

# Understanding Antedating of a Prior Art Reference for a Patent

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The Federal Circuit's decision in [ATI Technologies ULC v. Iancu](#) (April 11, 2019) highlights the proper standard to use in evaluating whether a claimed invention was reduced to practice before the effective date of a prior art reference. This evaluation is important because under [37 CFR 1.131](#) (Rule 131) for patents and patent applications being evaluated under pre-AIA (America Invents Act) guidelines, a reference that would otherwise qualify as prior art under [35 U.S.C. § 102\(e\)](#) can be eliminated as prior art ("antedated") if the claimed invention is shown to have been invented before the reference's effective date. Establishing invention for antedating purposes involves showing that the invention was conceived or was reduced to practice before the reference's effective date. The *ATI* decision focuses on actual reduction to practice, as there was no dispute that conception occurred before the relevant reference's effective date or that constructive reduction to practice occurred on the patents' filing dates.

ATI appealed three Patent Trial and Appeal Board (PTAB) decisions holding that ATI's Rule 131 Declarations and witness testimony failed to establish actual reduction to practice before the critical date and that, therefore, the asserted primary reference qualified as prior art to the patents at issue. The PTAB based its decision on ATI allegedly not showing "continuous reasonable diligence" from the invention's conception through constructive reduction to practice. The Federal Circuit stated that "the PTAB applied the wrong legal standard for diligence."

The Federal Circuit provided that the proper legal standard for evaluating diligence is whether from the invention's conception the inventor(s) "reasonably continued activity to reduce the invention to practice." In other words, the court emphasized the difference between "continuous reasonable diligence" (the PTAB's applied standard) and "reasonably continuous diligence" (the proper legal standard).

The court also indicated that "reasonably continuous diligence" cannot be established by inventor testimony alone in Rule 131 Declarations or court testimony. Instead, the court stated that "[a]n inventor's testimony regarding his reasonable diligence must be corroborated by evidence" (quoting [Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.](#), 841 F.3d 1004, 1007 (Fed. Cir. 2016)). Here the evidence included over 1,300 pages of documentary records indicating work done by team members assigned to the project that resulted in technology claimed in the patents at issue, with the records including electronic confirmations of who did what work and when

through metadata, document logs, and folder histories. The records also showed that at least one team member worked on the project every non-holiday business day from conception through constructive reduction to practice (patent application filing).

The *ATI* decision thus serves as a helpful indication of the proper standard for evaluating actual reduction to practice as well as the importance of maintaining evidence that may later be critical in supporting a finding of reasonably continuous diligence.

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