



## POST-GRANT PRACTICE

Trial Lawyers Who Focus  
on Post-Grant Practice

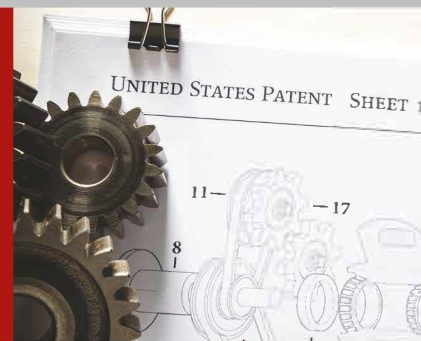
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## Desmarais LLP's Post-Grant Practice

Desmarais LLP has been ranked as one of the "Best Performing Law Firms" and "Most Active Law Firms" for PTAB work. Our lawyers have represented numerous top-tier companies in their most important post-grant matters, including representation of patent holders and patent challengers; cases allegedly involving implementation and/or standard-essential patents; and in cases involving myriad technologies such as the following non-exclusive list: medical devices, life sciences, computer hardware, computer software, networking, communications, security.

Our post-grant practitioners' expertise complements our nationally recognized patent litigation practice as the interplay between the post-grant proceedings and patent litigation becomes ever more intertwined and critical to our clients. Desmarais LLP leverages proceedings before both the PTAB and the USPTO to secure litigation settlements. We continue to expand our bench, including hiring several senior PTAB specialists.

Desmarais LLP's flexible and innovative fee structure allows us to work closely with our clients to develop arrangements tailored to their individual needs. We do not use the traditional, and frequently inefficient,

billable-hour approach to fees. Instead, we offer a flat-fee structure for all our post-grant matters negotiated at the outset of a matter that ensures costs are managed for our clients. Below is a sample of successes that our attorneys have obtained for our clients in the post-grant practice group.

### Delivering Wins for Patent Challengers

Our practitioners have extensive experience securing significant wins for various petitioners in invalidating patents. Our deep understanding of the technology allows us to identify prior art where others cannot, often relying not only on patents, but other specialized publications, such as doctoral theses, scientific publications, standard essential publications, and complex textbooks. And our extensive familiarity with the PTAB's complex procedural rules allows us to deliver significant wins for our clients.

For example, Desmarais LLP helped secure numerous wins for one of the world's largest semiconductor manufacturing company by not only finding key pieces of prior art that other firms were not able to find, but also

finding lack of written description arguments that allowed the use of Patent Owner's own earlier publication as prior art. As another example, Desmarais LLP attorneys were successful in demonstrating unpatentability of proposed substitute claims through a motion to amend initiated by the Patent Owner. Besides inter partes review proceedings, Desmarais LLP attorneys are also experienced practicing at the USPTO in other proceedings. For example, Desmarais LLP routinely employs ex parte re-examination proceedings, leading to numerous findings of substantial new questions of patentability and subsequent cancellation or amendment of the claims.

### Delivering Wins for Patent Owners

Desmarais LLP attorneys also have broad experience securing wins for patent owners. Our practitioners' deep understanding of the technology allows us to identify deficiencies in validity challenges in inter partes review and ex parte reexamination proceedings on behalf of patent owner. Desmarais LLP attorneys

have successfully defended patents by highlighting both substantive as well as procedural deficiencies and preventing the institution of a trial before the Board.

For example, our practitioners prevented institution of IPR proceedings by highlighting Petitioner's failure to demonstrate certain limitations were taught by the prior art. We also successfully highlighted Petitioner's failure to demonstrate public availability of the publication to prevent institution. Our practitioners have also secured discretionary denials of IPR institution based on parallel litigation schedules and by highlighting that it would not be an efficient use of the Board's resources when 80% of the challenged Grounds did not demonstrate a reasonable likelihood of success. In cases that have proceeded to trial before the Board, we have successfully defended the patentability of the challenged claims, ultimately preserving jury verdicts and delivering wins in final written decisions.

## Post-Grant Practice Contacts



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