

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

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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](#).