

**WHEN, IF EVER, DO BROADENING AMENDMENTS CREATE PROBLEMS  
UNDER 35 USC 135(b)<sup>1</sup>**

**By**

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**and**

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**Introduction**

35 USC 135(b)(1) states (with emphasis supplied) that “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.” Similarly, 35 USC 135 (b)(2) states (also with emphasis supplied) that “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.”

Mr. Gholz has previously expressed the view that “35 USC 135(b)(2) is probably the worst written section of Title 35.” Gholz and Wilcox, *Have Ding v. Singer and Ryan v. Young Rationalized 35 USC 135(b)(2)?*, 16 Intellectual Property Today No. 7 page 10 (2009) at page 10. Now we have a new issue--but this time with both 35 USC 135(b)(1) and 35 USC 135(b)(2). While most of the opinions that we cite deal with 35 USC 135(b)(1), we believe that the teachings that we draw from those opinions apply to both 35 USC 135(b)(1) and (b)(2).

## **Narrowing Rejections in Response to a Rejection Are Trouble**

The Federal Circuit has interpreted the requirement that a post-critical date claim be for at least “substantially the same subject matter as” a pre-critical date claim as meaning that the post-critical date claim be “not materially different than” a pre-critical date claim. Regents of the University of California v. University of Iowa Research Foundation, 455 F.3d 1371, 1374, 79 USPQ2d 1687, 1689 (Fed. Cir. 2006)(“[F]or 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 any ‘material limitation.’” (Emphasis in original)). The Regents opinion relied upon Corbett v. Chisholm, 568 F.2d 759, 766, 196 USPQ 337, 343 (CCPA 1977) (Rich. J.), which in turn specifically held: “There being a material limitation of the copied claim not present in Corbett's claims ..., they cannot be said to be directed to substantially the same invention.”<sup>4, 5</sup> Under that standard, “material limitations” include limitations that are (1) added by a patentee or applicant to avoid prior art; (2) relied upon to distinguish over prior art; or (3) identified as outcome-determinative in an examiner’s reasons for allowance.<sup>6, 7</sup>

It is important to recognize that the actions and conditions that influence whether a limitation is material may occur or may have occurred both to claims of the targeted applicant or patentee and to claims of the targeting applicant. See Parks v. Fine, 773 F.2d 1577, 1579-80, 227 USPQ 432, 434 (Fed. Cir. 1985). In Parks, the limitation in question was deemed “material” partly because Parks inserted the limitation in response to a prior art rejection during the prosecution of Parks’s patent; but “materiality” was also found due to actions by the applicant Fine, such as moving to amend the counts in interference to remove the limitation in question and Fine’s admission at oral argument that use of

Parks's patented process without the limitation in question would avoid infringement of Parks's patent.

After the material limitations in the post-critical date claim in question have been identified, the pre-critical date claim defines substantially the same subject matter under 35 USC 135(b) if the material limitations of the post-critical date claim are present "explicitly, implicitly, or inherently" in the pre-critical date claim. In re Berger, 279 F.3d 975, 983, 61 USPQ2d 1523, 1528 (Fed. Cir. 2002). Moreover, the Federal Circuit has indicated that, if a pre-critical date claim is rejected on non-35 USC 135(b) grounds and that claim is narrowed after the critical date to overcome that rejection, that claim is at least presumptively unpatentable under 35 USC 135(b)(1) and, if inadvertently issued, is at least presumptively invalid under 35 USC 135(b)(1). See In re Berger, 279 F.3d 975, 982-83, 61 USPQ2d 1523, 1527-28 (Fed. Cir. 2002) ("Inclusion of a limitation in a claim to avoid the prior art provides strong evidence of the materiality of the included limitation"), and Parks v. Fine, 773 F.2d 1577, 1579, 227 USPQ 432, 434 (Fed. Cir. 1985) ("The insertion of this limitation to overcome the examiner's rejection is strong, if not conclusive, evidence of materiality."). The theory is that the fact that the applicant had to narrow the claim to get it allowed is evidence of the materiality of the added limitation(s). That is, if the pre-critical date claim was not allowable (at least in the examiner's eyes), and if the post-critical date claim was allowable (at least in the examiner's eyes), the amendment must have been material (at least in the examiner's eyes). Although the Federal Circuit in Berger only said that a narrowing amendment is "strong evidence of the materiality of the included limitation," it is difficult to imagine a case in which the court would not hold (as it did in Berger and Parks) that such an

amendment was a material amendment, precluding the relation back of the amended claim to the pre-critical date claim.

**But Are Broadening Amendments in Response to a Written Description Rejection Under the First Paragraph of 35 USC 112 Always Material?**

Although at present we have no case law support for the following assertion, it seems to us that deleting an otherwise non-material limitation from a claim in response to a first paragraph of 35 USC 112 written description rejection should not automatically (or even presumptively) transform that limitation into a material limitation.<sup>8</sup> We believe that 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. See, e.g., Ex parte Kropp, 143 USPQ 148, 149 (PTOBPAI 1959) (“There is no exception to the requirement of section 112 except in the case of plant patents (35 U.S.C. 162)[,] and the presence of this specified exemption in the statute would indicate that there are no other exemptions.”) However, a trivial limitation is, by definition, not a material limitation. See, e.g., In re Phillips, 673 F.2d 1273, 1275, 213 USPQ 353, 355 (CCPA 1982)(Rich, J.)(contrasting “immaterial limitations” that could be deleted from copied claims with “material limitations” that could not be deleted from copied claims, under old rule 37 CFR 1.205(a)).<sup>9</sup>

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), the Federal Circuit stated that 35 USC 135(b)(1) does not act as a bar where the party confronted with the alleged bar established that a claim presented after the critical date “finds support” in a claim filed before the critical date. However, the tests for 35 USC 112, first paragraph support and 35 USC 135(b) support are very different. As demonstrated above, the test for 35 USC 112, first paragraph support is very stringent.

However, in Ryan v. Young, Paper 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), a panel of the BPAI held that extensive changes in verbiage did not materially alter the scope of Ryan’s claims because they only “further clarified” the pre-critical 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.”<sup>10</sup> Thus the test for 35 USC 135(b) support seems to be much looser.<sup>11</sup>

## **Conclusion**

Symmetry is wonderful, in the law as elsewhere. However, for policy reasons the law is not always symmetrical. In our judgment, this is such a situation. Narrowing amendments in response to a rejection can at least usually (if not always) give rise to 35 USC 135(b)(1) and (b)(2) bars. However broadening amendments in response to written description or other rejections need to be evaluated on a case-by-case basis.

We tentatively and respectfully offer a suggestion for a test to distinguish when a broadening amendment is broad enough to create a 35 USC 135(b) bar and when it isn’t. If a pre-critical date claim would have passed the two-way obviousness test of Eli Lilly & Co. v. Board of Regents of the University of Washington, 334 F.3d 1264, 67 USPQ2d 1161 (Fed. Cir. 2003), but the broadening amendment makes the claim so broad that it fails that test, then indeed the broadened claim is materially different than the pre-critical date claim. However, if the broadened claim still meets the two-way obviousness test, then it should not have a 35 USC 135(b)(1) or (b)(2) problem.

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<sup>4</sup> In addition to the “materiality” standard, a less common standard was resurrected in Coolidge v. Efendic, Paper 91, pp. 30-31, May 16, 2008 in Int. No. 105,457 (PTOBPAI, May 16, 2008)(non-precedential) (opinion by APJ Tierney for a panel that also consisted of APJs Torczon and Lane), citing Stalego v. Heymes, 263 F.2d 334, 339, 120 USPQ 473, 478 (CCPA 1959), for the proposition that, “in determining whether claims are directed to substantially the same subject matter within the meaning of 35 U.S.C. 135.... it is necessary to distinguish between those limitations which relate to the essence of the claimed subject matter and those which do not.” However, that opinion made no effort to explain what the phrase “the essence of the claimed subject matter” means.

<sup>5</sup> The Corbett court went one step further and added that a material limitation is one that is “necessary to patentability.” 568 F2d. at 765, 196 USPQ at 343.

<sup>6</sup> These three recited examples of material limitations are discernable generally from the case law cited throughout this article. See also, a presentation by our colleague Todd Baker, “Surviving the Pitfalls of 35 U.S.C. §135(b), dated December 2006, at slide 13, available at: <http://www.oblon.com/media/index.php?id=356>

<sup>7</sup> The three variables above lend themselves to very case-specific considerations. For example, in Strelchenko v. University of Massachusetts, Paper No. 88, pp. 16-18, in

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Int. No. 104,808 (PTOBPAI, March 18, 2003)(non-precedential) (opinion by APJ Schafer for a panel that also consisted of APJs Torczon and Nagumo), the materiality of a limitation was determined, in part, by the degree to which that limitation was in the prior art and even by the placement of the limitation in the claim (in this instance, its placement in the “improvement” portion of a Jepson claim, following the preamble portion of the claim summarizing the prior art).

<sup>8</sup> We have a case pending which presents this issue. However, we do not anticipate receiving a decision before this article goes to press.

<sup>9</sup> Old rule 37 CFR 1.205(a) included the following: “[A]n interference may be declared after copying the claims excluding an immaterial limitation or variation if such immaterial limitation or variation is not clearly supported in the application or if the applicant otherwise makes a satisfactory showing in justification thereof.” 37 CFR 1.205 (July 1, 1976).

<sup>10</sup> Paper No. 116 pages 44-45.

<sup>11</sup> Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1578, 227 USPQ 177, 182 (Fed. Cir. 1985)(Miller, J., dissenting-in-part, concurring-in-part)(“Section 112 does not refer to a mere ‘support’ standard”); In re Smith, 458 F.2d 1389, 1394, 173 USPQ 679, 683 (CCPA 1972) (“[R]ecent cases suggests [sic] a more stringent requirement for a description of the claimed invention than may have been previously applied in cases wherein the issue was framed in terms of 'support' for claimed subject matter.”); See also, Rieser v. Williams, 255 F.2d 419, 422, 118 USPQ 96, 99 (CCPA 1958) (“The rule that every limitation of an interference count must be considered material, which rule is applied in determining the right to make the count and priority of invention, is not

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controlling on the question of estoppel under 35 USC 135. In the latter situation, the question as to the materiality of limitations is to be considered on its merits, and limitations found to be immaterial may be disregarded....The determination as to whether the counts are supported by the disclosure of the Williams application involves a consideration of the same limitations that have been discussed above, but from a different viewpoint. Here each limitation must be regarded as material, and they are to be compared with the disclosure of the application rather than with what was claimed in it before the counts were copied from the Rieser patent.”)