

Seyfarth PTAB Blog



A legal look at Patent Trial and Appeal Board decisions and trends

Inherent Disclosure Argument Successful in Inter Partes Review

By Christopher A. Baxter

A vast majority of the time, petitioners in USPTO post-grant proceedings attempt to show invalidity of challenged claims by showing the prior art explicitly discloses all limitations of the claims. A petitioner in a recent Inter Partes Review (IPR) proceeding successfully invalidated claims of U.S. Patent No. 5,930,444 (the “444 patent”), titled “Simultaneous Recording and Playback Apparatus,” by establishing some of the claim limitations are inherently present in the prior art.

The ‘444 patent relates to “an audiovisual recording and playback device that provides substantially simultaneous recording and playback, allowing user-controlled programming delay.” *Unified Patents Inc. v. Dragon Intellectual Property, LLC*, IPR2014-01252, p. 3 (PTAB February 5, 2016). Claim 1 of the ‘444 patent partially recites “a keyboard having a record key and a playback key.” *Id.* at 4. The petitioner contended one of the prior art references discloses a remote control for controlling a device that simultaneously records and plays back television images, that such remote controls have keys/buttons, and that a person of ordinary skill in the art would know remote controls have keyboard keys as particularly claimed in the ‘444 patent. *Id.* at 11. The patent owner argued the petitioner’s inherency argument fails because the focus of the prior art reference is commercial skipping, the prior art reference does not provide specifics regarding the keys needed to perform commercial skipping, and the prior art device may be controlled via something other than a keypad. *Id.* at 14.

The PTAB agreed with the petitioner. Prior art references inherently disclose a claim limitation if that claim limitation is a “natural result” of the combination of the prior art references. *Id.* at 15. The PTAB rejected the patent owner’s limited view of the prior art reference. *Id.* The PTAB stated the prior art reference discloses a user “controls the device of the invention, for example with a remote[,]” and that this teaching indicates the remote control is used to control the device in general, not just a single function thereof. *Id.* The PTAB also stated the prior art reference describes its device as having record and playback functionality, and therefore held the device of the prior art reference must control both recording and playback, and must have buttons like those claimed in the ‘444 patent (i.e., a record key and a playback key). *Id.*

Takeaway

Explicit disclosure is not required to invalidate a patent in a post-grant review proceeding. If a petitioner is unable to find prior art explicitly disclosing every limitation of a challenged claim, the petitioner might determine whether logical reasoning (and expert testimony) can fill a gap between the explicit disclosure of a prior art reference and a challenged claim.

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