Insights: Alert

When Are Post-AIA Prior Art Patents Effectively Filed?

NOVEMBER 15, 2023 Written by John C. Alemanni

Today, the Director of the U.S. Patent Office designated the final written decision in *Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper 34 (March 10, 2023) precedential as to section II.E.3. In that section, the Board found that the holding in *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015), that under pre-AIA 35 U.S.C. § 102(e), a reference patent's claims must have written description support in its parent application to be entitled to that application's filing date for prior art purposes is not applicable to post-AIA patents. For post-AIA patents and published applications, the reference is entitled to a right of priority for whatever is described in the parent application.

Penumbra filed an IPR Petition relying on a post-AIA U.S. Patent Application, Teigen. Tiegen was a continuation of a PCT application that further claimed priority to a pair of provisional applications. Petitioner argued that Teigen was prior art under 35 U.S.C. §§ 102(a)(2) and (d)(2) because the relevant disclosure of Teigen was fully supported by the PCT application and by both provisional applications. Section 102(d)(2) recites:

> (d) Patents and Published Applications Effective as Prior Art.— For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—
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> (2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

The Petition cited to Teigen and to the relevant disclosure in the provisionals and also relied on expert testimony regarding the provisionals. Patent Owner argued that, under *Dynamic Drinkware*, Petitioner had to show that (1) at least one claim of Teigen is supported by the prior applications, and (2) the portions of Teigen relied upon are also supported by the parent applications. Petitioner responded that the *Dynamic Drinkware* analysis is limited to pre-AIA patents.

In its analysis, the Board first noted that AIA § 102 distinguishes between being entitled to priority to a prior-filed application as the "effective filing date" under 35 U.S.C. § 100(i)(1)(B), and merely being entitled to claim priority to a prior-filed application for prior-art purposes as "effectively filed" under § 102(d). The Board concluded that *Dynamic Drinkware* applies only to pre-AIA patents. Thus, a post-AIA patent document need only meet the ministerial requirements of 35 U.S.C. §§ 119 and 120, and the parent application need only describe the subject matter relied

upon in the reference as prior art.

The Board ultimately concluded that Teigen met both requirements. And because the *Dynamic Drinkware* analysis did not apply, Teigen was prior art as of the filing date of the PCT application, which was filed early enough to qualify as prior art. This decision illustrates the importance for Petitioners to carefully set out support for relevant disclosures in all of the priority documents. Similarly, Patent Owners should be cognizant of the burden on Petitioners to do so.

Related People



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