



## IPR Grounds Doomed for Failure to Show Patent Reference Was Supported by Disclosures in Priority Application

July 22, 2024

Reading Time : **3 min**

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The Patent Trial and Appeal Board has denied institution of an *inter partes* review, in part because the petitioner failed to show that a key reference qualified as prior art. The PTAB ruled that the petitioner was required to explain how a patent application publication was entitled to the priority date of a provisional application to qualify as prior art under AIA §§ 102(a) and (d)(2). Because the petitioner did not provide any analysis, there was no basis to find that the patent application publication was prior art.

The challenged claims related to methods of performing a hydraulic fracturing plan. The petitioner asserted five grounds of unpatentability, three of which relied on a patent application publication as either the sole or primary reference in anticipation or obviousness challenges. The patent owner's preliminary response challenged the status of the patent application publication as prior art. The patent owner argued that under a PTAB precedential decision, the petitioner had failed to meet its initial burden to show in the petition how the subject matter in the publication was supported by disclosures in the provisional application. *See Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper 34 at 32-34 (PTAB Mar. 10, 2023) (precedential as to § II.E.3).

The PTAB first explained that a petitioner has the burden to show that a reference cited in a ground of unpatentability qualifies as prior art. The PTAB then explained that if the petitioner wishes to rely on an earlier provisional application for priority, the petitioner has to show that the provisional application describes the subject matter that is relied on in the patent application publication. Furthermore, because priority claims are not examined by the

USPTO, the PTAB cannot simply assume that a patent application publication is entitled to an earlier priority date. See *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015). As such, it is the petitioner's burden to provide the necessary priority analysis.

Here, the PTAB found that the petitioner did not provide any analysis in the petition, nor was the provisional application introduced into the record. After the patent owner challenged the status of the patent application publication as prior art, the petitioner sought a preliminary reply to cure the deficiencies in the petition. But the PTAB denied the petitioner's request because the petitioner could have reasonably foreseen that the patent owner would challenge the patent application publication's status as prior art based on the filing dates at issue.

The PTAB concluded that there was no reasonable likelihood of success for grounds relying on the patent application publication because the petitioner had failed to make the necessary showing that the patent application publication was prior art. The PTAB rejected the other asserted grounds because the PTAB found that the references did not teach certain elements required by the claims. The petition was denied.

## Practice Tip

The petitioner in an AIA trial proceeding always has the burden to show that a reference cited in a ground of unpatentability qualifies as prior art. For patents and patent application publications, to the extent that the petitioner must establish priority to an earlier application, the petitioner should introduce the priority document into the record and provide analysis showing how the subject matter from the reference document is supported by the disclosures of the priority document. A patent owner should scrutinize the petition for defects in the analysis of how a reference is alleged to qualify as prior art. For further analysis of the precedential *Penumbra* decision, see Akin IP Newsflash, [PTAB: Dynamic Drinkware Written Description Requirement Inapplicable to Post-AIA Patents](#) (Jan. 30, 2024).

*Intelligent Wellhead Sys., Inc. v. Downing Wellhead Equip., LLC*, IPR2024-00256, Paper 11 (PTAB June 5, 2024).

## Categories

Patent Trial & Appeal Board

Inter Partes Review

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