

No. 18-109

In the Supreme Court of the United States

ARIOSA DIAGNOSTICS, INC., PETITIONER

v.

ILLUMINA, INC.

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

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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QUESTION PRESENTED

Before 2011, an invention was ineligible for a patent if “the invention was described in * * * an application for patent, published under [35 U.S.C.] 122(b), by another filed in the United States before the invention by the applicant for patent.” 35 U.S.C. 102(e) (2006). The question presented is as follows:

Whether, under former Section 102(e), disclosures in a published application that refers back to an earlier-filed provisional application, see 35 U.S.C. 119(e) (2006), are prior art as of the filing date of the provisional application.

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This brief is submitted in response to the Court's order inviting the Solicitor General to express the views of the United States. In the view of the United States, the petition for a writ of certiorari should be denied.

STATEMENT

1. The Patent Act, 35 U.S.C. 1 *et seq.*, sets forth the basic requirements for granting and issuing patents. Except as otherwise specified, this brief refers to the version of the Patent Act that was in effect before the enactment of the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284 (2011), and to the 2006 edition of the United States Code.

a. Since 1994, the Patent Act has recognized two different types of patent applications: non-provisional applications and provisional applications. See Uruguay Round Agreements Act, Pub. L. No. 103-465, Tit. V, Subtit. C, § 532, 108 Stat. 4986-4988. A non-provisional

patent application must include, among other things, a written description of the invention and one or more claims setting forth the contours of the invention for which a patent is sought. 35 U.S.C. 111(a)(2); see 35 U.S.C. 112. Like a non-provisional application, a provisional application also must include a written description of the invention. 35 U.S.C. 111(b). But as its name suggests, a provisional application may be more informal than a non-provisional application, and it need not—and frequently does not—include claims.

The Patent Act contemplates that an applicant will often follow a provisional application with a later-filed non-provisional application that addresses the same subject matter. When an applicant submits a follow-on non-provisional application within 12 months after the provisional application was filed, the applicant may be able to claim priority to the date of the earlier-filed provisional application. If the prerequisites to such priority are satisfied, the U.S. Patent and Trademark Office (USPTO) will treat the non-provisional application as though it had been filed on the earlier date. But if the applicant does not file a follow-on non-provisional application (or request that the provisional application be treated as non-provisional) within that one-year period, the provisional application is considered abandoned, and the USPTO does not act on it. 35 U.S.C. 111(b)(5); see 35 U.S.C. 111(b)(8) (provisional applications are not subject to examination under Section 131).

Section 119(e)(1) sets forth the requirements that a non-provisional application must satisfy in order to be given the earlier filing date of a provisional application. Under that provision, a non-provisional application “for an invention disclosed in the manner provided by the

first paragraph of section 112 of this title 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). The first paragraph of Section 112, in turn, requires “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art” to make and use the invention. 35 U.S.C. 112.

The Federal Circuit accordingly has explained that, for priority purposes, “the written description of the provisional must adequately support the claims of the non-provisional application.” *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (2002), cert. denied, 537 U.S. 1232 (2003). In other words, the specification in the provisional application must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Id.* at 1295 (citation omitted). If a claim in a non-provisional application is not supported by disclosures in the provisional application, by contrast, the claim is not entitled to the benefit of the provisional application’s filing date. *Ibid.*

b. “To receive patent protection a claimed invention must, among other things, * * * be novel.” *Microsoft Corp. v. i4i Ltd. P’ship*, 564 U.S. 91, 96 (2011). In evaluating whether a claimed invention is novel, the USPTO’s patent examiners look to evidence regarding whether the invention’s subject-matter has already been made available to the public, for instance in scientific literature in the relevant field. Such evidence is referred to as “prior art.” See, *e.g.*, 35 U.S.C. 103(a).

Information disclosed in issued patents and in published patent applications may also qualify as prior art. The Patent Act provides:

A person shall be entitled to a patent unless * * * the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

35 U.S.C. 102(e). The dispute here centers on the first prong—in particular, what it means for an invention to be “described in * * * an application for a patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.”

The referenced provision, Section 122(b), generally requires the USPTO to publish a patent application shortly after 18 months have elapsed from the earliest filing date for which the application seeks a benefit. 35 U.S.C. 122(b)(1)(A). This publication requirement is subject to certain exceptions, including for applications that are no longer pending, applications subject to “a secrecy order,” and provisional applications. 35 U.S.C. 122(b)(2)(A)(i), (ii), and (iii). Under those provisions and the USPTO’s implementing regulations, when a petitioner files a provisional application *and* subsequently files a timely non-provisional application claiming priority to the provisional application, the non-provisional application will be published 18 months after the filing of the provisional application (or shortly thereafter). At that time, the USPTO publishes the current version of the application and also makes available to the public

any prior provisional or non-provisional applications incorporated by reference. 37 C.F.R. 1.14. For example, if a patent applicant filed a provisional application on January 1, 2010, and then a follow-on non-provisional application on December 31, both applications would be made available to the public on or shortly after July 1, 2011.

2. Petitioner and respondent are competitors in the field of genetic testing. Along with related entities, they have been involved in decades of patent disputes before the federal courts and the USPTO. See, e.g., *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, No. 12-cv-5501 (N.D. Cal. filed Oct. 25, 2012); *Illumina Inc. v. Ariosa Diagnostics, Inc.*, No. 14-cv-1921 (N.D. Cal. filed Apr. 25, 2014); *Illumina Inc. v. Ariosa Diagnostics, Inc.*, 15-cv-2216 (N.D. Cal. filed May 18, 2015).

a. The current dispute traces its origin to February 2000, when Dr. Jian-Bing Fan (on behalf of himself and two others) filed a provisional application setting forth ideas and initial research regarding a method for copying DNA sequences. Pet. App. 8a. One year later, in February 2001, Dr. Fan filed a non-provisional application that incorporated by reference the written description from the provisional application and added specific claims. *Ibid.*; see Pet. 16. In November 2002, the USPTO published Dr. Fan's non-provisional application, along with the provisional application to which it referred. Pet. App. 8a.

In September 2000—several months *after* Dr. Fan had filed his provisional application but *before* he filed his non-provisional application—respondent applied for a patent on a related technology. Pet. App. 5a-6a. That application was granted, and the USPTO issued U.S. Patent No. 7,955,794 (the '794 patent). *Id.* at 4a; see *id.* at 5a-6a.

b. Respondent (along with a related entity) filed suit against petitioner in federal court, alleging that petitioner's prenatal test for Down Syndrome and other genetic disorders infringed the '794 patent. Compl., at 1-5, *Illumina, supra*, 14-cv-1921 (Apr. 25, 2014); see Pet. App. 5a. In response, petitioner sought inter partes review before the Patent Trial and Appeal Board (Board), challenging the validity of respondent's patent. Pet. App. 4a. Petitioner argued that the '794 patent was anticipated by Dr. Fan's February 2001 non-provisional application, and that the non-provisional application should be considered prior art as of the filing date of his February 2000 provisional application. *Id.* at 9a.

At the time petitioner sought inter partes review, the Board's precedent established that, under Section 102(e), a patent or application asserting priority to an earlier provisional application could be prior art as of the date of the provisional application, even if the claims in the prior-art patent or application were not supported by the provisional application. *Ex parte Yamaguchi*, No. 2007-4412, 2008 WL 4233306 (B.P.A.I. Aug. 29, 2008). In *Yamaguchi*, the Board's predecessor explained that a provisional application is *itself* an "application for patent" within the meaning of Section 102(e). *Id.* at *4. The Board recognized that an "intervening step"—the submission of a non-provisional application—is required before the provisional application can be published. *Id.* at *7. Once that occurs, however, Board precedent treated the provisional application as "a constructive reduction to practice" that "serves as prima facie evidence that the applicant was in possession of the subject matter disclosed in the provisional application when it was filed." *Ibid.*

While petitioner’s inter partes review proceeding was pending, however, the Federal Circuit overturned the *Yamaguchi* rule in *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (2015). In *Dynamic Drinkware*, the court held that when a party seeks to invalidate a patent on the ground that another, so-called “reference patent” is prior art as of the date of the reference patent’s provisional application, “the disclosure of the provisional application [must] provide[] support for the claims in the reference patent” that is being relied on as prior art. *Id.* at 1381. In other words, the Federal Circuit explained, the “provisional application’s effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional.” *Id.* at 1382.

In this case, following the Federal Circuit’s decision in *Dynamic Drinkware*, the Board rejected petitioner’s challenge to the ’794 patent. Pet. App. 3a-20a. Under the Federal Circuit’s approach, the Board explained, a patent may be treated as prior art as of the filing date of a provisional application only if the patent can “satisfy the requirements of 35 U.S.C. § 119(e)(1)” —*i.e.*, the requirements for priority, including that the patent’s claims are supported by the earlier application. *Id.* at 13a. The Board further explained that “the material being relied upon as teaching the subject matter of the challenged claims must be carried through from that earlier filed application to the patent document being used against the claim.” *Id.* at 14a. Petitioner argued that the *Dynamic Drinkware* rule applied only to *issued* patents, not to patent *applications*. But the Board agreed with respondent that “nothing in *Dynamic Drinkware* * * * suggests that the rationale applies only to issued patents.” *Id.* at 18a; see *id.* at 18a-19a.

The Board further determined that petitioner had not shown that the claims in Dr. Fan’s February 2001 non-provisional application were supported by his February 2000 provisional application. Pet. App. 17a; see *ibid.* (petitioner did not “demonstrate that the claims of [the non-provisional application] were supported by the disclosure of the [February 2000] provisional in compliance with 35 U.S.C. § 112, first paragraph”). The Board therefore concluded that petitioner had “failed to meet its burden of demonstrating that Fan is prior art to the ’794 patent.” *Id.* at 19a.

c. Petitioner appealed to the Federal Circuit. While that appeal was pending, the court of appeals extended its ruling in *Dynamic Drinkware*, which had addressed a contention that an issued patent was prior art, to assertions of prior-art status based on published patent applications. *Amgen Inc. v. Sanofi*, 872 F.3d 1367 (Fed Cir. 2017), cert. denied, 139 S. Ct. 787 (2019). In this case, the Federal Circuit affirmed the Board’s decision rejecting petitioner’s invalidity argument. Pet. App. 1a-2a. In a one-paragraph unpublished decision, the court stated that “the Board did not err in determining” that Dr. Fan’s non-provisional application “is not prior art.” *Id.* at 2a.

DISCUSSION

The question presented by the certiorari petition is whether, under the pre-2011 version of the Patent Act, a non-provisional patent application may claim the priority date of an earlier provisional application for purposes of determining whether the non-provisional application is prior art under Section 102(e). Under Section 102(e)(1), the validity of respondent’s patent depended on whether respondent’s patented “invention was de-

scribed in * * * an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent [*i.e.*, respondent].” 35 U.S.C. 102(e)(1). There is no dispute that petitioner’s non-provisional application was “published under section 122(b).” Petitioner argues that, for purposes of determining whether Dr. Fan’s “application for patent” was “filed * * * before” respondent’s invention, his non-provisional application should be given the February 2000 filing date of his earlier provisional application.

The Federal Circuit rejected that argument, holding that “the Board did not err in determining that Fan is not prior art.” Pet. App. 2a. The court’s one-paragraph opinion did not explain the basis for that conclusion. The Federal Circuit had previously held, however, that the determination whether to give a non-provisional application the filing date of an earlier provisional application turns on whether the requirements of Section 119(e) have been satisfied.

Although the parties dispute whether the Federal Circuit’s conclusion was correct, they agree that the resolution of this case turns on the proper interpretation of Section 119(e). Petitioner argues that, to receive priority under Section 119(e), a later-filed non-provisional application must simply *describe* the same invention that was disclosed in the earlier-filed provisional application. Respondent argues, consistent with Federal Circuit precedent, that Section 119(e) grants priority only if the provisional application supports the *claims* of the non-provisional application as well.

In contrast to the parties, the United States does not believe that Section 119(e) bears on prior-art determinations under Section 102(e). In our view, although

Section 119(e) does not provide a basis for treating a non-provisional application as prior art as of the date of an earlier-filed provisional application, a provisional application may *itself* qualify as prior art under Section 102(e). If the provisional application has been published in connection with a related non-provisional application, then it may qualify under Section 102(e) as “an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.”

The Federal Circuit’s decision did not address that argument, however, and this case is accordingly not an appropriate vehicle in which to consider it. The fact that this case involves the pre-2011 versions of the relevant Patent Act provisions also weighs against this Court’s review. The petition for a writ of certiorari should be denied.

A. A Patent Application’s Status As Prior Art Under Section 102(e) Does Not Depend On Establishing Priority Under Section 119(e)

1. Under Section 102(e), an invention cannot be patented if it “was described in * * * an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent.” Petitioner argues (Pet. 22) that Dr. Fan’s non-provisional application, which was filed *after* respondent’s application, nevertheless qualifies as “an application * * * filed in the United States *before* the invention by the applicant [*i.e.*, respondent].” 35 U.S.C. 102(e) (emphasis added). Although Dr. Fan’s non-provisional application was filed in February 2001, several months after respondent’s September 2000 application, petitioner argues that the priority rules set forth in Section 119(e) allow Dr. Fan’s non-provisional application to

claim the earlier filing date of his provisional application, which was filed in February 2000. See Pet. 22.

Like petitioner, the Federal Circuit has viewed an application's eligibility for a right of priority under Section 119(e) as also determining whether the application may count as prior art under Section 102(e). See *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (2017), cert. denied, 139 S. Ct. 787 (2019); see also *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1379-1380 (Fed. Cir. 2015) (evaluating priority under a related rule, 35 U.S.C. 120). Petitioner's disagreement with the Federal Circuit's approach goes not to the *relevance* of Section 119(e), but to the court's view of what Section 119(e) *requires*. The Federal Circuit has held that a non-provisional application is entitled to priority as of an earlier-filed provisional application only where "the provisional application[] provided written description support for the claims of the [non-provisional] application[]." *Amgen*, 872 F.3d at 1380. In petitioner's view, by contrast, it suffices if the provisional application contains a "*description* of [the] invention in [the] published patent application"—thus making it "the same disclosure"—"regardless of whether the earlier application supports the claims of the published patent application." Pet. 22. This case has accordingly been litigated as a dispute about the meaning of Section 119(e).

In the view of the United States, however, Section 119(e) has no bearing on the date on which a patent application qualifies as prior art under Section 102(e). Section 119 is directed to the separate question of when patent applicants are entitled to claim priority for *their own* applications. There is no textual basis for using that provision's priority rules to backdate patent applications sought to be relied on as prior art under Section

102(e). Consequently, both the Federal Circuit and the parties have approached the Section 102(e) inquiry from the wrong direction.

Section 119 is entitled “Benefit of earlier filing date; right of priority.” 35 U.S.C. 119 (emphasis omitted). Subsections (a)-(d) and (f) address the circumstances in which an applicant can claim a right of priority that dates to an earlier application that the applicant has filed in a foreign country. Subsection (a) provides that, in specified circumstances, a patent application that is filed domestically within 12 months after an application was filed in a foreign country “shall have the same effect as the same application would have if filed in this country on the date on which the [foreign] application” was filed. Subsections (b)-(d) and (f) make clear that the “effect” referred to by Subsection (a) is the establishment of a right of priority. Subsection (b)(1) describes conditions necessary for an application to be “entitled to this right of priority”; Subsection (c) states that priority does not apply if a different, earlier foreign application can serve “as a basis for claiming a right of priority”; Subsection (d) provides that “the right of priority under this section” may be predicated on foreign applications for inventors’ certificates; and Subsection (f) provides that foreign applications for plant-breeder’s rights “shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents.”

Subsection (e) similarly addresses the circumstances under which a right of priority can be based on the applicant’s own earlier-filed application—in particular, a domestic provisional application. As relevant here, it states that a non-provisional application that is filed within 12 months after 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). That language is in all relevant respects identical to the language of Subsection (a) establishing the right of priority associated with foreign applications, and it has the same scope and effect: Subsection (e) gives an applicant the “benefit” of an earlier filing date. *Ibid.* Other Patent Act provisions that cross-reference Section 119 thus refer to the “priority” of a filing date established under that section. See 35 U.S.C. 172 (“The right of priority provided for by section 119(e) of this title shall not apply to designs.”); see also 35 U.S.C. 154(a)(3) (“Priority under section 119 * * * shall not be taken into account in determining the term of a patent.”).

A priority inquiry under Section 119(e) focuses on whether a patent applicant has provided sufficiently clear and specific disclosures in a provisional application to support the claims in a later follow-on application. The disclosures in the provisional application thus must be made “in the manner provided by the first paragraph of section 112,” 35 U.S.C. 119(e)(1)—namely, there must be “a written description of the invention * * * in such full, clear, concise, and exact terms as to enable any person skilled in the art” to make and use the invention. 35 U.S.C. 112. To satisfy that standard, “the written description of the provisional must adequately support the claims of the non-provisional application.” *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002), cert. denied, 537 U.S. 1232 (2003). Moreover, every application in a chain of applications must identify all of the applications on which it relies and must state the relationship between them. See *Droplets, Inc. v. E*Trade Bank*, 887 F.3d 1309, 1315-1317 (Fed. Cir. 2018). These stringent rules serve

an “important public policy,” by enabling the public to easily ascertain the filing date on which a patent applicant relies. *Id.* at 1316 (citation omitted); see *id.* at 1316-1317; see also 37 C.F.R. 1.78 (PTO regulations implementing Section 119(e)).

The prior-art inquiry under Section 102(e), by contrast, focuses on whether a claimed invention is new. See *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 400 (1926) (Subject to certain exceptions, “one really must be the first inventor in order to be entitled to a patent.”); see also *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 255 (1965) (original version of Section 102(e) was adopted to codify the rule in *Alexander Milburn*). A patent application is simply one of many publicly available materials that may be relevant to that inquiry. For that purpose, a patent application submitted by person *A* may show that person *B*’s claimed invention is not new, and therefore is not patentable, even if person *A* likewise is not entitled to a patent.

“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (citation omitted). Given that Section 102(e) focuses on questions of *novelty* and *public disclosure*, imposing on that inquiry the stringent claim-based requirements set out in Section 119(e) therefore would serve no purpose. Nor does any other Patent Act provision suggest that the applicability of Section 102(e) should turn on whether the applicant named in a prior-art application satisfied Section 119(e).

In particular, Section 119(e)(1) states that, where specified requirements are satisfied, a non-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) (emphasis added). The italicized language refers to the invention described in the provisional and later non-provisional applications. That language does not suggest that Section 119(e)’s backdating rule can properly be used (as petitioner seeks to use it here) to determine the patentability of a *different* applicant’s invention.

In short, whether an application is entitled to the “right of priority” provided in Section 119, and whether it qualifies as prior art under Section 102(e), are separate inquiries that serve distinct goals. Contrary to the parties’ assumptions, the answer to the former question does not bear on the latter.

2. Although Section 119(e) does not link provisional applications with non-provisional applications for prior-art purposes, there are circumstances in which a provisional application may *itself* qualify as prior art. Any “application for patent, published under section 122(b), by another” that is “filed in the United States before the invention by the applicant for patent” is prior art under 35 U.S.C. 102(e)(1). When a provisional application is made public by the USPTO in conjunction with the publication of a follow-on non-provisional application, the provisional application is “an application * * * published under section 122(b),” and therefore constitutes prior art as of its own filing date.

Provisional patent applications are “application[s]” within the meaning of Section 102(e). See 35 U.S.C. 111(b)(8) (“The provisions of this title relating to applications for patent shall apply to provisional applications

for patent, except as otherwise provided, and except [for specified purposes].”). The Patent Act generally requires the USPTO to publish patent applications 18 months after the earliest date to which they claim priority; it also grants the agency’s Director broad authority to determine the procedures by which such applications shall be published. See 35 U.S.C. 122(b)(1)(A). Under that grant of authority, the USPTO’s longstanding practice is that when an application is published, any prior provisional (or non-provisional) applications referred to in the application are also made available to the public at the same time. See 37 C.F.R. 1.14(a)(1)(iv)-(vi). A provisional application is thus “an application * * * published under section 122(b),” within the meaning of Section 102(e), when it is made public in conjunction with the publication of the later-filed application that refers back to it.

To be sure, Section 122(b) specifies that several types of applications “shall not be published,” including “a provisional application filed under section 111(b).” 35 U.S.C. 122(b)(2)(A)(iii). That exception to the general publication requirement, however, is directed at provisional applications that have been “abandoned,” 35 U.S.C. 111(b)(5)—that is, provisional applications that have not been followed by a non-provisional application. See H.R. Rep. No. 464, 106th Cong., 1st Sess. 129 n.15 (1999) (“Pursuant to 35 U.S.C. § 111(b)(5), all provisional applications are abandoned 12 months after the date of their filing; accordingly, they are not subject to the 18-month publication requirement.”). Where, as here, a provisional application has been incorporated by reference into a later non-provisional application, the referenced provisional application effectively becomes part of the non-provisional application. Under those

circumstances, the USPTO's obligation to publish the non-provisional application encompasses the contents of the provisional application. Section 102(e)'s reference to applications "published under section 122(b)" thus does not suggest that Congress intended to differentiate among the various applications made public by the USPTO. Rather, it simply distinguishes between applications that are made public *by the USPTO* and those that become public *by some other means*.

This approach to Section 102(e), in which the critical inquiry is whether a provisional application is itself prior art under that provision, is consistent with agency precedent. In *Ex parte Yamaguchi*, No. 2007-4412, 2008 WL 4233306 (B.P.A.I. Aug. 29, 2008), the Board's predecessor explained that "the statutory scheme of Title 35 indicates that Congress intended for 'applications for patent' under § 102(e) to apply to both regular utility applications and provisional applications." *Id.* at *9. "Like a regular utility application," a provisional application therefore "is considered prior art for all that it teaches." *Id.* at *7; see *id.* at *6 (upon publication or issuance of patent on non-provisional application, "not only is the [non-provisional] application laid open to the public, but its corresponding provisional application is likewise made available to the public"). This approach also comports with the longstanding patent-law principle that the prior-art inquiry focuses primarily on whether a patent applicant was actually the first inventor of an invention claimed in a patent. See *Alexander Milburn*, 270 U.S. at 402. And, in contrast to the approach pursued by the parties in this case, it respects the distinct statutory roles played by principles of priority and prior art.

B. The Decision Below Does Not Warrant This Court's Review

Although the Federal Circuit has erred by relying on Section 119(e) in determining whether to treat a non-provisional application as prior art under Section 102(e), the decision below does not warrant this Court's review. The unpublished, one-paragraph decision correctly resolved the specific question at issue: whether Dr. Fan's non-provisional application qualified as prior art with respect to the '794 patent. Because the non-provisional application was filed in February 2001, several months after respondent's application was filed in September 2000, the Federal Circuit was correct to hold that the non-provisional application was not itself prior art. See Pet. App. 2a.

While governing Federal Circuit precedents have analyzed prior-art questions under Section 102(e) by looking to an inapplicable statutory provision, the petition for a writ of certiorari does not take issue with that underlying approach. The petition is predicated on the theory that Dr. Fan's later-filed non-provisional application is the pertinent prior art; that his provisional application is relevant only insofar as it affects the effective filing date of the non-provisional application; and that Section 119(e) supports treating the non-provisional application itself as prior art. See, *e.g.*, Reply Br. 1 (describing Section 119(e) as "the statutory provision at the center of the dispute"); *id.* at 3 ("It is undisputed that, before the AIA, a patent challenger could use § 119(e)(1) to establish that an invalidating disclosure in a reference patent or published application should be treated as prior art as of the date of an earlier provisional application.").

The Federal Circuit has not directly addressed the question whether a provisional application may *itself* qualify as prior art under Section 102(e)(1), without recourse to Section 119(e). If the court of appeals in a future case were to hold, consistent with the foregoing analysis, that a provisional application made public by the USPTO in connection with the publication of a follow-on non-provisional application may qualify as prior art under Section 102(e), the court's position regarding the applicability of Section 119(e) would lose most if not all of its practical significance. There is accordingly no sound reason for this Court to take up the latter issue before the Federal Circuit has addressed and resolved the former question.

In addition, the version of the Patent Act that is at issue in this case has been amended by the AIA in ways that may be relevant to the relationship between provisional applications and prior-art determinations. As amended by the AIA, Section 102 treats as prior art "an application for patent published *or deemed published* under section 122(b), * * * [which] was *effectively* filed before the *effective* filing date of the claimed invention." 35 U.S.C. 102(a)(2) (2012) (emphases added). In particular, current Section 102(a)(2)'s use of the term "effectively filed" at least suggests that a patent application that is asserted to constitute prior art sometimes may be treated as filed on a date other than its actual filing date. By contrast, the pre-AIA provision (Section 102(e)(1)) that governs this case provides no textual support for that approach.

While the pre-AIA version of the statute continues to govern a significant number of ongoing patent cases, those cases represent a closed universe, and the importance of pre-AIA law for the issue in this case will

diminish going forward. Even if this Court’s intervention ultimately becomes necessary, it would be preferable for the Court to address the prior-art status of provisional patent applications in a case arising under current law, by which all future disputes will be governed. Cf. Br. in Opp. 13-14 (discussing effect of “new § 102”); Reply Br. 5-6 (similar).

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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