying IPRs, PTAB discretionary denials increased more than 60 percent. Undeterred, our team devised a strategy utilizing district court stipulations—now commonly called *Sotera* stipulations—to avoid IPR institution denials under the *Fintiv* test. As a result, IPR institution rates are rising again, preserving an important tool to challenge weak patent claims.

Our team comprises leaders of the PTAB bar and regularly speaks and publishes on post-issuance issues. A member of our team, now retired, literally wrote the book on PTAB practice under the AIA (*The America Invents Act: A Guide to Patent Litigation & Patent*

*When we were blindsided by a patent infringement lawsuit that could have put us out of business if found meritorious, we immediately turned to Husch Blackwell for assistance. As one avenue of attack, the legal team challenged the patents' validity at the USPTO in what was, at the time, the untested post-grant review process. Their decisive action and novel approach resulted in dismissal of the lawsuit and an order from the USPTO invalidating every claim of the asserted patents.*

— Wade Shafer,  
American  
Simmental  
Association —

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*Procedure*), and current Husch Blackwell attorneys continue to edit and append the text. Our group also features numerous attorneys who are recognized as leading practitioners in top legal directories, including Chambers USA, Benchmark Litigation, and IP Stars.

## Representative Experience

Represented the American Simmental Association (ASA) in a patent infringement case in the U.S. District Court for the District of Colorado involving methods of using genetic merit data to determine relative value of livestock. Obtained dismissal for ASA in the litigation and petitioned the PTO to reevaluate validity of the patents in post-grant proceedings. PTAB granted the petitions and issued the first ever PGR final decisions invalidating the patents.

In connection with defending a global leader in baby and children's products charged with patent infringement in federal court in California, we successfully invalidated all claims of the patent in suit by filing and winning an IPR at the Patent Trial and Appeal Board.

In connection with asserting infringement of a patent of the same global leader in baby and children's products against a competitor in federal court in Texas, we successfully defended all claims of the patent in a companion IPR at the Patent Trial and Appeal Board brought by the competitor. At the outset, the firm persuaded the PTAB to exclude some of the challenged claims from the proceeding entirely because the challenger had failed to establish a reasonable

case as to them. As to the remaining claims that went forward, none were invalidated, an infrequent outcome at the PTAB.

Represented Gnosis SpA in the first pharmaceutical-related IPR proceeding, involving patent directed to compositions including natural active metabolites used to treat folate deficiencies. Obtained finding of invalidity in all 58 challenged claims.

Represented Semiconductor Energy Laboratory Co., Ltd., the patentee, in two IPRs. Petitions for IPRs were filed and initiated against the patents. We defended the patents through the expert phase and then the IPRs were settled. We were able to achieve our client successfully maintaining its patents and all of its patent rights.

Represented Sotera Wireless against a major competitor. Sotera was accused of infringing nine patents, and Husch Blackwell prepared nine IPR petitions, eight of which were instituted. Husch Blackwell invalidated over 170 claims through IPR, and the PTAB canceled every claim of the eight patents. In addition, despite facing a major *Fintiv* challenge, Husch Blackwell attorneys avoided procedural denial using the *Sotera* stipulation playbook, which was found so persuasive by the PTAB that the PTAB marked the decision instituting IPR precedential. The *Sotera* stipulations were such a strong factor pointing to granting institution, that the *Sotera* stipulations overcame problematic trial court dates.

Represented a plush toy manufacturer against an entity that

persistently asserted a broad patent against our client. Husch Blackwell's team personally found a silver bullet prior art Japanese reference, which was found by the PTAB to anticipate the asserted claims. Despite hiring several search companies to find strong prior art, it was a Husch Blackwell attorney who found the silver bullet prior art reference, not a professional searcher. Husch Blackwell's IPR team includes former Patent Examiners.

In connection with representing a major aerospace manufacturer against accusations of infringement, Husch Blackwell petitioned the PTAB to invalidate the asserted patent relating to gas separation membranes. Husch Blackwell's team successfully convinced the PTAB to give significant claim language no patentable weight, resulting in an institution decision so favorable to Husch Blackwell's client that the adverse party immediately settled the matter under very favorable terms to our client. In addition, Husch Blackwell's team successfully convinced the PTAB to re-evaluate a prior art reference considered by the patent examiner during prosecution, which can be a difficult argument to make given the PTAB precedence disfavoring procedures that reconsider art already considered fully by the examiner during prosecution.

A large competitor sued our client, Panduit Corp, asserting nine patents. Husch Blackwell attorneys drafted eleven IPR petitions in an effort to invalidate most of the asserted claims. Ten of the eleven IPR petitions were instituted, and nine of the ten instituted IPRs resulted in all challenged claims found unpatentable. Of note, Husch Blackwell

attorney, Nathan Sportel was responsible for drafting all ten of the instituted IPR petitions.