

No. 24-866

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IN THE  
**Supreme Court of the United States**

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CONVERTER MANUFACTURING, LLC,

*Petitioner,*

*v.*

TEKNI-PLEX, INC.,

*Respondent.*

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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**REPLY BRIEF**

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April 30, 2025

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381059



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## INTRODUCTION

Petitioner, Converter Manufacturing, LLC (“CM”) and respondent, Tekni-Plex, Inc. (“Respondent”) apparently agree that this Court’s answers to the Questions Presented will indelibly affect the entire scientific and creative community. *See* Petition (Pet.) at 1, 3, 37-38; *see* Respondent’s Brief (Br.) at 14-16.

The importance of these Questions Presented not being seriously disputed, this Court should grant the Petition on account of three more facts about which there cannot be any serious dispute:

1. This Court’s decision in *Seymour v. Osborne*, 11 Wall. 516 (1870) (“*Seymour*”) established the law of prior art enablement according to Sections 102 and 103 of the Patent Act. *See* Petition (“Pet.”) at ii (second Question Presented), 5-10; *cf.* Br. at 1-2.
2. *Seymour* and *Amgen Inc. v. Sanofi*, 598 U.S. 594, 605-06 (2023) each requires the same fullness of disclosure: to enable a person of ordinary skill in the art to make and use the claimed invention – the former applying that standard to prior art publications under 35 U.S.C. §§ 102 and 103 and the latter applying that standard to patents under 35 U.S.C. § 112.
3. According to the United States Court of Appeals for the Federal Circuit (“CAFC”), “[t]he standard for what constitutes proper enablement of a prior art reference for purposes of anticipation under section 102, however, differs from the enablement standard under section 112.” *See Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1325 (Fed. Cir. 2005).

In view of the above, this Court should grant review at least on the second Question Presented, because the CAFC's law of prior art enablement is in direct conflict with that laid down by this Court over one hundred years ago in *Seymour*. See Sup. Ct. R. 10(c) ("a United States court of appeals ... has decided an important federal question in a way that conflicts with relevant decisions of this Court.")

Each of Respondent and CM poses a similar first Question Presented, namely, whether the CAFC's presumption of prior art enablement is proper. *Compare* Pet. at i, 1-2, 11-12, 27, 33-34 *with* Opposition Brief ("Br.") at i, 1, 6-7. The first Question Presented satisfies each part of Sup. Ct. R. 10(c) because (i) the CAFC "decided an important question of federal law [namely, whether there is a presumption of prior art enablement] that has not been, but should be, settled by this Court," and (ii) the CAFC's presumption of prior art enablement "conflicts with relevant decisions of this Court." See, e.g., *Seymour*, 11 Wall. at 555; *Microsoft Corp. v. I4I Ltd. P'ship*, 564 U.S. 91, 98, 107 (2011) ("*Microsoft*"); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 278-79 (2016).

Finally, the CAFC abdicated its judicial responsibility and contradicted this Court's decision in *Loper Bright Enters. v. Raimondo*, 603 U.S. 369, 387, 413 (2024) when it deferred to an administrative agency's interpretation of the federal patent law, here that of the United States Patent and Trademark Office ("USPTO"). That contradiction forms the basis for CM's third Question Presented, which is also ripe for this Court's review under Sup. Ct. R. 10(c).

Therefore, CM respectfully requests this Court grant review of each of the Questions Presented.

## PETITIONER'S REPLY

### A. The Factual Background Illustrates the Unjust Results of Failure to Follow this Court's *Seymour* Precedent

This Court can read every citation to the record in Respondent's brief (Br. 3-5) but will never find one instance in which the USPTO or the CAFC analyzed Respondent's cited prior art references in accordance with this Court's *Seymour* precedent. Nowhere in the written decisions did an adjudicator conclude that Respondent's relied-upon prior art disclosures included "such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to ***make, construct, and practice*** the invention as they would be enabled to do if the information was derived from a prior patent." *Seymour*, 11 Wall. at 555 (citing *Hill v. Evans*, 45 E.R. 1195, 1200 (1861)) (emphasis added).

The absence of prior art enablement analysis in accordance with *Seymour* is not surprising because the CAFC and the USPTO do not follow this Court's prior art enablement precedent. See Pet. at 10, 28-29. For example, the USPTO held that all prior art publications are enabling even though no one could ever ***make, construct, and practice*** the relied-upon prior art disclosure. See Pet.Appx.32a-33a ("working examples are not required to show enablement."); Pet.Appx.137a (same); Pet.Appx.250a (same). As another example, the USPTO's rule, which was adopted-without-opinion by the CAFC under Fed. Cir. R. 36, presumes a prior art publication enabled notwithstanding that others experienced failures when using such prior art, provided

the noted failures do not “always” or “necessarily” occur. See Pet.Appx.31a (patent owner failed to prove non-enablement because puckering and adhesion failures did not “always” or “necessarily” occur); Pet.Appx.39a (same); Pet.Appx.135a (same); Pet.Appx.143a (same); Pet.Appx.243a-244a (same); Pet.Appx.257a (same), *aff’d per curiam* Pet.Appx.1-2.

Had the CAFC followed *Seymour*, CM’s evidence that skilled artisans failed to make, construct, *and* practice the invention (or that they believed the same to be “impossible” to “make” and “construct” before and after the invention date) (Pet. at 15) would have been dispositive on the issue of prior art non-enablement. Contrary to Respondent’s suggestion (Br. at 1-2, 13-14), the proper application of *Seymour* would undoubtedly have reversed the outcome in this case because Respondent failed to prove skilled artisans were enabled to “make, construct, ***and*** practice” the disclosures in its cited references and combinations of references before CM’s invention date. Indeed, the record evidence of failures from attempts to use the references proves the opposite of “an account of a complete and ***operative*** invention, capable of being put into ***practical operation***.” *Seymour*, 11 Wall. at 555 (emphasis added).

Furthermore, *Seymour* requires the prior art “to exhibit a substantial representation of the patented improvement in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct, and practice the invention as they would be enabled to do if the information was derived from a prior patent,” such that working examples may be necessary if the patented technology requires them. In this case, because CM’s patents all show



working examples as part of their enabled disclosure, under *Seymour*, Respondent’s prior art publications should have had to disclose embodiments made by the processes described in those references to the same extent as CM’s patents. See 11 Wall. at 555. Unlike CM’s patents and images of the working examples made by those patents’ disclosures, no prior art of record discloses any actual products made according to the prior art’s proposed processes. See Pet. at 16-19, 21-22, 39. Unable to find any working embodiments in the prior art references themselves, Respondent asserts that it “prov[ed]” that a third party made trays similar to those in CM’s patents prior to the invention date, albeit without correlating the third party trays to any patent claim. Br. at 4, 14 (citing Pet.Appx.44a-46a; Pet.Appx.148a-150a; Pet.Appx.264a.) (“articles made using Long’s [prior art] process, were, in fact, produced on a commercial scale ‘since at least as early as 2012.’”) However, these of Respondent’s alleged proofs were ruled to be inadmissible hearsay. See Pet.Appx.100a (“***we do not rely on these statements for the truth of the matter asserted, i.e., that Alto manufactured the identified trays in 2012.***”) (emphasis added); Pet.Appx.208a (same); Pet.Appx.306a (same).<sup>1</sup>

Respondent never disputed that this Court’s decision in *Seymour* is the law of prior art enablement. See Br. at 1-2. Instead, Respondent argues that “*Seymour* does not even mention the presumption or the

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<sup>1</sup> Even if the hearsay had been considered, this Court’s jurisprudence is clear that oral testimony, hearsay or otherwise, is insufficient to prove the prior use of a patented invention – which is the result Respondent had hoped for by misleadingly quoting this hearsay testimony in its opposition. See *The Barbed Wire Patent*, 143 U.S. 275, 332 (1892).

burden of proof on prior art enablement” and that the presumption creates no conflict with this Court’s law. *Cf.* Br. at i, 1, 6-7. Respondent is incorrect. This Court in *Seymour* predicated the enablement of a published disclosure on whether it is “an account of a complete and operative invention, capable of being put into practical operation.” 11 Wall. at 555. In so doing, this Court makes clear that all published disclosures cannot be presumed enabling, let alone imbued with a rebuttable presumption against the patent owner merely because they were published.

As there is no dispute that this Court’s *Seymour* decision is the law of prior art enablement, and this Court’s holding in *Seymour* belies any suggestion that it created a rebuttable presumption of enablement of a prior art publication in favor of the patent challenger, this Court should answer the first and second Questions Presented in CM’s favor on review.

### **B. CM Did Not Waive Any Question Presented in the Petition**

Respondent asserts “[a]ll three of CM’s Questions Presented are grounded in CM’s argument that the Court [sic] should eliminate the rebuttable presumption of enablement...” Br. at 10. This is wrong.

CM’s third Question Presented is whether the CAFC was allowed to use its appellate court deference rule to abdicate its judicial responsibility of stating what the law is regarding prior art enablement under Sections 102 and 103 of the Patent Act. *See* Pet. at ii, 2, 24.<sup>2</sup> CM’s

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<sup>2</sup> Respondent’s nit that the CAFC relied on the deference rule under Fed. Cir. R. 36, not the general appellate court deference

third Question Presented has nothing to do with “eliminat[ing] the rebuttable presumption of enablement...”

As for the second Question Presented, CM presented *Seymour* as the controlling law on prior art enablement in its briefing to the three member panel of the CAFC **before** CM filed for rehearing *en banc*. See CM Appeal No. 23-1801, Doc. 22 at 65-66. Respondent never challenged CM’s reliance on this Court’s *Seymour* precedent nor did it challenge that *Seymour* was controlling with respect to the prior art enablement issue. Cf. CM Appeal No. 23-1801, Doc. 27. Even now, Respondent does not seriously challenge that *Seymour* is the law of prior art enablement.

Despite CM clearly raising *Seymour* as controlling authority on the prior art enablement issue to the CAFC, Respondent erroneously asserts that CM waived the issue because CM had only raised *Seymour* in its rehearing *en banc* petition.<sup>3</sup> See Br. at 10-13. However, CM cited *Seymour* as controlling precedent on the prior art enablement issue **before** seeking rehearing *en banc*. Respondent’s failure to address *Seymour* as controlling precedent while the issue was before the CAFC is of its own making. In any event, CM clearly preserved for review the issue that *Seymour* is controlling law

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rule, Fed. R. App. P. 36 (Br. at 2 n.1), does not change the fact that the CAFC violated this Court’s holding in *Loper Bright* when the CAFC deferred to the USPTO’s interpretation of federal patent law.

<sup>3</sup> Respondent never argued that CM “waived” its third Question Presented based on *Loper Bright* even though CM only raised its *Loper Bright* argument to the CAFC in its petition for rehearing *en banc*. See CM Appeal 23-1801, Doc. 56 at 9-11; cf. Br. at 16-17.

regarding prior art enablement as set forth in the second Question Presented. There was no waiver.

Grasping at straws, Respondent argues that CM waived the first Question Presented – the applicable burden for proving prior art enablement. Br. at 10-11. That question is subsidiary to, and fairly included in, the question of whether *Seymour* is the controlling law of prior art enablement. See Sup. Ct. R. 14.1(a); see also *Gross v. FBL Fin. Servs., Inc.*, 557 U.S. 167, 173 (2009) (“The statement of any question presented is deemed to comprise every subsidiary question fairly included therein.”) Respondent misunderstands that this Court can address “[q]uestions not explicitly mentioned but essential to the analysis of the decisions below or to the correct disposition of the other issues....” See *City of Sherrill v. Oneida Indian Nation of N. Y.*, 544 U.S. 197, 214, n. 8 (2005). Moreover, Respondent is raising its own question for this Court to answer about whether the CAFC’s presumption of prior art enablement should be eliminated despite the fact it never raised that issue before any court or tribunal. See Br. at i.

Therefore, this Court should grant review of all of CM’s pending Questions Presented in its Petition and all subsidiary question fairly included therein.

**C. No Legitimate Policy Consideration Supports Maintaining the CAFC’s Erroneous Prior Art Enablement Law**

The Court should disregard Respondent’s so-called “policy considerations” (Br. at 14-16) which are merely excuses to continue the CAFC’s thoughtless law that presumes all published prior art is enabling. Respondent studiously avoids mentioning that the

CAFC's improper presumption of prior art enablement is the lone exception to this Court's law that "the burden of proving invalidity on the attacker ... is constant and never changes...." *Microsoft*, 564 U.S. at 98. Nowhere in this Court's *Microsoft* decision did the Court create a caveat for prior art enablement or allow the selective flipping of the burdens of persuasion and production depending on which invalidity attacks are made against a patent.

Respondent purports to imagine that patent owners are in a better position than any patent challenger to prove prior art *non*-enablement. *See* Br. at 15 (citing *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012)). However, the CAFC in *Antor Media* did not say that patent owners are "in a better position" compared to *any* patent challenger on the issue of prior art enablement. Instead, the CAFC made the unremarkable observation that patent applicants during *ex parte* patent examination were better equipped than USPTO employees to challenge prior art enablement because it would be "overly cumbersome" for the USPTO to prove enablement of prior art which its examiners cite during the process. *See* 689 F.3d at 1288. As CM's Petition explained, the logic of *Antor Media* does not apply when the patent challenger is anyone other than the USPTO, as is the case here. *See* Pet. at 31-32.

Incredibly, Respondent, a large international corporation with over a thousand employees, numerous facilities and equipment, and access to myriad experts in the field, seeks to convince this Court that patent owners, such as independent inventors, start-ups, and small businesses, are better equipped to challenge the enablement of the very prior art that entities like

Respondent rely on to destroy patents. *See* Br. at 15-16. The mere fact that a presumption of prior art enablement makes it convenient for Respondent to undercut the valid patents awarded to innovators like CM does not make such an anti-patent presumption legally appropriate let alone consistent with the principles espoused by Article I, Section 8, Clause 8 of the U.S. Constitution. *See* Pet. at 3, 11-12.

**D. *Loper Bright* Applies to CAFC's Approval of Agency Re-Interpretation of the Law of Prior Art Enablement Under Sections 102 and 103 of the Patent Act**

The text of Sections 102 and 103 is silent regarding enablement. Unlike Section 112 of the Patent Act which specifically recites the word “enable” as it relates to an issued U.S. patent, Sections 102 and 103 do not explicitly mention enablement with respect to prior art publications. Absent statutory text from which the prior art enablement law could be read, the USPTO's interpretation of that law embodied in Sections 102 and 103 of the Patent Act is necessarily an exercise in interpreting ambiguous statutes.

Respondent instead concludes that the USPTO “faithfully applied the Federal Circuit's precedents.” Br. at 17. However, the only certainty regarding the CAFC's use of Fed. Cir. R. 36 is that it must have agreed with the USPTO's threshold prior art enablement determination in order to unjustly invalidate CM's patents. *See* Pet. at 38. As explained *supra*, the USPTO's prior art enablement standard and the stringent rebuttable presumption it places on patent holders is inconsistent with CAFC and CCPA precedent. *See* Pet. at 27-28.

Because the USPTO's agency decisions were not aligned with CAFC law, the only conclusion one could draw from the CAFC's Fed. Cir. R. 36 affirmance is that a federal appellate patent law court granted the USPTO, an administrative agency, the judicial task of interpreting Sections 102 and 103 to arrive at its own law of prior art enablement.

Because Sections 102 and 103 of the Patent Act are ambiguous regarding the applicable standard for prior art enablement and the USPTO did not follow CAFC law, the CAFC's summary affirmance of the USPTO's decisions pursuant to Fed. Cir. R. 36, necessarily "defer[ed] to an agency interpretation of the [federal patent] law...." *See Loper Bright*, 603 U.S. at 387, 413. For the same reasons this Court stated in *Loper Bright*, the CAFC's abdication of judicial responsibility under the expedient of Fed. Cir. R. 36 was an error that deprived CM of due process under the law.

### CONCLUSION

For these and all prior reasons provided by Petitioner's counsel, it is respectfully requested that the Petition be granted.

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