

Anticipation Finding Based on PTAB's Claim Interpretation Deprived the Patentee of Due Notice

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M & K Holdings, Inc. v. Samsung Electronics Co., Ltd., No. 2020-1160 (Fed. Cir. Feb. 1, 2021)

The patentee appealed the Patent Trial and Appeal Board's (PTAB) decision in an *inter partes* review finding the challenged claims unpatentable. The patentee argued the PTAB erred by finding a claim anticipated when the petition only asserted obviousness as to that claim, and by relying on references that did not qualify as printed publications. The Federal Circuit affirmed in part, vacated in part, and remanded.

The Federal Circuit panel (Judges Moore, Bryson, and Chen) vacated the PTAB's anticipation decision because it was based on a claim interpretation not offered by either party and not disclosed until the PTAB's final written decision. The panel noted that the Board must "timely inform the patent owner of 'the matters of fact and law asserted'" and "give all interested parties the opportunity to submit and consider facts and arguments." Here, the patentee was aware of the prior art used to invalidate the claim given the asserted obviousness combination. But, the patentee was not provided notice that the PTAB might find the cited reference disclosed every limitation of that claim. Further, the PTAB's anticipation finding was not inherent in the petitioner's obviousness theory. Instead, the petition stated the reference did not disclose every limitation of the claim. The PTAB thus impermissibly deprived the patentee of an opportunity to challenge the PTAB's claim interpretation that resulted in its anticipation theory. The panel distinguished *Wasica Finance GmbH v. Continental Automotive Systems, Inc.*, 853 F.3d 1272 (Fed. Cir. 2017), where the petitioner alleged that a prior-art reference both anticipated and rendered obvious the challenged claims.

The court affirmed the PTAB's decision regarding the printed-publication issue. The references were reasonably accessible to interested artisans. They were discussed at a conference held by a prominent standard-setting organization and were posted to the organization's website. A public accessibility finding does not require showing the references themselves were prominent or were accessed by artisans in the field. Nor is it necessary to show the publishing website has a search function. Instead, a relevant factor, shown here, is whether the website indexes or otherwise categorizes its documents by subject matter.

Read the opinion [here](#).

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