

These IP Boutique Firms Are Dominating PTAB Work

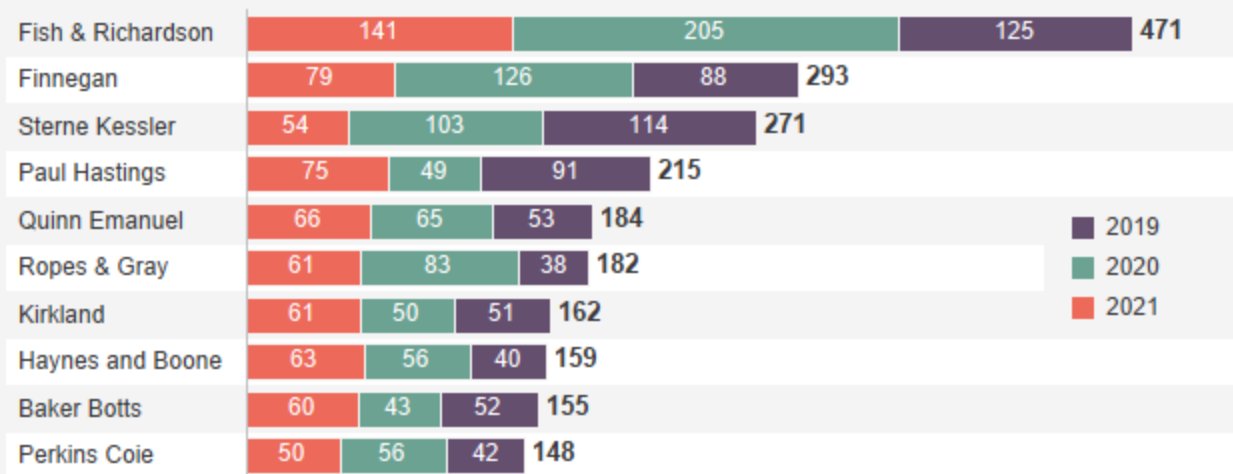
By Britain Eakin

Law360 (May 19, 2022, 9:02 AM EDT) -- Three intellectual property boutiques picked up the most work at the Patent Trial and Appeal Board over the last three years, with attorneys from the firms saying their patent-specific focus makes them a go-to for PTAB matters over general practice firms.

Fish & Richardson PC clocked in first by a wide margin, with 471 total cases between 2019 and 2021. Finnegan Henderson Farabow Garrett & Dunner LLP landed second, with 293 total cases over the last three years, and Sterne Kessler Goldstein & Fox PLLC followed close behind, securing the third spot with 271 cases, according to a new **patent litigation report by Lex Machina**.

The Most Active Firms Handling PTAB Litigation

Fish and Richardson dominated Patent Trial and Appeal Board work from 2019-21.



Source: Lex Machina

General practice firms Paul Hastings LLP and Quinn Emanuel Urquhart & Sullivan LLP filled the fourth and fifth spots, with 215 and 184 cases, respectively.

IP powerhouse Fish & Richardson is well-positioned from the get-go to nab the lion's share of PTAB work, according to Karl Renner, a principal who co-chairs the firm's post-grant practice group.

Fish & Richardson has led the pack of most active PTAB firms stretching back to 2016 and is a world-class patent prosecution, litigation and dispute resolution practice, Renner told Law360.

The firm's PTAB practice draws from its extensive experience litigating patent disputes in district courts, the U.S. International Trade Commission and the Federal Circuit. Renner said that know-how underlies the post-grant practice group's growth and success, and keeps clients coming back.

"The practice our litigation team brings forward is really well-informed and experienced in each of the forums, and that ends up being really helpful to us. It helps us understand how to navigate when decisions like *Fintiv* come down and how to think about how to approach the total defense," Renner said, referring to a controversial PTAB precedent that allows the board to deny review of patents that are already asserted in district court cases.

Working on behalf of both petitioners and patent owners also gives the firm an edge, said Fish & Richardson principal Dorothy Whelan, who co-chairs the post-grant practice alongside Renner. Over the last three years, 65% of the firm's PTAB work has been on behalf of petitioners, according to Lex Machina data.

"Doing all the patent owner work makes us better petitioners, and doing all the petitioner work makes us better patent owner representatives. There's a real synergy there because you're seeing the proceeding from both perspectives," Whelan said.

Meanwhile, Finnegan picked up enough PTAB proceedings over the last three years to secure second place among the firms doing the most work at the board. All told, the firm represented petitioners in 73% of the PTAB cases it handled between 2019 and 2021, according to Lex Machina.

Key to the firm's PTAB dominance is that it offers clients the "full package," including deep technical and PTAB experience, according to partner Joshua Goldberg, who leads the firm's PTAB trials section. The firm boasts more than a dozen attorneys who have handled more than 50 PTAB cases, and the firm's attorneys also have deep technical backgrounds.

Finnegan strategically utilizes all of its talent and expertise in each case, Goldberg said.

"If we're dealing with a complicated technical issue, the person who knows the technology best will help. If we're dealing with a procedural issue, then someone with extensive PTAB experience will help," he added. "And if a junior attorney drafted all the papers and knows the case inside and out, we'll recommend putting them up to argue."

Goldberg said the firm has been among the top users of the PTAB's Legal Experience and Advancement Program, or LEAP. The PTAB established the program in 2020 to incentivize less-experienced attorneys to argue cases before the board. Goldberg said that fits in nicely with the firm's emphasis on maintaining its pipeline of experienced attorneys, a necessary ingredient to keep clients happy and coming back.

For Sterne Kessler — a significantly smaller boutique than the 336-attorney Fish and roughly 340-attorney Finnegan — the firm's PTAB dominance comes down to the fact that "patents and technology are in our DNA," according to Michael Specht, a director who co-chairs the firm's patent office litigation practice.

Of Sterne Kessler's 146 attorneys, more than 50 have Ph.D.s and many have industry experience, giving the firm an advantage in front of PTAB judges, who have highly technical backgrounds, Specht said.

The patent-specific focus of the firm and the deep technical expertise are invaluable for identifying prior art — which the firm handles itself almost exclusively — and being able to make cogent arguments at the PTAB, he said.

"That's a distinguishing advantage when going up against a general practice firm that has to rely on external experts," Specht said.

Part of the firm's "secret sauce" is finding what Specht termed "emotionally devastating prior art," which is prior art that is so strong that even patent owners recognize it will succeed in invalidating their patents.

But the firm is no stranger to handling matters at the PTAB for patent owners. In fact, its PTAB work is about evenly split, with 49% of it over the last three years done on behalf of petitioners and the other 51% for patent owners, according to Lex Machina's data.

All of these factors mean the firm is poised to win at the PTAB and win fast, Specht said.

"Winning is important, but so is winning quickly," he said. "I think we do a good job of that with our clients, and many of them stick with us because of that."

--Editing by Marygrace Anderson and Dave Trumbore.

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