HAVE DING V. SINGER AND RYAN V. YOUNG RATIONALIZED 35 USC 135(b)(2)?[1]

By

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and

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Introduction

35 USC 135(b)(2) is probably the worst written section of Title 35. It reads as follows:

> (2) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

Now, quick: which application (the target application or the targeting application) does each appearance of the word "application" refer to? Does the "application [presumably meaning the targeting application] filed after the application [presumably meaning the target application] is published" have to be the actual application in which the claims are presented or can it be an earlier application to the benefit of the filing date of which those claims are entitled? Finally, given that original applications are now routinely publishing before they receive their initial examination, does it make any sense for potential defendants to have to go to the trouble and expense of monitoring published applications and, if possible, filing 37 CFR 41.202 suggestions of interference based on the published claims (which, as we all know, are exceedingly unlikely to be allowed as initially filed)?

What Ding v. Singer Said[4]

Ding v. Singer, Paper No. 56 in Int. No. 105,436 (PTOBPAI August 24, 2007)(non-

precedential)(opinion by APJ Lee for a panel that also consisted of APJs Medley and Moore) answered the second question in the introduction, and the answer that it gave was adopted by a different panel in Ryan v. Young, Paper No. 116 in Int. Nos. 105,504 and 105, 505 (PTOBPAI March 4, 2008)(Informative Opinion)(opinion by SAPJ McKelvey for a panel that also consisted of APJs Torczon and Lane).

According to Ding v. Singer, the answer to the second question is that 35 USC 135(b)(2) is not a bar if the "copied claim" (for this issue usually comes up in the context of an applicant that has copied claims from a patent in order to provoke an interference) is entitled to the benefit of the filing date of an earlier application filed before the "triggering date." It came to that conclusion by giving Singer the benefit of 35 USC 120 for its copied claims:

> The language of 35 U.S.C. §120 is clear in specifying an "effective" filing date which may be earlier than an application's actual filing date, if certain conditions are met. No exception of any kind is mentioned or provided, for any special scenario or circumstance. The later application "shall have the same effect…as though filed on the date of the earlier application." Ding's argument is rejected with regard to 35 U.S.C. §120.[5]

Ryan v. Young treats Ding v. Singer's holding as a done deal:

> Ryan maintains that the statutory language "in an application filed after" precludes applying the provisions of 35 U.S.C. §120 to that application [i.e., its target application] for the purpose of evaluating compliance with 35 U.S.C. §135(b) (2). We disagree. *See Ding v. Singer*, Interference 105,436, Paper 36, pages 8-13) (Bd. Pat. App. & Int. 2007)….[6]

What Ryan v. Young Said

Ryan v. Young deals with the third question in the introduction. It holds that 35 USC 135(b)(2) bars a target claim only if the reference claim "ultimately (1) issues as published or (2) issues with no material changes."[7]

We respectfully disagree. In our opinion, 35 USC 135(b)(2) does not impose that

condition subsequent. Indeed, 35 USC 135(b)(2) does not even require that the published application ever mature into a patent. Accordingly, we submit that a requirement that a claim in a 35 USC 135(b)(2) reference published application should issue substantially unchanged should no more be imposed judicially than a requirement that a 35 USC 102(e)(1) reference published application must issue should be imposed judicially. That is, each type of application becomes an indefeasible reference upon publication.[8]

While we have found no opinion that is precisely on point, we believe the following opinions to be instructive on this issue: Regents of the University of California v. University of Iowa Research Foundation, 455 F.3d 1371, 1374 n. 1, 79 USPQ2d 1687, 1689 n.1 (Fed. Cir. 2006) ("The difference between paragraphs (b)(1) and (b)(2) [of section 135] is that the former creates a one year bar relative to issued patents, while the latter creates a one year bar relative to published patent applications. Otherwise, the two paragraphs are the same."); OddsOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396, 1402, 43 USPQ2d 1641, 1645 (Fed. Cir. 1997) (the "secret prior art" of 35 USC 102(e) attains prior art status when the application matures into an issued patent); Lamb-Weston, Inc. v. McCain Foods, Ltd., 78 F.3d 540, 548 n. 4, 37 USPQ2d 1856, 1863 n. 4 (Fed. Cir. 1996) (Newman, J., dissenting) (if an application does not issue and is not referred to in an issued patent, it does not become prior art -- implying that, when an application does issue, it does become prior art regardless of what happens to it later); and Avocent Huntsville Corp. v. ClearCube Tech., Inc., 443 F.Supp.2d 1284, 1329-30 (N.D. Ala. 2006) (not published in the USPQ) (a 35 USC 102(e)(2) reference becomes prior art upon issuance--no mention of a condition subsequent). We also note that the Federal Circuit ruled that the term "issued patent" in 35 USC 135(b)(1) means "*any* issued patent."[9]

We think that what the panel in Ryan v. Young tried to do was to rewrite 35 USC 135(b)(2) to make sense. However, as the panel in Ding v. Singer said in response to Ding's

public policy arguments:

> It is not our role to legislate. We need not consider the various advantages and disadvantages articulated by the parties with regard to having 35 U.S.C. §120 apply or not apply in the context of 35 U.S.C. §135(b)(2). The statutory language of 35 U.S.C. §120 is clear and leaves no room for adding any scenario to which 35 U.S.C. §120 does not apply. Since 35 U.S.C. §135(b)(2) does not itself exclude the application of 35 U.S.C. §120, the latter does have application in the context of the former.[10]

Similarly, 35 USC 135(b)(2) as written does not itself require any correspondence between the claims of a published application and the claims of a patent that matures from that application or a continuation of that application. Indeed, as previously pointed out, 35 USC 135(b)(2) does not even require that <u>any</u> patent issue from the published application or any continuation of that application, let alone one that includes a claim that is not materially changed from a claim in the published application.[11]

<u>Conclusion</u>

We strongly agree with Judge McKelvey's apparent belief that 35 USC 135(b)(2) is a mess. However, we believe that it is a mess that Congress created and that Congress will have to clean up--preferably by repealing 35 USC 135(b)(2).[12]

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[5] Pages 11-12.

[6] Page 25.

[7] Page 43. In so holding, the panel adopted the position of counsel for Young set forth in Fitzpatrick & Abramic, Section 135(b)(2). Plain Meaning? Plainly Not., 15 Intellectual Property Today No. 2 (2008) at page 38.

[8] This position is diametrically opposite to the position advocated by the authors in Fitzpatrick & Abramic, op. cit. supra.

[9] Berman v. Housey, 291 F.3d 1324, 1355, 63 USPQ2d 1023, 1030 (Fed. Cir. 2002).

[10] Pages 12-13. While Fitzpatrick & Abramic, op. cit. supra, cited Ding v. Singer, they failed to deal with this passage in that opinion.

[11] Incidentally, it should be noted that, in Ryan v. Young, the panel held that extensive changes in verbiage did not materially alter the scope of Ryan's claims because they only "further clarified" the pre-bar date claims, the new language was "essentially…already present in…[a published claim] though in different wording," or the change was a "formal amendment to provide an antecedent." Pages 44-45.

[12] By the time this article is published, the Congress may have already passed a long-awaited patent reform bill that in all likelihood will repeal interference proceedings altogether and replace them with derivation proceedings and cancellation proceedings. 35 USC 135 as it would be rewritten by both the House and Senate versions of The Patent Reform Act of 2009 would not include equivalents of either 35 USC 135(b)(1) or (b)(2).