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Not a Patent or a 'Printed Publication'? Not a Problem—IPR Prior Art Not Limited to § 102(a)

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In a Final Written Decision, the Patent Trial and Appeal Board has held that prior art under 35 U.S.C. § 102(e) was available in an *inter partes* review proceeding. The patent at issue was directed to alternating current driven LEDs, LED circuits and AC drive circuits and methods. The Petitioner challenged the claims under § 103(a), relying on a prior art reference ("Martin") in seven of the nine grounds. Martin described LEDs formed on a single substrate connected in series for use with an AC source.

The Patent Owner argued that Martin was unavailable as prior art because it was neither a patent nor a printed publication as of the priority date of the challenged patent. The Patent Owner further argued that the Petitioner had cited no authority for invoking Martin's filing date as its effective prior art date under § 102(e). According to the Petitioner, the reference qualified as prior art—despite publishing after the priority date—because it was a patent application filed in the United States before the challenged patent's priority date. The Board agreed with Petitioner.

First, the Board contrasted the statute governing the formerly available covered business method proceeding with the statute governing IPRs. In CBM proceedings, the statute explicitly limited challenges to those based on prior art under § 102(a). But the language of the statute governing IPRs, § 311(b), imposes no such limitation.

Next, the Board noted that none of the cases the parties cited squarely addressed the issue. Still, the Federal Circuit has applied § 102(e) prior art in an appeal from an IPR. And the Board has also instituted trials and found claims unpatentable based on § 102(e) prior art. Because

the Martin reference was filed in the United States before the challenged patent's filing date, the Board found that Martin was available as a prior art reference in this IPR proceeding. As such, the Board found all the challenged claims unpatentable under § 103(a) in view of Martin and other prior art references.

Practice Tip: The AIA permits the use of § 102(e) prior art in IPR proceedings. Because the Board may institute trial on grounds that rely on § 102(e) prior art, Patent Owners are well advised to scrutinize substantively the suitability of such references when attempting to defeat IPR institution or an unpatentability finding in a final written decision.

Samsung Elecs. Co., Ltd. v. Lynk Labs, Inc., No. IPR2022-00149, Paper 33 (P.T.A.B. Jun. 26, 2023)

Categories

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