

David McCombs, Eugene Goryunov, Vinu Raj in The Patent Lawyer: PTAB May Raise a New Ground of Unpatentability Only Under 'Rare Circumstances'

September 16, 2020 David McCombs

PRACTICES Intellectual Property, Patents, Patent Office Trials

In *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, the Precedential Opinion Panel (POP) of the Patent Trial and Appeal Board (Board) held that the Board may raise a ground of unpatentability a petitioner did not advance or sufficiently develop in opposition to a patent owner's motion to amend but noted that the Board "should do so only under rare circumstances."

Background

Hunting Titan filed an IPR challenging all claims of a patent owned by DynaEnergetics. In its IPR petition, Hunting Titan presented sixteen (16) grounds of unpatentability based on a mix of anticipation and obviousness, with one ground in particular alleging that the claims were anticipated by a Schacherer patent. After the Board instituted an IPR trial on all grounds presented in the IPR, DynaEnergetics filed a motion to amend its patent. Hunting Titan opposed the motion, arguing that the proposed substitute claims were obvious. In its final written decision, however, the Board held both the original claims and the proposed substitute claims were anticipated by Schacherer. DynaEnergetics filed a request for rehearing and POP review of the Board's denial of the motion to amend.

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