

Eugene Goryunov, David McCombs, and Jonathan Bowser in Law360: 'Fed. Circ. Holding Recalls the Potential for PTAB Challenges'

April 11, 2022 David McCombs, Jonathan Bowser

PRACTICES Intellectual Property, Patents, Patent Litigation, Intellectual Property Litigation

Partners [Eugene Goryunov](#) and [David McCombs](#) and Counsel [Jonathan Bowser](#) authored an article in *Law360*.

Read an excerpt below:

The U.S. Court of Appeals for the Federal Circuit recently addressed, for the first time, the issue of when the Patent Trial and Appeal Board should raise its own ground of unpatentability against proposed substitute claims in a motion to amend.

In its March 24 *Hunting Titan Inc. v. DynaEnergetics Europe GmbH* decision, the court reluctantly affirmed the PTAB's decision granting a motion to amend despite concerns that the substitute claims were unpatentable on a ground that was not raised by the petitioner but took the time to express concern about the PTAB's "problematic" reasons for doing so.[1]

This decision serves as an important reminder that practitioners should consider and preserve all possible challenges to a PTAB decision, especially, including administrative law challenges, on appeal.

The PTAB Panel's Decision

Hunting Titan challenged claims of DynaEnergetics' patent as anticipated by the Schacherer reference. DynaEnergetics opposed the challenge to the original claims and filed a contingent motion to amend with substitute claims.

Hunting Titan opposed the substitute claims as obvious over Schacherer in view of two additional references. The PTAB panel held that the original claims were anticipated by Schacherer. In addition, the panel denied DynaEnergetics' motion to amend finding the substitute claims to be

anticipated by Schacherer, despite the petitioner not raising the anticipation ground in response to the motion to amend.[2]

DynaEnergetics sought review of the PTAB panel's decision by the Precedential Opinion Panel as to whether the PTAB panel could sua sponte raise its own ground of unpatentability against the substitute claims.

POP Decision

The POP reversed the PTAB panel's decision. The POP stated that while the PTAB panel "may raise a ground of unpatentability that a petition did not advance," it can do so only in rare circumstances.[3] The "better approach" is to "rely on the incentives the adversarial system creates, and expect that the petitioner will usually have an incentive to set forth the reasons why the proposed substitute claims are unpatentable." [4]

Excerpted from *Law360*. To read the full article, click [here](#).