McCombs, Goryunov and Beck in IPWatchdog: Takeaways from PTAB's Precedential Decision on Prior Art Analysis for Post-AIA Patents

By David L. McCombs | December 7, 2023

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Haynes Boone Partners David McCombs and Eugene Goryunov authored an article with Matthew Beck, Senior Patent Counsel at Unified Patents, in *IPWatchdog* on the evolution of the law around establishing a reference patent as prior art based on the filing date of an earlier-filed application, such as a provisional.

Read an excerpt below:

In March 2023, the Patent Trial and Appeal Board (Board) addressed in Penumbra, Inc. v. Rapidpulse, Inc., IPR2021-01466, Paper 34 (Mar. 10, 2023), a key issue in inter partes reviews: how to establish a reference patent as prior art based on the filing date of an earlier-filed application, such as a provisional. The Board held that the requirements of the Federal Circuit's decision in Dynamic Drinkware, LLC v. Nat'l Graphics, Inc., 800 F.3d 1375 (Fed. Cir. 2015), do not apply for post-America Invents Act (AIA) patents. Penumbra, IPR2021-01466, Paper 34 at 29-35. On November 15, 2023, U.S Patent and Trademark Office (USPTO) Director Kathi Vidal designated the Penumbra decision precedential. This article explores the evolution of the law on this issue.

Changes Under Dynamic Drinkware

In September 2015, the Federal Circuit decided Dynamic Drinkware, holding that a patent challenger carries the burden to prove that a reference patent is entitled to the filing date of an earlier-filed application. Dynamic Drinkware, 800 F.3d at 1379-80. According to the court, a patent challenger must show that at least one claim of the reference patent is supported by the disclosure of the earlier-filed application, in compliance with pre-AIA 35 U.S.C. § 112, ¶ 1. Id. at 1380.

The AIA, however, changed the requirements for a reference to qualify as prior art under Sections 102(a)(2) and 102(d)(2). As such, questions remained whether the Dynamic Drinkware analysis applied to post-AIA patents, as the Court's decision was limited to pre-AIA patents on its face. Id. at 1381, fn. 2.

To read the full article in *IPWatchdog*, click here.

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