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USPTO Confirms Different Frameworks for Pre-AIA and Post-AIA Prior-Art Determinations

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On November 15, 2023, Director of the United States Patent and Trademark Office (USPTO) Kathi Vidal designated as precedential the Patent Trial and Appeal Board's (PTAB) final written decision in *Penumbra, Inc. v. RapidPulse, Inc.*[1] The decision, which issued in March 2023, held that the US Court of Appeals for the Federal Circuit's framework in *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*[2] for prior-art determinations applies only to pre-AIA determinations and not to post-AIA determinations.

In *Dynamic Drinkware*, the Federal Circuit held that a reference patent is entitled to the priority benefit of its provisional application, and thus qualifies as prior art under pre-AIA § 102(e) as of the provisional application's filing date, if two conditions are met:

> (i) the portions of the reference patent relied on as prior art are supported by the provisional application, and
>
> (ii) at least one claim of the reference patent is supported by the provisional application.[3]

However, the *Penumbra* panel held that part (ii) of the *Dynamic Drinkware* framework does not apply to prior-art determinations under AIA § 102, stating: "under AIA §§ 102(a)(2) and 102(d), there is no need to evaluate whether any claim of a reference patent document is actually entitled to priority when applying such a reference patent as prior art."[4] Instead, the panel articulated the following requirements for qualifying a reference patent document as prior-art under AIA § 102 as of the filing date of a prior application in its priority chain:

> (i) the reference patent document must meet the ministerial requirements of §§ 119 and 120, and
>
> (ii) the prior application to which the reference patent document claims a right of priority must describe the subject matter relied upon as prior art in the reference patent document.[5]

The panel reasoned that under AIA §§ 102(a)(2) and (d) a reference patent document is "effectively filed" for prior-art purposes as of the filing date of a prior application in its priority chain if the reference document is *merely entitled to claim* a right of priority of or benefit to the prior application.[6] The panel noted that there is no requirement for the reference document to *actually be entitled to* the priority of or benefit to the prior application.[7] Accordingly, the PTAB held that "for prior-art determinations under AIA § 102, there is no need to evaluate whether any *claim* of a reference patent document is *actually entitled to priority* or benefit under 35 U.S.C. 119, 120."[8] To support its decision, the panel relied on the difference in language between the old and new statutory provisions, as well as a prior, non-precedential PTAB decision and the USPTO's guidance to the Patent Examining Corps indicating the difference between post-AIA and pre-AIA prior-art determinations.[9]

The elimination of *Dynamic Drinkware*'s requirement to find support for a claim in the priority document for post-AIA prior-art determinations is important. Whether a reference patent document can get an earlier filing date can be critical in anticipation and obviousness challenges. The USPTO's framework for post-AIA prior-art determinations is easier to meet than the Federal Circuit's *Dynamic Drinkware* framework (which now only applies to pre-AIA prior-art determinations). This distinction would make anticipation and obviousness challenges against the AIA patents easier compared to the pre-AIA patents.

The *Penumbra* decision arose in an inter partes review (IPR) proceeding that Penumbra filed against RapidPulse's patent. After deciding that a reference patent used by Penumbra for obviousness challenge qualified as prior art as of its priority date, the PTAB held the challenged claims unpatentable. RapidPulse has filed a notice of appeal before the Federal Circuit, but it remains unclear whether RapidPulse will challenge the PTAB's *Dynamic Drinkware* analysis.

[1] *Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper 34 (March 10, 2023) (precedential as to section II.E.3).
[2] *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015).
[3] *Dynamic Drinkware*, 800 F.3d at 1378, 1381-82.
[4] *Penumbra,* IPR2021-01466, Paper 34, at 29-30.
[5] *Id.* at 32.
[6] *Id.* at 30-31.
[7] *Id.*
[8] *Id.* at 32 (emphasis in original) (emphasis added).
[9] *Id.* at 30-33 (citing *Apple Inc. v. Telefonaktiebolaget LM Ericsson*, No. IPR2022-00341, Paper 10, at 14-22 (PTAB Sept. 14, 2022); Robert W. Bahr, Memorandum re: Critical Reference Date Under pre-AIA 35 U.S.C. §102(e) (Apr. 5, 2018), available at http://www.uspto.gov/sites/default/files/documents/dynamic_memo_05apr2018_0.pdf; MPEP § 2154.01(b)).

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