In re Wertheim is Back!
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The BPAI precedential decision *Ex parte Yamaguchi*, Appeal 2007-4412 (BPAI 8/29/2008) (Precedential); (effectively 'overruling' *In re Wertheim*, 646 F.2d 527 (CCPA 1981) appears itself to now have been overruled by the CAFC, in *Dynamic Drinkware, LLC v. National Graphics, Inc.*, (Fed. Cir. 9/4/2015). As former APJ Torczon stated in his concurrence in *Ex parte Yamaguchi*, "The majority understates, however, the significance of its statutory analysis. If it is correct, *In re Wertheim*, 646 F.2d 527 (CCPA 1981), is no longer tenable authority."

In Dynamic Drinkware, a question was whether the Raymond patent was prior art under 102(e) to patent that was the subject of an IPR trial. The Raymond patent claimed benefit to the Raymond provisional. The CAFC held that:

> Nowhere, however, does Dynamic demonstrate support in the Raymond provisional application for *the claims of the Raymond patent*. That was Dynamic's burden. A provisional application's effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional. Dynamic did not make that showing.

The CAFC expressly relied upon *Wertheim*, in reaching this conclusion.

While *Dynamic Drinkware* applies to petitioners' burdens in PTAB proceedings, it seems equally applicable to whether a reference is available under 102(e) in examination, and an examiner's burden of proof.

Keep in mind that these cases deal only with the pre-AIA issues of 102(e) prior art.