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CLIENT ALERT

Invention "By Another" Under § 102(e) Where the Contribution Is Significant in Light of the Invention as a Whole

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Duncan Parking Technologies, Inc. v. IPS Group, Inc., No. 2018-1360, *IPS Group, Inc. v. Duncan Solutions Inc. et al.*, No. 2018-1360 (Fed. Cir. Jan. 31, 2019)
The patent owner sued a competitor for the alleged infringement of two patents relating to parking meter technology. The district court granted summary judgment of non-infringement of both patents based on its construction of particular claim terms. Shortly after the patent owner filed its complaint, the accused infringer petitioned for *inter partes* review of the '310 patent, which the Patent Trial and Appeal Board (PTAB) instituted on 35 U.S.C. § 102(e) anticipation grounds. There was no dispute on the merits that the § 102(e) prior art disclosed all of the features of the '310 patent claims. However, the PTAB ultimately found that the anticipating disclosure was not "by another" under § 102(e). The petitioner appealed from the PTAB's decision.

On appeal, the Federal Circuit noted that in deciding whether a reference patent is "by another" for the purposes of § 102(e), the PTAB must: "(1) determine what portions of the reference patent were relied on as prior art to anticipate the claim limitations at issue, (2) evaluate the degree to which those portions were conceived 'by another,' and (3) decide whether that other person's contribution is significant enough, when measured against the full anticipating disclosure, to render him a joint inventor of the applied portions of the reference patent." Applying this standard, the court held that the anticipating disclosure was the result of a joint invention, an inventive entity different from that of the '310 patent, and reversed the PTAB's decision.
A copy of the opinion can be found here

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