IP Alert: Inter Partes Reviews – Who Can Get the Big Job Done



Inter Partes Reviews – Who Can Get the Big Job Done

By Charles W. Shifley

Inter partes review (IPR) statistics are fascinating. As of June 30, 2017, and in the 4 years and 10 months since they became available, 6,577 IPR petitions have been filed with the U.S. Patent and Trademark Office (USPTO). In fiscal year 2017 alone, 1,434 petitions were filed.

An interesting statistic close to home at this law firm, Banner & Witcoff, is that its lawyers, paralegals and staff filed more IPR petitions than any law firm filed in the first half of 2017. We filed 45 IPR petitions for one client in those six months, as well as appearing in about double that number of proceedings when other petitions and appearances on behalf of patent owners as well as patent challengers are counted.

Who does that? Who gets that big job done? Of our more than 100 patent, trademark, and copyright lawyers across the country, the following stand out for their IPR efforts: Fred Meeker, who appeared in all 45 petitions, Brad Wright, the 45-plus more, and Scott Kelly, all 45 again. There's

more about each of these three lawyers here, but Fred, Brad, and Scott, all three, would be quick to say that preparing 45 IPR petitions in six months is a team effort of many, many people, and not a thing for which they take credit only to themselves. Assuming we wrote our allotted 14,000 words per petition, plus more for mandatory notices, and helped our experts create thorough and solid reports of about equal and greater length to our petitions, the statistic is that we had more than about 1.3 million words to plan, organize, write, and edit, dense in patent law and technology, needing to be readily accessible to Patent Trial and Appeal (PTAB) judges, well more an effort than three lawyers might manage in years!

We're pleased to enjoy the compliment from the PTAB in an early institution decision on the first several of our first-half-2017 petitions, that our work was recognizably detailed and properly supported. Our IPR "operations" for the tasks we accomplished on the way to our results included teams of lawyers per petition, teams of lawyer reviewers, teams of paralegal editors, and our "management" team overall, including but not limited to Fred, Brad, and Scott. All pitched in, all gave it excellence, and all followed all the guidance we have in writing for the structured accomplishment of our IPR tasks.

Still, back to Fred, Brad, and Scott. Here's more on these Banner & Witcoff lawyers.



Fred Meeker is to the left. Fred is in a sweet spot in his intellectual property law career, with 25 years of experience after law degrees with distinction in Washington, D.C. Fred also brings to his IPR efforts two degrees in electronic and computer engineering, and large doses of real engineering experience. Before his legal career, Fred designed hardware and software. He was the lead engineer in developing network backbone components for the NSFNET (a forerunner to and now part of the Internet), a secure digital telephone, satellite based processors, a processor for the under ice display on the Seawolf submarine, and several commercial software applications, including applications for communication security, secured transactions, and digital rights management.



Brad Wright is to the right. Brad is also above 20 years in IP law experience, after degrees in engineering and law, one in electrical engineering from MIT. Brad adds to his legal skills the deep-seated experience of being a Federal Circuit Court of Appeals clerk to Judge Bryson. Brad also has electrical and software engineering experience, developing algorithms for signal intelligence, specialized hardware, and databases including an object-oriented database.

Scott Kelly is back to the left. Scott is among our former patent examiners from the USPTO. First trained in patent law there, he examined patents relating to word processing, spreadsheets, markup languages, input validation, display rendering, and assistive technologies. He also



examined business method patents, including several directed to the process of drafting a patent! Scott brings degrees with honors in computer science, physics, mathematics, and of course law to his IPR efforts. His last venture before joining the firm was founding a company to develop an intelligent patent search engine using document similarity analysis. And earlier, he was an early employee at a startup company developing gigapixel resolution video cameras for drones. While with us, Scott has represented clients in technologies including user interfaces, gesture-based inputs, mobile devices, cloud computing, algorithms, client-server architectures, network routing, and video games.

Where and how do we get teams of accomplishment, and people like Fred, Brad, and Scott? As a more than 40-year member of this firm, I'm proud to say it's always (well, at least for 40 years) been a matter of who we are. Sometimes we get to be proud of our statistics, for getting big jobs done. We start 45 IPRs in six months in an effort of more than 1.3 million words dense on patent law and technology, do it well, and lead statistics in doing it. But not sometimes and instead always, we're proud of our people, especially our teams, for all they bring to our firm, to each other, and all we accomplish together in teamwork for the clients we value so much.

Posted: August 15, 2017