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PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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PTAB Rejects “Unusual” Inventor Testimony That His Own Invention Was Not Reduced To Practice and Finds His Claims Not Unpatentable

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September 17, 2014 – In a final written decision, the PTAB found the petitioner failed to prove challenged claims unpatentable and rejected “unusual” inventor testimony about reduction to practice that was opposite the typical situation where inventor testimony is offered to establish an early invention date.

[IPR2013-00131 – Dynamic Drinkware LLC v. National Graphics, Inc. \(Paper 42, Sept. 12\)](#)

The patent owner did not attempt to distinguish the allegedly anticipatory art, but instead argued that it did not qualify as prior art. The PTAB agreed, finding that the petitioner failed to prove that the alleged prior art reference, a patent, was entitled to an earlier provisional application filing date, and that the patent owner established reduction to practice prior to the alleged prior art’s actual filing date.

According to the PTAB, the petition was deficient in establishing the earlier priority date of the alleged prior art because it only provided a chart comparing the priority provisional application to the challenged claims, but it did not also compare the asserted prior art patent to its priority provisional application. The Board appeared to require the petitioner to explicitly compare the challenged claims to subject matter common to both the asserted patent and its priority provisional application “to demonstrate that those portions were carried over from the provisional.” In not doing so, the PTAB found the petitioner failed to carry its burden to prove the effective date of the alleged prior art.

The PTAB also found that the patent owner swore behind the prior art patent’s actual filing date based on an earlier reduction to practice. Interestingly, the petitioner submitted a declaration of

the inventor in support of its position that the invention was not reduced to practice, which the PTAB noted is “unusual” as “normally” inventor testimony is proffered for the opposite position — to establish the earliest invention date. The inventor testified that he now worked for a company “related to” the petitioner. Discounting the inventor’s testimony because his “current interests are aligned against his patent,” the PTAB credited a notebook entry from the inventor and other testimony in concluding that the invention was reduced to practice prior to the filing date of the non-provisional application. The PTAB also conducted at the hearing a “visual inspection” of a sample that it concluded was reduced to practice.

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.



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