

Rehearing Granted and IPR Instituted Because Board Improperly Placed Burden of Disproving Priority Date of Challenged Patent on Petitioner

JUNE 15, 2021

Maxlite, Inc. v. Jiaxing Super Lighting Electric Appliance Co., Ltd., Case IPR2020-00208, Paper 14 (PTAB June 1, 2021).

Before: Moore, McNamara, Dirba.

The Board granted rehearing of its previous institution denial. Petitioner had asserted that a reference antedated the filing date of the challenged patent and that none of the potential priority applications listed on the face of the challenged patent “disclose all of the limitations of [the challenged claims] including, for example, a ‘mode determination circuit.’” In the preliminary response, patent owner asserted that the challenged claims were entitled to the date of one of the priority applications, but focused only on the written description support for the “mode determination circuit,” and did not demonstrate any written description support for the remaining limitations of the claim. In the institution decision, the Board denied institution on the grounds that petitioner failed to demonstrate that the challenged claims lacked written description support in the priority applications. But, on rehearing, the Board reversed itself and found that it had failed to properly place the burden on the patent owner to show that each limitation of the challenged claims is entitled to an earlier priority date. Because patent owner had not demonstrated written description support for all limitations of the claim, the patent owner had failed to prove that the asserted reference was not prior art to the challenged claims. The Board similarly reversed its decision regarding inventorship of the alleged priority reference and held that because there was no overlap in the named inventors between the alleged foreign priority reference and the U.S. application, the patent owner had the burden of demonstrating that the foreign application was filed on behalf of the U.S. inventors and that patent owner had failed to satisfy that burden.

Upon finding that the asserted reference was, in fact, prior art to the challenged patent, the Board went on to analyze whether the reference taught the elements of the challenged claims. The Board found that petitioner had demonstrated that the prior art reference taught each element of the challenged claims. The Board thus found a reasonable likelihood that petitioner would prevail on at least one claim and, therefore, instituted trial.

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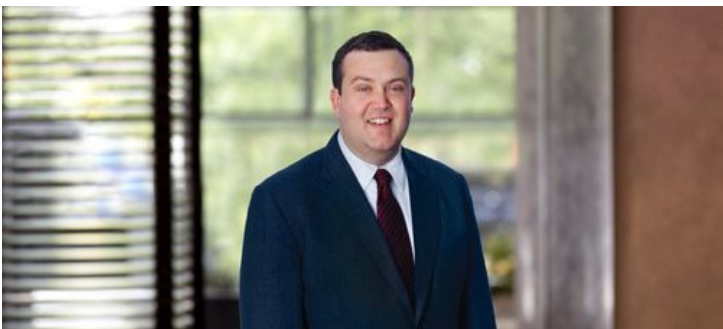
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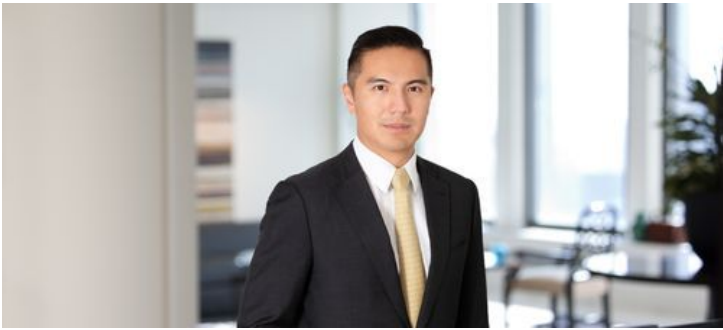
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