

# **Publish Your Defense**

*An analysis of the bar to patentability created by  
published claims under 35 USC 135(b)(2)*

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# ***35 USC § 135 (b)(2) History***

- **American Inventor's Protection Act of 1999**
  - The bar created by patented claims under 35 USC § 135 (b) is renumbered as 35 USC § 135 (b)(1), but remains substantively the same
  - The bar created by published claims is added as 35 USC § 135 (b)(2)

# ***35 USC § 135 Interferences***

**(b) (2)** A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

## **§ 135(b)(2) Elements**

- The same or substantially the same subject matter
- An application published under section 122(b) of this title
- An application filed after the application is published
- A claim of the published application

## ***§ 135(b) Interpretation***

**(b) (2)** A claim which is the same as, or **for the same or substantially the same subject matter as**, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

# ***What qualifies as “the same or substantially the same subject matter?”***

- Same patentable invention
- Apply the two-way test of obviousness

*See 37 CFR § 41.203 and MPEP 2301.03*

## **§ 135(b)(2) Interpretation**

**(b) (2)** A claim which is the same as, or for the same or substantially the same subject matter as, a claim of **an application published under section 122(b) of this title** may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

# ***What qualifies as “an application published under section 122(b)?”***

- US Publications
- PCT Publications designating the US per 35 USC § 374

# 135(b)(2)

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made **in an application filed after the application is published** only if the claim is made before 1 year after the date on which the application is published.

# Effective Filing Date Applies to USC § 135(b)(2)

The language of 35 U.S.C. §120 is clear in specifying an ‘effective’ filing date which may be earlier than an application’s actual filing date, if certain conditions are met. No exception of any kind is mentioned or provided, for any special scenario or circumstance. The later application ‘shall have the same effect...as though filed on the date of the earlier application.’

- *Ding v. Singer*, Paper No. 56 in Int. No. 105,436  
(PTOBPAI August 24, 2007)(non-precedential).

# *Effective Filing Dates*

- Continuations and divisional applications per 35 USC § 120
- Applications claiming the benefit of a provisional application per 35 USC § 119(e)
- National stage PCT applications claiming priority to a prior foreign application per 35 USC § 365(b)
- Foreign priority (Paris convention) per 35 USC § 119(a)

# *Ex parte Eckhart\**

- Examiner rejected claims of a continuation filed June 8, 2004 under 35 USC § 102(e) and 35 USC § 135(b)(2) based on an application filed April 6, 2001 and claims published November 21, 2002
- Continuation properly claimed priority to parent application filed October 4, 2002
- Board overturned the 35 USC § 135(b)(2) rejection stating that the effective filing date of the continuation applied and forwarded the application to the Trial Division for consideration of an interference.

\* Appeal 2009-003907, Application No. 10/863,322  
(PTOBPAI September 4, 2009).

# 135(b)(2)

**(b) (2)** A claim which is the same as, or for the same or substantially the same subject matter as, **a claim** of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

# ***Compare 135(b)(1) and 135(b)(2)***

“The difference between paragraphs (b)(1) and (b)(2) [of section 135] is that the former creates a one year bar relative to issued patents, while the latter creates a one year bar relative to published patent applications. Otherwise, the two paragraphs are the same.”

*Regents of the University of California v. University of Iowa Research Foundation*, 79 USPQ2d 1687, 1689 n.1 (Fed. Cir. 2006).

# ***Compare 135(b)(1) and 135(b)(2)***

**(b) (1)** A claim... may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

**(b) (2)** A claim... may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

# ***Purpose of 135(b)(1)***

35 USC § 135(b) – now 135(b)(1) – is the codification of “an equitable doctrine akin to laches,” and the undisputed purpose of the statute is to make a “patentee... more secure in his property right.”

*Corbett v. Chisholm*, 196 USPQ 337, 342  
(CCPA 1977).

# *Ryan v. Young*\*

- Cites the holding of *Ding v. Singer* in finding that 35 USC § 120 applies to 35 USC § 135(b)(2)

\* Paper No. 116 in Int. No. 105,504 (PTO BPAI March 4, 2008) (Informative Opinion).

# ***Ryan v. Young***

- Holds 35 USC § 135(b)(2) bars a target claim only if the reference claim ultimately issues as published or issues with no material changes.
- Points out that there is no need for an interference unless claims are patentable

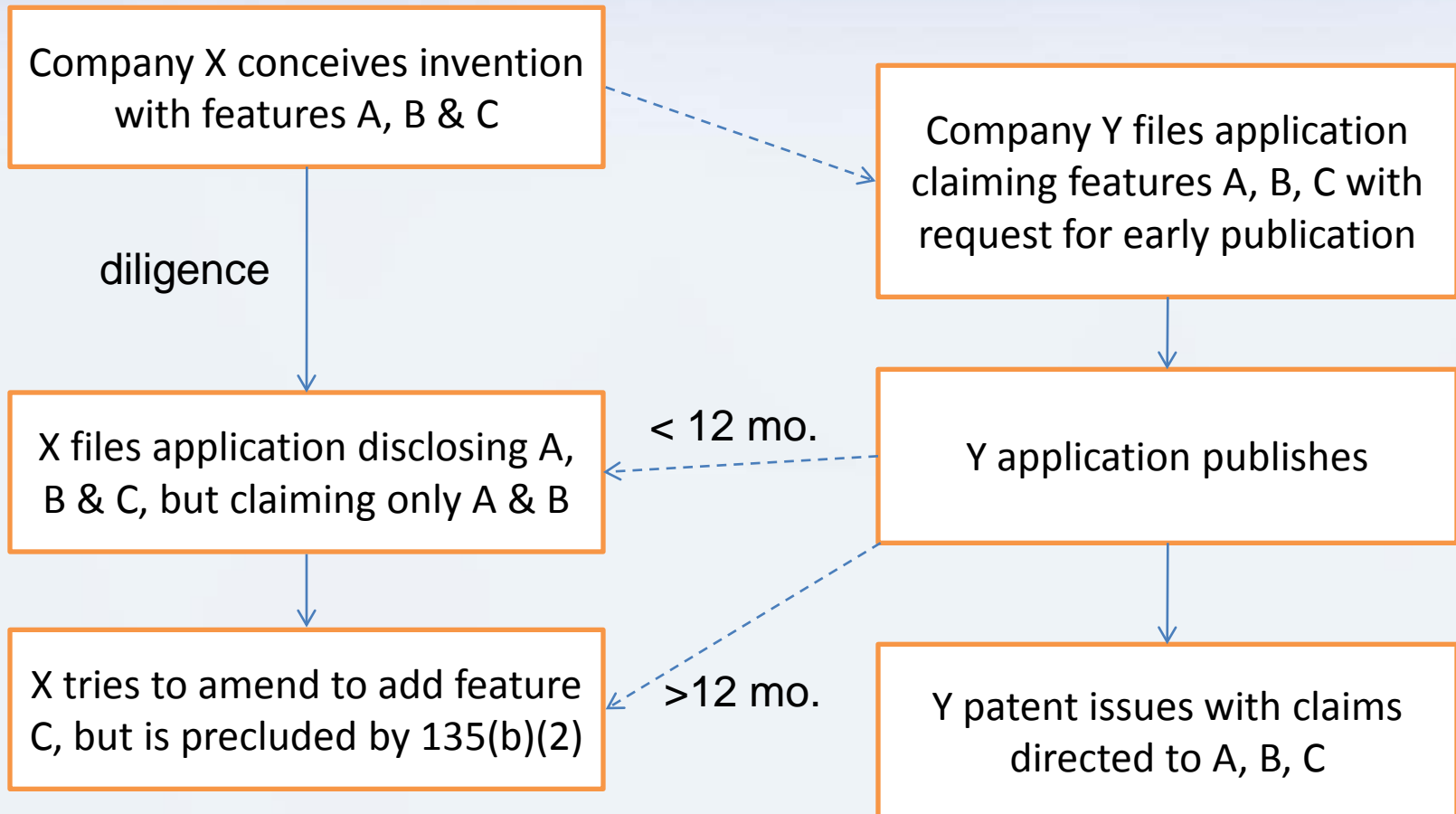
# ***35 USC § 135(b)(2) Interpretation***

- *Robertson v. Timmermans*, Paper No. 105 in Int. No. 105,602 (PTO BPAI November 21, 2008) has been appealed to the Federal Circuit
- Could result in the first interpretation of 35 USC 135(b)(2)

# ***135(b)(2) Strategies***

- Avoid 135(b)(2) bar for your applications by filing as soon as possible with a claim including all possible material limitations to preserve right to interference
  - *In re Berger*, 61 USPQ2d 1523 (Fed. Cir. 2002).
- “Publish Your Defense” by filing claims directed towards your products with a request for early publication as allowed by 37 CFR 1.219

# Example A



# Example B

