

DYNAMIC DRINKWARE, LLC v. NATIONAL GRAPHICS, INC., Appeal No. 2015-1214 (Fed. Cir. September 4, 2015). Before Lourie, Bryson, and O'Malley. Appealed from Patent Trial and Appeal Board.

Background:

The Board instituted *inter partes* review of claims of a patent owned by National Graphics on the basis that the Raymond patent was *prima facie* §102(e)(2) prior art to the claims. The Raymond patent has an actual U.S. filing date and claims priority to an earlier-filed U.S. provisional application. During trial, the Board found that (i) National Graphics proved invention prior to the actual filing date of the Raymond patent, and (ii) Dynamic failed to demonstrate that the Raymond patent was entitled to its provisional filing date for purposes of establishing that the Raymond patent was prior art to the claims at issue. Accordingly, the Board decided in favor of National Graphic. Dynamic appealed.

Issue/Holding:

Did the Board err in placing the burden on Dynamic to prove that the Raymond patent was entitled to its provisional filing date? No, affirmed.

Discussion:

Dynamic first argued that the Board erred in shifting the burden to Dynamic to prove that the Raymond patent was entitled to the filing date of its provisional application. Instead, Dynamic asserted that the Raymond patent, as a presumptively valid prior-art patent, should be presumed to be entitled to its earlier provisional application filing date.

The Federal Circuit rejected Dynamic's approach because it would create an unjustified presumption that a patent is entitled to the benefit of the filing date of its provisional application despite that the PTO does not examine priority claims unless necessary. Thus, the Board has no basis to presume that a reference patent is necessarily entitled to the filing date of its provisional application. Therefore, the Federal Circuit held that the Board did not err in concluding that Dynamic had the burden to prove that the Raymond patent was entitled to the filing date of its provisional application.

Dynamic also argued that it met the burden of establishing that the Raymond patent is prior art by comparing claim 1 of National Graphic's patent to the Raymond provisional application in its reply brief. The Federal Circuit held that this was insufficient because Dynamic was required to show that the disclosure of the provisional application provided support for the claims of the Raymond patent.