

Inter Partes Reviews and Other Post-Grant Proceedings

Overview

Dentons' post-grant team is among the strongest and most experienced in the country. Both the ABA and IPO recognize us as leaders in the field—they frequently invite us to speak at national meetings, and we lead many of their post-grant policy projects. Managing IP recognized Dentons as a top-ten IPR filer in 2015. We regularly advise on the most complex proceedings that are litigated in the Patent Trial and Appeal Board ("PTAB"). The team has conducted over 45 PTAB proceedings, including successfully handling several recent PTAB trials and oral arguments, as well as effectively representing petitioners and patent owners in hundreds of reexaminations.

Our team is skilled in handling complex proceedings before the US Patent and Trademark Office (USPTO)—including proceedings by which a patent can be challenged or patent owners can strengthen a patent. Our team's exceptional experience with IPRs, covered business method reviews, post-grant reviews, interferences, inter partes and ex parte reexaminations, reissues and oppositions makes Dentons uniquely qualified to take advantage of the challenges and opportunities presented by all areas of post-grant practice.

Our team's unique blend of patent prosecution and patent litigation experience provides the skills required to handle any post-grant proceeding before the USPTO. The team develops strategies and techniques for the offensive and defensive use of post-grant proceedings, both prior to litigation and as part of an overall litigation strategy. Several of our lawyers are former USPTO examiners. Our knowledge of these advanced patent office procedures, coupled with our deep and wide-ranging technical and scientific expertise, helps clients obtain and protect their intellectual property assets and further their business objectives.

Dentons has one of the strongest post-grant teams in the country. Find out more about our Post-Grant Services.

Representative Experience

- **WaveMarket v. Locationet:** Representation of petitioner, WaveMarket, in two IPR trials instituted in 2013–2014. Obtained rare grant of second subsequent IPR of same patent, and defeated real party-in-interest and privity challenges to both petitions. After a successful oral hearing and victorious final written decision in the first trial, we obtained a very favorable settlement for our client.
- **Jiawei Technology, et al. v. Richmond:** Ongoing representation of petitioners in multiple pending IPR proceedings filed in 2014 involving solar-powered lighting resulting in nearly all claims canceled after successful oral arguments, pending appeal. Dentons also successfully defended a procedural challenge regarding real party in interest—a rare and important victory for petitioners.
- **Ford Motor Company v. Paice et al.:** Ongoing representation of petitioner, Ford, who filed 25 IPR reviews through 2015 resulting in hundreds of claims being canceled, pending appeal.
- **Wowza v. Adobe:** Represented patent owner, Adobe, and received one of the first patent owner successes defending a 2012 IPR petition. By obtaining this decision to not institute, we preserved Adobe's patent and saved them many thousands of dollars that it would have cost to defend against the IPR.
- **eBay, Inc. v. XPRT Ventures, LLC:** Ongoing representation as third-party requester, eBay, in a multi-billion dollar dispute filed in 2011 involving six inter partes reexaminations. The PTAB has rejected all claims and appeals are presently pending at the Court of Appeals for the Federal Circuit.
- **Ossia v. Energous:** Represented patent owner/operating company, Energous, and successfully obtained denial of a PGR petition and denial of all meaningful claims, i.e., 16 of 18 claims, in a second PGR petition, both filed in

2016—an overwhelming victory.

- **Asus et al. v. KW-2:** Represented petitioners, Asus, Dell, HP, and LG, in obtaining a negotiated settlement in an IPR.
- **A.R. Arena Products, Inc.:** Defended a supplier of proprietary material handling products and systems in multiple inter partes and ex parte reexamination proceedings involving patents directed to bulk shipping container systems providing reduced residual content upon evacuation.
- **Monsanto:** Representing the agricultural biotechnology leader in several inter partes Reexamination proceedings involving patents covering healthier soybean seed oils and plants.
- **MotionPoint:** Representing a website translation company, as lead counsel in seven inter partes reexamination proceedings involving technologies in web site translation technologies.

Your Key Contacts

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