

PTAB Engages in a § 112-Centric Analysis to Deny Institution

MARCH 1, 2022

Google LLC v. Singular Computing LLC, Case IPR2021-00154, Paper 16 (May 12, 2021).

Before: Arbes, Sawert, Repko.

Petitioner filed an IPR asserting a single ground of unpatentability: the challenged claims would have been obvious over a patent application publication that was in the chain of priority of the challenged patent. In attempt to qualify the reference as prior art, petitioner had to break priority, arguing that the challenged patent could not claim benefit to the priority application. According to petitioner, the priority application described and enabled a single species, whereas the challenged claims covered a large genus, and thus the priority application failed to describe or enable a POSA to make and use the full scope of the claimed invention.

Petitioner's obviousness theory necessarily implicated an analysis of whether the challenged patent satisfied the written description and enablement requirements. The challenged patent, the priority application, and the reference all shared the same specification. Petitioner's argument that the priority application failed to describe or enable the challenged claims was thus akin to arguing that the specification of the *challenged patent* failed to describe or enable the challenged claims—an issue that is statutorily prohibited under § 311. See 35 U.S.C. § 311(b) (limiting the scope of IPR to grounds “that could be raised under section 102 or 103”).

The Board denied institution, declining to address patent owner's arguments that petitioner's theory inappropriately raised § 112 issues and holding that the challenged patent properly claimed priority to the priority application. In doing so, the Board engaged in a thorough analysis of whether the priority application adequately described the claimed invention and enabled a POSA to make and use the claimed invention. After analyzing the priority application's disclosures and considering the nature and scope of the challenged claims, the Board found that the priority application described and enabled the challenged claims under applicable precedent. The Board thus held that petitioner failed to prove the reference qualified as prior art and denied the petition.

While the Board ultimately denied the petition, the issue raised by the petition highlights how petitioners can leverage IPRs to support their defenses in parallel proceedings. For example, eliciting patent owner arguments that a patent's claim scope is narrow, and thus supported by the specification for purposes of priority, could support a narrower claim construction in district court litigation. See, e.g., *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1361 (Fed. Cir. 2017) (holding “statements made by a patent owner during an IPR proceeding can be considered during

claim construction and relied upon to support a finding of prosecution disclaimer”). Petitions implicating priority arguments may also prompt patent owner concessions that certain claim elements were known in the prior art, which could support obviousness arguments preserved in other proceedings. Petitioners should carefully weigh whether it may be appropriate to raise § 112-based arguments in an IPR (assuming those arguments are legitimately part of Section 102 or 103 grounds based on printed patents or publications) and whether such arguments could help support alternative defenses.

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Authors

[Claire Fundakowski](#)

[Brian E. Ferguson](#)

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[Claire Fundakowski](#)



Brian E. Ferguson

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