

No. 23-2346

United States Court of Appeals
for the Federal Circuit

LYNK LABS, INC.,

Appellant

v.

SAMSUNG ELECTRONICS CO., LTD.,

Appellee

KATHERINE K. VIDAL, Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent
and Trademark Office, *Intervenor*

On Appeal from the United States Patent and Trademark Office
in IPR2022-00149

**BRIEF OF THE HIGH TECH INVENTORS ALLIANCE AND
THE COMPUTER & COMMUNICATIONS INDUSTRY
ASSOCIATION AS AMICI CURIAE IN SUPPORT OF
AFFIRMANCE AND APPELLEE SAMSUNG**

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May 3, 2024

CERTIFICATE OF INTEREST

Case Number No. 23-2346

Short Case Caption *Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.*

Filing Party/Entity High Tech Inventors Alliance
Computer & Communications Industry Assoc.

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: May 3, 2024

Signature: /s/ Joseph Matal

Name: Joseph Matal

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. <input checked="" type="checkbox"/> None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. <input checked="" type="checkbox"/> None/Not Applicable
High Tech Inventors Alliance		

Computer &
Communications Industry
Association

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

X None/Not Applicable

Additional pages attached

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)? Yes (file separate notice; see below) No **X** N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

X None/Not Applicable

Additional pages attached

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INTEREST OF AMICI CURIAE

The High Tech Inventors Alliance (HTIA) represents leading technology providers and includes some of the most innovative companies in the world. HTIA member companies are global leaders in software, ecommerce, cloud computing, artificial intelligence, quantum computing, digital advertising and marketing, streaming, networking and telecommunications hardware, computers, smartphones, and semiconductors. HTIA includes four of the top six software companies in the world, two of the top ten providers of 5G network infrastructure, three of the ten largest tech hardware companies, and three of the ten largest semiconductor companies in the world.

HTIA's member companies are some of the world's largest funders of research and development, collectively investing more than \$165 billion in these activities annually. They are also some of the world's largest patent owners and have collectively been granted nearly 350,000 patents.

The Computer & Communications Industry Association is an international, not-for-profit trade association representing a broad cross section of communications and technology firms. For more than fifty years, CCIA has promoted open markets, open systems,

and open networks. CCIA members employ more than 1.6 million workers, invest more than \$100 billion in research and development, and contribute trillions of dollars in productivity to the global economy. CCIA members are at the forefront of research and development in technological fields such as artificial intelligence and machine learning, quantum computing, and other computer-related inventions. CCIA members are also active participants in the patent system, holding approximately 5% of all active U.S. patents and significant patent holdings in other jurisdictions such as the EU and China.

As developers of innovative high-technology products, amici's members are frequent targets of patent assertions. In many cases, the asserted patents claim things that were already known at the time the patent was filed. In these circumstances, post-issuance review at the Patent Trial and Appeal Board can prove to be a critical tool. In amici's members' experience, the technical expertise of PTAB judges produces highly reliable and accurate patentability judgments. Conducting validity review in the PTAB removes much of the unpredictability of litigation and creates business certainty that allows companies to develop products and innovate. Amici's members thus have a keen interest in ensuring

that PTAB review remains available—and that the PTAB can consider the full scope of the prior art contemplated by Congress.¹

¹ No counsel for any party wrote any part of this brief. No party other than amici curiae's members contributed any money that was intended to fund the preparation or submission of this brief. (Samsung, although a member of HTIA, did not participate in the decision to file or the preparation of this brief or provide funding intended for this brief.) Because Lynk Labs has declined to consent to the filing of this brief, it is accompanied by a motion for leave to file.

ARGUMENT

I. Published patent applications are “printed publications” whose effective date as prior art in post-issuance reviews is governed by 35 U.S.C. § 102(e)(1).

In 1999, Congress via the American Inventors Protection Act (AIPA) amended the Patent Act to provide that applications for patent shall presumptively be published within 18 months of their earliest priority claim. *See America Inventors Protection Act, Public Law No. 106-113 (1999), §4502 (amending 35 U.S.C. § 122).* Today, more than 90% of patent applications are published pursuant to 35 U.S.C. § 122(b), regardless of whether the application subsequently issues as a patent.²

Simultaneously with providing for publication of patent applications, the AIPA also enacted new 35 U.S.C. § 102(e)(1) (pre-AIA), which establishes when published patent applications are effective as prior art. *See Pub. L. No. 106-113, § 4505 (“Prior*

² A U.S. application is exempt from 18-month publication only if the applicant agrees to forego patenting its invention in all foreign countries or under international agreements. *See 35 U.S.C. § 122(b)(2)(B).* According to a recent study, only about 9% of applicants choose to pursue non-publication. *See Richard Gruner, The Secrecy Gambit: Why Do Patent Applicants Forego Foreign Rights to Retain Temporary Secrecy?, 18 Ohio St. Tech. L.J. 20, 32 (figure 2) (2021).*

Art Effect of Published Applications") (amending 35 U.S.C. § 102(e)). Section 102(e)(1) provides that published applications are effective as prior art as of their *filing date*:

A person shall be entitled to a patent unless—

* * *

(e) 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

35 U.S.C. § 102(e)(1) (pre-AIA).³

As the USPTO has recognized since the AIPA was enacted, § 102(e)(1) makes published patent applications effective as prior art as of their filing date—not when they are published:

Pre-AIA 35 U.S.C. 102(e) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under pre-AIA 35 U.S.C. 102(e) as of their respective U.S. filing dates[.]

MPEP 2136.

³ The America Invents Act, which adopted the first-inventor-to-file system and thus bases a patent's priority date on its filing date rather than invention date, similarly provides that published patent applications are effective as prior art as of their filing dates. See 35 U.S.C. § 102(a)(2), (d) (AIA). Because this case involves a pre-AIA patent, this brief cites pre-AIA § 102(e), although the arguments herein extend to § 102(e)'s AIA counterparts as well.

Finally, the AIPA also enacted *inter partes* reexamination—the precursor to today’s system of *inter partes* review. See Pub. L. No. 106-113, § 4604. *Inter partes* reexamination allows issued patents to be challenged based on “prior art consisting of patents or printed publications.” 35 U.S.C. § 301 (incorporated by pre-AIA 35 U.S.C. § 311).

There can be no dispute that all patent applications published under § 122(b) are “printed publications.” After Congress enacted the AIPA, the USPTO adopted regulations providing “any member of the public with access to the file wrapper and contents of each published application.” Changes to Implement Eighteen-Month Publication of Patent Applications, 65 Fed. Reg. 57024, 57025 (Sept. 20, 2000); see 37 C.F.R. §§ 1.11(a), 1.14(a)(1). Published patent applications are thus publicly accessible.

It is well-established once a reference has been made “sufficiently accessible to the public interested in the art,” it is deemed to have been published. *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016) (quoting *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989)); see also *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988) (“[D]issemination and public accessibility are the keys to the

legal determination whether a prior art reference was ‘published.’”).⁴

In addition, although *other* types of printed publications are effective as prior art only as of their publication date, 35 U.S.C. § 102(e) sets forth a *different* rule for patents and published applications, providing that they are effective as prior art as of their filing dates.⁵

⁴ Making a reference publicly accessible on the internet (as published patent applications are) also qualifies as publication. See *Blue Calypso*, 815 F.3d at 1349 (discussing *Voter Verified, Inc. v. Premier Election Sols.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012)).

⁵ Indeed, even before the enactment of the AIPA, although most applications that did not issue as patents were never published, when an “abandoned application” was incorporated by reference or relied on in a subsequent patent, it not only was made publicly accessible by the Patent Office, but it became effective as prior art as of its *filings* date—not its publication date or the filing date of the subsequent incorporating patent. See *In re Switzer*, 166 F.2d 827, 831 (CCPA 1948) (holding that claim limitations in an application were disclosed by “abandoned applications which were referred to in [an issued] . . . patent as co-pending applications” and are thus “part of the record herein”); *In re Lund*, 376 F.2d 982, 989 (CCPA 1967); *Lee Pharms. v. Kreps*, 577 F.2d 610, 613 (9th Cir. 1978); MPEP 901.02 (7th Ed., July 1998) (noting cases holding “that where the reference patent refers to a previously copending but subsequently abandoned application which discloses subject matter in common with the patent, the effective date of the

In sum, a patent application published under § 122(b) is available as prior art in an inter partes review because it is a species of “printed publication,” and once it is available, its effective date as prior art is determined by § 102(e) because it is an “application for patent, published under § 122(b).” 35 U.S.C. § 102(e)(1). The fact that a published application is *admissible* as part of the broader category of “printed publications” does nothing to erase its identity as a published patent application that is governed by § 102(e).

Lynk Labs and its amicus’s principal response is to pretend that the AIPA was never enacted. They cite caselaw from the 19th and early 20th centuries holding that patent applications are not “printed publications” because they are not published (Lynk Labs at 60-61; VLSI at 14), and they cite cases holding that a *non-patent* printed publication is effective as prior art only as of its publication date. Lynk Labs at 58, 63; VLSI at 5-7.

Lynk Labs’ argument might have carried weight in the 1800s, but it cannot do so today. Once the AIPA authorized the publication

reference as to the common subject matter is the filing date of the abandoned application”).

of patent applications, those published applications qualified as “printed publications” and became available as prior art. And when a published application for patent is available as prior art, its effective date is governed by § 102(e)(1).

Lynk Labs cites no evidence that the prior-art effective date of a published application has ever been determined by anything other than its filing date pursuant § 102(e)(1).⁶ Every single case that Lynk Labs (and its amicus) cite to the contrary is a case that involves only *non-patent* prior art. Amici are aware of no authority that suggests there exists a hybrid class of prior art that consists of patents or published applications but that is effective as prior art only as of its publication date.⁷

⁶ Indeed, as noted *supra* n. 5, even before the enactment of the AIPA, in the rare cases where “abandoned patents” (i.e., applications) could be cited as prior art, they were effective as prior art as of their filing dates.

⁷ Lynk Labs cites *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022), for the proposition that patents can be challenged in *inter partes* reviews only on the basis of patents and printed publications “existing at the time of the patent application.” Lynk Labs at 65 (quoting *Qualcomm*, 24 F.4th at 1374) (emphasis removed). There can be no question, however, that the Martin patent application “existed” at the time that it was filed with the Patent Office. Were this passage in *Qualcomm*—which does not address § 102(e)—construed to endorse Lynk Labs’ contrary

Lynk Labs' interpretation is particularly implausible given that the same Congress that enacted §§ 122(b) and 102(e)(1) also enacted the *inter partes* reexamination system. By allowing third parties to participate in validity challenges based on "patents and printed publications," the AIPA Congress sought to "reduce[] expensive patent litigation in U.S. district courts." H.R. Rep. 106-287 (1999), at 57; *see also id.* at 33 (noting that a person that "wishes to test the validity of an issued U.S. patent . . . has no effective alternative to simply waiting and challenging the patent in an expensive district court proceeding").

It strains credulity to suggest that the same Congress that chose to allow publication of patent applications, and to make such publications effective as prior art as of their filing date, would nevertheless, through silence alone, block the operation of these reforms for the system that it simultaneously created for "reduc[ing] expensive patent litigation in U.S. district courts." *Id.* at 57. Certainly the legislative record is devoid of any suggestion that Congress intended such a counterintuitive result.

interpretation that "existing" means "published," it would also overthrow over a century of precedent holding that *issued patents* are effective as prior art at least as of their filing date.

To the extent that this Court or Congress has identified a legislative intent behind the “patents and printed publications” restriction in post-issuance review, it was to “avoid[] some of the more challenging types of prior art . . . such as commercial sales and public uses, by restricting the ‘prior art’ which may form a basis of a ground to prior art documents.” *Qualcomm*, 24 F.4th at 1376; see also H.R. Rep. 106-287 at 57-58 (“grounds for reexamination are limited to earlier patents and printed publications—grounds that are well-suited for consideration in PTO proceedings”).

In sum, the better reading of the AIPA is that Congress used the phrase “patents and printed publications” to limit the *form* of prior art that can be asserted in *inter partes* reexamination to “printed materials,” H.R. Rep. 106-287 at 35, while leaving it to the subsections of § 102 to determine when and in what way patents and printed publications become *effective* as prior art. Thus published applications are available as prior art because they are printed publications—and their effective date as prior art is governed by § 102(e)(1) (pre-AIA) or § 102(d) (AIA).

As the next section shows, this reading is confirmed by the fact that it was officially adopted by the USPTO shortly after the

AIPA was enacted—and relied on by Congress when it reenacted the same “patents and printed publications” language in the AIA.

II. The Congress that enacted the AIA is presumed to have relied on—and in fact *did* rely on—the USPTO’s official interpretation that published applications in post-issuance reviews are governed by § 102(e)(1).

Shortly after the AIPA was enacted, the USPTO published in the Manual of Patent Examining Procedure its understanding that the “patents and printed publications” cited in the new statute are governed by all the subsections of § 102 that address the use of patents and printed publications—including § 102(e)(1). The eighth edition of the MPEP—the first edition to issue after the AIPA became effective—stated that “[t]he prior art applied may only consist of prior art patents or printed publications,” that “[s]ubstantial new questions of patentability may be based upon the following portions of 35 U.S.C. 102:”—and then listed subsections (a), (b), (d), (e), (f), and (g) of § 102 as applicable to reexamination. MPEP 2217 (8th ed., August 2001).⁸

In other words, from the beginning of the USPTO’s administration of *inter partes* reexamination, the USPTO’s official

⁸ The entirety of this version of MPEP 2717 (August 2001) is reproduced as an addendum to this brief.

interpretation has been that the term “patents and printed publications” is governed by § 102(e)(1)—and thus published patent applications in post-issuance reviews are effective as prior art as of their filing dates.

“Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change.” *Lorillard v. Pons*, 434 U.S. 575, 580 (1978); *see also Immersion Corp. v. HTC Corp.*, 826 F. 3d 1357, 1365 (Fed. Cir. 2016) (noting that “Congress has done nothing to disapprove of this clearly articulated [administrative and judicial] position despite having amended section 120 several times since its first enactment in 1952”).⁹

⁹ This canon of statutory construction extends to an agency’s interpretation of the statute that it administers. *See National Lead Co. v. United States*, 252 U.S. 140, 145, 146 (1920) (“[When Congress reenacts language] without substantial change . . . [it] amounts to an implied legislative recognition and approval of the executive construction of the statute”) (citations omitted); *National Treasury Employees Union v. United States Merit Sys. Protection Bd.*, 743 F.2d 895, 916 (D.C. Cir. 1984) (“Although in this case the rules in effect prior to the statutory enactment were administrative,” the canon “applies just as if the rules were statutory.”).

Thus when interpreting the AIA, this Court looks to the state of the law “[w]hen Congress enacted the AIA in 2011.” *Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350, 1363 (Fed. Cir. 2017) (citing *Mississippi ex rel. Hood v. AU Optronics Corp.*, 571 U.S. 161, 169 (2014)), *rev’d on other grounds, Return Mail, Inc. v. United States Postal Serv.*, 139 S. Ct. 1853 (2019).

The USPTO consistently maintained its official interpretation that § 102(e)(1) applies to “patents and printed publications” in post-issuance reviews during the dozen years between the enactment of the AIPA and the enactment of the AIA. Indeed, amici are not aware of *any* authority—much less an executive or judicial authority that is presumed to guide Congress’s deliberations—that ever suggested before the AIA was enacted that § 102(e)(1) does *not* govern published applications that are cited in reexamination.

The canon favoring implied incorporation of settled administrative constructions into a new statute applies with special force in this case, for several reasons.

First, in this case it is more than a presumption. It is evident from the legislative record that the Congress that enacted the AIA *did* understand that the published applications incorporated into

new § 311(b)'s "patents and printed publications" would be fully effective as prior art pursuant to § 102(e)(1).

During the deliberations on the AIA, members of Congress made clear their understanding that because of the AIA's "reasonably could have raised" estoppel, 35 U.S.C. § 315(e)(2), "if an *inter partes* review is instituted while litigation is pending, that review will completely substitute for at least the patents-and-printed-publications portion of the civil litigation." 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011). A similar understanding was expressed by then-USPTO Director David Kappos while testifying at a House IP Subcommittee hearing on the America Invents Act when the bill was pending in the House: Director Kappos explained that because of the statutory estoppels that govern *inter partes* review, a patent "is largely unchallengeable again by the same party."¹⁰

¹⁰ *America Invents Act: Hearing Before the Subcommittee on Intellectual Property, Competition, And the Internet of the Committee On The Judiciary House Of Representatives*, 112th Cong. at 52-53, Serial No. 112-35 (Mar. 30, 2011) (Statement of David J. Kappos).

These statements necessarily reflect an understanding that *all* “patents and printed publications” are fully effective as prior art in an *inter partes* review. If it were otherwise—if Lynk Labs’ arguments were correct, and the USPTO’s consistent, 12-year interpretation were wrong—then an *inter partes* review could *not* “completely substitute for at least the patents-and-printed-publications portion of . . . civil litigation,” 157 Cong. Rec. S1376; nor could it render a patent “largely unchallengeable,” Serial No. 112–35 at 52–53, on patents-and-printed-publications grounds.

If Lynk Labs’ contention were correct, and published applications were *not* effective as printed-publications art during the 18-month period between their filing and publication, then such art would also *not* be something that the petitioner “could have raised” in the *inter partes* review. Yet Lynk Labs acknowledges (as it must) that published applications are otherwise governed by § 102(e)(1) and thus are effective as prior art as of their filing date *in infringement litigation*. See Lynk Labs at 60. The result, under Lynk Labs’ logic, is to create a class of published-application prior art that *cannot* be raised in an *inter partes* review—and therefore *can* be raised in civil litigation *even after* the PTAB review results in a final written decision.

It bears contemplating just how bizarre and unwieldy such a system would be. In the universe that Lynk Labs envisions, a litigation defendant planning to file an *inter partes* review petition would conduct its prior art search and then sort the relevant prior art into two categories: patents and printed publications that it can raise at the PTAB, and § 102(e)(1) published applications that it *cannot* cite to the Board but *can* assert in district court. Moreover, the parties to the proceedings must keep in mind that whether particular patent publications can be cited in the PTAB will depend on the *timing* of the reference patent's issuance. The average utility patent issues about two years after it is filed—*i.e.*, about six months after the underlying application is scheduled to be published under § 122(b).¹¹ Therefore, in many cases, a published application that *cannot* be cited as of its filing date will, before the petition for *inter partes* review is filed, mature into a patent that *can* be cited as prior art as of its filing date pursuant to § 102(e)(2). In such a case, according to Lynk Labs, the *patent* can be cited in the PTAB petition, but the *published application* cannot be cited in

¹¹ See USPTO FY 2023 Annual Report Workload Tables, Table 1, available at <https://www.uspto.gov/about-us/performance-and-planning/uspto-annual-reports>.

the petition, and thus is reserved for assertion only in district court (because, according to Lynk Labs, published applications are stripped of their § 102(e) effect in *inter partes* reviews but issued patents are not).

Surely one must hesitate to conclude that the AIA Congress—which also enacted the strong estoppels of § 315(e)—nevertheless intended to spread the litigation of patents-and-published-applications validity challenges across multiple proceedings and different fora. Again, in this case there is no need to give credence to such an awkward construction. The Patent Office had expressly and consistently construed § 102(e)(1) to apply to “patents and printed publications” prior art in post-issuance reviews prior to the AIA’s enactment, and both the AIA’s legislative sponsors and the USPTO Director relied on that understanding to conclude that the final decision in an *inter partes* review would effectively preclude the relitigation of patents-and-printed-publications issues by the same petitioner in subsequent infringement litigation. Indeed, Lynk Labs and its amicus cite no indication that *anyone*—much less an authoritative judicial or executive interpretation—adopted their contrary and counterintuitive view at any time before the AIA’s enactment. In such circumstances, Congress was entitled to rely

on the settled meaning of “patents and printed publications” when it incorporated the identical language in the AIA’s § 311(b).

III. It is important to high-technology innovators that *inter partes* reviews can consider the full scope of patents-and-printed-publications prior art.

In the high-technology sector, the products that are targeted in patent assertions often are complex. In many cases, simply explaining the *background* of the relevant technology can be a challenge. It is thus frequently invaluable to have validity reviews conducted before triers of fact who are “persons of competent legal knowledge and scientific ability,” as PTAB judges are required to be. 35 U.S.C. § 6(a).

In amici’s members’ experience, PTAB reviews are not simply faster and less expensive than litigation—they most often produce more accurate and reliable results.¹² And because the PTAB is

¹² Amici’s views are consistent with the findings of a recent academic study that examined how often PTAB panels are affirmed on appeal compared to other proceedings. The study found that the PTAB’s patentability-merits determinations are affirmed “notably more often than those” of other tribunals—and that “the most straightforward conclusion” is that PTAB judges’ technical expertise has “aided decision-making on the thorny scientific questions endemic to patent law.” See Matthew G. Sipe, *Experts,*

subject to the Administrative Procedure Act, it is required to analyze the evidence before it and explain its reasoning, which facilitates judicial review and the correction of errors on appeal.

See *In re Nuvasive*, 842 F.3d 1376, 1382-83 (Fed. Cir. 2016).

The result is that PTAB proceedings are reasonably predictable: if you have strong evidence that patent claims are invalid, the PTAB is likely to understand and recognize that evidence and will cancel the claims. (And if you do *not* have good evidence of invalidity, there is no point in filing a petition—the Board will not even institute review.) The PTAB system thus fulfills Congress's original design when it first authorized post-issuance administrative review of patents: to allow the USPTO to apply its expertise to reduce uncertainty about the validity of issued patents.¹³

Generalists, Laypeople—and the Federal Circuit, 32 Harv. J.L. & Tech. 575, 610, 637 (2019).

¹³ See H.R. Rep. No. 96-1307, 96th Cong., at 4 (1980) (emphasizing the need "to have the validity of his patent tested in the Patent office where the most expert opinions exist and at a much reduced cost") (report to accompany H.R. 6933, authorizing reexamination of patents); Weekly Compilation of Presidential Documents, President Jimmy Carter, Dec. 12, 1980, Vol. 16, No. 50 (Statement on Signing H.R. 6933 into Law) ("Patent

A critical component of the PTAB system is its ability to consider the full scope of the knowledge that is disclosed in patents and printed publications—including published patent applications. Patent publications often provide the most comprehensive and detailed evidence of the state of the art at various points in time. And much of that evidence is available only in published *applications*. According to the last two years of data, for example, the USPTO publishes about 100,000 more applications per year

reexamination will make it possible to focus extra attention on the most commercially significant patents. This legislation will improve the reliability of reexamined patents, thereby reducing the costs and uncertainties of testing patent validity in the courts."); 126 Cong. Rec. 30364 (daily ed. Nov. 20, 1980) ("Reexamination will allow patent holders and challengers to avoid the present costs and delays of patent litigation . . . [and] reduce the burden on our overworked courts by drawing on the expertise of the Patent and Trademark Office.") (Statement of Sen. Bayh); 126 Cong. Rec. 29900 (daily ed. Nov. 17, 1980) ("Members of the public today have only two ways of contesting patent validity, no matter how affected or concerned they may be about the validity of a particular patent. A person may either wait to be sued for patent infringement and then raise the defense of invalidity or, if a business interest is directly threatened, bring a declaratory judgment suit. Both of these remedies must be sought in Federal Courts, and they are almost always expensive, protracted, and uncertain as to outcome.") (Statement of Rep. Butler).

than it issues as patents.¹⁴ If these published applications could not be considered as prior art as of their § 102(e)(1) filing dates, a vast trove of relevant evidence would be excluded from the PTAB's purview when it evaluates the validity of issued patents.

Particularly in the high-technology sector, in which technology evolves rapidly and many patents claim only incremental advances, to exclude 18 months' worth of prior art from the scope of *inter partes* review would substantially degrade the effectiveness of the proceedings.

The rule that Lynk Labs urges also would undermine the PTAB's ability to resolve inventorship-priority disputes. When a new enabling technology emerges, such as the internet or artificial intelligence, multiple inventors often will seek patents for new applications of the technology. In many cases, these claimed inventions, though independently made, will prove to be patentably indistinct from one another. When such cases emerge, it is important that the PTAB be able to fully consider published

¹⁴ See USPTO FY 2023 Annual Report Workload Tables, Table 1, *supra* note 11 (noting that in 2022 and 2023, 415,725 and 413,521 applications were published, respectively, but only 318,496 and 310,245 utility patents were issued, respectively).

applications as prior art. This is particularly so for AIA patents, which rely exclusively on patent filings to show possession of the invention. Depriving the first filing inventor of the ability to cite its own application as prior art as of its filing date would effectively prevent the PTAB from being able to resolve competing claims to the same invention during the period before both patents issue.

There is no good reason to embrace such a result. In 1999, Congress provided that patent applications shall be published and that they are effective as prior art as of their filing dates—as the USPTO has consistently recognized since the AIPA was enacted. And because Congress is presumed to have been aware of and indeed *did* rely on that authoritative interpretation when it reenacted the words “patents and printed publications” in the AIA, the same words should carry the same meaning in *inter partes* reviews.

CONCLUSION

The PTAB'S conclusion that patent applications that are published under § 122(b) are effective as prior art as of their filing dates should be affirmed.

Respectfully submitted,

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ADDENDUM

MPEP 2717 (8th Edition, August 2001)

2217 Statement in the Request Applying Prior Art

The third sentence of 35 U.S.C. 302 indicates that the “request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.” 37 CFR 1.510(b)(2) requires that the request include “[a]n identification of every claim for which reexamination is requested, and a detailed explanation of the pertinency and manner of applying the cited prior art to every claim for which reexamination is requested.” If the request is filed by the patent owner, the request for reexamination may also point out how claims distinguish over cited prior art.

The prior art applied may only consist of prior art patents or printed publications. Substantial new questions of patentability may be based upon the following portions of 35 U.S.C. 102:

“(a)...patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or”

“(b) the invention was patented or described in a printed publication in this or a foreign country... more than one year prior to the date of the application for patent in the United States, or”

“(d) the invention was first patented or caused to be patented, or was the subject of an inventor’s certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor’s certificate filed more than twelve months before the filing of the application in the United States, or”

“(e) 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, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; 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, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or”

“(f) he did not himself invent the subject matter sought to be patented, or”

“(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person’s invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (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.”

Where substantial new questions of patentability are presented under 35 U.S.C. 102(f) or (g), the prior invention of another must be disclosed in a patent or printed publication. Substantial new questions of patentability may also be presented under 35 U.S.C. 103 which are based on the above indicated portions of 35 U.S.C. 102. Substantial new questions of patentability may be found under 35 U.S.C. 102(f)/103 or 102(g)/ 103 based on the prior invention of another disclosed in a patent or printed publication if the reference invention and the claimed invention were not commonly owned at the time the claimed invention was made. See, 35 U.S.C. 103(c) and MPEP

Affidavits or declarations which explain the contents or pertinent dates of prior patents or printed publications in more detail may be considered in reexamination. See MPEP § 2258.

ADMISSIONS

The consideration under 35 U.S.C. 303 of a request for reexamination is limited to prior art patents and printed publications. See *Ex parte McGaughay*, 6 USPQ2d 1334, 1337 (Bd. Pat. App. & Inter. 1988). Thus an admission, *per se*, may not be the basis for establishing a substantial new question of patentability. However, an admission by the patent owner of record in the file or in a court record may be utilized in combination with a patent or printed publication.

For handling of admissions during the examination stage of a proceeding (i.e., after reexamination has been ordered), see MPEP § 2258.

The admission can reside in the patent file (made of record during the prosecution of the patent application) or may be presented during the pendency of the reexamination proceeding or in litigation. Admissions by the patent owner as to any matter affecting patentability may be utilized to determine the scope and content of the prior art **in conjunction with patents and printed publications** in a prior art rejection, whether such admissions result from patents or printed publications or from some other source. An admission relating to *any* prior art (i.e., on sale, public use, etc.) established in the record or in court may be used by the examiner in combination with patents or printed publications in a reexamination proceeding. The admission must stand on its own. Information supplementing or further defining the admission would be improper.

Any admission submitted by the patent owner is proper. A third party, however, may not submit admissions of the patent owner made outside the record of the file or the court record. Such a submission would be outside the scope of reexamination.

CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(g), the undersigned counsel for Amici certifies that this brief:

- (1) complies with the type-volume limitation of Federal Rule of Appellate Procedure 29(b)(4) and Federal Circuit Rule 40(f) because it contains 4,243 words, including footnotes and excluding the parts of the brief exempted by Federal Circuit Rule 32(b) and Federal Rule of Appellate Procedure 32(f); and
- (2) complies with the typeface and style requirements of Federal Rules of Appellate Procedure 32(a)(5) and 32(a)(6) because this document has been prepared using Microsoft Office Word and is set in Verdana font in a size equivalent to 14 points or larger.

Dated: May 3, 2024

/s/ Joseph Mata