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## PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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## First IPR Design Patent Decision Affirmed by Federal Circuit

By Pieter van Es

April 15, 2015 – In the first *inter partes* review of a design patent, the Federal Circuit affirmed the Patent Trial and Appeal Board’s final decision that the only claim was unpatentable. Design patent D617,465 on a drinking cup was the subject of three lawsuits and an *inter partes* reexamination.

In the IPR, IPR2013-0072, the PTAB found the claim obvious in view of prior art patents. The case hinged on a priority date issue. The PTAB found the ‘465 patent was not entitled to an earlier priority date due to a lack of written description of the claimed design in an earlier filed application. The patent owner conceded that its claim was not patentable over the prior art if it was denied the priority date.

The PTAB also denied the patent owner’s motion to amend the claim, ruling that the motion impermissibly sought to enlarge the claimed subject matter. The patent owner appealed on several grounds and the Federal Circuit [affirmed per curiam](#) under Rule 36.

*The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer weekly summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.*