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PTAB Grants Rare Request for Rehearing and Modifies Final Written Decision

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In its petition, Duncan Parking Technologies (DPT) argued that Claims 1-5 and 7-10 of U.S. Patent No. 7,854,310 ("King '310") were anticipated by an earlier patent with partially overlapping inventors, U.S. Patent No. 8,595,054 ("King '054"). The Board issued a Final Written Decision holding that DPT had not carried its burden to show that Claims 1-5, 7 and 9 of King '310 were anticipated by King '054, but that DPT **had** established that Claims 8 and 10 of King '310 were unpatentable. In reaching different conclusions regarding these claims, the Board looked to the inventorship of the claims at issue: the parties agreed that all named inventors of King '310 contributed to Claims 8 and 10, whereas Claims 1-5, 7 and 9 were attributed to the work of inventor David King alone. The portions of King '054 asserted to anticipate claims 1-5, 7 and 9 were also attributed to Mr. King alone, but there was a dispute as to the inventorship of the portions of King '054 applied against Claims 8 and 10.

In the Final Written Decision, the Board held that, because named inventor Mr. King's own work was asserted to anticipate Claims 1-5, 7, and 9 of King '310, earlier work was not "by another" and thus did not constitute prior art to those claims under 35 U.S.C. § 102(e). Conversely, the Board concluded that, because other named inventors had contributed to the King '054 disclosures asserted to anticipate Claims 8 and 10, that work **was** "by another" and therefore constituted anticipatory prior art with respect to those claims.

In its motion for rehearing, patent owner IPS Group argued that that the Board overlooked its argument concerning the inventorship of the subject matter of Claims 8 and 10 of King '310. IPS Group argued that the portions of King '054 applied against Claims 8 and 10 actually disclose an invention of the King '310 inventors, which was communicated by them to the King '045 inventors. In other words, "where claims 1-5, 7, and 9 of the '310 patent and the

involved subject matter of King '054 were invented by the same entity, i.e., Mr. King, the same theory should be applied to claims 8 and 10, but with Mr. King replaced with the named inventors of the '310 patent." Therefore, just as Mr. King's own work could not anticipate Claims 1-5, 7 and 9, the work of Mr. King and his co-inventors in King '054 could not anticipate those same inventors' work in King '310.

The Board agreed, finding it undisputed that Mr. King and his co-inventors invented the substantive content that became claims 8 and 10 of King '310, and concluding that this same inventive entity (i.e., Mr. King and his co-inventors) also invented that same subject matter in King '054 and communicated it to the King '045 inventors. Those disclosures in King '054 therefore were not the work "of another" and could not constitute prior art to Claims 8 and 10 under § 102(e). Accordingly, the Board vacated portions of its previous ruling, and held that DPT had failed to carry its burden to show that any of Claims 1-5 and 7-10 were unpatentable.

Duncan Parking Technologies, Inc. v. *IPS Group Inc.*, Case IPR2016-00067, Paper No. 37 (PTAB Oct. 22, 2015)

Categories

Patent Trial & Appeal Board | 35 U.S.C. § 102