



PTAB: Patent Owner's Burden Regarding a Showing of Priority Is Strictly Circumscribed by the Extent of Petitioner's Challenge in an IPR Petition

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The challenged patent claimed LED lamp devices that include a “mode determination circuit.” The petitioner raised one ground of unpatentability under § 102(a)(1) for anticipation by a foreign patent published on July 1, 2015. The petitioner challenged priority by arguing that earlier applications in the chain of priority lacked written description support for the “mode determination circuit” limitation. The patent owner responded by arguing that the patent properly claimed, and was entitled to, priority to a Chinese patent application filed on June 10, 2015, and argued how the Chinese application disclosed the claim limitation in question.

The board first rejected the petitioner's argument that the patent owner should have responded to the priority challenge by identifying written description support for *all* limitations of the claims. The board explained that the interference case cited by the petitioner was not relevant because in interferences, “all limitations of the claim must be shown to gain priority over another patent.”

The board then explained that the burdens imposed on each side were based on the Federal Circuit's *Dynamic Drinkware* decision. First, the petitioner must raise the issue of whether the challenged patent is entitled to an effective filing date by “identifying, specifically, the features, claims, and ancestral applications allegedly lacking written description support for the claims based on the identified features.” The burden then shifts to the patent owner to “make a sufficient showing of entitlement to earlier filing date(s), *in a manner that is commensurate in scope with the specific points and contentions raised by the petitioner.*”

The board determined that petitioner had met its initial burden by raising the issue of whether the patent could claim priority to the Chinese application because it lacked written description for the “mode determination circuit” limitation. Then, the board determined that the patent owner had sufficiently responded by “providing specific citations and argument” that the Chinese application provided support for that limitation.

The board also rejected the petitioner’s argument that the patent owner first had to show priority to its parent U.S. application, explaining that the patent properly claimed direct priority to the Chinese application because it was filed within one year of that application and indicated its priority claim. The fact that the patent issued from a continuation-in-part of another U.S. application was of no moment.

Finally, the board declined to consider the petitioner’s arguments—raised for the first time in reply—that the Chinese application had different inventorship from the patent, and that it did not provide support for another limitation in the claims. The board explained that the petitioner had raised these arguments too late, and that the patent owner was not required to hit the “moving target” presented by the new theories.

Practice tip:

When a petitioner must establish that a patent lacks priority to an earlier application from which priority was claimed, the petitioner must raise all potential challenges in the IPR petition. In particular, the petitioner should identify any and all elements of the claims that the petitioner believes lack written description support in any and all earlier applications. Furthermore, the petitioner should raise any differences in inventorship. On the other side, a patent owner need only respond to the specific arguments raised by a petitioner. A patent owner should be on the lookout for new theories that were not raised in the IPR petition and challenge them as outside the scope of the proceeding.

MaxLite, Inc. v Jiaxing Super Lighting Elec. Appliance Co., IPR2020-00208, Paper 10 (PTAB June 24, 2020)

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