
Post-Grant Proceedings

We advise clients on the smartest, most cost-effective ways to challenge or defend issued patents.

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Clients depend on us to further their objectives by strategically implementing *inter partes* reviews, post-grant reviews, covered business method reviews and *ex parte* reexaminations. For petitioners, these procedures can provide a faster, more cost-effective means to adjudicate the validity of a patent and obtain freedom to operate. For patent owners, an effective strategy and thorough understanding of the procedures are important to preserve claims and claim breadth. Post-grant proceedings can also serve as tools to limit and define issues before or during patent litigation, or promote settlement.

Following the 2012 passage of the America Invents Act, WilmerHale has distinguished itself as a leading adviser on post-grant proceedings and the interplay between these proceedings and concurrent litigation.

Our patent prosecution and litigation experience enables us to navigate complex procedural, substantive and strategic issues posed by post-grant proceedings and deliver favorable results.

Key Contacts



David L. Cavanaugh

PARTNER

 david.cavanaugh@wilmerhale.com

 WASHINGTON DC

 + 1 202 663 6025



Joshua L. Stern

PARTNER

✉ joshua.stern@wilmerhale.com

📍 WASHINGTON DC

☎ + 1 202 663 6329



Emily R. Whelan

PARTNER

✉ emily.whelan@wilmerhale.com

📍 BOSTON

☎ + 1 617 526 6567



Joseph F. Haag

PARTNER

✉ joseph.haag@wilmerhale.com

📍 PALO ALTO

☎ + 1 650 858 6032



Peter M. Dichiaro

PARTNER

✉ peter.dichiaro@wilmerhale.com

📍 BOSTON

☎ + 1 617 526 6466



Monica Grewal

PARTNER

✉ monica.grewal@wilmerhale.com

📍 BOSTON

☎ + 1 617 526 6223



Gregory H. Lantier

PARTNER

✉ gregory.lantier@wilmerhale.com

📍 WASHINGTON DC

☎ + 1 202 663 6327

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Experience

Successfully represented Aegerion (alongside co-counsel) in two *inter partes* reviews challenging patents covering the approved dosing methods of Juxtapid, a lipid-lowering agent for the treatment of familial hypercholesterolemia.

Achieved a victory for patent owner Akamai Technologies against Limelight Networks when the Patent Trial and Appeal Board issued a final written decision finding all instituted claims not invalid.

Successfully invalidated all 371 claims of 10 patents asserted against a major consumer products company (later affirmed by the Federal Circuit) in one of the largest *inter partes* review proceedings ever brought.

WilmerHale secured a total victory, along with co-counsel, for Gilead Sciences when the PTAB denied institution of the tenth straight petition for IPR of patents directed to Gilead's Hepatitis C products, including the blockbuster drugs Sovaldi, Harvoni and Epclusa. The series of 10 for 10 denials by the PTAB across eight patents is particularly notable because the PTAB's IPR institution rate for pharmaceutical patents is generally about 60%.

On behalf of Unified Patents, achieved a significant victory when the Patent Trial and Appeal Board issued its final written decision invalidating all claims against a patent, assigned to Nonend Inventions N.V., which Nonend asserted in multiple district court cases against a wide range of companies.

Also for Unified Patents, used the *inter partes* review process to successfully challenge all 16 claims of a patent held by Sportbrain Holdings, which had been asserted against more than 140 defendants.

Achieved a series of victories, culminating in four successful covered business method reviews, in which the Patent Trial and Appeal Board invalidated 83 of a patent assertion entity's claims against a group of major financial institutions.

For electronic wheelchair developer Permobil, achieved a victory when the Patent Trial and Appeal Board issued final written decisions on two *inter partes* reviews that declared all challenged claims unpatentable. WilmerHale also successfully convinced the US Court of Appeals for the Federal Circuit to uphold the decisions after the patent owner appealed.

Successfully invalidated a patent through an *inter partes* review on behalf of Becton Dickinson, challenging a patent relating to needle technology. BD filed the proceeding after it was sued for infringement. We obtained a final written decision canceling all the challenged claims, and the litigation subsequently settled on terms favorable to BD during the Federal Circuit appeal.

For a Fortune 500 technology company, obtained a significant victory when the Federal Circuit held that three patent claims that we had challenged in an *inter partes* review adverse to an acoustics company were unpatentable. The patents related to speaker designs that the acoustics company accused our client of infringing.

Represented VMware and EMC in a suit, initially filed in the Eastern District of Texas, relating to cloud computing. The plaintiff, a non-practicing entity, alleged infringement of a portfolio of patents by most of the major cloud computing companies. VMware and EMC were the only companies in the first round of defendants to file *inter partes* reviews. We ultimately convinced the Eastern District of Texas to transfer the case to California, and convinced the Northern District of California to stay the case pending the proceedings. The Patent Trial and Appeal Board subsequently invalidated all challenged claims, and the Federal Circuit affirmed.

Recognition



***Among the Top 3 Full-Service Firms
for PTAB Work***

Law360

2021



Ranked Tier 1 in PTAB Litigation

Managing IP

2021



Law Firm of the Year in Patent Law

U.S. News – Best Lawyers®

2022

- *The American Lawyer* – Named WilmerHale the Law Firm of the Year (2020), was honored as a finalist in the Litigation Department of the Year contest (2018) and as the IP Litigation Department of the Year (2014, 2008), and named a finalist in the IP category six times since the publication first awarded it in 2004.
- BTI Consulting Group – Named as an IP Litigation Powerhouse in the *BTI Litigation Outlook* (2019) and an IP Litigation Standout (2017, 2018); recognized as the Most-Favored IP Department in the nation, as one of two firms Best at Complex IP Litigation, one of six Go To IP Litigation Firms, and one of five Go To IP Firms for non-litigation IP work in the *BTI Intellectual Property Outlook* (2015).
- *Chambers USA* – Ranked nationally in band one for Intellectual Property (2011–2022); noted as “frequently sought after by hi-tech and life sciences companies for handling contentious proceedings arising from patent infringement claims and PTAB post-grant reviews.” Consistently recognized in the regional IP tables for Massachusetts (2003–2022), California (2012–2022), Colorado (2016–2022), New York (2012–2022) and Washington DC (2012–2022).
- *IAM Patent 1000* – Two partners ranked as leading practitioners for post-grant proceedings work in the United States (2021, 2022); consistently ranked as a leading firm for litigation in the US and UK, and in regional US rankings in California, Colorado, the DC Metro area, Massachusetts and New York.
- *Law360* – Named among the top three full-service firms for PTAB work in recognition of the firm’s successful representation of both patent challengers and patent owners in 2021; also consistently named among top five “go-to” firms for PTAB litigation in a report on the law firms that handled the most cases at PTAB since 2012.
- *The Legal 500 United States* – Named among the top law firms for intellectual property (2011–2021).
- *Lex Machina Patent Trial and Appeal Board Report* – Identified as one of two full-service law firms that are most experienced in representing petitioners at the Patent Trial and Appeal Board (2017).
- *LMG Life Sciences Awards* – Shortlisted as the *Inter-Partes* Review Firm of the Year since 2018 and named the 2022 Hatch-Waxman Litigation Firm of the Year – Branded; recipient of numerous other consistent recognitions such as being named among the top firms for General Patent Litigation, Hatch-Waxman Patent Litigation and Patent Strategy & Management.
- *Managing IP* – Ranked in Tier 1 for PTAB Litigation in the United States (2019–2021) and listed among the “top 30 law firms for petitioners in IPRs filed in 2021.” Consistently named as Patent Contentious Firm of the Year for the Northeast region and named as the US Patent Contentious Firm of the Year or shortlisted for the recognition for nine consecutive years (2011–2019).
- *Unified Patents* – Recognized for achieving a higher IPR institution rate by claim than any other firm in the country (2015).
- *U.S. News - Best Lawyers®* – Named Patent Firm of the Year (2022, 2021), Biotechnology Law Firm of the Year (2020) and IP Litigation Law Firm of the Year (2018). Honored with first-tier national “Best Law Firm” rankings in Patent Law, Biotechnology Law, IP Litigation and Patent Litigation; and numerous first-tier metropolitan rankings (2013–2022).