

No. 18-109

IN THE
Supreme Court of the United States

ARIOSA DIAGNOSTICS, INC.,
Petitioner,

v.

ILLUMINA, INC.,
Respondent.

**On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit**

SUPPLEMENTAL BRIEF FOR RESPONDENT

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This case concerns a narrow issue about a *superseded* version of the Patent Act—not current law. As Illumina explained, review is unwarranted for that reason alone. Br. in Opp. 11-14. The government agrees that the petition should be denied because it concerns the now-obsolete “pre-2011 version of the Patent Act,” U.S. Br. 8, and does not “aris[e] under current law,” *id.* at 20. The government also underscores the “contrast” between the “pre-AIA provision (Section 102(e)(1)) that governs this case” and critical new provisions under current law that were added by the AIA in 2011. *Id.* at 19-20. Indeed, the AIA added an entirely new provision—§ 102(d)—that specifically regulates when a published patent application can backdate to a provisional application. That new pro-

vision would govern this case if current law governed here; but this case is governed by superseded provisions. The government thus properly recommends against reviewing the “pre-AIA” issue presented because it has “diminish[ing]” significance “going forward.” *Ibid.*

Beyond that, the government alerts the Court that this case may not present a proper question *even under pre-AIA* law. The government explains that, in its view, petitioner failed to present the relevant pre-AIA question in its petition or to the Federal Circuit below. The Federal Circuit, the government further urges, has not yet addressed that pre-AIA question. Petitioner’s failures to press the relevant question in this Court, and to preserve it below, weigh dispositively against review. U.S. Br. 18-19. Indeed, the record makes it clear that petitioner has waived the only relevant legal question, on the narrow issue of a patent application’s backdating to a provisional application, under the government’s stated view.

I. THIS COURT SHOULD NOT GRANT REVIEW TO ADDRESS SUPERSEDED PROVISIONS THAT SIGNIFICANTLY DIFFER FROM CURRENT LAW

The AIA dramatically changed the applicable statutory regime in 2011. Illumina identified major differences between pre-AIA § 102—which governs the question of what counts as “prior art”—and current law. Br. in Opp. 11-14. The government agrees that the petition addresses old law and not current law. See U.S. Br. i (question presented asks about priority-date rules for prior art “under *former* Section 102(e)” (emphasis added)); *id.* at 8 (“The question presented by the certiorari petition is whether, under the pre-2011 version of the Patent Act * * * ”); *id.* at 10 (“[T]his case involves the pre-2011 versions of the relevant Patent Act provisions.”). As the government observes, because “the importance of pre-

AIA law” “will diminish going forward,” it would “be preferable for the Court to address” any issues about the relationship between prior-art priority dates and earlier provisional applications “in a case arising under current law, by which all future disputes will be governed.” *Id.* at 19-20.

More importantly, the government underscores the significant—and potentially dispositive—differences between the superseded provisions that govern this case and current patent law. For example, as the government recognizes, the AIA significantly changed §102’s treatment of prior-art reference dating, adding language that may specifically address when a patent application can be considered “prior art” based on an earlier-filed provisional application. U.S. Br. 19. *Pre-AIA* patent law had no statutory provision specifically directed to backdating prior-art references. *Pre-AIA* §102, for example, did not provide an express mechanism for deeming an application to be prior art as of some other, earlier date; it simply provided that a patent application is prior art if it was “filed * * * before” the challenged patent. *Pre-AIA* 35 U.S.C. §102(e)(1). Parties therefore turned to §119, a priority-date provision not specifically directed to whether an application can be given an earlier date so as to render it “prior art.”

By contrast, *post-AIA* §102 provides language about “determining” appropriate filing dates when deciding “whether a patent or application for patent is prior art.” *AIA* 35 U.S.C. §102(d). First, §102(a)(2) states that a patent application can be prior art as of the date it was “*effectively* filed.” Section 102(d), in turn, explains how to determine when a patent application was “effectively filed.” If an application asserted as a prior-art reference “*is entitled to claim a right of priority*” to another, earli-

er application “under section 119,” the reference may be considered “effectively filed, with respect to any subject matter described” in the earlier application, “as of the filing date of the earliest such application that describes the subject matter.” AIA 35 U.S.C. §102(d) (emphasis added); see Br. in Opp. 11-14. The government thus explains that the language of new §102(a), together with new §102(d)(2), may govern when an application asserted as “prior art sometimes may be treated as filed on a date other than its actual filing date.” U.S. Br. 19. As discussed above, pre-AIA §102, which governs this case, has no corresponding language.

Moreover, current law now would provide a different statutory formula for determining priority- or filing-date issues, depending on the context. See U.S. Br. 19. For example, when determining the priority date for the invention being claimed in a patent, the patent application can be given the earlier priority date of a provisional application if it is “*entitled * * * to a right of priority under section 119.*” AIA 35 U.S.C. §100(i)(1)(B) (emphasis added). By contrast, to the extent permitted by new §§102(a)(2) & (d)(2), a different formula governs the effective filing date for applications *asserted as prior art* under §102 to invalidate a claimed invention. Insofar as new §§102(a)(2) & (d)(2) allow §119 to be used for “prior art” purposes—to give an application the filing date of an earlier provisional application so as to render it a potentially invalidating “prior-art” reference—the later-filed non-provisional application need only be “*entitled to claim a right of priority*” to the earlier provisional application “under section 119.” AIA 35 U.S.C. §102(d)(2) (emphasis added); see Br. in Opp. 12-14 (highlighting additional differences between pre-AIA and post-AIA provisions).

That distinction—between the inquiry into whether an application is “*entitled to a right of priority*” under § 119 itself, and the post-AIA language of “*entitled to claim a right of priority*” from new §§ 102(a)(2) & (d)(2)—is potentially significant. Br. in Opp. 13. The AIA’s legislative history,¹ and official guidance from the U.S. Patent and Trademark Office (“PTO”),² make that clear. But this case concerns only the former, pre-AIA statute. This Court ought not grant review in a case governed by superseded statutory provisions that differ significantly from current law—in the view of the government, the PTO, and respondent alike.

¹ Senator Kyl described the distinction as bifurcating the “ministerial requirements” of § 119, from § 119’s “core” substantive requirement “that the [provisional] application include an enabling disclosure.” 157 Cong. Rec. 3423 (2011) (statement of Sen. Kyl). According to Senator Kyl, an “application that meets the ministerial requirements of codependency and specific reference is *entitled to claim* the benefit or priority” for purposes of becoming prior art. *Ibid.* (emphasis added). But the provisional application must meet § 119’s substantive requirements, including an enabling disclosure, for a later non-provisional to be “*actually entitled* to the benefit or priority itself” apart from being asserted as prior art. *Ibid.* (emphasis added).

² PTO guidance indicates that post-AIA § 102 prior-art reference effective filing-date determinations differ from pre-AIA law. Compare Manual of Patent Examining Procedure (“MPEP”) 2136.03 (9th ed. Rev. 8, Jan. 2018) (pre-AIA) with MPEP 2154.01(b) (post-AIA); see Robert W. Bahr, *Memorandum re: Critical reference date under pre-AIA 35 U.S.C. §102(e)* (Apr. 5, 2018), available at http://www.uspto.gov/sites/default/files/documents/dynamic_memo_05apr2018_0.pdf (explaining that procedures for pre-AIA patents do not apply to AIA patents). For example, the MPEP states that, for prior-art determinations under AIA § 102, “there is no need to evaluate whether any claim of [the application] is *actually entitled to priority* or benefit under 35 U.S.C. 119”; only the “ministerial requirements” of § 119 need be met. MPEP 2154.01(b) (emphasis added).

II. SERIOUS PRESERVATION ISSUES WEIGH AGAINST FURTHER REVIEW

The government does not merely urge that the petition concerns superseded law. In its view, the petition also fails to present a meaningful legal question of any sort—and waives review of any proper question. The petition argues that the Federal Circuit erred in its approach to “what Section 119(e) *requires*” before it will afford a non-provisional application an earlier provisional application’s filing date so as to make it prior art. U.S. Br. 11. In particular, Ariosa challenges the requirement in § 119 that the provisional application provide “‘written description support for the claims of the [non-provisional] application[.]’” *Ibid.*; see Pet. 18, 21-22.

The government agrees that the Federal Circuit properly refused to allow Ariosa to invoke § 119 to backdate the ’946 Fan application, to give it the filing date of the earlier ’810 provisional application. U.S. Br. 18; see Pet. App. 2a. According to the government, however, that outcome was correct because, for purposes of determining whether an application is prior art under pre-AIA § 102, § 119 *never* provides a basis for backdating the application’s filing date. U.S. Br. 10-15. Here, the ’946 Fan application undisputedly was filed after the application leading to Illumina’s ’794 patent. *Id.* at 18-19. It thus cannot be “prior art.” *Ibid.*

Consequently, in the government’s view, the question presented by Ariosa does not make sense even under pre-AIA law. This Court cannot sensibly grant review to determine whether the Federal Circuit should (or should not) impose a particular requirement before allowing prior-art references to be backdated under § 119, as the petition asks, if § 119 cannot be invoked for that purpose at all.

The government also suggests that pre-AIA § 102 may allow a *provisional application itself* to be asserted as a prior-art reference. The government notes, moreover, that allowing the provisional application itself to be asserted as prior art would make it unnecessary to backdate a later non-provisional application, like the '946 Fan reference, to an earlier provisional application's filing date. U.S. Br. 18-19. But that theory weighs even more strongly against review. *Ibid.* As the government explains, Ariosa does not make that argument in its petition. *Id.* at 18. Ariosa identifies “[t]he prior art reference” here as “the ‘Fan reference,’” Pet. 16, and argues *only* for backdating the '946 Fan application to the date of the earlier '810 provisional, Pet. 21-22; see Pet. Reply 2 (question presented asks when “the prior art reference,” being used to challenge the validity of another patent, be given “the filing date of a [prior] provisional patent application”); see U.S. Br. 18 (additional citations).

That waiver cannot be overcome. Ariosa *never* urged that an earlier provisional application—such as the provisional '810 application here—could itself be prior art. Ariosa's petition for *inter partes* review asserted the published '946 Fan application as the § 102(e) prior art, not some earlier provisional application like the '810. See *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. IPR2014-01093, Pet. 14-25 (P.T.A.B. July 2, 2014) (Paper 1). The Board instituted review only on the '946 Fan reference, Pet. App. 8a, a decision that is unreviewable, 35 U.S.C. § 314(d). Ariosa did not assert the provisional application was itself prior art when the Board requested briefing on *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015). Pet. App. 14a-19a. Ariosa did not raise such an argument before the Federal Circuit either. To the contrary, for the relevant claims, Ari-

osa insisted that it “relied *solely* on Fan (not the ’810 application).” Pet. C.A. Reply Br. 11. And Ariosa did not raise the argument in its rehearing petition, even as it urged the Federal Circuit to overrule precedent. This Court does not ordinarily address arguments not pressed or passed upon below. *Glover v. United States*, 531 U.S. 198, 205 (2001).

Consistent with that, the government urges that “[t]he Federal Circuit has not directly addressed” the issue. U.S. Br. 19. This Court has repeatedly emphasized that it is a court “of final review, ‘not of first view.’” *FCC v. Fox Television Stations, Inc.*, 556 U.S. 502, 529 (2009) (quoting *Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7 (2005)); see, e.g., *United States v. United Foods, Inc.*, 533 U.S. 405, 417 (2001) (refusing to “allow a petitioner to assert new substantive arguments attacking * * * the judgment when those arguments were not pressed in the court whose opinion we are reviewing, or at least passed upon by it”). There is no “sound reason” for this Court to grant review in a case plagued by such waivers, to address the meaning of superseded statutory provisions, before the Federal Circuit has done so. U.S. Br. 19.

CONCLUSION

The petition should be denied.

Respectfully submitted.

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