

## Keys To Successful Swear-Behind Attempts Before PTAB

Law360, New York (June 9, 2017, 1:04 PM EDT)



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For patents subject to pre-AIA 35 U.S.C. § 102, patent owners involved in post-grant challenges such as inter partes review before the Patent Trial and Appeal Board can disqualify an asserted reference by establishing an earlier date of invention before the critical date of the asserted reference, provided the reference does not constitute a statutory bar under § 102(b). In our previous Expert Analysis article, we [explored](#) common reasons why patent owners have generally been unsuccessful before the PTAB in swearing behind asserted references. The common reasons include insufficient corroboration of evidence, failing to establishing an earlier date of invention for all limitations of the challenged claims, insufficient evidence demonstrating diligence from conception through reduction to practice, and insufficiencies from relying on Rule 131 practice (37 C.F.R. § 1.131).

While most patent owners have been unsuccessful in swearing behind asserted references in post-grant proceedings, a handful of patent owners have succeeded. In that previous article, we indicated that patent owners successfully swore behind an asserted reference in only five of 41 America Invents Act trials reaching a final written decision. Since that time, another patent owner succeeded, bringing the successful tally to six out of 43 trials.[1] This article explores the approach and evidentiary rationales that resulted in successful swear-behinds in those six trials.

### Establishing Prior Invention

Prior invention can be demonstrated in one of two ways. First, a patent owner may demonstrate a reduction to practice of the claimed invention prior to the critical date of the reference.[2] Second, a patent owner may prove conception of the invention prior to the critical date of the reference, followed by reasonably continuous diligence in reducing the invention to practice subsequent to the critical date.[3]

In post-grant proceedings, the petitioner bears the burden of persuasion to demonstrate by a preponderance of the

evidence that the challenged claims are unpatentable, including establishing that any asserted reference qualifies as prior art against the challenged claims.[4] If, however, an asserted reference qualifies on its face as prior art, the patent owner has the burden of producing evidence to support a date of invention prior to the critical date of the asserted reference.[5] In the event the patent owner meets its burden of production to support an earlier date of invention, the burden of production then shifts to the petitioner to demonstrate that the subject matter in the challenged claims is not entitled to the earlier date of invention.[6]

### Establishing Reduction to Practice Prior to the Reference's Critical Date

In *Green Cross Corp. v. Shire Human Genetic Therapies Inc.*, the patent owner successfully established an actual reduction to practice of the invention prior to the critical date of the asserted reference.[7] The challenged claims are directed to a composition comprising purified recombinant I2S protein having a recited amino acid sequence and a minimum amount of specifically modified protein.[8] To support its swear-behind attempt, the patent owner submitted laboratory studies and other documentary evidence, a declaration from the inventor, and declarations from three other noninventor employees of the company acquired by the patent owner to corroborate the inventor's testimony.[9]

The PTAB panel determined that the supporting evidence established by a preponderance of the evidence that (1) the inventor constructed an embodiment meeting all the limitations of the challenged claims, (2) the inventor determined that the invention would work for its intended purpose, and (3) the reduction to practice was sufficiently corroborated.[10] Based on this determination, the PTAB panel indicated that the burden of production shifted to the petitioner to "establish by the preponderance of the evidence that Patent Owner has not shown possession of each element of the challenged claims as of the critical date." [11] The petitioner argued that

the inventor's prior reduction to practice did not meet all claim limitations. The PTAB panel disagreed with the petitioner, finding that the patent owner had "provided sufficient evidence to show that it reduced to practice an embodiment encompassing all elements of the challenged claims prior to the critical date of [the asserted reference.]"[12]

### ***Failure to Address Sufficiency of Swear-Behind Evidence Under Patent Owner's Construction***

In *Wright Medical Technology Inc. v. Biomedical Enterprises Inc.*, the patent owner successfully demonstrated a prior reduction to practice based on the PTAB panel's adoption of the patent owner's proposed claim construction for the challenged claims.[13] The challenged claims are directed to an orthopedic fixation system having a sterile packaged implant kit.[14] The petitioner argued that the claims should be construed to require a compressive force for loading a surgical implant of the implant kit on an insertion device of the implant kit.[15] The PTAB panel disagreed with the petitioner's proposed construction and determined that the claims are not limited to a particular process for assembling the implant kit. [16]

To swear behind the asserted reference, the patent owner produced documentary and testimonial evidence of a "second generation kit" that was reduced to practice prior to the critical date of the reference.[17] The petitioner's argument that the "second generation kit" did not include each element of the challenged claims was predicated on its proposed claim construction requiring a particular process of loading the surgical implant on the insertion device. Due to the PTAB panel declining to adopt the petitioner's claim construction, the patent owner's swear-behind evidence was un rebutted. [18] Accordingly, the PTAB panel determined that the patent owner had successfully met its burden in swearing behind the asserted reference by establishing an earlier reduction to practice.

### ***Establishing Reduction to Practice for Broader Claims, But Not Narrower Claims***

In *Nintendo of America v. iLife Techs.*, the patent owner successfully swore behind an asserted reference to defeat an obviousness challenge of independent claims 1 and 11, but failed to swear behind the reference for narrower dependent claims 2 and 12.[19] The challenged claims are directed to a system and method for evaluating movement of a body relative to an environment, such as falls, irregular movement, and inactivity.[20] The critical date of the asserted Yasushi reference was Nov. 10, 1998. The patent owner was able to establish a reduction to practice for independent claims 1 and 11 in September 1998, before the critical date of the

Yasushi reference.[21] In support of its swear-behind effort, the patent owner submitted declarations of the named inventors, declarations of two noninventor corroborating witnesses, and evidence of prototypes including engineering drawings and circuit diagrams that demonstrated that the constructed embodiments met all the limitations of independent claims 1 and 11 and worked for their intended purpose.[22]

Similar to *Wright Medical*, a dispositive issue in the patent owner's ability to swear behind the Yasushi reference was the construction of a claim limitation directed to a sensor for sensing an accelerative phenomena of a body "relative to a three dimensional frame of reference" in the environment. The PTAB panel agreed with the patent owner's construction, which defeated the petitioner's challenge to the patent owner's reduction to practice evidence.[23] The patent owner was, however, unable to demonstrate an earlier date of invention for narrower dependent claims 2 and 12, and these claims were held to be unpatentable over the Yasushi reference.[24]

### ***Sufficiently Corroborating Inventor Testimony of Earlier Reduction to Practice***

In *Sequenom Inc. v. The Board of Trustees of The Leland Stanford Jr. University*, the dispositive issue was whether the inventors' asserted earlier date of invention was sufficiently corroborated by independent evidence or testimony.[25] To support its swear-behind effort, the patent owner relied on two drafts of a paper published in the *Proceedings of the National Academy of Sciences*. The PNAS paper was co-authored by two inventors of the challenged patent. The patent owner produced the PNAS paper, email correspondence associated with the drafts of the paper, and testimony by another one of the co-authors of the PNAS paper who was not a named inventor of the patent.[26] As noted by the PTAB panel, corroboration "is not necessary to establish what a physical exhibit before the [B]oard includes. Only the inventor's testimony requires corroboration before it can be considered." [27] In this case, the PTAB panel was persuaded that the non-inventor co-author's testimony corroborated the inventors' testimony that the drafts of the PNAS paper submitted into evidence were in fact the drafts that were received by the non-inventor co-author.[28] The PTAB panel determined that the drafts of the PNAS paper sufficiently established that the inventors reduced to practice the invention in the challenged claims.[29] Accordingly, the PTAB panel held that the patent owner had successfully sworn behind the asserted reference.

### ***Overcoming Negative Inventor Testimony***

In *Dynamic Drinkware LLC v. National Graphics Inc.*, the patent owner was successful in establishing an earlier date of

invention for the challenged claims despite one of the inventors of the patent testifying that the challenged claims were entitled to a date later than the asserted reference.[30] In this case, one of the inventors, who worked for the patent owner for twenty years, testified on behalf of the petitioner while he worked for a company that is “related” to the petitioner.[31] The PTAB panel gave close scrutiny to the former employee’s testimony as “being aligned against his patent,” while noting that the former employee “had no motivation to be untruthful” when he completed notebook entries while employed by the patent owner.[32] The PTAB panel gave less weight to the former employee’s after-the-fact testimony concerning alleged drawbacks of the prototype because the former employee was an interested witness.[33] The PTAB panel concluded that the patent owner’s evidence demonstrated that the inventors reduced to practice the features in the challenged claims, and that the inventors determined that the prototype evidence worked for its intended purpose.[34]

### ***Establishing That Invention Was Not by Another***

In *Varian Medical Systems v. William Beaumont Hospital*, the patent owner successfully removed two asserted references as prior art under pre-AIA § 102(a) because the petitioner did not establish that the portions of the references relied on by the petitioner were the work of “others.”[35] Pre-AIA § 102(a) prevents patentability if “the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.” The patent owner presented evidence and testimony establishing that the relied-upon portions of the references were the work of the named inventors, not the work of the noninventor co-authors.[36] Noting that the petitioner bears the burden to establish that an asserted reference qualifies as prior art, the PTAB panel was not persuaded by the petitioner’s arguments about the lack of corroboration for the patent owner’s testimony. Further, the PTAB panel disagreed with the petitioner’s argument that the patent owner should be required to demonstrate conception and reduction to practice by only the named inventors before the critical dates of the asserted references. The PTAB panel held that adopting such an approach would impose an unnecessary requirement on the patent owner, when it was the petitioner’s obligation to establish that the asserted references qualify as prior art.[37]

### ***Conclusion***

While patent owners have generally been unsuccessful in swearing behind asserted references for pre-AIA patents involved in post-grant proceedings, the aforementioned cases illustrate that meeting the stringent evidentiary standards can indeed lead to success. Parties before the PTAB should be

mindful of the shifting burdens for establishing whether an asserted reference qualifies as prior art. In addition, parties should consider the potential effect that claim construction can have on the evidentiary requirements for swearing behind, and that a successful swear-behind may only apply to some of the challenged claims. Further, since the ultimate burden of establishing that an asserted reference qualifies as prior art rests with the petitioner, petitioners should likewise consider establishing the earliest possible critical dates for asserted references to counteract any attempts to swear behind asserted references.

[1] Using Docket Navigator®, the authors identified 43 distinct PTAB final written decisions addressing attempts by patent owners to swear behind an asserted reference. To avoid double-counting, the authors did not take into account proceedings involving patents that are the same as or related to patents challenged in a proceeding that is already accounted for in the data set.

[2] *Purdue Pharma L.P. v. Boehringer Ingelheim GmbH*, 237 F.3d 1359, 1365 (Fed. Cir. 2001); *Fox Group, Inc. v. Cree, Inc.*, 700 F.3d 1300, 1304-05 (Fed. Cir. 2012).

[3] *Purdue Pharma*, 237 F.3d at 1365; *Monsanto Co. v. Mycogen Plant Sci.*, 261 F.3d 1356, 1362-63 (Fed. Cir. 2011).

[4] 35 U.S.C. § 316(e); see *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1576 (Fed. Cir. 1996) (holding that the challenger of a patent bears the burden of persuasion on all issues related to whether an asserted reference qualifies as prior art against the patent).

[5] see *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378-80 (Fed. Cir. 2015).

[6] *Id.* at 1380.

[7] IPR2016-00258, Paper 89 at 13, 24 (PTAB Mar. 22, 2017).

[8] *Id.* at 2, 5-6.

[9] *Id.* at 12.

[10] *Id.* at 12-13.

[11] *Id.* at 13 (emphasis original).

[12] *Id.* at 24.

[13] IPR2015-00786, Paper 38 at 10-11 (PTAB May 4, 2016).

[14] Id. at 3-5.

[15] Id. at 6-8.

[16] Id. at 8.

[17] Id. at 9.

[18] Id. at 10.

[19] IPR2015-00112, Paper 39 at 38-39 (PTAB Apr. 28, 2016).

[20] Id. at 4.

[21] Id. at 38-39.

[22] Id. at 31-38.

[23] Id. at 16-17, 39.

[24] Id. at 45-47.

[25] IPR2013-00390, Paper 45 at 6-7 (PTAB Nov. 25, 2014).

[26] Id. at 6.

[27] Id. at 8 (quoting *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993)).

[28] Id. at 11-12.

[29] Id. at 12-15.

[30] IPR2013-00131, Paper 42 at 15 (PTAB Sept. 12, 2014).

[31] Id.

[32] Id. at 16.

[33] Id. at 18.

[34] Id. at 18-19.

[35] IPR2016-00160, Paper 82 at 22 (PTAB May 4, 2017).

[36] Id. at 23.

[37] Id. at 26.