

## Intellectual Property Alert: When is a Published Patent Application Entitled to an Earlier Date as a Reference?

By Sarah A. Kagan

March 9, 2018 — A recent petition to the U.S. Court of Appeals for the Federal Circuit for rehearing *en banc* has raised questions as to what qualifies as prior art to an invention. The definition of prior art is one of the most fundamental building blocks of patent law.

The holding in *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015), surprised some patent practitioners by finding an *inter partes* review challenge insufficient for failing to prove that a reference patent was entitled to its priority date.<sup>1</sup> The challenger had shown that both the priority application and its issued patent disclosed the subject matter claimed in the challenged patent. However, fatally, the challenger failed to show that the priority application taught the subject matter claimed in the reference patent. The court held, “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.” *Id.* at 1382.

This qualification of a prior art patent reference based on support for its claims seems to be firmly grounded in a decades-old U.S. Court of Customs and Patent Appeals case, *In re Wertheim*, 646 F.2d 527, 537 (C.C.P.A. 1981). Nonetheless, the Wertheim doctrine seems to have been forgotten and rarely used. *Dynamic Drinkware* breathed new life into the *Wertheim* doctrine, as it provides a powerful defensive tool for patent proprietors to eliminate patentability-damaging prior art.<sup>2</sup>

This doctrine once again is front and center in the recent petition for rehearing. As background, Ariosa Diagnostics, Inc. and Illumina, Inc. were involved in an *inter partes* review when the Federal Circuit handed down its decision in *Dynamic Drinkware*. The Patent Trial and Appeal Board permitted the parties additional briefing to address the *Dynamic Drinkware* issue, but discovery was completed. The Patent Trial and Appeal Board concluded that Ariosa had not met its burden of persuasion that a reference published patent application was prior art to the challenged patent. Final Written Decision, January 7, 2016. When Ariosa appealed to the Federal Circuit, a three-judge

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<sup>1</sup> The U.S. Patent and Trademark Office must also have been surprised. Two years earlier, it published Examination Guidelines for Implementing the America Invents Act (AIA), in which it stated that the claims of a reference need not be supported in a priority application under the AIA or pre-AIA. “[T]here is no need to evaluate whether any claim of a U.S. patent, U.S. patent application publication, or WIPO published application is actually entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365 when applying such a document as prior art.” 78 Fed. Reg. 11078 (Feb. 14, 2013). The U.S. Patent and Trademark Office seemed to base its conclusion on an interpretation of *In re Giacomini*, 612 F.3d 1380 (Fed. Cir. 2010), that differed from the interpretation of the Federal Circuit panel in *Dynamic Drinkware*.

<sup>2</sup> *Dynamic Drinkware* involved a first-to-invent (pre-AIA) patent. Whether this doctrine will also apply to first-to-file patents is not yet known.

panel affirmed the Patent Trial and Appeal Board decision in one paragraph. December 11, 2017 (2016-2388, 2017-1020).

Ariosa petitioned for rehearing *en banc* on February 9, 2018. In its petition for rehearing *en banc*, Ariosa asserts that the panel decision conflicts with the Supreme Court precedent in *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926). The *Milburn* court, in an opinion delivered by Justice Holmes, found a first-filed but later-granted patent to be prior art. The 1952 patent statute codified the *Milburn* rule in 35 U.S.C. § 102(e). Ariosa asserts that the Court of Customs and Patent Appeals improperly narrowed the *Milburn* rule by requiring that a priority application of a reference must adequately describe and enable the invention claimed in the reference, not merely the subject matter of the challenged patent.

Ariosa also asserts that the Federal Circuit panel that affirmed its loss at the Patent Trial and Appeal Board should have expressly dealt with the effect of the statutory expansion of Section 102(e) to include published patent applications as prior art on the *Wertheim* rule. Ariosa warns of two adverse consequences of applying the *Wertheim* rule to published patent applications. First, support for the claims of a published application is a moving target, because the claims of an application can be amended over time. Thus, a reference may not be prior art today, but may be prior art tomorrow upon amendment of its claims. Second, trials will be unnecessarily complicated by including extraneous, collateral determinations of claims not otherwise at issue in a suit.

Two groups submitted amicus briefs in support of Ariosa on February 23, 2018. The first group consists of 19 intellectual property law professors.<sup>3</sup> The second group consists of two non-profit policy organizations, Electronic Frontier Foundation and R Street Institute. The group of 19 intellectual property law professors filed a brief that tracks very closely with the Ariosa brief. The Electronic Frontier Foundation and R Street Institute filed a brief that focuses on 35 U.S.C. § 119(e)(1). This brief asserts that “invention” does not necessarily mean “claimed invention,” particularly in 35 U.S.C. § 119(e)(1). Moreover, the brief argues, a provisional application should be treated as any other prior art publication, with all subject matter disclosed available as prior art. Failing to treat provisional application disclosures as prior art, the brief asserts, subverts the policy goal of granting a patent to a first inventor (pre-America Invents Act) and would withdraw from the public the right to use inventions already disclosed. Finally, the brief echoes Ariosa’s concern that “prior art” will become a moving target as claims of a reference published patent application are amended.

Illumina has not yet filed its response to the petition for rehearing *en banc*, but should do so by March 12, 2018. However, its brief to the panel on the merits provides a likely preview of its brief

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<sup>3</sup> Professor Ann Bartow, University of New Hampshire School of Law; Professor Jeremy W. Bock, University of Memphis Cecil C. Humphreys School of Law; Professor Andrew Chin, University of North Carolina School of Law; Professor Colleen V. Chien, Santa Clara University School of Law; Professor Ralph D. Clifford, University of Massachusetts School of Law; Professor Samuel F. Ernst, Golden Gate University School of Law; Professor Shubha Ghosh, Syracuse University College of Law; Professor Paul R. Gugliuzza, Boston University School of Law; Professor Yaniv Heled, Georgia State University College of Law; Professor Mark A. Lemley, Stanford Law School; Professor David Levine, Elon University School of Law; Professor Yvette Joy Liebesman, Saint Louis University School of Law; Professor Lee Ann Wheelis Lockridge, Louisiana State University Law Center; Professor Brian J. Love, Santa Clara University School of Law; Professor Michael S. Mireles, University of the Pacific, McGeorge School of Law; Professor Ira S. Nathenson, St. Thomas University School of Law; Professor David S. Olson, Boston College Law School; Professor Sharon K. Sandeen, Mitchell Hamline School of Law; and Professor Joshua D. Sarnoff, DePaul University College of Law.

opposing rehearing *en banc*. This prior Illumina brief supported the *Dynamic Drinkware* holding that 35 U.S.C. § 119(e)(1) requires that a reference's claims be supported in a priority document in order to be entitled to the priority date. The prior Illumina brief asserted that Ariosa was advocating without basis that the court construe 35 U.S.C. § 119(e)(1) in two different ways, depending on whether the reference is a published application or a patent.

Will the Federal Circuit find that Ariosa has raised a significant conflict in the case law, which the full court could remedy? If not, the extended analysis of a reference's claim support that is required by *Dynamic Drinkware* will become more common.

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