

## Precedential Opinion: PTAB may, in rare circumstances, raise a ground of unpatentability for proposed amended/substituted claims, that a petitioner did not advance, or insufficiently developed

SEPTEMBER 10, 2020

**Hunting Titan, Inc. v. DynaEnergetics Europe GmbH**, Case IPR2018-00600, Paper 67 (PTAB July 6, 2020) (designated precedential: July 6, 2020). Before: Andrei Iancu, Andrew Hirshfeld and Scott R. Boalick.

The challenged patent ([US9581422](#)) relates to a wireless detonator used for extracting fossil fuels. Petitioner alleged sixteen grounds of unpatentability based on anticipation and obviousness theories. Patent Owner filed a motion to amend. Petitioner challenged the proposed amended claims based only on obviousness (not anticipation). But Board found that the original and proposed amended claims were *anticipated*.

Patent Owner requested rehearing and Precedential Opinion Panel (POP) review on the following issues:

Under what circumstances and at what time during an *inter partes* review may the Board raise a ground of unpatentability that a petitioner did not advance or insufficiently developed against substitute claims proposed in a motion to amend?

If the Board raises such a ground of unpatentability, whether the Board must provide the parties notice and an opportunity to respond to the ground of unpatentability before the Board makes a final determination.

For the first issue: The POP opinion held that “the Board may, in certain rare circumstances, raise a ground of unpatentability that a petitioner did not advance, or insufficiently developed, against substitute claims proposed in a motion to amend.” The opinion rationalized by citing to *Nike, Inc. v. Adidas AG*, 955 F.3d 45 (Fed. Cir. 2020) for the proposition that “the Board should not be constrained to arguments and theories raised by the petitioner in its petition or opposition to the motion to amend. . . . Otherwise, were a petitioner not to oppose a motion to amend, the Patent Office would be left with no ability to examine the new claims.” *Id.* at 51. The Board then noted that *Nike* held that the Board *may* sua sponte identify patentability issues, but did not hold that the “the Board *must* do so.” Instead, the adversarial process inherent in IPR proceedings places the incentives on the parties to identify pertinent evidence and arguments for their desired outcomes.

As to the second issue: the POP opinion disagreed with the Petitioner’s argument that the anticipation arguments raised against the original (non-amended) claims provided sufficient notice. Instead, due process requires that the petitioners (or the Board) provide notice and a fair opportunity to the Patent Owner to respond to the alleged grounds of rejection for the proposed amended/substituted claims.

Ultimately the POP opinion found that the present case, as a matter of policy, was not one of the “rare circumstances” where the Board should have raised a non-advanced ground of rejection for the proposed amended claims. The opinion stated that the “public interest is not well-served by the Office filling in gaps intentionally left void by IPR petitioners.” Instead, the “public interest is best served by the Office acting with humility and restraint, and deferring to those who come before the Board in these adversarial proceedings, who have the most at stake, and who surely know the record best.” The POP opinion found that the present case did not present the “sort of readily identifiable and persuasive evidence of anticipation in the record that would justify the Board raising its own grounds of unpatentability.” The POP opinion also found that the Petitioner’s obviousness challenge was not well developed where the petition primarily provided a comparison of the prior art to the discrete claim limitations without providing (i) “any specific statement” of obviousness such as “‘obvious over [X prior art reference] alone’ or ‘obvious over the combined disclosures of [X + Y prior art references]’” or (ii) a reason “why a person of ordinary skill would have modified or combined the prior art.”

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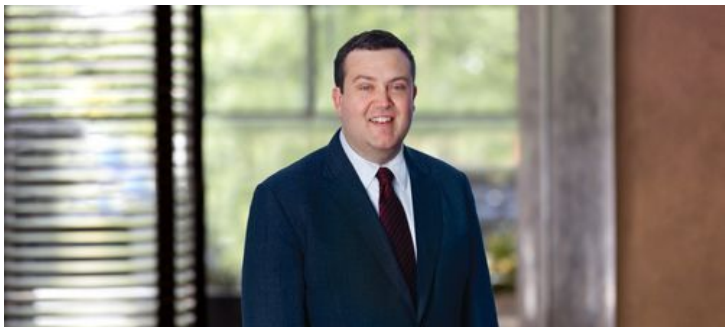
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