



Failure to Provide Patent Examiner with Copy of PTAB Decision Not Grounds for Inequitable Conduct

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Tinnus Enterprises, LLC and Zuru Ltd. filed a patent infringement suit against Telebrands Corp. and Bulbhead.com, LLC. The patents at issue are U.S. Patent Nos. 9,242,749 (the “749 patent”) and 9,315,282 (the “282 patent”), which generally involve a system and method for simultaneously filling multiple water balloons. Defendants alleged that the ’749 and ’282 patents were unenforceable for inequitable conduct because, during prosecution, Tinnus failed to provide the examiner with a copy of a PTAB decision to institute post-grant review of U.S. Patent No. 9,051,066. Defendants also alleged that the patents-in-suit improperly claimed priority to the ’066 patent with the intent to deceive the USPTO. Plaintiffs then filed a motion for summary judgment of no inequitable conduct and no unclean hands.

In his report and recommendation, Magistrate Judge John D. Love stated that defendants’ motion is based on the assumption that there is some requirement for a patent applicant to disclose relevant PTAB decisions to the patent examiner, but defendants do not cite any authority for this position. Judge Love also noted that Tinnus’ prosecution counsel did disclose the ’066 patent PGR institution decision to the patent examiner during an interview. Furthermore, Judge Love stated that defendants’ position assumes that the patent examiner is incapable of finding relevant PTAB decisions.

Judge Love went on to write that defendants provided no explanation to support the allegation that Tinnus intended to deceive the USPTO. Judge Love stated that the more likely inference is that Tinnus’ prosecution counsel believed that he had satisfied any duty of candor by disclosing the ’066 patent PGR institution decision during the interview with the

examiner. Defendants also did not cite to any statement or testimony from Tinnus, the inventor, or Tinnus' patent counsel that related to mental state or any intentional actions. Because defendants could not show a specific intent to deceive, Judge Love recommended that plaintiffs' motion for summary judgment be granted.

Tinnus Enterprises LLC v. Telebrands Corp., No. 6:16-cv-00033 (E.D. Tex. August 15, 2017, Report and Recommendation of United States Magistrate Judge) (Love, J.D.)

Categories

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Patent Infringement

Post-Grant Review

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