Our IP lawyers have extensive district court and trial experience, which gives our clients a competitive edge in PTAB proceedings. As a result of this trial experience, our lawyers have developed an enhanced understanding of the strategic concerns in PTAB and parallel district court cases, along with an awareness of the best technical arguments and evidence with respect to prior art, claim construction, and invalidity contentions. According to a recent case study by Patexia, McKool Smith ranks as the second most successful law firm in the nation for representing patent holders in IPR disputes.

Representative Matters

Our attorneys’ IPR/PTAB experience includes the following matters, among others:

- **Parallel Networks.** Represented patent owner Parallel Networks as lead and sole counsel before the PTAB against multiple IPR petitions filed by Microsoft and IBM, obtaining confirmation of every challenged claim in final written decisions. Microsoft and IBM had filed the IPR petitions after Parallel Networks sued the companies in the District of Delaware for infringement of the patents concerning dynamic web page generation. McKool Smith represented Parallel Networks throughout the IPR proceedings, from the patent owner preliminary response through the final hearing before the PTAB. The PTAB final written decisions found every challenged claim valid.

- **BMC.** Represented patent owner BMC as lead and sole counsel before the PTAB against several IPR and CBM petitions filed by ServiceNow, obtaining four decisions of non-institution.

- **ContentGuard.** Represented patent owner ContentGuard as co-counsel in thirty-five IPR and CBM proceedings filed by Google and Apple. Institution was denied with respect to all but one of these petitions.

- **PersonalWeb.** Represented patent owner PersonalWeb against Apple in a Federal Circuit appeal of an adverse IPR decision involving a cloud storage patent, obtaining vacation and remand.

- **Good Technology.** Represented patent owner Good Technology in four IPR proceedings filed by VMware, securing four denials of institution in landmark decisions. The PTAB agreed with Good Technology that the petitioner VMware was time-barred under 35 U.S.C. §315(b). Good Technology successfully argued that privity was to be determined at the time the IPR petitions were filed (at which point in time there was a parent-subsidiary relationship between VMware and the district court defendant AirWatch), rather than the much earlier date on which the district court complaint for infringement was served on AirWatch (prior to VMware’s relationship with AirWatch).

- **T-Mobile.** Represented T-Mobile against Mobile Telecommunications Technologies in securing the institution of two IPR proceedings against patents involving wireless technology. The IPRs were successfully joined with earlier PTAB proceedings over opposition from the patentee. The proceedings were later terminated by party agreement as part of a favorable settlement.

- **NFC Technology.** Representing patent owner NFC Technology as lead and co-counsel against three IPR petitions filed by HTC on two near-field communication patents, securing the denial of one of the petitions and obtaining a rare reversal and remand after appealing to the Federal Circuit.
Inter Partes Review/PTAB Disputes (cont'd)

- **Massachusetts Institute of Technology (MIT).** Represented patent owner MIT as lead and sole counsel against an IPR petition filed by Micron Technology against an MIT patent directed to semiconductor fuse technology.

- **Albritton.** Successfully represented Dr. Ford Albritton in an *inter partes review* trial before the Patent Trial and Appeal Board (PTAB) against Acclarent concerning the validity of patents for a sinuplasty device. McKool Smith recently scored a victory, when the board upheld a patent on a surgical device that the doctor has accused Acclarent Inc. of infringing. The board rejected Acclarent’s arguments in inter partes review that numerous claims in Dr. Ford Albritton IV’s patent were invalid either because they were anticipated or because they were made obvious by earlier inventions. The PTAB’s decision ends the second of two challenges Acclarent brought against the patent.