

No. 18-109

IN THE
Supreme Court of the United States

ARIOSIA DIAGNOSTICS, INC.,

Petitioner,

v.

ILLUMINA, INC.,

Respondent.

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

**BRIEF OF *AMICI CURIAE*
INTELLECTUAL PROPERTY
LAW PROFESSORS
IN SUPPORT OF PETITIONER**

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INTEREST OF *AMICI CURIAE*

Amici curiae are 16 professors of law at universities throughout the United States.¹ *Amici* professors have no personal interest in the outcome of this case, but a professional interest in seeing patent law develop in a way that efficiently encourages innovation.²

SUMMARY OF ARGUMENT

The Federal Circuit's current framework for identifying prior art under section 102(e) of the 1952 Patent Act, upheld in the decision below, contradicts both Supreme Court jurisprudence and the Patent Act. Taken to its logical conclusion, the Federal Circuit's jurisprudence would require a § 112 analysis of the claims of every patent to determine if its application is prior art. These departures are unwarranted and undesirable as a matter of policy. If the Federal Circuit continues in this direction, it will foster uncertainty as to a patent's validity and

¹ Pursuant to Rule 37.2(a), counsel for both parties received notice of intent to file this brief at least 10 days before its due date. The parties have consented to the filing of this brief; their written consents are on file with the Clerk. No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund its preparation or submission. No person other than the *amici* or their counsel made a monetary contribution to the preparation or submission of this brief.

² A full list of *amici* law professors is contained in the Appendix.

effectively prevent public knowledge from qualifying as prior art.

Petitioner sought, and many of the *amici* here supported, en banc rehearing by the Federal Circuit. The Circuit declined to rehear the case and to resolve the conflict its rulings have created with this Court's precedents. Accordingly, this Court should grant certiorari to correct the Federal Circuit's erroneous rule and to clarify that provisional patent applications, like other patent applications, are prior art for what they teach, not for what they might later claim.³

ARGUMENT

I. The Federal Circuit's Approach Directly Conflicts With Supreme Court Precedent

A. This Court Has Long Held That Disclosures in a Patent Application Count as Prior Art as of the Application's Filing Date.

For nearly a century, this Court has consistently held that disclosures in a patent application constitute prior art as of the application's filing date. The Court first announced this rule in 1926. It was later codified by Congress and then reaffirmed by this Court in 1965. The Court's rule applies with equal force to provisional as well as non-provisional applications.

In *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), the Court held that the teachings contained in a patent constitute prior art as

³ *Amici* take no position on the ultimate validity of the challenged claims.

of the date the application for patent is filed—*irrespective* of whether the disclosures are claimed. *Id.* at 400-01. Two co-pending applications each received a patent. The first “gave a complete and adequate description of the thing” in the second, “but did not claim it.” *Id.* at 399. Although the first application was not yet publicly available when the second was filed, the Court ruled that the disclosure in the first patent was effective as prior art as of the first application’s filing date.

The patent system is designed to incentivize the public disclosure of new knowledge, *id.* at 399-400, so issuing a second patent for an invention that had already been described would undermine the exchange of a patent for a *previously unknown* invention. Furthermore, had the first application been published in a periodical, or if it had issued before the second application was filed, its teachings would unquestionably constitute prior art. *Id.* at 400-01. But no “sound distinction” can be drawn between such disclosures and an earlier co-pending application. *Id.* at 401. In each case, the content of the second patent would not be new knowledge.

Thus, even though amendments might be required, or a new application might be filed based on the original description, the teachings of an original application were held to be prior art as of its filing date. *Id.* at 401-02. Rather than having kept the description in a “portfolio uncommunicated to anyone,” an applicant has done as much as possible to make a public disclosure, which in turn must count as prior art. *Id.* at 400-01. This Court held that it would be anomalous if later applicants could secure a patent on previously disclosed knowledge, or if the particular

medium of the disclosure could affect its status as prior art. *See id.*

This Court extended *Milburn* to obviousness inquiries in *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252 (1965). There, a later applicant argued that *Milburn* applied only to § 102, and that an earlier-filed, co-pending patent was not prior art under § 103 because its teachings “were secret and not known to the public” at the time. *Hazeltine*, 382 U.S. at 253-54. The Court dismissed these concerns about secret prior art and reaffirmed that “the disclosures contained in [a] patent become a part of the prior art as of the time the application was filed.” *Id.* at 254-55.

2. Congress codified *Milburn* in § 102(e) of the Patent Act of 1952, which states that a patent cannot issue if “the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent.” Patent Act of 1952, Pub. L. No. 82-593, 66 Stat. 792, 797. As the House Committee Report explained, “Paragraph (e) is new and enacts the rule of *Milburn* . . . by reason of which a United States patent disclosing an invention dates from the date of filing the application for the purpose of anticipating a subsequent inventor.” H.R. Rep. No. 82-1923, at 17 (1952).

3. This Court’s *Milburn* rule has applied with equal force to provisional applications since they were added in the 1994 amendments to the Patent Act. Section 111 provides that “[t]he provisions of this title relating to applications for patent shall apply to provisional applications for patent,” subject to several exceptions, none of which is relevant here. 35 U.S.C. § 111(b)(8) (2000). A provisional can therefore serve as

the effective “fil[ing]” of an application within the meaning of § 102(e)(1)-(2). *See* 35 U.S.C. § 102(e) (2000). This is also consistent with the logic of *Milburn*: unless a provisional is abandoned before publication (akin to an invention being kept in a “portfolio uncommunicated to anyone,” 270 U.S. at 400), its disclosure is intended for the public and can be used to invalidate later claims.

B. The Federal Circuit Has Departed from this Court’s *Milburn* Rule.

The predecessor to the Federal Circuit, the United States Court of Customs and Patent Appeals (“C.C.P.A.”), strayed from the Supreme Court’s clear holdings and the 1952 Act’s adoption of the *Milburn* rule when it decided *In re Wertheim*, 646 F.2d 527 (C.C.P.A. 1981). The Federal Circuit then continued this departure from the well-established rule *even after* the 1999 amendments to the Patent Act nullified *Wertheim*’s concerns about secret prior art. These decisions cannot be reconciled with Supreme Court precedent and the Patent Act, and they should be reviewed by this Court.

1. *Wertheim*, decided in 1981, ignored the reasoning in *Milburn* and *Hazeltine*. Instead, the C.C.P.A. followed its own rationale about secret prior art—despite this Court’s rejection of such concerns when raised in *Milburn* and *Hazeltine*. In *Wertheim*, the Patent and Trademark Board of Appeals (“the Board”) rejected *Wertheim*’s patent application on the grounds that the invention was obvious in light of the prior art. *Wertheim*, 646 F.2d at 531. The primary reference was the “Pfluger” series of patent applications. *Id.* at 529. “Pfluger I” became the Pfluger patent after two continuations-in-part and a

continuation. *Id.* Wertheim's earliest priority date came partway through the Pfluger series. *Id.*

The Board found that Pfluger I, combined with two publications, rendered Wertheim's invention obvious. *Id.* at 531. But the C.C.P.A. reversed, finding that the Pfluger patent was not entitled to the filing date of Pfluger I, *id.* at 539, and thus could not be used to support a § 103 rejection. *Wertheim* not only distorted key aspects of *Milburn*, but also pursued an irrelevant inquiry in determining whether information disclosed in a patent application constitutes prior art.

First, the C.C.P.A. invented a "but-for" rationale that cannot be reconciled with *Milburn* and *Hazeltine*. The *Wertheim* court construed *Milburn* as saying that, by filing an application, "the inventor was presumed to have disclosed an invention which, *but for the delays inherent in the prosecution*, would have been disclosed to the public on the filing date." *Id.* at 536 (emphasis added). Because continuations were required for the Pfluger patent to issue, the court reasoned, it was not only the delays of the Patent and Trademark Office (PTO) that kept the teachings of Pfluger I from the public. *Id.* at 539.

This Court's holding in *Milburn*, however, forecloses the "but-for" misinterpretation adopted in *Wertheim*. In fact, this Court recognized that the earlier applicant "had taken steps that would make [his disclosure] public as soon as the Patent Office did its work, *although, of course, amendments might be required of him before the end could be reached.*" *Milburn*, 270 U.S. at 401 (emphasis added). Indeed, this Court noted that even if a *new application* were filed based on the original description, prior art would

be established as of the earlier filing date. *Id.* at 402. Thus, delays *not* inherent in prosecution—such as amendments and new applications in *Milburn* or continuations in *Wertheim*—do not alter the application’s status as prior art.

The C.C.P.A. further deviated from this Court’s rule in *Milburn* by pursuing an irrelevant prior art inquiry, focusing on whether the disclosures in Pfluger I were sufficient to support the claims in the Pfluger patent in accordance with § 112. *Wertheim*, 646 F.2d at 537. Because limitations necessary for the Pfluger patent to issue were only added later in the series of continuations, the *Wertheim* court held that the Pfluger patent was not entitled to the Pfluger I filing date. *Id.* at 538-39.

Milburn, however, demonstrates that this inquiry is entirely beside the point; what matters for prior art is not what a reference claims but what it teaches. 270 U.S. at 401. Thus, in *Wertheim*, because Pfluger I disclosed knowledge inconsistent with the allowance of *Wertheim*’s claim and such matter was ultimately available to the public, 646 F.2d at 536, the rejection of *Wertheim*’s application should have been upheld.

2. *Wertheim* was wrong under this Court’s precedent at the time it was decided. Its misguided concern about secret prior art, *see* 646 F.2d at 539, was subsequently vitiated (with limited exceptions) by the 1999 amendments to the Patent Act, in which Congress amended § 122(b) to mandate the publication of patent applications within eighteen months of filing. *See* Pub. L. No. 106-113, § 4502, 113 Stat. 1501, 1501A-561 (1999). Congress thus eliminated the accumulation of undisclosed applications in the PTO, thereby nullifying the secret-

prior-art rationale that (mistakenly) grounded *Wertheim*'s divergence from this Court's precedent.

3. *Wertheim* was wrong, and the Federal Circuit has perpetuated its error. Though the 1999 amendments effectively invalidated *Wertheim*, the Federal Circuit has continued to apply its faulty reasoning. In *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015), the circuit refused to reject certain patent claims as anticipated by a prior patent, holding that a reference patent can only date back to the filing date of its provisional if the provisional provides § 112 support for a claim that ultimately issues in a patent deriving from a later application that claims priority to the provisional, or for a claim from a later published application – whether or not examined – that claims priority to the provisional.

That decision, like *Wertheim*, directly contravenes this Court's long-established *Milburn* rule. There is no basis for applying a § 112(a) requirement to an application or provisional application for the purposes of identifying prior art. *Dynamic Drinkware* bases its prior art § 112 requirement on the § 119(e)(1) (similar to the pre-AIA § 120) statement that

[a]n application for patent . . . for an invention disclosed in the manner provided by section 112(a) . . . in a provisional application . . . shall have the same effect, as to such invention, as though filed on the date of the provisional application.

35 U.S.C. § 119(e)(1) (2018); *see also* 800 F.3d at 1378. However, the critical “for an invention . . . as to such invention” language makes clear that § 119(e)(1) only

applies for determining if an application can claim priority to *its own provisional*. Section 112 support for claims is irrelevant when a provisional is used as prior art against a *different* invention. That is, so long as a provisional provides *any* disclosure support for *any* claim in a patent issuing from a subsequently filed application that claims priority to the provisional application, the *entire disclosure* of the provisional application becomes prior art against the world as of the provisional's filing date, just like the unclaimed but disclosed subject matter in the application that resulted in a patent in *Alexander Milburn*.

II. The Federal Circuit's Rule Undermines Important National Policies and Interests by Creating Unnecessary Burdens and Damaging Uncertainty for Patent Applicants.

The identification and determination of prior art is a fundamental inquiry in patent proceedings. The Federal Circuit's continued departure from this Court's rule in *Milburn* in favor of *Wertheim*'s flawed and obsolete rationale unnecessarily complicates patent proceedings, creates harmful confusion and uncertainty about prior art and patent validity, and threatens to stifle efficient patenting and innovation relying on the public domain. These important questions of federal law are vital to significant national interests and highlight the need for a grant of certiorari in this case.

A. The Federal Circuit's Approach Adds Burdensome, Uncertain Analysis to Prior Art Determinations.

Under the Federal Circuit's erroneous approach, an inventor will need to do a § 112 written description analysis to determine if a patent application after a continuation-in-part or any provisional application qualifies as prior art. *See Wertheim*, 646 F.2d at 537. This inquiry is highly uncertain, often requiring court intervention to resolve. Even if the application's disclosure was clear and unquestionably public, a prior art determination would require analysis of later patent claims, which could be very complex, or even in a different technological field. And this inquiry would have to be repeated for every application or provisional that *on its face* disclosed relevant material, even though the later claims are irrelevant to the prior art disclosure.

This burdensome requirement has no basis in law or policy. It produces particularly bizarre results when applied to cases where the issue is the prior art status of a provisional application with an identical specification to that of the published application. It makes no sense to include a § 112 written description requirement to create different prior art dates for public documents with identical disclosures.

B. Under the Federal Circuit's Rule, a Valid Patent Could Be Invalidated by Amendments Made to an Unrelated Application.

The Federal Circuit's rule creates harmful practical consequences for patentees, as well. These

harmful consequences can be illustrated by a simple example. Assume an inventor files a provisional that discloses inventions M and N, and then a non-provisional application that incorporates the provisional by reference but claims only M. Even after the non-provisional is published, N would not be considered prior art under the Federal Circuit's *Wertheim* rule. Suppose a second inventor then applies for and receives a patent on N. If—but only if—the first inventor later amended the application to claim N, the provisional's disclosure of N would *retroactively* become prior art as of the provisional's filing date. The second inventor's issued patent would silently and retroactively become invalid. This is true even though the disclosures were public when the second inventor's patent was filed and the disclosures had not changed at all—instead, the invalidation resulted from a change in the claims of *another* application. Such a result makes no sense and is harmful to the efficient operation of the patent system and the normal expectations of inventors who use it. This outcome, and the Federal Circuit's rule which causes it, are inconsistent with *Milburn* and the rest of § 102, both of which focus on what a prior art reference teaches, not what it claims.

III. This Case Presents An Appropriate Vehicle to Correct the Federal Circuit's Erroneous Application of *Milburn* and *Hazeltine*

This case squarely presents the question of whether the Federal Circuit has deviated from this Court's precedent and the Patent Act in its prior art jurisprudence. That divergence was perpetuated by the Federal Circuit in its 2015 *Dynamic Drinkware*

and further entrenched two years later in *Amgen Inc. v. Sanofi*, 872 F.3d 1367 (Fed. Cir. 2017).

Petitioner in the current case sought en banc rehearing so the Federal Circuit could consider and correct the conflict between its precedents and those of this Court, and many of the current *amici* filed an *amicus* brief at that stage urging the Circuit to take that opportunity. The Federal Circuit declined to do so, leaving its jurisprudence in conflict. Because the Circuit is unwilling to act, this Court's review is necessary to resolve the divergence.

CONCLUSION

For the foregoing reasons, this Court should grant the petition for certiorari to correct the Federal Circuit's departure from well-established Supreme Court precedent on a matter of considerable national importance.

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August 23, 2018

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APPENDIX

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