


No. _____

**In the
Supreme Court of the United States**



SAWSTOP HOLDING LLC,

Petitioner,

v.

UNITED STATES PATENT AND TRADEMARK OFFICE,
AND KATHI VIDAL, UNDER SECRETARY OF COMMERCE FOR
INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE, IN HER OFFICIAL CAPACITY,

Respondents.

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

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The Patent Act adopted by Congress provides that a person shall be entitled to a patent if an invention meets three conditions: the eligibility condition of 35 U.S.C. § 101, the novelty condition of 35 U.S.C. § 102, and the non-obvious subject matter condition of 35 U.S.C. § 103. Beyond the Patent Act, the judiciary has created a fourth condition for patentability called non-statutory double patenting or obviousness-type double patenting.

The Questions Presented Are:

1. Does the judiciary have the authority to require a patent applicant to meet a condition for patentability not required by the Patent Act?
2. Is the judicially created doctrine of non-statutory double patenting *ultra vires*?

PARTIES TO THE PROCEEDINGS

All parties are named in the caption.

CORPORATE DISCLOSURE STATEMENT

Petitioner SawStop Holding LLC is the owner of SawStop, LLC, which makes and sells table saws with technology that detects when a user accidentally contacts a moving blade, and then stops the blade within milliseconds to mitigate injury.

The parent companies of SawStop Holding LLC are TTS Oregon Holdings LLC, TTS Oregon, Inc., TTS Tooltechnic Systems AG & Co. KG, and TTS Tooltechnic Systems Holding AG.

There is no publicly held company owning 10% or more of the stock of SawStop Holding LLC.

LIST OF PROCEEDINGS

United States Court of Appeals for the Federal Circuit
No. 2021-2161

In Re: Sawstop Holding LLC, Appellant

Date of Final Judgment: April 11, 2022

United States Patent and Trademark Office
Appeal 2020-005769; Application 15/935,432

Ex parte Stephen F. Gass

Date of Final Decision: May 24, 2021

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OPINIONS BELOW

The judgment of the U.S. Court of Appeals for the Federal Circuit is reported as *In re: SawStop Holding LLC*, 2022 WL 1073339 (Fed. Cir. 2022), and is reproduced at App.1a.

The opinion of the Patent Trial and Appeal Board is reported as *Ex Parte Stephen F. Gass*, 2021 WL 2157593 (PTAB 2021), and is reproduced at App.3a.



JURISDICTION

The judgment of the Federal Circuit issued on April 11, 2022. This Court has jurisdiction under 28 U.S.C. § 1254(1).



CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

U.S. Constitution, Article 1, Section 8, Clause 8

The Congress shall have Power . . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

35 U.S.C. § 101**Inventions patentable**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 102**Conditions for patentability; novelty**

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
- (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) Exceptions.—

- (1) Disclosures made 1 year or less before the effective filing date of the claimed invention. —A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

- (A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
 - (B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.
- (2) Disclosures appearing in applications and patents.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—
- (A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;
 - (B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or
 - (C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

[. . .]

35 U.S.C. § 103**Conditions for patentability; non-obvious subject matter**

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

**STATEMENT OF THE CASE**

On March 26, 2018, Petitioner SawStop Holding LLC filed a patent application claiming a new band saw. An examiner at the patent office rejected the application, not because the application failed to meet the statutory conditions for patentability—it met them all—but because the application failed to meet a judicially created condition for patentability called non-statutory double patenting or obviousness-type double patenting.

SawStop appealed the examiner’s rejection to the Patent Trial and Appeal Board pursuant to 35 U.S.C. § 134(a). SawStop argued, *inter alia*, that the doctrine of non-statutory double patenting was improper because it is not based on a statute, and because the judiciary does not have the authority to impose an

additional condition of patentability. In a decision issued May 24, 2021, the Board recognized that “non-statutory double patenting is a judicially created doctrine . . . ,” but nevertheless, the Board affirmed the examiner’s rejection saying, “we decline the Appellant’s request to retire a doctrine upheld by our reviewing court.” (App.7a)

SawStop then appealed to the U.S. Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. § 141(a). The Federal Circuit had jurisdiction under 28 U.S.C. § 1295(a)(4)(A). SawStop again argued that the doctrine of non-statutory double patenting was improper because it is not based on a statute, and as a result, the judiciary’s adoption of that doctrine was *ultra vires*, *i.e.*, beyond the judiciary’s authority. On April 11, 2022, the Federal Circuit affirmed the Board’s decision without opinion pursuant to Federal Circuit Rule 36. (App.2a) By affirming without an opinion, the Federal Circuit did not explain how it has the authority to impose an additional condition of patentability.

SawStop now petitions this Court for a writ of certiorari to resolve the question of whether the judiciary has the authority to impose a condition for patentability beyond the conditions set forth by Congress in the Patent Act.



REASONS FOR GRANTING THE WRIT

I. THIS PETITION ADDRESSES AN IMPORTANT QUESTION OF PATENT LAW.

This petition should be granted because, as stated in Supreme Court Rule 10(c), “a United States court of appeals has decided an important question of federal law that has not been, but should be, settled by this Court” The question is whether the judiciary has the authority to impose an additional condition of patentability, and more specifically, whether the doctrine of non-statutory double patenting is *ultra vires*.

The answer to this question seems straight forward. The U.S. Constitution, art. 1, sec. 8, cl. 8, gives Congress, not the judiciary, the authority to impose conditions for patentability. Additionally, this Court, in *Graham v. John Deere*, 383 U.S. 1, 6 (1966), explained, “Within the scope established by the Constitution, Congress may set out conditions and tests for patentability.”

Nevertheless, the Federal Circuit has imposed an additional condition for patentability beyond what Congress requires, namely, that a pending claim in a patent application be non-obvious over claims in an earlier patent that is not prior art but that has a common inventor or applicant, is commonly owned, or is subject to a joint research agreement. *See, e.g.*, MANUAL OF PATENT EXAMINING PROCEDURE, Section 804 (Ninth Ed., Rev. 10-2019, Last Revised June 2020). This additional condition for patentability is known as non-statutory double patenting or obviousness-type double patenting. The questions presented in this petition are important because the doctrine of non-

statutory double patenting is currently preventing inventors from obtaining patents that would otherwise be allowed under the statutes adopted by Congress.

II. NON-STATUTORY DOUBLE PATENTING IS DIFFERENT THAN STATUTORY DOUBLE PATENTING.

It is important to understand that non-statutory double patenting is different than statutory double patenting. Statutory double patenting is based on 35 U.S.C. § 101 which says: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” The Federal Circuit has interpreted the phrase “a patent” in that statute to mean an inventor can obtain only one patent per invention. Accordingly, if a patent application claims the same invention claimed in a prior patent, the application would be denied on the ground of statutory double patenting because of the language of 35 U.S.C. § 101. *See, e.g., In re Longi*, 759 F.2d 887, 892 (Fed. Cir. 1985).

Statutory double patenting is not at issue in this case. Petitioner’s patent application was denied solely on the ground of non-statutory double patenting. (App. 11a-12a) The patent application at issue here claims a different invention than what is claimed in prior patents, and therefore, statutory double patenting does not apply.¹

¹ The patent application at issue here claims a band saw. (App.4a-5a, claim 6) U.S. Patent No. 7,284,467 is the basis for the non-statutory double patenting rejection, and the ‘467 patent claims a woodworking machine. Comparing claim 6 in the patent application with claim 1 in the ‘467 patent shows that the band saw

III. NON-STATUTORY DOUBLE PATENTING IS A JUDICIALLY CREATED CONDITION FOR PATENT-ABILITY.

This Court addressed double patenting in *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894). That case involved the alleged infringement of two patents for “wheeled cultivators.” *Id.* at 187. In considering whether the two patents were valid, the Court explained that “no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ” *Id.* at 198. The Court, however, did not identify a statutory basis for double patenting, and did not discuss the distinction between statutory double patenting and non-statutory double patenting.

The distinction between statutory double patenting and non-statutory double patenting was first articulated by Judge Giles Sutherland Rich in *In re Zickendraht*, 319 F.2d 225 (C.C.P.A. 1963). In that case, Judge Rich concurred with the majority in affirming the denial of a patent on the ground of double patenting, but the majority said there was only one invention at issue while Judge Rich said there were two. Judge Rich

claimed in the patent application is different than the wood-working machine claimed in the '467 patent. Claim 1 from the '467 patent reads: “A woodworking machine, comprising: a motor; an electrically isolated, rotatable arbor configured to be driven by the motor, where the arbor has an outer surface; a circular blade coupled to the arbor; an excitation system adapted to generate an electrical signal; and a capacitive coupling adapted to capacitively couple the excitation system to the arbor to transfer at least a portion of the electrical signal to the blade, where the capacitive coupling includes two spaced-apart conductors, and where at least a portion of the outer surface of the arbor is one of the conductors.”

concurrent in the denial of a patent for the second invention because he said the second invention was obvious over the first invention. He recognized, however, there was no statutory basis to deny a patent for the second invention since the first invention was not prior art. That recognition caused him to explain the difference between statutory and non-statutory double patenting. In footnote 4 to his concurring opinion, he explained:

Where there is in fact only one invention and, in one way or another, it is being claimed twice, it would seem appropriate to refer to 35 U.S.C. § 101 as authority for saying that the statutes permit an inventor to obtain a patent, meaning only one patent. Where there are in fact two inventions, whether or not they are patentable, this statute would seem to be inapplicable and the second patent has to be denied, if it is denied[,] on some other ground. The ground one finds stated in the cases is to the effect that the second invention must be patentable on its own account, over the invention claimed in the issued patent, just as though the invention so claimed were in the prior art, and tested (since 1953) by the unobviousness requirement of 35 U.S.C. § 103. But since the patented invention is not prior art, the basis for denial is not a statutory basis; rather it is a caselaw development. . . .

Zickendraht, 319 F.2d at 231 n. 4.

In subsequent cases the Federal Circuit adopted Judge Rich's reasoning and referred to non-statutory double patenting as a judicially created doctrine. *See*,

e.g., *Perricone, M.D. v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1373 (Fed. Cir. 2005) (“Non-statutory or ‘obviousness-type,’ double patenting is a judicially created doctrine adopted to prevent claims in separate applications or patents that do not recite the ‘same’ invention, but nonetheless claim inventions so alike that granting both exclusive rights would effectively extend the life of patent protection.”); *Eli Lilly & Co. v. Barr Labs, Inc.*, 251 F.3d 955, 967 (Fed Cir. 2001) (“The judicially-created doctrine of obviousness type double patenting . . . prohibit[s] a party from obtaining an extension of the right to exclude through claims in a later patent that are not patentably distinct from claims in a commonly owned earlier patent.”); *In re Braat*, 937 F.2d 589, 592 (Fed. Cir. 1991) (“Obviousness-type double patenting is a judicially created doctrine intended to prevent improper timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not ‘patentably distinct’ from the claims of a first patent.”)

More recently, in *Abbvie v. Mathilda & Terence Kennedy Institute*, 764 F.3d 1366, 1372 (Fed. Cir. 2014), the Federal Circuit said “obviousness-type double patenting is grounded in the text of the Patent Act” because “[35 U.S.C.] § 101 forbids an individual from obtaining more than one patent on the same invention, *i.e.*, double patenting.” However, the court then said, “As this court has explained, ‘a rejection based upon double patenting of the obviousness type’ is ‘grounded in public policy (a policy reflected in the patent statute).” *Id.* (quoting *In re Longi*, 759 F.2d 887, 892 (Fed. Cir. 1985)). Thus, when the Federal Circuit said non-statutory double patenting “is grounded in the text of the Patent Act,” it meant the doctrine is based

on public policy “reflected in the patent statute.” The Federal Circuit was not interpreting the text of a specific statute, rather, it was adding an additional clause to the statute which the court believed should have been included for reasons of public policy.

IV. THE JUDICIARY DOES NOT HAVE THE AUTHORITY TO CREATE A CONDITION FOR PATENTABILITY BASED ON POLICY.

Petitioner asserts that the judiciary does not have the authority to create an additional condition for patentability based on policy “reflected in the patent statute.” Congress is the entity to consider policy and specify conditions for patentability, not the judiciary, U.S. Const., art. 1, sec. 8, cl. 8; *Graham v. John Deere*, 383 U.S. 1, 6 (1966), and Congress did so when it adopted the statutory scheme specified in Title 35 of the United States Code.

It is not the judiciary’s role to augment or supplement the conditions for patentability specified by Congress, regardless of whether additional conditions seem necessary. As Justice Murphy explained in a dissent in *Western Union Telegraph Co. v. Lenroot*, 323 U.S. 490, 514 (1945), “the judicial function does not allow us to disregard that which Congress has plainly and constitutionally decreed and to formulate exceptions which we think, for practical reasons, Congress might have made had it thought more about the problem.”

Congress “has plainly and constitutionally decreed” what is required to obtain a patent, and Petitioner’s application met all those requirements. Nevertheless, Petitioner was denied a patent because the Federal Circuit has said a patent application must also be non-obvious over a patent that is not prior art if that patent

has a common inventor or applicant, is commonly owned, or is subject to a joint research agreement. That is an additional, substantive, and judicially created condition of patentability that has blocked Petitioner from obtaining a patent.



CONCLUSION

Petitioner has been denied a patent even though Petitioner's patent application meets all the conditions for patentability specified by Congress. There is no dispute on this point. The only dispute is whether the judiciary has the authority to impose an additional condition for patentability. If the judiciary does not have that authority, Petitioner should receive the patent to which it is entitled. Accordingly, Petitioner asks this Court to grant a writ of certiorari to resolve the question of whether the doctrine of non-statutory double patenting is *ultra vires*.

Respectfully submitted,

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