

These Firms Landed The Most PTAB Work In 2020

By Britain Eakin

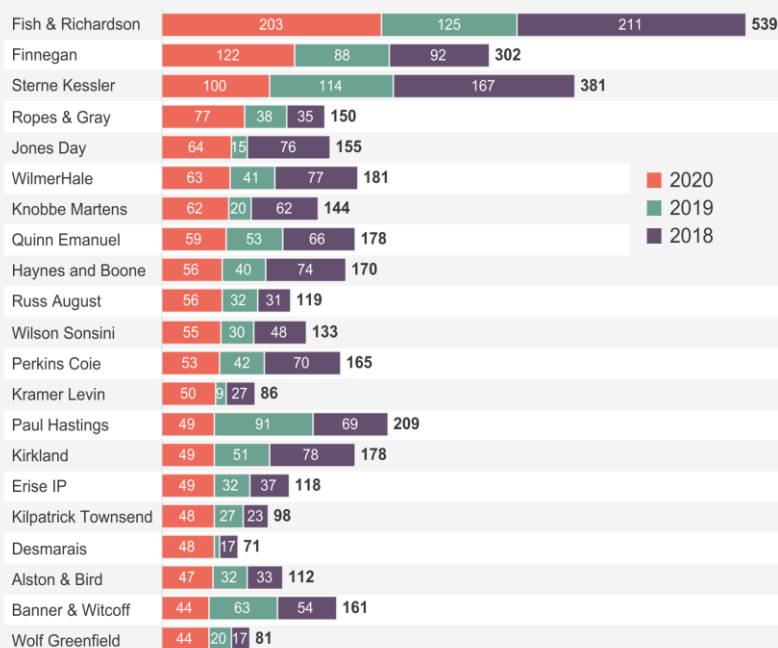
Law360 (March 11, 2021, 10:30 AM EST) -- Three intellectual property boutiques dominated Patent Trial and Appeal Board work in 2020, attributing their success in part to their technical expertise and deep understanding of how PTAB disputes play into parallel district court cases.

Fish & Richardson PC sat atop the heap for the third year in a row, litigating 203 cases at the PTAB. Finnegan Henderson Farabow Garrett & Dunner LLP came in second with 122 cases, and Sterne Kessler Goldstein & Fox PLLC followed close behind in third spot with 100 cases, according to a new report from Lex Machina.

Full-service firms Ropes & Gray LLP and Jones Day rounded out the top five, with 77 and 64 cases, respectively.

The Go-To Firms for PTAB Litigation in 2020

Fish & Richardson tops the list of firms that handled the most cases last year.



Source: Lex Machina

Having handled well over 1,200 cases at the PTAB since the board's inception in 2012 under the America Invents Act, IP powerhouse Fish & Richardson has long been a leading force there. The firm landed the top spot in 2019 with 125 cases and in 2018 with 211 cases.

According to partner Jeremy J. Monaldo, Fish & Richardson lands so many PTAB cases because of its deep familiarity with the procedural rules and the board's practice style, and the technical expertise among its attorneys. But another strength he said Fish & Richardson brings to bear is the coordination and collaboration between the patent practitioners and IP litigators.

"Having strong litigation and patent practices gives the firm a good understanding of the strategic importance of how the PTAB plays with co-pending litigation, and allows us to strategically advise clients to leverage the PTAB and implement strategies that are directed to achieving the business goals of our clients," he said.

Coming in second, Finnegan landed enough PTAB work last year to bump it up from third place in 2019, when it handled 88 cases. In 2020, 72% of its cases were on behalf of petitioners.

The firm's expertise perfectly primed it to rake in so much PTAB work, said Joshua L. Goldberg, leader of Finnegan's PTAB trials section. With proceedings growing increasingly complex in light of precedential decisions concerning when the board has discretion to deny petitions — from *General Plastic v. Canon Kabushiki Kaisha* to *Apple v. Fintiv* — Goldberg said clients recognize the need to work with well-seasoned experts who are best positioned to help them clear that hurdle.

"We have a large number of attorneys who have not just done 10 or 20 proceedings but have done scores and even hundreds of proceedings. So when they want that true expertise, we can make that available," he said.

Despite being significantly smaller than Fish & Richardson or Finnegan, with 156 attorneys, Sterne Kessler has consistently nabbed a sizable chunk of PTAB work. By comparison, Fish & Richardson has 354 attorneys and Finnegan has 350.

A slight majority of Sterne Kessler's work last year was on behalf of patent owners.

With the right mix of litigation, patent prosecution, ex parte reexam, and interference experience, Sterne Kessler is well positioned to pursue PTAB work, according to managing director Mike Ray. He said 2020 was a particularly good year for the practice, with an institution rate for petitioners that was 10 percentage points higher than the PTAB average and 20 percentage points lower on the patent owner side.

"It's just great lawyering," he said. "We understand the technology and the case law, as well as looking at what the PTAB is doing. We handle a lot of proceedings. We can look across proceedings and learn from them to see what's working and what's not."

Landing in the fourth and fifth spots, Ropes & Gray and Jones Day devoted the majority of their PTAB efforts in 2020 to petitioners, 78% and 67% respectively. Both firms told Law360 they plan to bolster their PTAB practice this year.

Ropes & Gray partner Scott McKeown said the firm added a former PTAB judge this year and hopes to

add to earlier successes.

"Given our significant success for patent owners on merit-based denials and final decisions, including on appeals ... we will be looking to build upon that success in 2021," he said.

Jones Day partner Sarah A. Geers, meanwhile, said the firm wants to increase its interactions with the patent office this year.

"Based on the many cases we've handled, we have a number of thoughts on issues for the new director to consider to improve how the PTAB handles matters for our clients," Geers said. "We've been happy with many of the changes that have occurred over the past year, but there is always room for further discussion of how these are working out."

--Editing by Brian Baresch.

Law360 is owned by LexisNexis Legal & Professional, a RELX company, which owns Lex Machina.