David McCombs, Eugene Goryunov and Jonathan Bowser in Westlaw: The Tough Task of 'Swearing Behind' an Asserted Prior Art Reference

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A third party who is not the patent owner may file a petition for *inter partes* review (IPR) to challenge the validity of an issued patent. A petitioner may challenge a patent's claims on the basis of prior art consisting of patents or printed publications. 35 U.S.C. § 311(b). IPRs are frequently filed as part of a defense strategy to challenge the validity of an asserted patent.

The America Invents Act (AIA) transitioned U.S. patent law from a first-to-invent system to a first-to-file system. While patents that issue today are mostly AIA patents (i.e., first-to-file), many pre-AIA patents are still being litigated and are subject to IPR petitions. A patent is considered a pre-AIA patent if it has an effective filing date before March 16, 2013.

In IPRs, the owner of a pre-AIA patent may attempt to "antedate" or "swear behind" an asserted reference by proving a date of invention before the critical date of the reference. If the patent owner is successful in antedating the reference, the patent owner would remove that reference as prior art against the challenged patent.

A patent owner can demonstrate prior invention for a pre-AIA patent in one of two ways: (1) establish an earlier reduction to practice of the claimed invention before the critical date of the reference, or (2) establish conception of the invention prior to the critical date plus reasonably continuous diligence to reduce the invention to practice after the critical date. *REG Synthetic Fuels, LLC v. Neste Oil Oyj*, 841 F.3d 954, 958 (Fed. Cir. 2016); *Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1009 (Fed. Cir. 2019) (a patent owner "must show there was reasonably continuous diligence.").

A patent owner "bears the burden of establishing that its claimed invention is entitled to an earlier priority date than an asserted prior art reference." *In re Magnum Oil Tools Int'l Ltd.*, 829 F.3d 1364, 1375-76 (Fed. Cir. 2016). Thus, it is the patent owner who has the burden to prove that it is entitled to an earlier date of invention.

A reduction to practice can either be a constructive reduction to practice, which occurs when a patent application is filed, or an actual reduction to practice, such as when the inventor makes a prototype or working model of the invention.

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