

VII. THE 35 USC 135(b) BARS

A. Can An Amendment Deleting a Limitation Run Afoul of 35 USC 135(b)?

Rilo v. Benedict¹

In *Regents of the University of California v. University of Iowa Research Foundation*, 455 F.3d 1371, 1374-75, 79 USPQ2d 1687, 1689 (Fed. Cir. 2006)(opinion by Circuit Judge Rader for a panel that also consisted of Circuit Judges Bryson and Linn), the Federal Circuit stated that 35 USC 135(b)(1) will not act as a bar to an interference where the party confronted with the potential bar establishes that a claim presented after the critical date "finds support" in a claim presented before the critical date. For the last five years, one of the great mysteries of interference practice has been what the court meant by the phrase "finds support" in this context. In particular, if a pre-critical date claim recited the combination of A, B, C, D, and E, would that claim "support" a post-critical date claim reciting the combination of A, B, C, and D?

As I wrote in Gholz, [A Critique of Recent Opinions in Patent Interferences](#), 89 JPTOS 1 (2007), § VIII.B, "The 35 USC 135(b) Bars", sub-section B, "Post-Bar Date Claims Must be 'Supported' by Pre-Bar Date Claims":

in an extremely strange use of the word "support," the court said that "a party confronted with a section 135(b)(1) bar [or, presumably, a 35 USC 135(b)(2) bar] [can overcome that bar by] show[ing] that claims filed after the critical date find support in claims filed before the critical date."¹⁸

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Regrettably, because UC "d[id] not contest the Board's finding of material differences between claim 205 [the post-bar date claim] and claims 202-204 [the pre-bar date claims],"²⁰ this opinion provides no further guidance as to how that crucial language

¹ Rilo was represented by Susan Mizer and John Garred of Tucker Ellis & West. My partner Todd Baker and I were of counsel for Rilo.

should now be interpreted. Thus, every time one amends a claim after the critical date in order to provoke an interference, one should anticipate a 35 USC 135(b) challenge.²

^{18.} 455 F.3d at 1374, 79 USPQ2d at 1689.

^{20.} 455 F.3d at 1373, 79 USPQ2d at 1689.

It did not take long for such a challenge to arise.³ However, the BPAI's opinion in *Rilo v. Benedict*, Interference No. 105,684, Paper No. 59 (non-precedential)(opinion by APJ Torczon for a panel that also consisted of APJs Lane and Tierney), did not do a great deal to resolve the mystery.

What the BPAI Said and Did in *Rilo v. Benedict*

In *Rilo v. Benedict*, Rilo's claims 62-79 were copied from Benedict's patent prior to the critical date, but they were rejected for lack of written description support under the first paragraph of 35 USC 112. In partial response, Rilo presented claim 80--after the critical date.⁴ Rilo's claim 80 was a broadened version of Rilo's claims 62-79, leaving out the recitations for

² 89 JPTOS at 14-15; footnote 21 omitted; interpolations of "the post-bar date claim" and "the pre-bar date claims" supplied.

³ While the BPAI's opinion discussed in this article is dated 24 February 2011, the interference was declared on 17 February 2009. Thus, the BPAI did not meet its goal of entering judgment in the interference within two years of its declaration--despite the fact that the panel hearing took place on 17 December 2009.

⁴ Rilo also amended claims 62-79. However, during the course of the interference, Rilo consented to the entry of judgment against those claims, even as amended, so the BPAI's opinion deals only with Rilo's claim 80.

which the examiner had asserted that Rilo had no support but not adding any limitation not present in the pre-critical date claims.

While the examiner did not reject Rilo's claim 80 under either the first paragraph of 35 USC 112 or 35 USC 135(b)(1), and while it was accordingly designated as corresponding to the count in the interference, Benedict filed a motion for a judgment that it was unpatentable under 35 USC 135(b)(1).

The BPAI denied Benedict's motion, reasoning as follows:

Under § 135(b)(1)[,] a post-critical date claim may nevertheless be maintained if it is not materially different from a timely claim, but an amendment creates a presumption of a material difference.⁵³ Rilo argues that the presumption is raised by added limitations, as was the case in the cited precedent, but not by deleted limitations. Benedict relies on a single-judge order in an unrelated interference for the proposition that written description problems are material.⁵⁴ The logic of the precedent does not permit a categorical statement about the relationship between materiality and typical rejections and amendments. A prior art rejection ordinarily results in narrowing amendments, while amendments to address formalities^[5] are not necessarily narrowing. At most, rejections for formalities are more likely to result in amendments more in the nature of a clarification rather than a change in scope. It is important to remember that amendment only creates a presumption, which must be evaluated in the context in which it arises.⁶

^{53.} *In re Berger*, 279 F.3d 975, 982-83 [61 USPQ2d 1523, 1527-28] (Fed. Cir. 2002); *Corbett v. Chisholm*, 568 F.2d 759, 765 [196 USPQ 337, 343] (CCPA 1977).

^{54.} *Barany v. McGall*, Intf. 105,351, Paper 59 (6 February 2009)(Exh. 1012).

⁵ Is the BPAI suggesting that a rejection under the written description requirement of the first paragraph of 35 USC 112 is "a mere formality"? It certainly feels like a substantive rejection when one is confronted with such a rejection!

⁶ Slip opinion at pages 14-15.

Nevertheless, despite having said that Rilo's "amendment" (actually, the addition of a new, post-critical date claim) created a presumption of materiality, the BPAI then decided the interference by holding that:

Benedict must give some reason why selection of all of the listed parameters [i.e., selection of the additional limitations present in the pre-critical date claims and absent in the post-critical date claim] would be [sic; would have been, at the time of the amendment?⁷] a material change. * * * We cannot presume that the claims are necessarily directed to different inventions. * * *

Benedict has failed to meet its burden for its motion 4.⁸

Comments

So, where does that leave us? Rilo had argued for a nice, clear rule that merely deleting limitations never raises a 35 USC 135 (b)(1) issue:

While Rilo agrees that adding a limitation in response to a prior art rejection suggests (although it does not prove) that the additional limitation is material, deleting an otherwise non-material limitation from a claim in response to a 35 U.S.C. 112, first paragraph, rejection does not automatically transform that limitation into a material limitation--or even strongly suggest that the deleted limitation is material.^[9] This is so because even a trivial limitation contained in a claim that is not supported by the specification must be cancelled from the claim, and a trivial limitation is, by definition, not a material limitation. The tests for 35 U.S.C. 112, first paragraph support and 35 U.S.C. 135(b)(1)

⁷ I am suggesting that the materiality of the amendment (which is a function of “the state of the art”) should be judged as of a specific time, presumably the time when the amendment was made.

⁸ Slip opinion at pages 17-18.

⁹ In glorious retrospect, I wish that we'd left out the word “strongly.” Our use of that word can be read to suggest that the deletion of a limitation in response to a 35 USC 112, first paragraph rejection suggests, albeit weakly, that the deleted limitation was material.

support are simply different¹⁰

However, the BPAI first said that Rilo's "amendment" "create[d] a presumption" that the amendment was material (which suggests that the burden was on Rilo to prove that the "amendment" was not material), then held that "Benedict must give some reason why... [the differences between the pre-critical date claims and the post-critical date claims] would be [sic; would have been?] a material change" and that, because it had not done so, "Benedict has failed to meet its burden for its motion 4." Thus, the holding of *Rilo v. Benedict* appears to be that the burden is on the party asserting the 35 USC 135(b) bar to prove that the difference(s) between the pre-critical date claim(s) and the post-critical date claim(s) was material.

And, in specific response to the question posed at the outset, the teaching of *Rilo v. Benedict* appears to be that sometimes a pre-critical date claim reciting the combination of A, B, C, D, and E supports a post-critical date claim reciting the combination of A, B, C, and D and that sometimes it does not.

¹⁰ Opposition 4 page 3.