

Patent Office Trials

Post-issuance review and reexamination proceedings are frequently used to address patent validity issues at the Patent Trial and Appeal Board (PTAB) in parallel with, or as an alternative to, federal district court cases. The interplay between litigation and patent office trials and reexamination is complex and extensive. Choosing an appropriate strategy may involve issues with conflicting priorities where each proceeding may impact another, including claim construction, admissions impacting infringement, claim amendments, estoppel against further validity challenges, entitlement to injunctive relief, intervening rights, vacatur of trial court judgments and enhanced damages.

Given this substantial interrelationship, it is essential—especially in high-stakes matters with significant strategic complexity—to hire a legal team that seamlessly integrates in-depth experience in patent post-issuance review, reexamination and litigation. Irell & Manella LLP offers this unique combination. Our practice combines one of the nation's premier litigation practices with substantial experience in PTAB proceedings, including inter partes review (IPR), covered business method review and ex parte reexamination.

Our Patent Office Trials team includes Michael Fleming, former chief administrative patent judge of the PTAB. As chief judge, he assisted Congress in drafting the post-grant provisions of the America Invents Act (AIA) and played a critical role in the creation of the IPR statute. During more than 30 years with the USPTO, including 17 years as an administrative patent judge, he helped establish many of its present patent procedures and policies, including several of the examination guidelines and the federal rules for patent office examination. Judge Fleming was responsible for many of the precedential opinions that are currently binding on administrative patent judges of the PTAB. He also instituted the official standard operating procedure for issuing precedential opinions that establish binding precedent on issues before the PTAB and aid in developing best examination practices.

Irell's team boasts more than 20 registered patent lawyers, including former patent examiners and U.S. Court of Appeals for the Federal Circuit clerks. Many of our partners bring to the practice substantial professional experience working in the technology industry, as well as advanced technical degrees in areas such as computer engineering, computer science, chemical engineering, electrical engineering, mechanical engineering, inorganic chemistry, physics, materials science, molecular pharmacology and pharmacy. Our team also has extensive connections with scientists, engineers and technologists who can provide expert testimony in PTAB proceedings.

Experience

Representative Patent Office Trials

- *Wells Fargo Bank, N.A. v. United Services Automobile Association*. Successfully represented USAA at the PTAB after Wells Fargo sought to invalidate seven USAA patents involving mobile remote deposit capture technology. Irell blocked all seven of Wells Fargo's first wave of petitions—six CBMs and one IPR—and subsequently secured \$200 million and \$102 million jury awards, plus individual findings of willful infringement, for USAA in separate patent trials against Wells Fargo. In November 2020, the PTAB issued final written decisions finding not invalid all of the claims of two USAA patents, one of which was the basis for the \$200 million verdict.
- *Apple v. Optis Cellular Technology LLC; Apple v. Optis Wireless Technology LLC; Apple v. Unwired Planet Int'l Ltd.* Successfully defended PanOptis entities against three IPR petitions filed by Apple related to patents for 4G LTE

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technology. The Federal Circuit rejected Apple's attempt to overturn the PTAB's non-institution decisions. The three patents involved in the IPRs are a subset of the patents that secured a trial win against Apple in related patent litigation.

- *Fundamental Innovation Systems International LLC*. Representing Fundamental, successfully defended 29 IPR petitions filed by four of the leading technology companies in the world against 10 patents relating to USB charging technology developed by BlackBerry, resulting in 14 non-institution decisions on the merits, two final written decisions upholding all challenged claims and early settlement in others (many before institution decisions). This was the largest campaign against a single patent owner in 2018.
- *Apple Inc. v. Immersion Corporation*. Represented Immersion in nine IPRs brought by Apple over patents related to haptics technology used in the current generation of iPhones, MacBooks and the Apple Watch. Irell persuaded the PTAB to deny institution.
- *Amkor Technology, Inc. v. Tessera, Inc.* Secured a victory in an IPR trial before the PTAB. In an attempt to void an arbitration award, Amkor filed an IPR against the semiconductor manufacturing patent responsible for the majority of damages. The PTAB affirmed the patentability of every one of the 14 claims that Tessera contended was patentable and on every one of the claims that Amkor was found to have used.
- *Sienna Biopharmaceutical, Inc. v. William March Rice University*. Representing Sienna Biopharmaceutical challenging Rice's therapeutic nanoparticles methods patents. Irell prevailed in the IPR, with the PTAB cancelling all challenged claims.
- *Symantec Corp. v. Trustees of Columbia University*. Prevailed at trial before the PTAB on five Symantec IPRs challenging the validity of four of Columbia's data security patents. Also prevented institution on two Columbia patents.
- *Juniper Networks, Inc. v. Brixham Solutions, LTD.* Represented Juniper in two IPR proceedings involving router technology. The PTAB invalidated each of the claims from the two patents that Brixham Solutions Ltd. had asserted against Juniper in Northern California, finding that all of the asserted claims were rendered obvious by the prior art Juniper had identified in its petitions. The PTAB also denied Brixham's motions to exclude the declarations of Juniper's technical expert in both proceedings.
- *Apple, Inc. v. Wisconsin Alumni Research Foundation*. Represented patent owner Wisconsin Alumni Research Foundation (WARF) in an IPR proceeding brought by Apple, which filed the petition as part of the ongoing litigation between the parties on Apple's unauthorized use of WARF's memory disambiguation technology. WARF defeated Apple's attempt to shield from the board highly relevant and damaging admissions from its own witnesses. The PTAB declined to commence an IPR on any grounds asserted in Apple's petition.
- *Samsung Electronics Co, LTD. v. KAIST IP US LLC*. Representing the licensing representative for the Korean Advanced Institute of Science and Technology, Irell convinced the PTAB not to institute the IPR proceedings involving a fundamental patent relating to bulk FinFET technology.
- *Mylan Pharmaceuticals Inc. v. Gilead Sciences, Inc.* Defeated challenges brought by Mylan Pharmaceuticals to four Gilead patents related to the HIV drug tenofovir disoproxil fumarate. The PTAB declined to institute IPR proceedings on all four petitions.
- *Legend3D, Inc. v. Prime Focus Creative Services Canada Inc.* Represented Prime Focus in an IPR brought by Legend3D in an attempt to invalidate Prime Focus's 3D technology patent and persuaded the PTAB to deny institution.

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- *Apple v. Papst Licensing GMBH & Co.* Represented Papst Licensing in IPRs concerning an interface device for communication between a computer host device and a data transmit/receive device. Irell persuaded the PTAB to deny institution.
- *Nipro Corporation v. NxStage Medical.* Secured a win for a pioneer in high-efficiency blood tubing sets for extracorporeal blood handling applications, defeating a challenge by competitor Nipro Corporation. The Irell team employed recently adopted PTAB rules governing the early submission of expert testimony to argue that Nipro's proposed constructions were unreasonably broad. The PTAB agreed that Nipro's constructions were unreasonable and denied institution of the IPR on that basis.
- *The General Hospital Corp. v. Sienna Biopharmaceutical, Inc.* Secured a win for Sienna, a developer of groundbreaking products to treat acne and hair removal. General Hospital Corp. (GHC) sought to invalidate Sienna's patent by having an interference declared with GHC's patent application in which GHC copied Sienna's claims, presumably to clear the way for GHC hair removal products. Irell convinced the PTAB that the interfering GHC patent application lacked written description support. This led the PTAB to enter a judgment of validity for Sienna and to find GHC's patent application unpatentable.
- *B/E Aerospace, Inc. v. MAG Aerospace Industries LLC.* Represented B/E Aerospace in IPRs filed against a competitor in the field of aircraft water and waste systems. The IPRs were requested on patents that MAG asserted in a concurrent patent infringement action against B/E in district court. B/E prevailed on noninfringement in court. The USPTO also invalidated all of the challenged claims of the three patents, concluding that they were obvious based on prior art.
- *Cisco Systems, Inc. v. Constellation Technologies LLC.* Secured a series of wins for patent owner Constellation Technologies LLC. Constellation managed a patent portfolio on fundamental networking technologies that were developed by Nortel Networks Ltd. The PTAB declined to institute on four IPR petitions, ruling that Cisco has not shown a reasonable likelihood of prevailing.
- *Palo Alto Networks (PAN) v. Juniper Networks, Inc.* Represented Juniper in two IPRs filed by a competing provider of networking hardware. These IPRs were part of a long-running dispute with a competing company founded by former employees who left Juniper to compete in the same field. The IPRs were resolved through a \$175 million settlement payment to Juniper and termination of the IPRs with Juniper's patents fully intact.
- *MaxLinear, Inc. v. Cresta Technology Corp.* Represented Cresta in this IPR proceeding related to multi-format television tuners. The PTAB declined to institute IPR proceedings.
- *Boehringer Ingelheim Int'l GmbH and Boehringer Ingelheim Pharm., Inc. v. Biogen, Inc.* Represented Biogen in this IPR proceeding related to the use of the drug Rituximab for the treatment of cancer and rheumatoid arthritis. The PTAB declined to institute IPR proceedings.
- *Ardagh Glass, Inc. v. Culchrome, LLC.* Represented Culchrome in IPR proceedings related to the production of recycled glass products. The PTAB declined to institute IPR proceedings.

Representative Reexamination Matters

- Represented NxStage in connection with an ex parte reexamination.
- Represented Juniper Networks in connection with inter partes reexamination involving network security.

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- Represented TiVo in connection with ex parte reexamination proceedings brought against multiple patents owned by EchoStar and asserted by EchoStar against TiVo in co-pending litigation.
- Represented co-owner City of Hope in connection with multiple reexaminations of one of the most important biotechnology patents in history—the coexpression of an antibody in a cell.
- Represented Chimei Optoelectronics in connection with inter partes reexamination and ex parte reexamination involving liquid crystal displays.
- Represented a Fortune 500 chemical company in connection with ex parte reexamination of four patents involving chemical mechanical polishing of semiconductor substrates.
- Represented inventor Bruce Finn in connection with ex parte reexamination involving lighting fixture for motion picture industry.