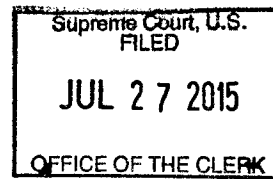


14-115

No. 15-__



IN THE
Supreme Court of the United States

TYCO HEALTHCARE GROUP LP AND
UNITED STATES SURGICAL CORPORATION,

Petitioners,

v.

ETHICON ENDO-SURGERY, INC.,

Respondent.

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

PETITION FOR A WRIT OF CERTIORARI

J. MICHAEL JAKES
Counsel of Record
KATHLEEN A. DALEY
JASON L. ROMRELL
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 New York Avenue, NW
Washington, DC 20001
(202) 408-4000
mike.jakes@finnegan.com
Counsel for Petitioners

July 27, 2015

BLANK PAGE

QUESTION PRESENTED

Title 35 U.S.C. § 103(a) (2006) prohibits the issuance of a patent where “the differences between the subject matter sought to be patented and *the prior art* are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill in the art to which said subject matter pertains.” (Emphases added). This statute will continue to govern hundreds of thousands of patents (those with effective filing dates before March 16, 2013) for many years to come.

The question presented is whether a mere conception that was neither known to the public nor reduced to practice at the time a patented invention was made is “prior art” to that invention under the pre-2013 version of 35 U.S.C. § 103.

PARTIES TO THE PROCEEDING

The parties to the proceeding below are Petitioners Tyco Healthcare Group LP and United States Surgical Corporation and Respondent Ethicon Endo-Surgery, Inc.

**RULE 29.6 CORPORATE
DISCLOSURE STATEMENT**

The sole parent corporation or publicly held company that owns 10 percent or more of the stock of Covidien LP (formerly known as Tyco Healthcare Group LP) is Medtronic PLC.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
PARTIES TO THE PROCEEDING	ii
RULE 29.6 CORPORATE DISCLOSURE STATEMENT	ii
PETITION FOR A WRIT OF CERTIORARI.....	1
OPINIONS BELOW	1
JURISDICTION	1
STATUTORY PROVISIONS INVOLVED.....	1
INTRODUCTION	3
STATEMENT OF THE CASE	6
I. Factual Background	6
II. District Court Proceedings	9
III. The Federal Circuit’s Decision	11
REASONS FOR GRANTING THE PETITION..	12
I. The Federal Circuit’s Decision Conflicts with the Text of 35 U.S.C. § 103	14
II. The Federal Circuit’s Decision Conflicts with This Court’s Precedent.....	20
III. The Federal Circuit’s Decision Conflicts with Its Own Precedent.....	23
IV. Unless Reversed, the Federal Circuit’s Decision Will Have Far-Reaching Negative Effects on Patent Holders.....	26
CONCLUSION	29

TABLE OF CONTENTS—Continued

APPENDIX	Page
APPENDIX A: Federal Circuit Opinion (December 4, 2014).....	1a
APPENDIX B: District Court Memorandum of Decision and Order (March 28, 2013).....	20a
APPENDIX C: Federal Circuit Rehearing Denial (February 17, 2015).....	134a

TABLE OF AUTHORITIES

CASES	Page(s)
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010)	25
<i>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.</i> , 489 U.S. 141 (1989)	13, 21, 28
<i>Cardiac Pacemakers, Inc. v. Cordis Corp.</i> , 549 F. Supp. 564 (D. Minn.), <i>aff'd</i> , 690 F.2d 665 (8th Cir. 1982)	24
<i>eBay Inc. v. MercExchange, L.L.C.</i> , 547 U.S. 388 (2006)	26
<i>Global-Tech Appliances, Inc. v. SEB S.A.</i> , 131 S. Ct. 2060 (2011)	25
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	<i>passim</i>
<i>Hazeltine Research, Inc. v. Brenner</i> , 382 U.S. 252 (1965)	19, 21, 22
<i>Hotchkiss v. Greenwood</i> , 11 How. 248 (1850)	5, 14
<i>In re Bass</i> , 474 F.2d 1276 (CCPA 1973)	19
<i>In re Clemens</i> , 622 F.2d 1029 (CCPA 1980)	19
<i>Kimberly-Clark Corp. v. Johnson & Johnson</i> , 745 F.2d 1437 (Fed. Cir. 1984)	<i>passim</i>
<i>Kimble v. Marvel Entertainment, LLC</i> , 576 U.S. ___, No. 13-720 (June 22, 2015)	25

TABLE OF AUTHORITIES—Continued

	Page(s)
<i>KSR International Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	27
<i>Leocal v. Ashcroft</i> , 543 U.S. 1 (2004)	16
<i>Limelight Networks, Inc. v. Akamai Technologies, Inc.</i> , 134 S. Ct. 2111 (2014)	26
<i>Marconi Wireless Telegraph Co. of America v. United States</i> , 320 U.S. 1 (1943)	16, 24
<i>Mycogen Plant Science, Inc. v. Monsanto Co.</i> , 243 F.3d 1316 (Fed. Cir. 2001).....	16
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 134 S. Ct. 2120 (2014)	26
<i>Pfaff v. Wells Electronics, Inc.</i> , 525 U.S. 55 (1998)	15, 16
<i>Solvay S.A. v. Honeywell International, Inc.</i> , 742 F.3d 998 (Fed. Cir. 2014).....	16
<i>Sutter Products Co. v. Pettibone Mulliken Corp.</i> , 428 F.2d 639 (7th Cir. 1970)	24
 STATUTES	
28 U.S.C. § 1254(1) (2014)	1
35 U.S.C. § 102 (2006)	15, 20
35 U.S.C. § 102(a) (2014)	19
35 U.S.C. § 102(c) (2006).....	20
35 U.S.C. § 102(e) (2006)	19, 21

TABLE OF AUTHORITIES—Continued

	Page(s)
35 U.S.C. § 102(g) (2006)	<i>passim</i>
35 U.S.C. § 102(g)(2) (2006).....	4, 15, 16
35 U.S.C. § 103 (2006)	<i>passim</i>
35 U.S.C. § 103(a) (2006)	<i>passim</i>
35 U.S.C. § 103(c) (2006).....	20
35 U.S.C. § 103(c)(1) (2006)	18, 20
35 U.S.C. § 112 (2006)	26
35 U.S.C. § 271(b) (2006)	26
35 U.S.C. § 283 (2006)	26
Cooperative Research and Technology Enhancement (CREATE) Act of 2004, Pub. L. 108-453, 118 Stat. 3596 (2004).	18
Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3, 125 Stat. 284, 285–93 (2011)	3, 20
Patent Law Amendments Act, Pub. L. No. 98- 622, 98 Stat. 3383, 3384 (1984).....	18
OTHER AUTHORITIES	
157 Cong. Rec. S5319-21 (daily ed. Sept. 6, 2011).....	29
Hearings on H.R. 3760 Before Subcomm. No. 3 of the House Comm. on the Judiciary, 82d Cong., 1st Sess. (1951).....	16, 21
Manual of Patent Examining Procedure § 2138.....	25

TABLE OF AUTHORITIES—Continued

	Page(s)
Section-by-Section Analysis: Patent Law Amendments Act of 1984, 130 Cong. Rec. 28069, 28071 (Oct. 1, 1984), <i>reprinted in</i> 1984 U.S.C.C.A.N. 5827, 5833	18

PETITION FOR A WRIT OF CERTIORARI

Petitioners Tyco Healthcare Group LP and United States Surgical Corporation (collectively “Tyco”) respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit (Pet. App. 1a–19a) is reported at 774 F.3d 968 (Fed. Cir. 2014). The opinion of the District Court for the District of Connecticut (Pet. App. 20a–133a) is reported at 936 F. Supp. 2d 30 (D. Conn. 2013). The order of the court of appeals denying rehearing and rehearing en banc (Pet. App. 134a–135a) is unreported.

JURISDICTION

The Federal Circuit entered judgment on December 14, 2014, and denied Petitioners’ request for rehearing on February 27, 2015. On May 18, 2015, Chief Justice Roberts granted an application to extend the time to file a petition for a writ of certiorari until July 27, 2015. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1) (2014).

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 102(g) (2006) provides that:

A person shall be entitled to a patent unless

...

(2) before such person’s invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of

invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. § 103 (2006) provides that:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

...

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

INTRODUCTION

This case raises a purely legal question of broad and general importance on the interpretation of a federal statute: can a mere conception that has not been reduced to practice at the time a patentee’s invention is made constitute “prior art” for determining obviousness under the pre-America Invents Act (AIA) version¹ of 35 U.S.C. § 103 (2006)? The answer affects the validity of hundreds of thousands of patents that are still governed by the pre-AIA patent statute and will continue to be governed thereunder for many years to come. The Federal Circuit’s decision that such a secret conception can constitute prior art and thus invalidate a patent for obviousness contradicts the text of the statute, conflicts with this Court’s prior decisions, and conflicts with the Federal Circuit’s own precedent. As a result, this Court should grant certiorari to review the decision.

Section 103—the nonobviousness requirement—denies patent protection “if the differences between the subject matter sought to be patented and the *prior* art are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2006) (emphases added); *see also Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966) (a patent may not be obtained if “the difference between the new

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3, 125 Stat. 284, 285–93 (2011) (“AIA”), moved the United States from a “first-to-invent” system to a “first-inventor-to-file” system. Nevertheless, the pre-AIA patent statute discussed in this petition still applies to patents and applications with an effective filing date before March 16, 2013, including Tyco’s patents at issue here. *See* AIA, 125 Stat. at 293.

thing and what was *known before* is not considered sufficiently great to warrant a patent” (emphasis added)).

Here, the Federal Circuit held that Respondent Ethicon Endo-Surgery, Inc.’s (Ethicon) unfinished and secret prototype was § 103 “prior art” to Tyco’s patents. At the time of Tyco’s invention, however, Ethicon had not yet invented anything because it had not yet reduced its prototype to practice. In fact, at the time of Tyco’s invention, Ethicon had not yet offered its prototype for sale, had not yet filed a patent application, and had not yet described the invention in any printed publication. Ethicon’s unfinished prototype was, at most, a conception. Nevertheless, the court of appeals held, for the very first time, that a secret conception that had not yet been reduced to practice is prior art under § 103.

The Federal Circuit based its decision on the standard in 35 U.S.C. § 102(g)(2) (2006). Under § 102(g), an issued patent can be invalidated by the same invention “made in this country by another inventor” where that inventor either: (1) reduced the invention to practice first; or (2) conceived of the invention first and was diligent in reducing it to practice. Section 102(g) thus authorizes a legal conclusion of prior inventorship when the first person to conceive works diligently to a later reduction to practice of the *same* invention. Congress specifically designed § 102(g) so that the precise timing of the reduction to practice would not be the decisive factor in assigning “true” inventorship, so long as a reduction to practice diligently occurred.

Section 102(g) is a completely separate inquiry from obviousness under § 103 and serves a distinct purpose. Section 102(g) answers the question: who is the first inventor when there are competing conceptions? The answer has nothing to do with what would have been

obvious from the prior art that existed at the time. Section 103, by contrast, asks a different question: what would have been obvious to a person having ordinary skill in the art at the time of the patented invention? But the Federal Circuit's new rule and change to the previously settled law allows the outcome of the § 102(g) inquiry to dictate the answer to the § 103 question. The rule thus allows art that was created *after* the claimed invention was made to drive an obviousness finding. Nothing in § 102(g) or § 103 justifies such a sweeping change. The Federal Circuit's holding cannot be squared with § 103's plain language, which includes both a temporal requirement and a requirement that obviousness must be to a person having ordinary skill. To qualify as prior art under § 103, the work of another inventor must actually exist "at the time the [patentee's] invention was made." And to "exist" under § 102(g), it must first be reduced to practice.

The Federal Circuit's per se rule converting every § 102(g) invention into § 103 prior art conflicts with this Court's prior precedent holding that § 103 "place[s] emphasis on the pertinent art *existing at the time the invention was made.*" See *Graham*, 383 U.S. at 14 (emphasis added) (citing *Hotchkiss v. Greenwood*, 11 How. 248 (1850)). The new rule likewise conflicts with the precedent of the Federal Circuit itself: in *Kimberly-Clark Corp. v. Johnson & Johnson*, the Federal Circuit faithfully followed § 103's temporal requirement, making clear that a prototype that has not been reduced to practice is not § 103 prior art. 745 F.2d 1437, 1444–45 (Fed. Cir. 1984).

Additionally, the Federal Circuit's new rule is the wrong direction to propel litigants at a time when Congress has decreed that § 102(g) inventorship should eventually have no role at all in our patent system. In

moving the United States to a “first-to-file” system, Congress dismantled secret prior art altogether. But the old law still applies to hundreds of thousands of patents. This Court should end the Federal Circuit’s unwarranted expansion of § 102(g).

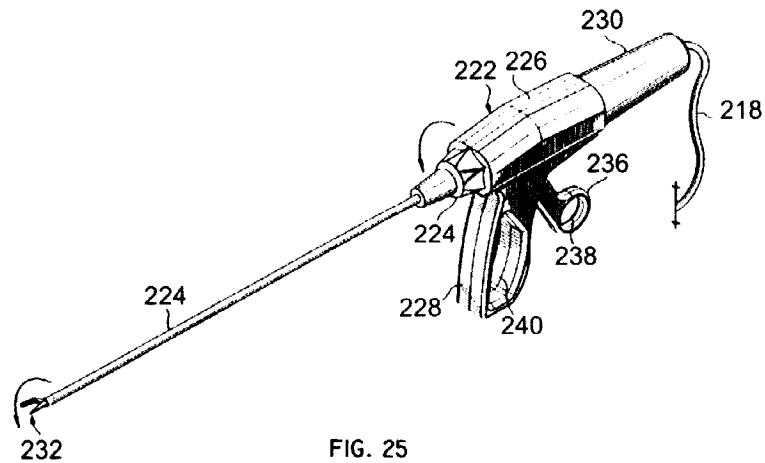
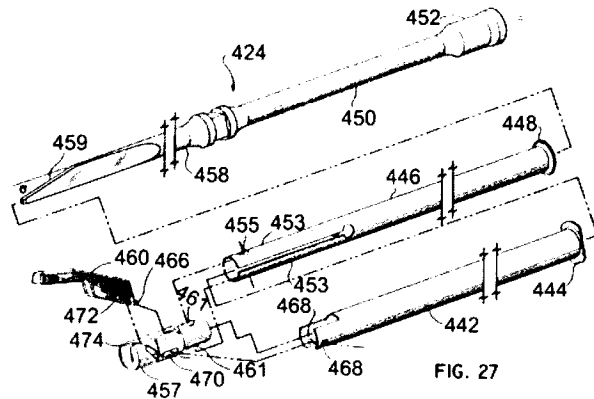
STATEMENT OF THE CASE

I. Factual Background

This case involves medical instruments that use ultrasonic energy to cut and seal blood vessels during surgery. In the mid-1990s, there was a pressing need for ultrasonic surgical instruments that could fit through a 5-millimeter trocar. A trocar holds open an incision in the patient and acts as a port for inserting the blade end of a surgical instrument. Smaller instruments enable smaller incisions, shorter hospitalizations, less post-operative pain, and a much smaller area of scarring. Pet. App. 24a–25a.

Petitioner Tyco and Respondent Ethicon both raced to meet this need. But their paths diverged widely. In late 1996, Tyco began developing an ultrasonic surgical device—the “Ultra Shear”—that could fit within a 5-millimeter trocar. Prior-art devices were incompatible with a 5-millimeter trocar and instead could use only a 10-millimeter trocar. Tyco crossed the finish line first on March 10, 1997, when it successfully tested its Ultra Shear prototype. Tyco filed a patent application in August 1997, and all three of Tyco’s asserted patents in this case—U.S. Patent No. 6,063,050 (the ’050 patent), U.S. Patent No. 6,468,286 (the ’286 patent), and U.S. Patent No. 6,682,544 (the ’544 patent)—claim priority to that original application.

Tyco's patents cover revolutionary improvements over the prior art. For one, Tyco's patented technology uses an innovative tube-within-a-tube design. The ultrasonic vibration coupler runs down the center of the device surrounded by two concentric tubes.



See '050 patent at Figs. 25, 27 (annotations added). The inner tube (actuating tube) moves forward and back to open and close the clamp at the distal end of the device. By using the two-tube design to open and close the clamp, rather than the prior technique of a separate rod running down the center of the device,

the strength of the device over the extension could be increased and the overall diameter reduced to fit down a 5-millimeter trocar.

Shrinking the diameter of the shaft, however, was only one step in the process of developing an effective 5-millimeter ultrasonic device. There must also be a mechanism that provides enough strength and balance to operate the clamp. Enter Tyco's dual-cam structure, which attaches both sides of the clamp to the inner tube. The cam members on each side of the clamp fit into cam slots on the inner tube and move in the path of the slots as the inner tube is moved forward and back to open and close the clamp against the blade. As Tyco first discovered—and Ethicon later realized—this dual-cam mechanism made a 5-millimeter device workable.

Tyco's patented technology also enabled other advancements. For example, Tyco's patented curved-blade design created better visibility and improved cutting action. The '050, '286, and '544 patents each contain claims directed to a dual-cam or curved-blade feature.

While Tyco was successfully inventing its new 5-millimeter ultrasonic surgical device, Ethicon was struggling to create its own. Ethicon's efforts began with its November 1995 acquisition of Ultracision, which already had a 10-millimeter device on the market. Earlier that year, Ultracision had set out to design a 5-millimeter ultrasonic instrument that featured a small straight blade and a single-tab clamp arm. The Ultracision prototype, however, could not effectively and reliably cut and coagulate (seal) tissue. Ethicon's project design team tried to fix the problem by modifying several design parameters, but their efforts were unsuccessful.

Eventually, Ethicon's engineers made changes to the clamp-arm attachment configuration, the rotation knob, and the handle of the Ultracision prototype. Pet. App. 59a. Ethicon relied on a November 22, 1996, drawing as showing these changes, and claimed to have made a physical prototype corresponding to the drawing by December 1996. The district court referred to this work as the "Ethicon Prototype." *Id.*

Like the Ultracision prototype, the Ethicon Prototype proved unworkable. From April 1997 to July 1997, Ethicon conducted numerous tests on goats, which resulted in multiple failures of the Ethicon Prototype, including "charring, trouble grasping, generator lock out, and incidences of intraoperative hemorrhage." Pet. App. 73a. So in July 1997, Ethicon's design team went back to the drawing board, eventually recognizing that its single-tab design would not work. Ethicon's team considered forty ideas related to a new clamp-arm design and ultimately decided to adopt a dual-cam design in August 1997—the same dual-cam design that Tyco had successfully invented months earlier. This fundamental design choice finally enabled Ethicon to develop and market its own 5-millimeter ultrasonic surgical devices.

II. District Court Proceedings

Tyco sued Ethicon in October 2004 for infringing the '050, '286, and '544 patents. In 2007, the district court granted summary judgment that Ethicon's ultrasonic surgical devices infringed claims 1, 5, and 9 of the '050 patent and claims 1, 6, 7, and 15 of the '286 patent. Pet. App. 26a.

After a bench trial, the district court set forth its findings and conclusions on infringement, validity, and remedies. The court found that Tyco had proven

infringement of the remaining asserted claims: claims 10–12 of the '050 patent, claims 8–14 of the '286 patent, and claims 1–3, 6, 8–13, 16, 18, and 23–25 of the '544 patent. Pet. App. 52a. Ethicon did not challenge these infringement findings on appeal.

Ethicon relied on several invalidity theories at trial. First, it contended that some of the claims were invalid under § 102(g) because Ethicon was both first to conceive and first to actually reduce to practice Tyco's claimed inventions. Pet. App. 53a. The district court rejected this theory, finding that Ethicon failed to prove that it reduced the Ethicon Prototype to practice before Tyco's priority date. Pet. App. 70a–74a.

Ethicon also contended that the claims were invalid under an alternative § 102(g) theory—that it was the first to conceive and was diligent in later reaching a constructive reduction to practice. Pet. App. 74a. The district court accepted this anticipation theory for some of the claims. Pet. App. 74a–77a. For the remaining claims, Ethicon asserted that the dual-cam claims (claims 11 and 12 of the '050 patent and claim 3 of the '544 patent) and the curved-blade claims (claim 15 of the '286 patent and claims 6 and 8 of the '544 patent) would have been obvious under § 103 based on the Ultracision and Ethicon prototypes and other prior art. Pet. App. 79a. But, based on Federal Circuit precedent, the district court rejected Ethicon's reliance on the prototypes because they had not been reduced to practice before Tyco's invention. Pet. App. 80a–81a (citing *Kimberly-Clark*, 745 F.2d at 1445 (“Proof of conception alone does [not] suffice to establish . . . work as prior [art].” (second alteration in original))). The district court also noted that information regarding the Ultracision and Ethicon prototypes was not publicly available. Pet. App. 80a. And, after analyzing the

prior art that did in fact exist at the time of Tyco's invention, the district court concluded that Ethicon failed to prove that the dual-cam claims or the curved-blade claims would have been obvious to one of ordinary skill in the art. Pet. App. 88a–99a.

III. The Federal Circuit's Decision

Both Tyco and Ethicon appealed to the Federal Circuit. As relevant here, the Federal Circuit reversed the district court's obviousness determination, instead holding that the Ethicon Prototype was § 103 prior art to Tyco's dual-cam and curved-blade claims. Pet. App. 12a–19a.

Tyco argued that obviousness—which must be evaluated from the perspective of one of ordinary skill in the art “at the time the invention was made” under § 103—cannot be determined using art that did not exist at the time the patented invention was made. The court of appeals acknowledged that a patentee's invention “should not be measured against ‘secret’ prior art.” Pet. App. 13a–14a. But the court nevertheless rejected Tyco's argument, concluding that “[t]he district court erred when it inconsistently applied § 102(g) to the Ethicon Prototype by not requiring prior reduction to practice for anticipation purposes but requiring it for the obviousness analysis.” Pet. App. 13a. Even though it had previously held in *Kimberly-Clark* that the “dispositive issue” in determining whether § 102(g) art qualifies as prior art for obviousness is “whether there had been a *prior* reduction to practice of [the] invention relied on as invalidating art,” 745 F.2d at 1444 (emphasis added), the court treated the issue as a legal question of first impression. Pet. App. 13a. And according to the court of appeals, “neither § 102(g) nor § 103 make prior reduction to practice the *only* avenue

through which § 102(g) prior art can constitute prior art under § 103.” *Id.* At bottom, the Federal Circuit established a new per se rule transforming all § 102(g) art into § 103 prior art for purposes of obviousness, regardless of whether the § 102(g) art actually existed at the time the patented invention was made.

Tyco sought rehearing, arguing that the panel had erroneously interpreted §§ 102(g) and 103 to allow nonexistent, secret art to drive an obviousness analysis. The court of appeals denied rehearing on February 27, 2015. Pet. App. 134a–135a.

REASONS FOR GRANTING THE PETITION

The Federal Circuit’s decision should be reversed because it contradicts § 103, this Court’s precedent, and the Federal Circuit’s own precedent. The plain text of § 103 requires denial of patent protection “if the differences between the subject matter sought to be patented and the *prior* art are such that the subject matter as a whole would have been obvious *at the time the invention was made to a person having ordinary skill in the art.*” 35 U.S.C. § 103(a) (emphases added). The Federal Circuit’s decision creates a new rule, striking § 103’s temporal requirement that obviousness must be evaluated against the “prior art . . . at the time the invention was made,” as well as the requirement that it must have been obvious “to a person having ordinary skill.” That is because the Federal Circuit wrongly imported the standard for determining the first inventor under § 102(g)—a statutory provision that does not even use the term “prior art” and which Congress has abolished—into § 103’s nonobviousness inquiry regarding “prior art” to hold that prior art did not need to exist at the time the patentee’s invention was made.

Not only does this new rule rewrite the statute, it also conflicts with this Court's precedent holding that the fundamental purpose of the nonobviousness requirement is to "extend[] the field of unpatentable material beyond that which is *known to the public* under § 102, to include that which could readily be deduced *from publicly available material* by a person of ordinary skill in the pertinent field of endeavor." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989) (emphases added). That which does not exist is neither literally nor constructively "available" to the public.

When Tyco made its invention in March 1997, the Ethicon Prototype had not yet been reduced to practice. To be sure, the Federal Circuit held that Ethicon was the first to conceive of the invention recited in some of Tyco's claims. Ethicon's reduction to practice, however, came only after Tyco filed for a patent. Under § 102(g), Ethicon's later reduction to practice is relevant in determining the priority of identical inventions. But § 102(g) cannot be read—contrary to § 103's explicit temporal and knowability requirements—to apply the Ethicon Prototype retroactively in an obviousness analysis. At the time of Tyco's invention, the Ethicon Prototype did not qualify as prior art under § 102(g). It simply did not exist. The Federal Circuit did not explain how art that does not yet exist can satisfy the "at the time the invention was made" requirement of § 103. And the Federal Circuit did not explain how art that does not yet exist can make an invention obvious to a person of ordinary skill.

If left unchecked, the Federal Circuit's new rule created in this case will significantly expand the use of secret prior art precisely at the time that Congress has resoundingly rejected it by removing § 102(g) from the law altogether.

I. The Federal Circuit's Decision Conflicts with the Text of 35 U.S.C. § 103

Section 103 codified a long-understood condition of patentability that prohibits a patent where “the differences between the subject matter sought to be patented and the *prior* art are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (emphases added); *see also Graham*, 383 U.S. at 14–15 (section 103 of the Patent Act of 1952 codified the condition that had “existed for more than 100 years, but only by reason of decisions of the courts,” that a patent may not be obtained if “the difference between the new thing and *what was known before* is not considered sufficiently great to warrant a patent” (emphasis added)); *Hotchkiss*, 11 How. at 267 (“[U]nless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful mechanic, not that of the inventor.”). That is, the invention is compared to what existed in the prior art at the time the invention was made, not to what existed after the fact. And therein lies the fundamental problem with the Federal Circuit’s decision—at the time Tyco made its invention, the Ethicon Prototype did not yet exist in the prior art, and could not have been obvious “to a person having ordinary skill in the art.”

Specifically, the Federal Circuit erroneously held that the Ethicon Prototype was § 103 “prior art” to Tyco’s curved-blade and dual-cam claims by conflating § 103 with the standard for determining the first inventor under 35 U.S.C. § 102(g), despite the fact that

the Ethicon Prototype did not exist at the time Tyco made its invention. Pet. App. 12a–14a. Section 102(g) sets forth the standard for “resolving priority contests between two competing claimants to a patent.” *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 60–61 (1998). Section 102(g) reads:

A person shall be entitled to a patent unless

...

(2) before such person’s invention thereof, the invention *was made* in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception *and* reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. § 102(g)(2) (emphases added).

Unlike neighboring § 102 provisions, § 102(g) does not require a patent, a printed publication, or an application for patent. Section 102(g) is unique in requiring that the same “invention *was made* in this country by another inventor.” (Emphasis added.) In *Pfaff*, this Court noted that “[t]he primary meaning of the word ‘invention’ in the Patent Act unquestionably refers to the inventor’s conception rather than to a physical embodiment of that idea,” and that “[t]he statute does not contain any express requirement that an invention must be reduced to practice before it can be patented.” 525 U.S. at 60–61. But § 102(g) is expressly different—it requires the invention to be “made” and further contains “[t]he statute’s only specific reference”

to the term “reduction to practice.” *Id.* at 61. In fact, § 102(g) requires courts to consider “conception *and* reduction to practice” in determining priority. 35 U.S.C. § 102(g)(2) (emphasis added). Moreover, § 102(g) separately uses the terms “invention was made,” “conception,” and “reduction to practice.” Each of these terms must be given meaning when reading the statute. *See Leocal v. Ashcroft*, 543 U.S. 1, 12 (2004) (“[W]e must give effect to every word of a statute wherever possible.”). For an invention to be “made” as required by § 102(g), conception alone is not enough—“[m]aking the invention requires conception *and* reduction to practice.” *Solvay S.A. v. Honeywell Int’l Inc.*, 742 F.3d 998, 1000 (Fed. Cir. 2014) (emphasis added).

Section 102(g)(2) provides two ways for a challenger to establish priority: “(1) it reduced its invention to practice first . . . or (2) it was the first party to conceive of the invention and then exercised reasonable diligence in reducing that invention to practice.” *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 243 F.3d 1316, 1332 (Fed. Cir. 2001). Consistent with the statute, both paths to priority require a reduction to practice.² Here, the Federal Circuit held that Ethicon established priority the latter way.

² Section 102(g) of the Patent Act of 1952 was “intended to codify the existing law.” Hearings on H.R. 3760 Before Subcomm. No. 3 of the House Comm. on the Judiciary, 82d Cong., 1st Sess., at 33 (1951). And the pre-1952 law regarding priority of invention unmistakably required a reduction to practice. *See Marconi Wireless Tel. Co. of Am. v. United States*, 320 U.S. 1, 34–36 (1943) (“To obtain the benefit of his prior conception, the inventor must not abandon his invention, but must proceed with diligence to reduce it to practice.” (citation omitted)).

But at the time Tyco made its invention (its March 1997 priority date), Ethicon had not yet reduced its prototype to practice. Put differently, at the time of Tyco's invention, Ethicon had not yet "made" the invention as ultimately required by § 102(g). Nevertheless, the Federal Circuit held that the Ethicon Prototype was § 103 prior art as of the time it was conceived, relying exclusively on Ethicon's *later* reduction to practice. Pet. App. 12a–14a. That holding, however, cannot be reconciled with § 103's unmistakable temporal requirement, which tethers the obviousness analysis here to the prior art that existed at the time Tyco made its invention, which is the only way it could be obvious "to a person having ordinary skill in the art."

Under the Federal Circuit's holding, every § 102(g) invention by another is § 103 *prior* art as of the moment of conception, regardless of when the § 102(g) invention was reduced to practice. That bright-line rule, however, contravenes § 103's plain language and ignores that § 102(g) and § 103 serve different purposes that warrant different treatment of work that was conceived before, but reduced to practice only after, a patented invention was made. In priority contests, § 102(g) authorizes a legal conclusion of prior inventorship when the first conceiver works diligently to a later reduction to practice of the *same* invention, provided that the invention is not abandoned, suppressed, or concealed. Section 103, in contrast, serves a different purpose entirely: it denies patent protection for a different invention that nonetheless "would have been obvious at the time . . . [it] was made." 35 U.S.C. § 103(a); *see also Graham*, 383 U.S. at 14 (comparing the Patent Act of 1952 with the conditions for patentability in *Hotchkiss*, and noting that "[b]oth formulations place emphasis on the pertinent art existing at the time the invention was made"). Section

102(g) may permit a legal conclusion of prior inventorship of the same invention based on prior conception and diligence to a later constructive reduction to practice. But it does not make § 103 prior art out of interim work—like the failed Ethicon Prototype here—that was not reduced to practice before the patentee’s invention and thus unknowable by the patentee or any person having ordinary skill in the art.

The Federal Circuit’s reason for ignoring § 103’s temporal requirement is unavailing. In 1984, Congress enacted the Patent Law Amendments Act, which provides certain exceptions to § 103 prior art that are not applicable in this case. *See* Pub. L. No. 98-622, 98 Stat. 3383, 3384 (1984). Those exceptions eventually became 35 U.S.C. § 103(c)(1) (2006),³ which provides that a § 102(g) invention made by another cannot be used as § 103(a) “prior art” where “the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” According to the Federal Circuit, “[t]he presence of this exception strongly indicates that the statute itself contemplates that § 102(g) prior art may constitute prior art under § 103.” *Pet. App.* 14a. But there, Congress changed the law to address a single concern that has no bearing on this case—a line of judicial authority under which a secret § 102(g) invention could be § 103 prior art even where that § 102(g) invention was owned by the same person or subject to an obligation of assignment to the same person.⁴

³ *See* Cooperative Research and Technology Enhancement (CREATE) Act of 2004, Pub. L. 108-453, 118 Stat. 3596 (2004).

⁴ *See* Section-by-Section Analysis: Patent Law Amendments Act of 1984, 130 Cong. Rec. 28069, 28071 (Oct. 1, 1984), *reprinted in* 1984 U.S.C.C.A.N. 5827, 5833 (stating that the amendment

Congress did not need to change § 103 to state that a § 102(g) invention by another had to be made (i.e., conceived *and* reduced to practice) at the time of the patented invention, since that was already the law by the text of § 103. And before now, no court had ever held that a § 102(g) invention made by another but reduced to practice only after a patentee's priority date qualifies as § 103 prior art.

To be sure, where an invention was actually made by another (i.e., conceived *and* reduced to practice) before the patentee's priority date, such work may constitute "prior art . . . at the time the [patentee's] invention was made." 35 U.S.C. § 103(a). But just because a § 102(g) invention made by another *may* constitute "prior art" under § 103 does not mean that it *always* will. Not everything referred to in § 102 is always "prior art" under § 103.⁵ In fact, the term "prior art" appears only in § 103.⁶ And while much of what is

to § 103, which "encourage[s] communication among members of research teams, and patenting, and consequently public dissemination," was a response to *In re Bass*, 474 F.2d 1276 (CCPA 1973), and *In re Clemens*, 622 F.2d 1029 (CCPA 1980)). Neither *Bass* nor *Clemens* involved a § 102(g) invention made by another that was reduced to practice only *after* the patentee's priority date being used as prior art under § 103.

⁵ This Court in *Hazeltine* could have held that a patent application under 35 U.S.C. § 102(e) (2006) qualifies as § 103 "prior art" as of its filing date solely because § 102(e) is part of § 102, and all of § 102 qualifies as § 103 "prior art." But that was not the Court's holding. Instead, the Court based its holding on the fact that when an application is filed, the inventor "ha[s] done what he could to add his disclosures to the prior art." *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 255-56 (1965).

⁶ Notably, the title for the new 35 U.S.C. § 102(a) (2014) under the AIA—which eliminated § 102(g) or other "secret" art provisions—now reads "Novelty; Prior Art." See AIA, 125 Stat. at 285. In contrast, the pre-AIA § 102 was entitled "Conditions for

mentioned as defeating novelty or establishing loss of right under § 102 is also considered “prior art” under § 103, portions of § 102 deal with matter that is not “prior art” at all. For example, 35 U.S.C. § 102(c) (2006) provides that “[a] person shall be entitled to a patent unless . . . (c) he has abandoned the invention.” Yet abandonment is not “prior art . . . at the time the invention was made” for purposes of § 103—it is only a condition that defeats patentability. Similarly, a § 102(g) invention made by another is not always § 103 prior art. Nothing in § 103(c) suggests otherwise. Whether a § 102(g) invention made by another is § 103 prior art depends on whether it was made “at the time the [patentee’s] invention was made,” as required by the plain text of § 103(a). And to be “made in this country by another,” § 102(g) unmistakably requires “conception *and* reduction to practice.” (Emphasis added.) These requirements are unaffected by § 103(c)(1).

II. The Federal Circuit’s Decision Conflicts with This Court’s Precedent

Not only does the Federal Circuit’s holding conflict with the text and purpose of § 103, it also conflicts with this Court’s precedent. Consistent with the text of § 103, this Court has long recognized that obviousness focuses on the time of the invention and includes material known to the public or which could be deduced from publicly available material by one of skill in the art. In *Bonito Boats*, this Court explained:

patentability; novelty and loss of right to patent.” See 35 U.S.C. § 102 (2006).

The nonobviousness requirement extends the field of unpatentable material beyond that which is known to the public under § 102, to include that which could readily *be deduced from publicly available material* by a person of ordinary skill in the pertinent field of endeavor. Taken together, the novelty and nonobviousness requirements express a congressional determination that the purposes behind the Patent Clause are best served by free competition and exploitation of either that which is *already available to the public* or that which may be *readily discerned from publicly available material*.

489 U.S. at 150 (emphases added) (citing *Graham*, 383 U.S. at 15); *see also* Hearings on H.R. 3760 Before Subcomm. No. 3 of the House Comm. on the Judiciary, 82d Cong., 1st Sess., at 38 (1951) (“[Section 103] refers to the difference between the subject matter to be patented and the prior art, meaning what was *known* before . . .” (emphasis added)). Whatever “available to the public” means, it cannot include secret art that does not yet exist.

Here, the Federal Circuit used the secret work of Ethicon employees—the conception of a failed prototype—to set the standard of knowledge for persons having ordinary skill in the art at the time of Tyco’s patented invention. But this Court has allowed “secret” prior art for purposes of § 103 in only limited circumstances. For instance, in *Hazeltine*, 382 U.S. at 255–56, this Court held that a U.S. patent is effective as § 103 prior art under 35 U.S.C. § 102(e) as of its application date, even though the knowledge contained in the application is not made public until the patent application is published or the patent issues.

This Court explained that when the applicant “filed his application, he had done what he could to add his disclosures to the prior art. The rest was up to the Patent Office.” *Id.* at 256. *Hazeltine*, however, does nothing to extend the effective date of a patent application to a point in time *before* the applicant had “done what he could to add his disclosures to the prior art.” Here, at the time Tyco made its invention, Ethicon had not yet done all it could do to add its prototype to the prior art. Indeed, Ethicon had only a conception at best, and had not yet reduced its prototype to practice or made any public disclosure describing its conception.

Even as it was expanding the use of secret prior art beyond this Court’s limited holding in *Hazeltine*, the Federal Circuit acknowledged that “an applicant’s contribution should not be measured against ‘secret’ prior art, as this could be detrimental to the innovative spirit the patent laws are intended to kindle.” Pet. App. 13a–14a (citation and internal quotation marks omitted). Nevertheless, the Federal Circuit believed that “the requirement in § 102(g) that the prior invention not be abandoned, suppressed, or concealed after reduction to practice does mollify somewhat the ‘secret’ nature of § 102(g) prior art.” Pet. App. 14a (citation and internal quotation marks omitted). But that is only a requirement *after* a reduction to practice—it does nothing to encourage the disclosure of a conception *before* a reduction to practice. In any event, the Federal Circuit’s rationale cannot “mollify” the statutory requirement that obviousness must be evaluated using the prior art at the time the patentee’s invention was made. In *Hazeltine*, the prior-art patent application at least existed when filed at the U.S. Patent & Trademark Office, even though it remained temporarily secret to the general public. The Ethicon Prototype,

in contrast, did not yet exist as a § 102(g) invention “made” by another.

III. The Federal Circuit’s Decision Conflicts with Its Own Precedent

In addition to conflicting with this Court’s precedents, the Federal Circuit’s decision in this case conflicts with its prior decision in *Kimberly-Clark*. In that case, the Federal Circuit faithfully followed § 103’s temporal requirement, making clear that a prototype that has not been reduced to practice is not § 103 prior art. 745 F.2d at 1444–45. There, in evaluating whether work qualified as prior art for obviousness, the court of appeals specifically characterized “[t]he dispositive issue” as “whether there had been a *prior* reduction to practice of [the] invention relied on as invalidating art.” *Id.* at 1444 (emphasis added). The court of appeals then applied this standard to two sets of work done before the patentee’s priority date. *Id.* at 1442, 1444–45. For one set of prior work, the court of appeals affirmed the district court’s finding that “[it] was a prior reduction to practice.” *Id.* at 1444. For the other set of prior work, the court of appeals ruled there had not been a reduction to practice. *Id.* at 1445 (“We hold the Mobley experiments were not *prima facie* evidence of a reduction to practice. . . . We therefore agree with K-C that Mobley’s work was unavailable as § 103 ‘prior art’ under 102(g).”). Allowing later art to make obvious an earlier invention merely because it is relevant in an entirely different context (i.e., a priority determination between identical inventions) would contradict this precedent and undermine the purpose of § 103.

Sidestepping its prior holding, the Federal Circuit distinguished this case from *Kimberly-Clark* on the basis that the latter did not directly involve a § 102(g)

invention by another arising from a prior conception and later diligent reduction to practice. Pet. App. 13a. That is a distinction without a difference. *Kimberly-Clark* was clear on this point—the “dispositive issue” in applying § 102(g) in an obviousness analysis is not whether an invention made by another was ever reduced to practice, but “whether there had been a *prior* reduction to practice.” 745 F.2d at 1444 (emphasis added). Regardless of the particular facts at issue, *Kimberly-Clark* effectively states the settled rule⁷ on the §§ 102(g)/103 issue—so much so that, before now, there was no case where a § 102(g) invention made by another and reduced to practice *after* the patentee’s priority date had been used as prior art under § 103. *Cf.* Pet. App. 80a (relying on *Kimberly-Clark* in holding that “Ethicon has not proved by clear and convincing evidence prior reduction to practice, and therefore, the prototypes cannot be considered ‘prior art’ for an obviousness determination”). And the U.S. Patent & Trademark Office, the agency charged with interpreting

⁷ While the United States operated under a “first-to-invent” regime, priority disputes arising from another inventor’s earlier conception and diligence in achieving a later reduction to practice of the same invention were not uncommon. *See, e.g., Marconi Wireless*, 320 U.S. at 34–35 (citing multiple cases spanning a century in support of the proposition that, “[t]o obtain the benefit of his prior conception, the inventor must not abandon his invention, but must proceed with diligence to reduce it to practice” (citation omitted)). But whether another inventor’s work qualifies as “prior art” for obviousness has always depended, until now, on a prior reduction to practice. *See, e.g., Kimberly-Clark*, 745 F.2d at 1444–45; *Cardiac Pacemakers, Inc. v. Cordis Corp.*, 549 F. Supp. 564, 569 (D. Minn.), *aff’d*, 690 F.2d 665 (8th Cir. 1982) (“*Prior* reductions to practice under 35 U.S.C. § 102(g) are properly considered in making a determination of obviousness under 35 U.S.C. § 103.” (emphasis added) (citing *Sutter Prods. Co. v. Pettibone Mulliken Corp.*, 428 F.2d 639 (7th Cir. 1970))).

the patent statute, has long recognized that § 102(g) requires both conception and reduction to practice to qualify as prior art. *See* Manual of Patent Examining Procedure § 2138 (“To qualify as prior art under pre-AIA 35 U.S.C. § 102(g), . . . there must be evidence that the subject matter was actually reduced to practice, in that conception alone is not sufficient.” (citing *Kimberly-Clark*, 745 F.2d at 1445)).

The Federal Circuit’s new rule upsets this long-standing—and correct—application of § 102(g) when evaluating obviousness. At least as a matter of statutory *stare decisis*, the Federal Circuit’s new per se rule should be reversed. *See, e.g., Kimble v. Marvel Entm’t, LLC*, 576 U.S. ___, No. 13-720, slip op. at 8 (June 22, 2015) (“What is more, *stare decisis* carries enhanced force when a decision . . . interprets a statute. Then, unlike in a constitutional case, critics of our ruling can take their objections across the street, and Congress can correct any mistake it sees.”); *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2068 (2011) (“In light of the ‘special force’ of the doctrine of *stare decisis* with regard to questions of statutory interpretation, we proceed on the premise that § 271(c) requires knowledge of the existence of the patent that is infringed.” (citation omitted)); *Bilski v. Kappos*, 561 U.S. 593, 601–02 (2010) (“[I]n any case, these exceptions [to 35 U.S.C. § 101 (2006)] have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years.”).

* * * * *

The Federal Circuit fashioned from whole judicial cloth a new per se rule that contradicts the language and purpose of § 103. Given the Federal Circuit’s virtually exclusive jurisdiction over patent cases, a circuit split is extremely unlikely to develop. This Court therefore should intervene now to ensure that the

answer to the important question of patent law raised by this case conforms to Congress’s mandate.

In recent years, this Court has repeatedly rejected similar judicial departures from the requirements of the Patent Act. *See, e.g., Limelight Networks, Inc. v. Akamai Techs., Inc.*, 134 S. Ct. 2111 (2014) (holding that Federal Circuit’s test for induced infringement liability in “divided infringement” scenarios was inconsistent with 35 U.S.C. § 271(b) (2006)); *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014) (holding that Federal Circuit’s indefiniteness jurisprudence was inconsistent with text and purpose of 35 U.S.C. § 112 (2006)); *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (holding that Federal Circuit’s nearly per se rule of injunctive relief cannot be squared with 35 U.S.C. § 283 (2006)). These cases have diverse issues and outcomes, but a common theme is clear: Congress is the architect of the patent laws. So long as those laws do not exceed constitutional limits, the judiciary must respect its designs. In this case, the Federal Circuit has redrawn § 103 without constitutional warrant. This Court therefore should grant review.

IV. Unless Reversed, the Federal Circuit’s Decision Will Have Far-Reaching Negative Effects on Patent Holders

The Federal Circuit’s new rule erroneously expands the reach of a statute—§ 102(g)—that Congress recently saw fit to remove from the Patent Act in the AIA. Because of the AIA’s effective-date provisions, however, § 102(g) will continue to affect hundreds of thousands of patents in litigation for many years. If left intact, the per se rule converting all § 102(g) art

into § 103 prior art would undermine the text and purpose of § 103 while giving outsized importance to § 102(g). The Federal Circuit's new rule contravenes two important—and previously settled—principles at the heart of the law of invalidity, undermining patentee rights in the process.

First, the Federal Circuit's decision violates the settled principle that obviousness is gauged as of the time of the patented invention, and not from a vantage point after the invention is made. The statutory language requires the assessment of what “would have been obvious *at the time the invention was made*” to one of ordinary skill in the art. 35 U.S.C. § 103(a) (emphasis added). The Federal Circuit's new rule replaces that statute with a moving target. Patentees must now defend the nonobviousness of their patents against a new universe of “prior” art that post-dates their inventions.

Like the statute, this Court's precedent requires evaluating obviousness from the perspective of a skilled artisan at the time of the invention. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419-20 (2007) (placing the obviousness analysis “at the time of invention”); *Graham*, 383 U.S. at 14 (comparing the Patent Act of 1952 with the conditions for patentability in *Hotchkiss*, and noting that “[b]oth formulations place emphasis on the pertinent art existing at the time the invention was made”). Similarly, the Federal Circuit's decision in *Kimberly-Clark* likewise faithfully followed § 103's temporal requirement, making clear that a prototype that has not been reduced to practice is not § 103 prior art. 745 F.2d at 1444–45.

Second, the Federal Circuit's per se rule would invigorate the use of secret prior art precisely at the time that Congress has resoundingly rejected it. As

the Federal Circuit acknowledged in *Kimberly-Clark*, the use of “secret art—as § 103 ‘prior art’—except as required by § 102(e), is not favored for reasons of public policy.” 745 F.2d at 1446. This Court has also acknowledged that the fundamental purpose of the nonobviousness requirement is to “extend[] the field of unpatentable material beyond that which is *known to the public* under § 102, to include that which could readily be deduced *from publicly available material* by a person of ordinary skill in the pertinent field of endeavor.” *Bonito Boats*, 489 U.S. at 150 (emphases added). The standard for a person of ordinary skill should not be set by secret conceptions.

In the AIA, Congress abolished § 102(g) for patents with an effective filing date after March 15, 2013, thus rooting out secret prior art’s negative impact on innovation going forward.⁸ The effective-date provision of

⁸ In removing § 102(g), Congress fully recognized that moving to a first-to-file system would eliminate the costs and inherent unfairness associated with secret prior art:

The main benefit of the AIA public availability standard of prior art is that it is relatively inexpensive to establish the existence of events that make an invention available to the public. Under current law, depositions and litigation discovery are required in order to identify all of the inventor’s private dealings with third parties and determine whether those dealings constitute a secret offer for sale or third party use that invalidates the patent under the current law’s forfeiture doctrines. The need for such discovery is eliminated once the definition of “prior art” is limited to those activities that make the [invention] accessible to the public. This will greatly reduce the time and cost of patent litigation and allow the courts and the [USPTO] to operate much more efficiently.

...

the AIA, however, still leaves hundreds of thousands of issued and to-be-issued patents subject to § 102(g). The Federal Circuit's decision now expands the role of § 102(g) by making it an engine for converting after-the-fact art into § 103 prior art. There is no evidence that Congress intended this result, and it is especially inadvisable to give § 102(g) this new significance now that Congress has removed § 102(g) altogether.

CONCLUSION

For these reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

J. MICHAEL JAKES
Counsel of Record
KATHLEEN A. DALEY
JASON L. ROMRELL
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 New York Avenue, NW
Washington, DC 20001
(202) 408-4000
mike.jakes@finnegan.com
Counsel for Petitioners

July 27, 2015

Under the AIA, only those actions that made the invention publicly available will constitute prior art, and these are much harder to fake than are claims of having secretly made the invention in a private laboratory.

157 Cong. Rec. S5319-21 (daily ed. Sept. 6, 2011) (statement of Sen. Kyl).

BLANK PAGE