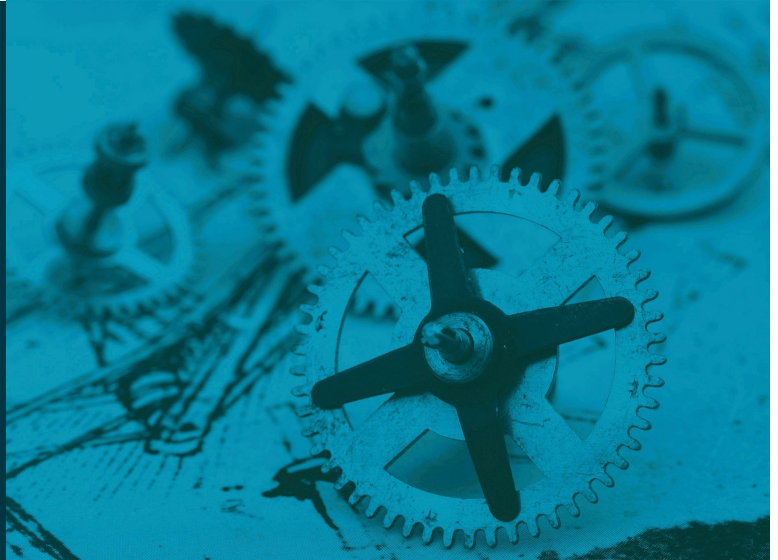


Post-Grant Review



HIGHLIGHTS

■ Extensive PTAB Experience

Wilson Sonsini's attorneys have extensive experience before the Patent Trial and Appeal Board, representing clients in numerous new trial proceedings, reexaminations, and patent interference trials.

■ Comprehensive Post-Grant Review Practice

Wilson Sonsini's team provides services in connection with covered business method review, inter partes review, post-grant review, derivations, and interferences.

■ A Recognized Practice

Wilson Sonsini's post-grant practice has been recognized for its representation of litigants before the PTAB by *Managing Intellectual Property* magazine and *Docket Navigator*.

OVERVIEW

The professionals in Wilson Sonsini's Patent Trial and Appeal Board (PTAB) practice are well suited to navigate the complex trial proceedings at the United States Patent and Trademark Office (USPTO). We have extensive experience before the PTAB, representing clients in numerous new trial proceedings, as well as reexaminations and patent interference trials.

Our practice includes professionals with decades of experience at the PTAB, including former PTAB personnel. Our core team leverages firmwide intellectual property expertise to provide comprehensive IP solutions for clients that cover strategy, prosecution, licensing, enforcement, and defense. When there is concurrent infringement litigation, our PTAB litigation team coordinates seamlessly with our other litigators.

Responding to Change

The America Invents Act (AIA), signed into law in 2011, created four fast-track trial proceedings at the USPTO: covered business method review (CBM), *inter partes* review (IPR), post-grant review (PGR), and derivations. The PTAB administers each of these new trials, as well as legacy trials, particularly patent interferences (for patents and patent applications with effective filing dates prior to March 16, 2013).

An intricate web of administrative rules, practice guidelines, and decisional law governs PTAB trials. Trials are designed to ensure that all discovery, briefing, and oral arguments are completed within nine months. The PTAB must issue a final written decision within one year from the date trial is instituted. Given these tight timeframes, a successful strategy for PTAB litigation requires careful planning and execution by experienced practitioners who are well versed in PTAB rules and strategy. Misguided PTAB strategy and/or failure to adhere to these rules have caused needless expense and unfavorable case outcomes.

Full Range of Offerings

Covered Business Method Review. Wilson Sonsini is among the top filers of petitions for CBMs in the country. CBM trials address the patentability for certain business method patents that claim a method or apparatus used in the practice, administration, or management of a financial, product, or service, with the exception of patents directed to technological inventions. A party may not file a petition for a CBM proceeding unless the party, its real party in interest, or its privy has been charged with infringement of the patent. CBM proceedings employ the standards and procedures of a post-grant review, with certain exceptions.

Wilson Sonsini had one of the earliest CBM cases to reach final decision, resulting in the cancellation of all challenged patent claims, *Bloomberg Inc. v. Markets-Alert Pty. Ltd.*, CBM2013-00005, and obtained the first stay of litigation pending CBM review by the Patent Board, *Markets-Alert Pty. Ltd. v. Bloomberg Finance L.P.*, No. 12-780-GMS, 2013WL 443973 (D. Del. Feb. 5, 2013). Wilson Sonsini also obtained the first U.S. Court of Appeals for the Federal Circuit decision overturning a district court denial of stay pending CBM Review, *VirtualAgility, Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307 (Fed. Cir. 2014). Wilson Sonsini represented Salesforce.com in the CBM proceeding and at the Federal Circuit.

Inter Partes Review. IPRs are trials challenging patents based on prior art patents and printed publications. Any issued U.S. patent, regardless of priority, can be challenged by a third party, but patents issuing on applications filed after March 16, 2013, must go through a nine-month period post-grant to allow for any possible post-grant review. Although the majority of IPRs involve co-pending litigation, a challenger need not have been sued on the patent or threatened with suit to file a petition. If sued on a patent, a party has one year to file its petition with the PTAB after being served with a complaint. A party must file a petition before filing a declaratory judgment action challenging the validity of a claim of a patent. If the PTAB determines that a petition demonstrates a "reasonable likelihood" of prevailing on at least one claim, trial is instituted. The patent owner has an opportunity to respond to the allegations, including optionally amending the patent's claims. Even though the burden of proof is on the petitioner, PTAB statistics indicate that once trial is instituted, in most cases at least some of the challenged claims will be held unpatentable. A final PTAB decision can only be appealed to the U.S. Court of Appeals for the Federal Circuit.

We have extensive experience in IPRs, representing both petitioners and patent owners. Wilson Sonsini has represented numerous petitioners, successfully employing coordinated PTAB and district court litigation strategies in defending against infringement assertions. Wilson Sonsini has also established a tremendous track record defending innovators of key life sciences technologies, including successfully defending all challenged claims of entirely through PTAB trials—an uncommon feat at the PTAB. *Ariosa Diagnostics v. Verninata Health, Inc.* (IPR2013-00276, 00277).

Post-Grant Review. PGRs are new trial proceedings that apply only to patents issuing from applications filed on or after March 16, 2013, pursuant to the AIA's first-inventor-to-file system. A patent can only be challenged in a PGR during the first nine months after it issues. In contrast to an IPR, which is limited to prior art patents and printed publications, a PGR can advance a challenge on any basis of unpatentability. A PGR may be instituted upon a showing that it is "more likely than not" that at least one challenged claim is unpatentable. As with IPR, the patent owner has an opportunity to respond and may file a motion to amend the patent by substituting new claims. The PTAB will issue a final determination within one year after it institutes trial, and an appeal can only be filed with the Federal Circuit.

Derivations. This new PTAB trial procedure determines whether an inventor who is the first to file an application is the true inventor or had derived the invention from someone who files later. The later-filing applicant must initiate the petition, requesting a derivation proceeding within one year of the first publication of a claim in the first-file application that is the same as the later-filed application's claim. The petition must be supported by substantial evidence of derivation. This new proceeding is an adaptation of derivation motions in interference proceedings, but only applies to applications filed under the first-inventor-to-file regime effective March 16, 2013.

Interferences. Wilson Sonsini's PTAB professionals have unsurpassed experience in patent interferences, a PTAB trial procedure available for applications with effective filing dates prior to March 16, 2013. In an interference, the PTAB determines who was the first to invent the subject matter being claimed among competing patent applications, or applications and patents owned by two or more entities (priority), and may also determine patentability of the involved claims.

Third-Party Recognitions

Wilson Sonsini's post-grant practice is nationally recognized as a leader for representing petitioners and patent owners before the Patent Trial and Appeal Board. For the first half of 2016, the firm was ranked by *Managing Intellectual Property* magazine as the No. 2 law firm acting on behalf of petitioners, and as the No. 4 law firm representing either petitioners or patent owners before the PTAB. Additionally, Wilson Sonsini was ranked No. 8 in Docket Navigator's list of the top law firms and corporate legal departments that represented litigants in 2016 *inter partes* review (IPR), covered business method (CBM), or post-grant review (PGR) proceedings at the PTAB. Wilson Sonsini partner Michael Rosato was also ranked as the No. 1 attorney in the country for filing the most petitions on behalf of petitioners during the period. In addition, Michael and partner Matt Argenti were named among Docket Navigator's list of top attorneys that represented litigants in 2016 IPR, CBM, or PGR proceedings at the PTAB. Further, Wilson Sonsini was ranked among the top 15 percent of all law firms for IP litigation in the *BTI Litigation Outlook 2017* report, based on client feedback from in-depth interviews with corporate counsel at the world's largest companies.