

THOMPSON V. HAMILTON SHOULD BE OVERRULED!¹

By

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and

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INTRODUCTION

Pioneer Hi-Bred International, Inc. v. Monsanto Technology LLC, ___ F.3d ____, 101 USPQ2d 1849 (Fed. Cir. 2012)(opinion by Senior Circuit Judge Clevenger for a panel that also consisted of Circuit Judges Prost and Reyna)(hereinafter referred to as “Pioneer”), held that “multiple pre-critical date claims, considered together, can provide the foundation necessary for post-critical date claims to be held timely [under 35 USC 135(b)(1)].”⁴ In support of that holding,⁵ Judge Clevenger cited Thompson v. Hamilton, 152 F.2d 994, 68 USPQ 161 (CCPA 1946)(hereinafter referred to as “Thompson”), and Corbett v. Chisholm, 568 F.2d 759, 196 USPQ 337 (CCPA 1977)(Rich, J.)(hereinafter referred to as “Corbett”).

WHAT 35 USC 135(b)(1) SAYS AND HOW IT’S BEEN INTERPRETED

Present-day 35 USC 135(b)(1) (which is identical to 35 USC 135(b) as it read when Thompson and Corbett were decided) reads as follows:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted. [Emphasis supplied.]

As Judge Rich explained in his didactic opinion in Corbett, 35 USC 135(b) had its origins in an equitable policy created by the Supreme Court which was interpreted very loosely,

depending on the equities of the individual case as seen by the tribunal deciding that particular case. However, as Judge Rich also explained in Corbett:

The amendment of R.S. 4903 [in 1939] and successor enactments converted what had been an equitable doctrine, applicable at the court's discretion, into a statutory requirement, like the statutory time bar of § 102(b), the application of which is mandatory.⁶

Unfortunately, the 1939 amendment to R.S. 4903 notably did not clarify what in the heck Congress meant by “[a] claim...for...substantially the same subject matter as” another claim in this context, and both the CCPA⁷ and the Court of Appeals for the Federal Circuit have struggled to interpret that language sensibly. The only thing that has seemed clear in recent years is that it does not mean the same thing as “patentably [in]distinct” in 37 CFR 41.201's requirement that, “Where there is more than one count, each count must describe a patentably distinct invention.”

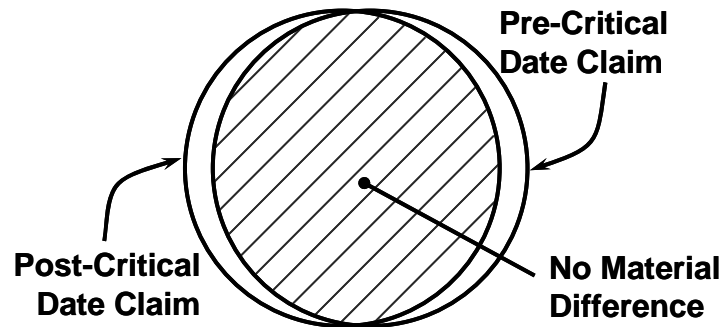
As the court said in In re Berger, 279 F.3d 975, 61 USPQ2d 1523 (Fed. Cir. 2002), discussed in Gholz, A Critique of Recent Opinions in Patent Interferences, 85 JPTOS 401 (2003) § VIII.A., “37 CFR 1.601(n) Does Not Set Forth the Test for Compliance with 35 USC 135(b)”⁸:

Berger's arguments directed to § 1.601(n) are unavailing. Whether claim 7 is obvious in view of original claims 1-6 is not germane to the question of whether claim 7 is entitled to the earlier effective date of claims 1-6 for purposes of the one-year bar of 35 U.S.C. § 135(b). To establish entitlement to the earlier effective date of existing claims for purposes of the one-year bar of 35 U.S.C. § 135(b), a party must show that the later filed claim does not differ from an earlier claim in an “material limitation.” *Corbett v. Chisholm*, 568 F.2d 759, 765-66, 196 USPQ 337, 343 (CCPA 1977). This is a distinctly different question from whether claims made for purposes of interference by different parties are directed to the same or substantially the same subject matter.⁹

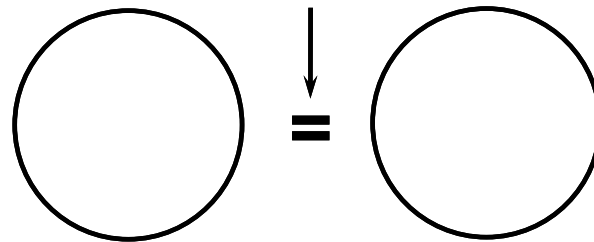
That is, for a post-critical date claim to be close enough to a pre-critical date claim to avoid a 35 USC 135(b)(1) bar (or, presumably, a 35 USC 135(b)(2) bar—although there are no opinions on

that subject), the post-critical date claim has to be much closer to the pre-critical date claim than would be required for the two claims to be said to interfere.¹⁰

The relationship that one can draw from In re Berger and similar opinions and its contrast with the relationship required for two claims to interfere can be illustrated in Venn diagram form as follows:



Two-Way Obviousness

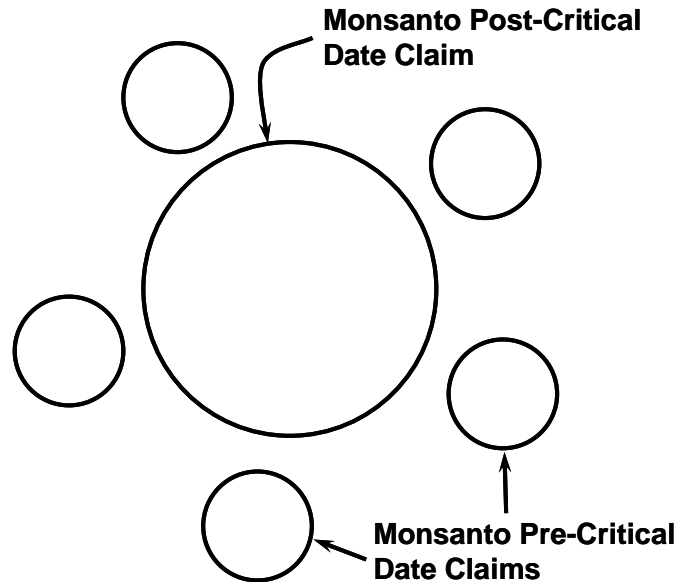


Two Interfering, but Non-Overlapping Claims

The point to be drawn from the first illustrations and the opinions on which they are based is that, while the two Venn diagrams need not be congruent to support a finding of “no material difference” (each Venn diagram can extend beyond the other), they have to be pretty darned close to being congruent. The point to be drawn from the second illustration and the opinions on which it is based is that the two Venn diagrams don’t have to overlap at all to support a finding of interference-in-fact.

WHAT THE COURT SAID AND DID IN PIONEER

The BPAI had found pre-critical date support for fragments of Monsanto’s post-critical date claim in seven different, largely non-overlapping claims¹¹ in Monsanto’s parent, pre-critical date application.¹² The relationship between Monsanto’s post-critical date claim in interference and its pre-critical date claims can be illustrated in Venn diagram form as follows¹³:



Judge Clevenger complained that “[t]he *Thompson* opinion does not expressly reproduce the [pre-critical date] claims that were at issue in that appeal, so it is not possible to reconstruct every detail of the CCPA’s claim interpretation.”¹⁴ (The Thompson opinion does expressly reproduce the post-critical date claims that were on appeal.¹⁵) However, based on his analysis of what the Thompson opinion did say, he concluded that Thompson “stands for the proposition that, for purposes of section 135(b)(1), the Board may in some cases find the required pre-critical date claiming by analyzing multiple claims together.”¹⁶

Having decided that “there is no general prohibition against analyzing multiple pre-critical date claims together,”¹⁷ Judge Clevenger then went on to explain, at least inferentially, what he had meant by saying that, “in some cases,” the board could “find the required pre-critical

date claiming by analyzing multiple claims together.”¹⁸ He held that, in the case before him, the board had been entitled to find support for Monsanto’s post-critical date claim in the pre-critical date claims on two bases. First, at least five of the seven claims on which the board focused were “directed to the same invention”¹⁹ in the sense that they all depended from the same independent claim and (surprise, surprise!) all added limitations to that claim. Second, nothing in each non-overlapping claim “indicates a choice away from the limitations of . . . [the other non-overlapping claims].”²⁰

WHAT THE COURT SAID AND DID IN THOMPSON

First we’d like to deal with Judge Clevenger’s complaint that “The *Thompson* opinion does not expressly reproduce the [pre-critical date] claims that were at issue in that appeal”²¹

We start by describing how we obtained Hamilton’s pre-critical date claims from the U.S. National Archives.

We searched on the term “patent interference” in the Archival Research Catalog (ARC),²² which readily identified the collection of “Interference Case Files, compiled 1838 – 1956,” located at the College Park, Maryland facility. Next, through an email address provided in the ARC search results, we requested copies of the particular case files by supplying the ARC identifier number (563063) from the ARC search results and the interference numbers (80,607 and 80,608) from the Thompson opinion.²³ The Archives promptly responded with a quote for copying both files in their entirety (382 pages combined).²⁴ However, we decided to visit the Archives in person to review and copy selected documents from the files.

Curiously, Hamilton’s pre-critical date claims were not included in the board’s opinion in either Thompson or Shelters.²⁵ However, Hamilton’s pre-critical date claims were recited in Hamilton’s brief submitted to the Board of Interference Examiners.²⁶ In turn, we have posted an

electronic scan of Hamilton's brief in addition to other documents copied from the two interference file wrappers on the Oblon, Spivak firm website--in order to assist anyone who undertakes to try to get Thompson v. Hamilton overruled.²⁷

In analyzing Hamilton's five pre-critical date claims, we noted that they are all independent claims.²⁸ Mapping²⁹ the elements of Hamilton's pre-critical date claims to those of the counts revealed that Hamilton's pre-critical date claim 5 recites all the limitations of Count 2 except for the limitation that "the overall width of said shoe...[is] less than the width of said side piece." However, this element missing from Hamilton's claim 5 is not recited in any of the other pre-critical date claims.³⁰ Thus, assuming that the missing element is not material, one could conclude that Hamilton's pre-critical date claim 5 is for the same or substantially the same subject matter as Hamilton's post-critical date claim corresponding to Count 2.

However, Hamilton's claim 5 could not be considered the same as, or for substantially the same subject matter as, the post-critical date claims corresponding to Count 1 because of material differences therebetween. Indeed, Count 1 does not include a limitation analogous to either a horizontal flange of a metallic channel member or a groove in the side rail receiving the horizontal flange. Further, the limitations of the horizontal flange and the groove in the side rail are presumptively material limitations because they were added to patentably define over references cited in rejection of claim 4,³¹ which was canceled after adding claim 5.³²

Moreover, none of Hamilton's claims 1-4, either considered individually or as a group, could be for the same, or substantially the same, subject matter as Count 1 because none of those claims recites "a drawer bottom member," which the panel of the board that decided Thompson identified as one of three "essential features in issue," including "(1) a drawer bottom member; (2) a side piece; and (3) a channel shaped runner shoe."³³ Indeed, Hamilton's claim 5 is the only

pre-critical date claim reciting “a drawer bottom piece.” Thus, in order to find support for Count 1 in Hamilton’s pre-critical date claims, the panel must have cherry picked individual limitations from claim 5 in some combination with one or more of claims 1-4, thereby erroneously ignoring the materiality of the horizontal flange and the groove in the side rail recited in claim 5 but not recited in Count 1.

Based on the foregoing analysis, we conclude that Judge Clevenger’s speculation that Hamilton’s five pre-critical date claims were non-dependent and non-overlapping claims was correct.

THE THOMPSON COURT’S ANALYSIS

However, the more important point for present purposes is to ascertain why the Thompson court held as it did. Regrettably, the Thompson court’s analysis is woefully cursory. First, it summarized Thompson’s argument as being “[t]hat Hamilton may not make count 1 [which was identical to one of Hamilton’s post-critical date claims] because he did not present, within one year after . . . [the critical date], in just one claim, a claim embracing all the features which rendered the count patentable”³⁴ and “[t]hat Hamilton may not make count 2 [which was also identical to one of Hamilton’s post-critical date claims] because he did not present, within one year after . . . [the critical date], in just one claim, a claim embracing all the features which rendered that count patentable.”³⁵ It then segued immediately to its conclusion:

It is obvious [to us!] that the construction for which appellant contends would create an anomalous situation in cases such as that under consideration.³⁶

Why would that construction have “create[d] an anomalous situation in cases such as that under consideration”?

Well, in the first place the court noted that counsel for Thompson had conceded “that there was disclosed in the Hamilton application every physical feature defined in the counts so arranged in combination as to meet the counts.”³⁷ Note, however, that that description of the disclosure in Hamilton’s specification says nothing whatsoever about what Hamilton was claiming prior to the critical date!³⁸

From there the court descended into incomprehensibility:

Furthermore, it is not seriously contended that in claims presented by Hamilton during the prosecution of his application and *more than one year before* the issuance of the Thompson patent subject matter substantially the same as the subject matter of the counts was not covered.³⁹

In the first place, what does the date one year before the issuance of the Thompson patent have to do with anything? Moreover, even if you assume that the introduction to that sentence should read: “Furthermore, it is not seriously contended that, in claims present by Hamilton during the prosecution of his application and before the date one year after the issuance of the Thompson patent . . . ,” what does the rest of that sentence mean?

It is true that the court then said that “The matter is, in our opinion, fully and fairly stated and properly decided by the board in the following which we quote from its decision . . . ”⁴⁰ and that the quoted portion of the board’s opinion makes a lot more sense than the court’s opinion:

The Hamilton application as filed contained three claims; during the prosecution of the application two additional claims, 4 and 5[,] were presented, all within a year from the issuance of the Hamilton [sic; Thompson?] patent. * * *

An examination of these five claims clearly shows that each feature of the counts had been covered by claim. * * * While it is true that the exact terminology of the counts in issue was not found in the Hamilton application prior to the year period, this is of no consequence as the rule [both the board and the court focused on a Patent Office rule—which was, however, word-for-word identical to the statute] does not require him to make the identical claims of the patent during this period; all that is required is that he shall be

urging claims covering the matter which is claimed in the patent before the critical period has terminated.

The objects of the invention of the two parties are the same and substantially the same results are obtained with substantially the same mechanism. The difference is more in the form of expression than in the inventive subject matter covered.⁴¹

However, the fact that what the court itself said makes no sense should, we submit, detract substantially from its precedential value.

WHAT THE COURT SAID AND DID IN CORBETT

The trouble with relying on Corbett as support for what the court did in Pioneer is that the court in Corbett actually held that the pre-critical date claims did not support the post-critical date claim! After considering each of the pre-critical date claims on which Corbett relied individually and ruling that none of them recited substantially the same subject matter as Corbett's post-critical date claim, Judge Rich wrote as follows:

There remains appellant's contention that he should be entitled to rely upon all of the claims discussed above, in various combinations, to support his allegation of compliance with § 135(b). Appellant's cited authority, *Thompson v. Hamilton . . .*, seems to support his contention that he need not have earlier presented a single claim embodying every material limitation of the copied claim. As once suggested by Judge Learned Hand, in a somewhat different context, one does not claim a different invention by "amendments which go no further than to make express what would have been regarded as an equivalent of the original or to incorporate into one claim what was to be gathered from the perusal of all, if read together." *Engineering Development Laboratories v. Radio Corporation of America*, 153 F.2d 523, 526, 68 U.S.P.Q. (BNA) 238, 242 (CA 2 1946)(quoted with approval by this court in *In re Tanke*, supra). This seems to have been the rationale of the *Thompson* case where the board and this court agreed that the five claims presented during the prosecution of the application there involved were, as a group, intended to secure a property right in subject matter substantially the same as that defined by the copied claims.

We believe, however, that there is a substantial difference between that which is to be gathered from the perusal of a group of related claims to the same invention and that which is to be gathered from the perusal of a group of claims to related inventions. The more divergent the subject matter of the individual claims, the less likely it is that coverage of the interstices therebetween is realized. Appellant correctly contends that claims copied from issued U.S. patents should not for purposes of this inquiry, be conclusively presumed to be directed to different inventions, but the fact remains that the particular claims copied from U.S. patents into the Corbett application, and the restricted apparatus claim in the parent application as well, are substantially divergent in scope and emphasis. In our opinion, a reading of all four groups of claims, together, does not manifest a unitary scheme or attempt to secure a property right in the subject matter defined by Chisholm's patent claim 1.⁴²

COMMENT

Judge Rich's language holding that Corbett was not "entitled to rely upon all of . . . [his pre-critical date claims] in various combinations, to support his allegation of compliance with § 135(b)" because those claims were "substantially divergent in scope and emphasis" and "d[id] not manifest a unitary scheme or attempt to secure a property right in the subject matter defined by Chisholm's patent claim" is marginally more satisfactory than the court's language in either Pioneer or Thompson. However, we respectfully submit that the real answer to the problem is to adopt the argument put forward by Thompson's counsel: to avoid a 35 USC 135(b)(1) bar (or a 35 USC 135(b)(2) bar), one should be able to point to a pre-critical date claim (that is, to one and only one pre-critical date claim) that defines subject matter that is not substantially different than the subject matter defined by the post-critical date claim in issue.⁴³ We suggest that is true, not only because the court's opinion in Thompson makes no sense, but also because interference practice has changed so much since 1946 that the procedures mentioned (if not discussed) in the Thompson opinion bear little or no resemblance to the procedures that govern patent interferences today. The court's opinion in Berger strongly suggests that, to avoid a 35 USC

135(b)(1) bar (or, presumably, a 35 USC 135(b)(2) bar), the two claims being compared should be pretty nearly congruent in scope.

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⁴ ___ F.3d at ___, 101 USPQ2d at 1852.

⁵ In his blog discussion of the opinion the next day, Prof. Crouch described the holding as “odd.” Dennis Crouch, *Deference to BPAI: Federal Circuit Affirms Ruling that Monsanto’s Late-Filed Claims Win Priority over Pioneer’s Issued Patent* (Feb. 29, 2012), www.patentlyo.com (last visited Mar. 10, 2012). We agree!

⁶ 568 F.2d at 765, 196 USPQ at 342-43.

⁷ In his opinion in Pioneer, Senior Circuit Judge Clevenger translated “CCPA” as –the Court of Claims and Patent Appeals--. ___F.3d at ___, 101 USPQ2d at 1851. However, as every patent attorney knows, the CCPA was the Court of Customs and Patent Appeals!

⁸ 37 CFR 1.601(n) is the predecessor of present-day 37 CFR 41.201.

⁹ 279 F.3d at 981-82, 61 USPQ2d at 1527. As pointed out in Mr. Gholz’s write-up of In re Berger, what the court said there is flatly contrary to what the CCPA said in Aelony v. Arni, 547 F.2d 566, 570, 192 USPQ 486, 490 (CCPA 1977)(holding that “the test of interference in fact is

not whether two sets of claims overlap, but whether they are patentably distinct from each other”).

¹⁰ To interfere, two claims do not even have to overlap—as best illustrated in the famous case of Moore v. McGrew, 170 USPQ 149 (PTOBPA 1971)(Modance, EIC).

¹¹ We believe that five of the seven claims on which the board had relied were non-overlapping.

¹² It is worth noting that all of the claims in question were found in a single pre-critical date application. That is, the board had not found support for some limitations in claims in the parent of the application that matured into Monsanto’s patent in interference and support for other limitations in a grandparent application. However, there is nothing in Judge Clevenger’s analysis which would preclude the board from finding pre-critical date support for a post-critical date claim in claims in different generations spawned from a progenitor application—or even in sibling applications.

¹³ No significance should be attached to the angular relationship of Monsanto’s pre-critical date claims to its post-critical date claim in the illustration.

¹⁴ ___ F.3d at ___, 101 USPQ2d at 1852. This aspect of Thompson is dealt with infra in our discussion of Thompson.

¹⁵ The Thompson opinion actually reproduces the counts, but it says that the counts were identical to Hamilton’s post-critical date claims.

¹⁶ ___ F.3d at ___, 101 USPQ2d at 1853 (emphasis supplied).

¹⁷ ___ F.3d at ___, 101 USPQ2d at 1853.

¹⁸ ___ F.3d at ___, 101 USPQ2d at 1853.

¹⁹ ___ F.3d at ___, 101 USPQ2d at 1853.

²⁰ ___ F.3d at ___, 101 USPQ2d at 1853 (quoting from the board’s opinion).

²¹ ___ F.3d at ___, 101 USPQ2d at 1852.

²² <http://www.archives.gov/research/arc> (last visited March 31, 2012).

²³ 152 F.2d at 995, 997, 68 USPQ at 162, 164.

²⁴ The authors acknowledge, with appreciation, the assistance of Mr. Gene Morris from the National Archives.

²⁵ Thompson v. Hamilton, Patent Interference No. 80,607 (Board of Interference Examiners, Jan. 28, 1944); Shelters v. Hamilton, Patent Interference No. 80,608 (Board of Interference Examiners, Jan. 28, 1944). Both board decisions are available at www.oblon.com/publications/Thompson-Documents.

²⁶ Brief for Party Hamilton at Final Hearing, Interference Nos. 80,607 & 80,608, 12-15 (Board of Interference Examiners, Jan. 1, 1944). This brief is available at www.oblon.com/publications/Thompson-Documents.

²⁷ www.oblon.com/publications/Thompson-Documents.

²⁸ See Hamilton Brief, 14-15.

²⁹ A claim chart mapping Hamilton’s pre-critical date claims against the counts is available at www.oblon.com/publications/Thompson-Documents.

³⁰ See id.

³¹ Hamilton Brief at 14 (stating “Hamilton’s claim 4, following a rejection . . . was canceled by amendment . . . and in lieu thereof there was inserted . . . Hamilton’s claim 5”).

³² See In re Berger, 279 F.3d at 982, 61 USPQ2d at 1527-28 (stating that “[i]nclusion of a limitation in a claim to avoid the prior art provides strong evidence of the materiality of the included limitation”).

³³ 152 F.2d at 996, 68 USPQ at 163-64 (quoting from the board’s opinion).

³⁴ 152 F.2d at 996, 68 USPQ at 163.

³⁵ 152 F.2d at 996, 68 USPQ at 163.

³⁶ 152 F.2d at 996, 68 USPQ at 163.

³⁷ 152 F.2d at 996, 68 USPQ at 163.

³⁸ See In re Berger, 279 F.3d at 983, 61 USPQ2d at 1528 (indicating that the inquiry regarding expression of a material limitation is not whether such a limitation is disclosed, but rather whether the limitation was claimed)(emphasis supplied).

³⁹ 152 F.2d at 996, 68 USPQ at 163 (emphasis in the original).

⁴⁰ 152 F.2d at 996, 68 USPQ at 163.

⁴¹ 152 F.2d at 996-97, 68 USPQ at 164.

⁴² 568 F.2d at 766-67, 196 USPQ at 343-44.

⁴³ That one and only one pre-critical date claim may, of course, be a dependent claim which incorporates by reference all of the limitations of every claim from which it depends.