



Timely Assignment Records Key to Defeating IPR Challenge

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The Patent Trial and Appeal Board denied institution of an *inter partes* review petition in part because it determined that a patent reference was not prior art under the common ownership exception of pre-AIA 35 U.S.C. § 103(c)(1).

The challenged patent relates to communication systems, and the patent owner argued that a patent reference was not prior art under § 103(c)(1) because its subject matter and the claimed invention were “owned by . . . or subject to an obligation of assignment to the same [entity]” at the time of the invention. Both parties treated the filing date of the challenged patent’s provisional application as the invention date—April 14, 2003.

The patent owner presented assignment records showing both the reference patent and the challenged patent were assigned to the same entity, on September 20, 2002 and November 25, 2003, respectively. To establish there was an earlier obligation to assign the challenged patent, the patent owner cited a 1996 employment agreement requiring the sole inventor to assign all inventions to a company (where the inventor had worked), and a 2000 news article reporting that the present assignee had acquired that company’s electronic systems business. The petitioner countered that the patent owner had not sufficiently proven that the inventor’s obligations under the employment agreement transferred ownership to the current assignee.

The board placed significant weight on the recorded assignments showing that both the challenged and reference patents had been assigned to the same entity, noting that the inventor’s assignment was recorded “shortly after” the invention date. Taken together with the patent owner’s supporting evidence, this convinced the board that the inventor was

indeed obligated to assign the invention to that entity as of April 14, 2003. Because the petitioner failed to present any evidence or rationale suggesting the inventor would not have been obligated as of April 2003 to assign the invention, the board concluded there was no reasonable likelihood that the reference could qualify as prior art.

Takeaway: For patent owners, timely recording of assignments with the Patent Office can be crucial in establishing common ownership between a challenged patent and alleged prior art, thereby excluding such reference from consideration. Petitioners relying on references potentially subject to the common ownership exception must be prepared to rebut assignment evidence with concrete facts (e.g., demonstrating that an inventor's obligations were not transferred by acquisition) or risk that art being excluded from an invalidity challenge.

Samsung Electronics America, Inc. v. Collision Communications Inc., IPR2024-01500, Paper 14 (P.T.A.B. April 28, 2025)

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