

IP Law News

## PTAB's Precedent Tightens Prior Art Guidelines in Validity Trials

By Ian Lopez

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New Patent Trial and Appeal Board precedents addressing how the board will assess prior inventions in patent challenges could drive parties to be more discriminating about what evidence they submit in efforts to invalidate patents.

The board March 24 designated two decisions—*Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH* and *Oticon Medical AB v. Cochlear Limited*—as precedential to offer guidance on how the tribunal exercises the discretion it has to grant or deny a patent review.

“As a practitioner, you really want to look at potential art that is going to really bring something new to the table,” said Ravi Mohan, a Rutan & Tucker LLP attorney. “You’re going to have to ask yourself, ‘Is this substantially the same?’”

In *Advanced Bionics*, the board found that art the company used against a MED-EL patent was substantially the same’ as that an examiner used in weighing to grant intellectual property protection. Advanced Bionics also failed to show the examiner made a mistake in issuing the patent, and the board therefore decided not to institute a review.

In *Oticon*, the PTAB found that prior art wasn’t substantially the same as that in the examination process, and the examiner erred in not considering it before issuing the patent. The board, therefore, allowed the trial.

Scenarios in which parties try to invalidate patent claims with prior art used by examiners in granting the intellectual property protection come up “all the time,” Armond Wilson LLP co-founder Michelle Armond said. The precedent is meant “to provide a roadmap on how they’re going to deal” with them, he said.

“You frequently see people using the same or very similar art,” she said. “Both of these cases had art that that was previously considered.” Armond said.

In *Advanced Bionics*, the art proved “fatal,” Armond said. Advanced Bionics fell short of proving the examiner made a mistake when issuing the patent, the board found.

But the decision provides practitioners clarity about what the board means when it says art “was previously considered,” according to Haynes and Boone LLP partner Raghav Bajaj. It “provides less squishiness” as to whether prior art is the same or substantially the same as that considered during patent examination.

In *Oticon*, the board found there was a material difference between art considered during examination and that used in attempt to invalidate the patent claims, Armond said.

The *Oticon* decision provides practitioners with guidance on cumulative art, or earlier inventions that “teach the same thing but in a different way,” Bajaj said.

“As a petitioner, that’s always a tough call, whether you need to argue that at all, because anytime you have a second look at something, the other side could say, well, you’re reference is cumulative because it teaches the same thing. So this decision helps a little bit on that front,” Bajaj said.

The decisions illustrate that the PTAB “basically don’t want people to get a second bite at the apple, as far as prior art is concerned,” Mohan said.

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