Pillsbury IP practitioners literally wrote the book on post-grant proceedings, offering insights into past decisions and guidance on navigating the complex rules and procedures that govern the PTAB hearing process.

Blending exceptional knowledge of technologies with patent prosecution and patent litigation skill, Pillsbury IP lawyers represent clients in a wide range of proceedings before the USPTO’s Patent Trial and Appeal Board. These matters include *inter partes* reviews, covered business method reviews, post-grant reviews, derivation proceedings, and appeals. We are also involved in other USPTO proceedings such as patent reissues. Many of the Pillsbury IP lawyers have advanced degrees in every technology sector from biotechnology to telecommunications and computer software. We assist clients from a wide range of industries regarding a vast array of technologies, including medical devices, imaging technology, polymers, films, catalyst technology, fuel cells, biomass fuels, industrial manufacturing, cosmetics, pharmaceuticals, advanced telecommunications, and biotechnology.

Well versed in the America Invents Act of 2011, its rules and their ramifications, we represent patent holders and patent challengers, utilizing post-grant proceedings to challenge competitors’ patents or strengthen a patent already granted. Our lawyers offer cost-effective counsel, advising on the strategic advantages of the various types of proceeding available, and helping clients to evaluate their options and select the best course of action. In many instances, we have enabled clients to avoid costly patent infringement litigation and injunctions that would have severely impacted their businesses.

Our intellectual property lawyers are experienced in all forms of post-grant review, representing clients regarding:

- Covered business method
• Derivation proceedings
• *Ex parte* reexaminations
• *Inter partes* reviews
• Patent reissues
• Post-grant reviews
• Supplemental examinations
• Interferences (applies to patent applications filed prior to March 16, 2013)

**REPRESENTATIVE EXPERIENCE**

Represented MotionPoint Inc., won a covered business method review before the PTAB by convincing the Patent Office to invalidate Transperfect’s Scanlon patent previously found by district court to be valid and infringed.

Won *inter partes* victories safeguarding medical device marker’s life-saving innovations by establishing validity of key patents in multiple IPR proceedings in which plaintiffs alleged patent infringement.

Took over representation from another law firm that filed a petition for IPR on a patent covering Cialis, a multi-billion dollar a year drug. After the PTAB denied institution, we filed a request for reconsideration of the denial, the PTAB ordered briefing on the request, and we secured a favorable settlement for our client in a few weeks after the PTAB ordered briefing.

• Represented Textron in two Post Grant Reviews of a patent asserted in pending district court litigation. After nearly a year of litigation, we obtained a very favorable settlement for Textron two days after the PTAB granted the first petition for PGR.

• Represented tool manufacturer in multiple IPR proceedings against a patent asserted in district court litigation. Obtained a final written decision invalidating the relevant claims that was affirmed by the Federal Circuit.

• Achieved victory for Schrader-Bridgeport International in *inter partes* review with PTAB finding unpatentable several claims in a tire pressure monitoring system patent-owned by two Swiss companies. Federal Circuit affirmed the PTAB’s decision on invalidity, and reversed the PTAB with respect to one claim that the PTAB found not invalid.

• Convinced the PTAB to deny institution of a petition for IPR filed against our client’s key patent covering self-assembling peptides. The petitioner asserted its own patent against our client in district court litigation in which we received a favorable Markman order. The petitioner requested adverse judgment of non-infringement shortly thereafter.
Represented an international beverage and brewing company in a derivation matter.

Represented semiconductor company in three separate inter partes reexaminations.

Advised client on indemnification request related to a release of escrow stemming from a Merger and Acquisition Agreement, in the context of patent litigation and IPR proceedings.

Conducted a number of inter partes reviews on behalf of clients involved in patent infringement litigation.

Represented client in covered business method reviews of patents asserted in litigation and succeeded in invalidating a patent found by the district court to be not-invalid, and infringed.

Represented client in patent infringement litigation and corresponding inter partes and ex parte reexaminations, inter partes review, and interferences.

Represented a medical device maker as petitioner in a number of inter partes reviews invalidating patents that were asserted in litigation.

Represented patent owner, a multi-industry conglomerate, in three inter partes reviews involving patents asserted in litigation.

Served as lead attorneys for patent owner conglomerate in two inter partes reexaminations (and one ex parte reexamination) involving patents asserted in litigation. (Patents survived reexamination.)

Conducted four inter partes reexaminations for a wireless technology company on GPS-related patents for client years after ITC found them not invalid. Following USPTO initial determination of invalidity, helped establish a global settlement.

PRACTICE AREA HIGHLIGHTS

Ranked by The Legal 500 U.S. in patent prosecution, including reexamination and post-grant proceedings (2018).


Ranked in Washington, DC and Texas as one of the world’s leading IP practices across all aspects of patent law by Intellectual Asset Management’s “IAM Patent 1000” and four partners named individually (2018).

- Ranked as a “Recommended” firm for IP in four categories in California and as “Highly Recommended” in one IP category in Virginia by Managing Intellectual Property magazine (2018).
- Corporate Counsel named Pillsbury 2015 “Go-To Firm” – Intellectual Property Litigation and noted
the firm as a Top-10 Intellectual Property “Go-To” Firm for Fortune 500 companies.