35 U.S.C. §135(b)

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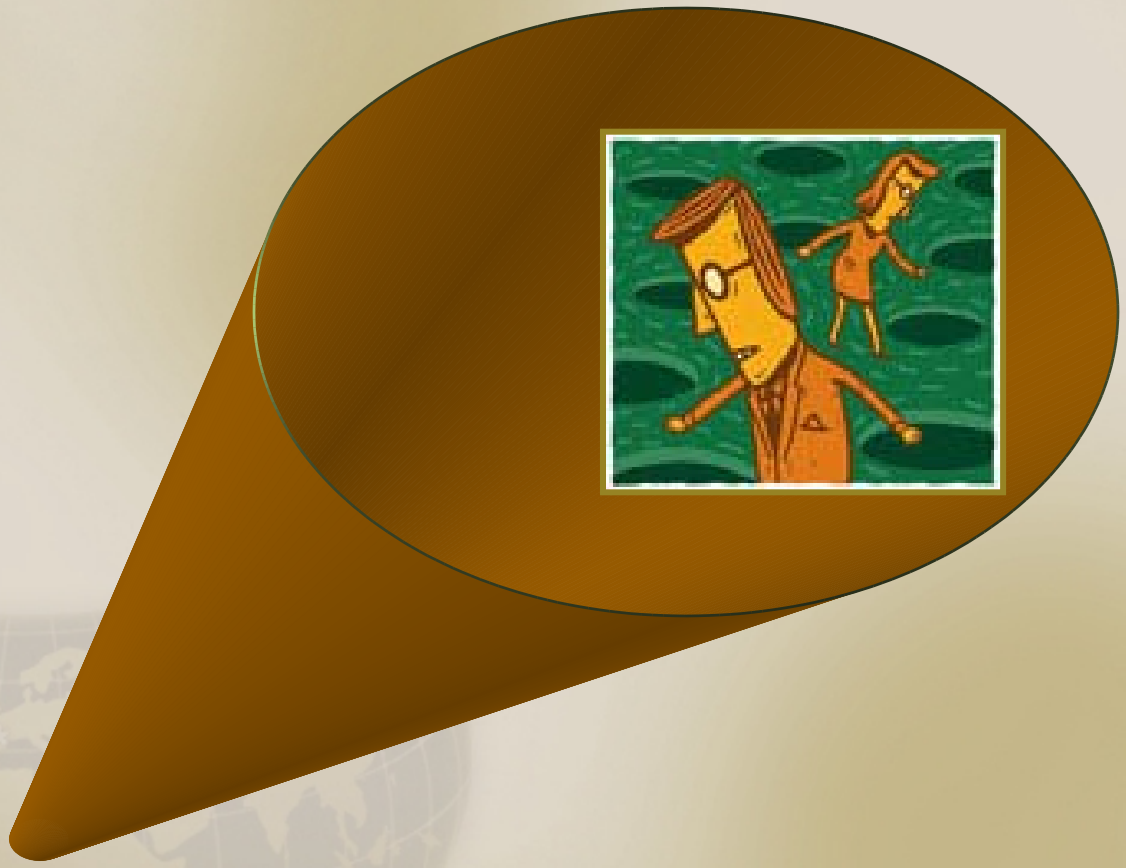
Surviving the Pitfalls



Common Questions Regarding Priority

Two most common questions of non-interference practitioners:

- What should be shown in a 37 C.F.R. §1.131 Declaration?
- What should be done to preserve an applicant's rights under 35 U.S.C. §135(b)?

35 U.S.C. §135(b) Recites:

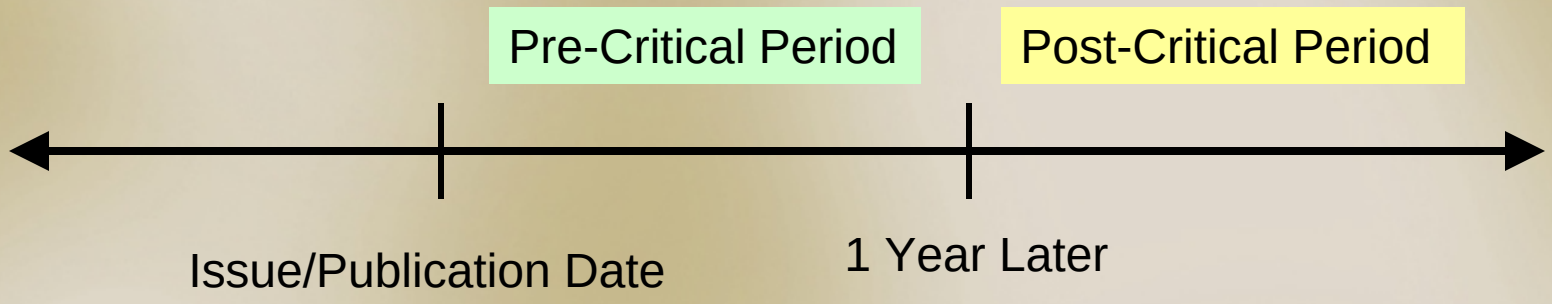
- (b)(1) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.
- (b)(2) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title [35 USCS §122(b)] 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.

- A claim is directed to substantially the same subject matter as a patent [published application] claim when the claim recites all of the "material limitations" of the patent [published application] claim. See *Corbett v. Chisolm*, 568 F. 2d. 759, 196 USPQ 337 (CCPA 1977) (Rich. J.).

Todd's Top 5 List

(Most Common Pitfalls of 35 U.S.C. §135(b) Practice)

- Failing to monitor issued patents (35 U.S.C. §135(b)(1))
- Failing to monitor published applications (35 U.S.C. §135(b)(2))
- Copying claims literally instead of presenting interfering claims for which one has support.
- Amending timely (pre-critical date) copied claims after the one year critical period
- Canceling a timely copied claim with the intent to later present the same claim if a decision is made to pursue an interference



Overview

I will discuss:

- How to identify material limitations ("M.L.") in order to determine whether a claim is directed to substantially the same subject matter as an issued/published claim. This is not an obviousness test!
- Whether 35 U.S.C. §135(b)(2) applies to an application having an effective filing date before the publication date of a target application.

Failure to Timely "Copy" Claims

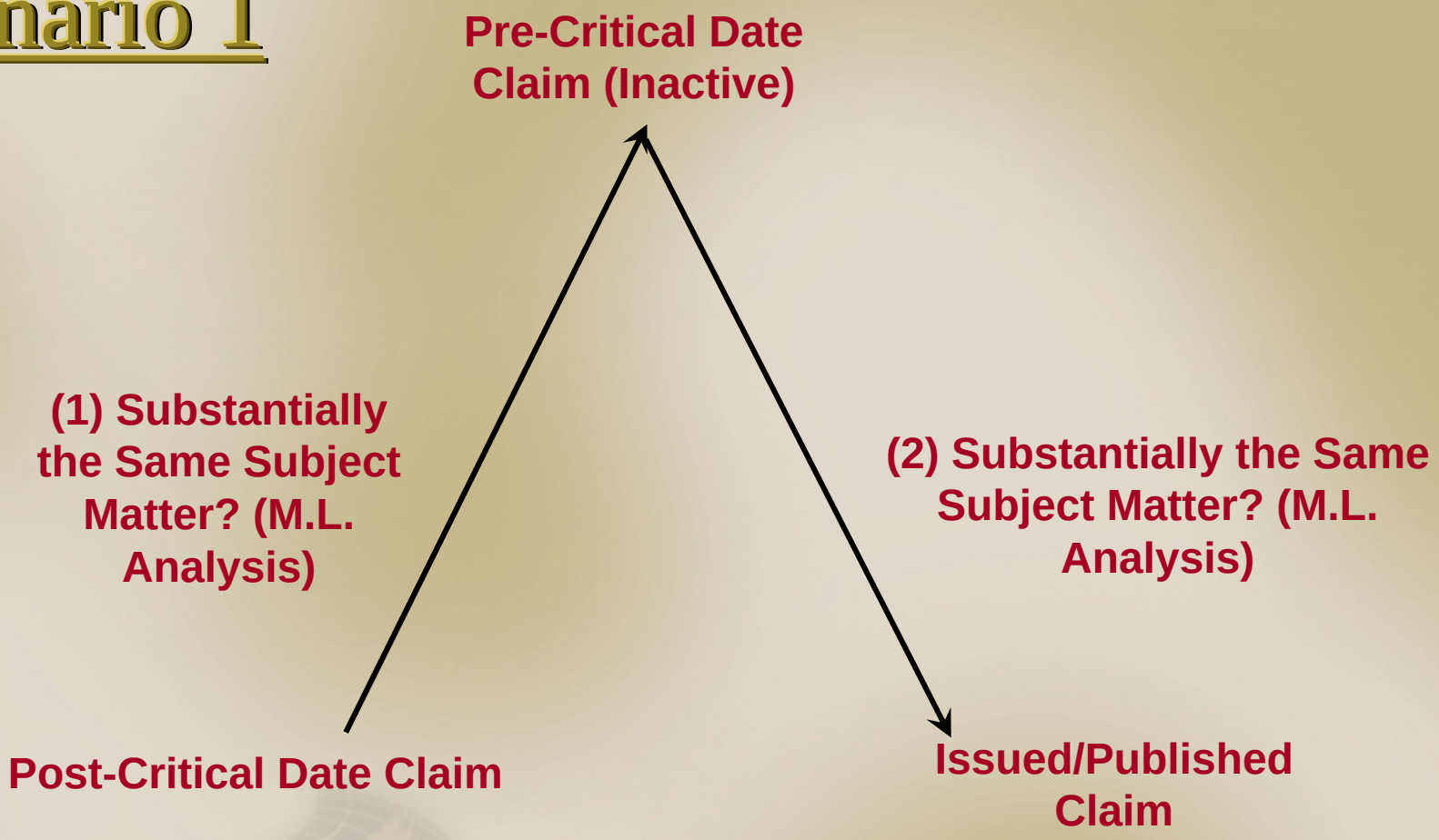
- Primary consequence is highly reduced likelihood of obtaining claim directed to the same or substantially the same subject matter as issued/published claim.
  - Applicant must establish entitlement to presentation date of at least one pre-critical date claim to satisfy 35 U.S.C. §135(b).
  - Showing requires determination whether each post-critical date claim recites material limitations of pre-critical date claim (if a relevant pre-critical date claim exists).

Establishing Entitlement to Presentation Date of Pre-Critical Date Claim

Two Most Common Scenarios:

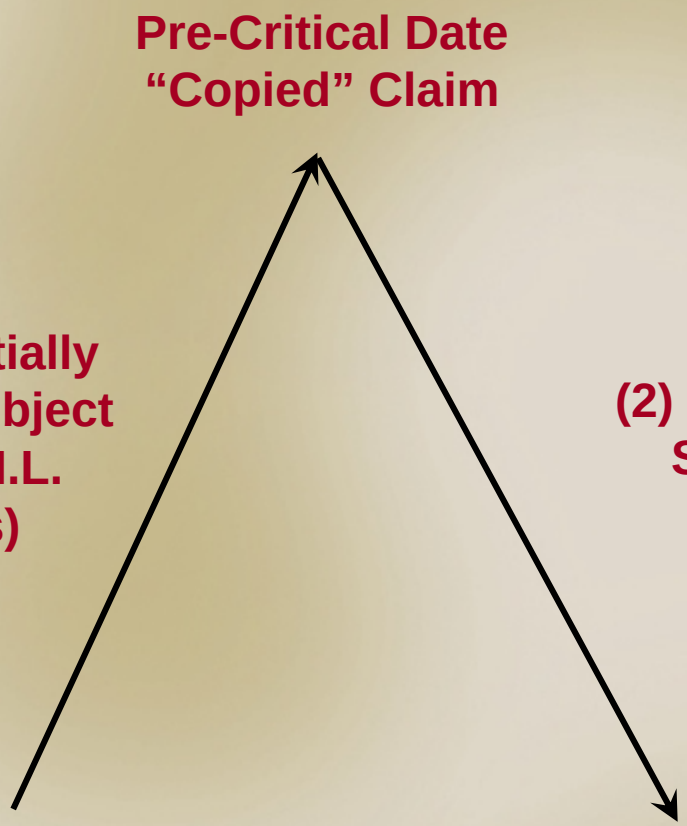
- Applicant is relying upon an inactive pre-critical date claim which was presented in the same application or a parent application as a post-critical date claim to satisfy 35 U.S.C. §135(b). See *Corbett*, 568 F.2d at 765, 196 USPQ at 342.
- Applicant is relying upon a claim which was originally presented before the critical date to satisfy 35 U.S.C. §135(b), but which was subsequently amended after the critical date. See *Regents of the University of California v. University of Iowa Research Foundation*, 455 F.3d 1371, 79 USPQ2d 1687 (Fed. Cir. 2006).

Scenario 1



Both questions (1) and (2) must be answered Yes to satisfy 35 U.S.C. §135(b).

Scenario 2



- **Question (1) must be answered Yes.**
- **If the pre-critical date claim is literally copied from the targeted application/patent, then (2) is satisfied because applicant timely copied the issue/published claim.**
- **If the pre-critical date claim is "based" on a claim from the targeted application/patent, then Question (2) must also be answered yes to satisfy 35 U.S.C. §135(b).**

Identifying Material Limitations

Judge Rich stated in *Corbett* that a material limitation is a limitation "necessary to patentability…." Those limitations include:

1. Limitations added by a patentee to avoid prior art.
2. Limitations relied upon to distinguish over prior art.
3. Limitations identified by an examiner's reasons for allowance.

Material Limitations

Once the material limitations have been identified for a claim, a second claim defines substantially the same subject matter under 35 U.S.C. §135(b) if the material limitation[s] of the first claim is [are] present "explicitly, implicitly, or inherently" in the second claim. *In re Berger*, 279 F.3d 975, 983, 61 USPQ2d 1523, 1528 (Fed. Cir. 2002).

35 U.S.C. §135(b)(2)

(b)(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 *[35 USCS §122(b)]* 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.

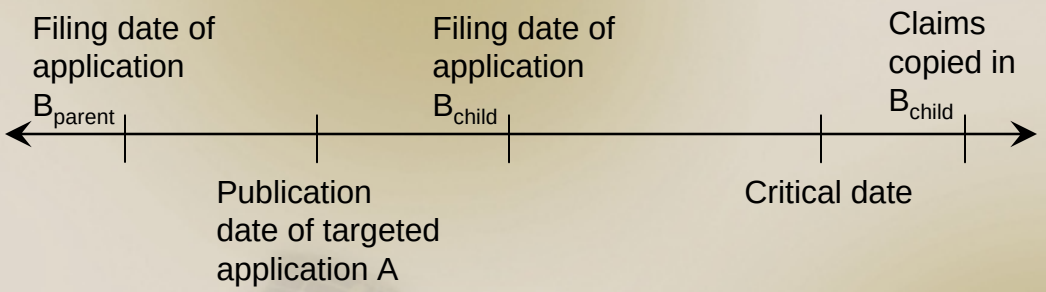
- Do all of the appearances of the word "application" refer to the same document?
- Which applications are subject to 35 U.S.C. §135(b)(2)?

35 U.S.C. §135(b)(2)

- Does the term "filed" mean the 35 U.S.C. §111(a)(4) filing date of the application or the "effective" filing date of the application?
- The legislative history of the American Inventors Protection Act of 1999 provides no pertinent informative discussion on §135(b)(2).

35 U.S.C. §135(b)(2)

Interpreting the term "filed" to mean the 35 U.S.C. §111(a)(4) filing date leads to incongruous and irreconcilable results.



If both B_{parent} and B_{child} are pending after the critical date, why should B_{child} be subject to §135(b)(2) but not B_{parent}?

35 U.S.C §135(b)(2)

- Both 35 U.S.C. §135(b) and 35 U.S.C. §102(b) are akin to a statute of limitations. See *Corbett*, 568 F.2d 764, 196 USPQ2d 342.
- Under 35 U.S.C. §102(b) , an applicant receives benefit of his effective filing date under §119(e)(1) and §120 when determining whether prior art is time-wise available.

35 U.S.C. §135(b)(2)

- If "filed" means "effective" filing date then there are two categories of applicants:
  1. New applicants who have had the opportunity to glean from the published application the value of the publicly described invention; and
  2. Applicants with an earlier established filing date prior to the publication date of the targeted application.

35 U.S.C. §135(b)(2) Proposed Interpretation

- Category (1) applicants are subject to 35 U.S.C. §135(b)(2)
- Category (2) applicants are not subject to 35 U.S.C. §135(b)(2)
- Such a two tiered approach is consistent with 37 C.F.R. §41.202(d) and 37 C.F.R. §41.207.

37 C.F.R. §41.207 states:

> Priority may be proved by a preponderance of the evidence except a party must prove priority by clear and convincing evidence if the date of its earliest constructive reduction to practice [roughly translated to "effective filing date"] is after the issue date of an involved patent or the publication date under 35 U.S.C. §122(b) of an involved application or patent.

37 C.F.R. §41.202(d) states:

When an applicant has an earliest constructive reduction to practice that is later than the apparent earliest constructive reduction to practice for a patent or published application claiming interfering subject matter, the applicant must show why it would prevail on priority.

35 U.S.C. §135(b)(2)

- Additional benefit of effective filing date interpretation is reduced "copying" of claims that have not been examined.

35 U.S.C. §135(b)(2)

- The statutory interpretation of 35 U.S.C. §135(b)(2) is currently being litigated in interference No. 105,436, *Ding v. Singer*.
- *Ding* argued (paraphrased) that "filed" means the actual filing date of the application otherwise Congress would have explicitly stated "effective" filing date in §135(b)(2). See e.g., 35 U.S.C. §154(a)(2).

Claim "copying"

- Literally copying targeted claims often leads to trouble.
  - Invites 35 U.S.C. §112 arguments during prosecution and in the interference
  - Amending claims after the critical date in response to a 35 U.S.C. §112 attack can also lead to scenario (2) discussed earlier.

Claim "copying"

- Present two sets of claims, a literally copied set and a set based on terminology of applicant's specification.
- Always inform the examiner where the claims are "copied" from. (Rule 56 obligation!)

Amending a Timely Copied Claim

- In view of the *University of California* decision, amend timely copied claims only as a last resort. See Scenario (2).
- Appealing a rejection based on patentability grounds will in many cases be a better alternative than amending claims and confronting 35 U.S.C. §135(b).

Canceling a Timely Copied Claim (Good tactic or not?)

- There has been a prevailing belief that an applicant could preserve rights under 35 U.S.C. §135(b) by timely presenting copied claims and then canceling the claims while deciding whether to pursue an interference.

Canceling a Timely Copied Claim (Good tactic or not)

§135(b)(1)

- Even if the applicant can make a sufficient showing under scenario (1), this is a risky strategy in view of the equities.

§135(b)(2)

- Because the majority of claims in published applications have not been examined at the time of publication, this seems to be a safer tactic.

THANK YOU

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