
IN THE
**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

03-1569
(Serial No. 09/664,247)

IN RE WILHELM ELSNER

03-1585
(Serial No. 09/267,559)

IN RE KEITH W. ZARY

Appeals from the United States Patent and Trademark Office
Board of Patent Appeals and Interferences

BRIEF FOR *AMICUS CURIAE*
AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF APPELLANTS' PETITIONS FOR REHEARING
EN BANC

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October 12, 2004

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American Intellectual Property Law Association

2. The real party in interest represented by the undersigned is:

American Intellectual Property Law Association

3. All parent companies and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:

None

4. The names of all law firms and the partners or associates that appeared for the party now represented by the undersigned in the trial court or are expected to appear in this court are:

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MISCELLANEOUS

2 R. Carl Moy, Moy's Walker On Patents, §7:18 at 7-64-65
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STATEMENT OF INTEREST OF AMICUS CURIAE

The American Intellectual Property Law Association (AIPLA) is a national association of more than 15,000 members interested in all areas of intellectual property law. AIPLA members include attorneys employed in private practice and by corporations, universities, and government. AIPLA members represent both owners and users of intellectual property.

The AIPLA has no stake in any of the parties to this litigation or the result of this case, other than its interest in seeking correct and consistent interpretation of the patent law.¹

Pursuant to Rule 29(a) of the Federal Rules of Appellate Procedure, AIPLA is authorized to state that all parties have consented to the filing of this brief. The United States Patent & Trademark Office does not, however, by consenting to the filing of the amicus brief, agree with any of the

¹ After reasonable investigation, AIPLA believes that (a) no member of its Board or Amicus Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation, (b) no representative of any party to this litigation participated in the authorship of this brief, and (c) no one other than the AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief. Some committee members or attorneys in their respective law firms or corporations may represent entities which have an interest in other matters which may be affected by the outcome of this litigation.

substantive positions expressed therein or that the Court should hear the
case en banc.

STATEMENT OF THE ISSUE

This case presents an important issue that the Court has not previously directly addressed; *viz.*, whether information not itself constituting prior art under 35 U.S.C. § 102 may be considered in determining whether other information constitutes a statutory bar. The issue was squarely addressed by the Panel decision, which concluded that foreign sales admittedly not qualifying as § 102(b) prior art might, in appropriate circumstances, be used in assessing whether a publication asserted as § 102 prior art was enabling. AIPLA believes the issue is of sufficient importance that the Court should consider it *en banc*. AIPLA does not, however, take a position on the merits at this time.

ARGUMENT

For a publication, use, or knowledge to constitute prior art under 35 U.S.C. § 102 (a) or § 102(b), the publication, use or knowledge must satisfy the appropriate statutory temporal limitation and be enabling. *See, e.g., Minnesota Mining & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1301 (Fed. Cir. 2002); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994); *In re LeGrice*, 301 F.2d 929, 933 (C.C.P.A. 1962) (citing treatises). Determining whether a potential reference is enabling entails consideration of what the reference

specifically states, not in isolation, but with the knowledge and understanding of one of ordinary skill in the pertinent art. *See, e.g., In re Samour*, 571 F.2d 559, 562 (C.C.P.A. 1978) (citing prior cases). Even in the context of anticipation, which requires a single reference disclosing all of the claim limitations, additional references may be cited as evidence of the level of skill in the art. *Id.* at 563 n.7.

This leads to the question of what may be considered in defining the knowledge of a person of ordinary skill. In *In re Howarth*, 654 F.2d 103, 107 (C.C.P.A. 1981), the Court explained that “[n]ot everything that may be cited as prior art to preclude the grant of a patent in accordance with 35 U.S.C. § 102 can be equated with common knowledge for purposes of enablement under § 112.” *Id.* While *Howarth* instructs that not all information qualifying as § 102 prior art must be considered in determining enablement under § 112, it does not shed light on whether information that does *not* qualify as prior art under § 102 may be considered as evidence of what one of ordinary skill would know and understand.

In holding that it could be considered, the Panel initially explained that “[o]rdinarily foreign sales of an invention in combination with a

publication will not constitute a bar because such a result would circumvent the established rules that neither non-enabling publications nor foreign sales can bar one's right to a patent." Slip Op. at 6. Relying on the observation in *LeGrice* that "there are inherent differences between plants and manufactured articles," and the exclusionary right set forth in § 163, however, the Court concluded it was appropriate to consider whether the foreign sales were within the knowledge of the skilled artisan. Slip Op. at 8 (quoting *LeGrice*, 301 F.2d at 935). If so, the foreign sales would enable the printed publication. *Id.*

Thus, building on *LeGrice*, the Panel relied on a factual distinction between patentable plants and manufactured articles to establish a legal difference between the rules governing enablement of a "printed publication" under § 102(b). Slip Op. at 6. *Cf. In re Kollar*, 286 F.3d 1326 (Fed. Cir. 2002) (discussing differences in placing products and methods on sale).

In *LeGrice*, the Court instructed that the then-current knowledge of plant genetics (or lack thereof) may well mean that, "as a practical matter," general publications depicting plants cannot be relied on as a statutory bar. 301 F.2d at 939. The Court emphasized, however, that it was construing

the statute the same way it had with respect to other inventions, such that only an enabling publication is effective to bar a patent. *Id.* This approach is consistent with 35 U.S.C. § 161, which instructs that “the provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise noted.” *Id.*

While the Panel here took pains to limit its holding to plant patents, the opinion strongly suggests that there are situations under which foreign acts might also be considered in the context of enabling a reference being applied against a utility patent. Such a result would be consistent with § 161 and the analytical framework set forth in *LeGrice*, since enablement is a question of law, with underlying facts. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 774 F.2d 1452 (Fed. Cir. 1984).

The Panel analogized the issue at hand to the deposit procedures applicable to microorganisms, which permit public access to satisfy the § 112 enablement requirement. Slip Op. at 10. An applicant may satisfy this requirement by depositing material in “[a]ny International Depository Authority.” 37 C.F.R. § 1.803(a)(1). Thus, enablement of a utility application can be satisfied by deposits done abroad. Does that inevitably lead to the conclusion that a non-enabled publication may become enabled

as a result of non-statutory subject matter? And, if so, can this rule be limited to enablement of printed publications being applied against plant patents or plant patent applications, especially when the deposits are approved for use in connection with utility patent applications?

Consider a related aspect of enablement which arises in the context of the on-sale bar. Drawings or other descriptions sufficient to satisfy the “ready-for-patenting” prong of the on-sale bar provision of §102(b) must be enabling. *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 66-67 (1998). In *Abbott Labs. v. Geneva Pharma., Inc.*, 182 F.3d 1315 (Fed. Cir. 1999), the Court based its holding that the claimed subject matter was “ready for patenting” on evidence that “at least two foreign manufacturers had already reduced it to practice.” *Id.* at 1318. Stated differently, the Court relied on non-prior art acts (performed abroad) to fulfill one of the subsidiary *Pfaff* tests, although the on-sale bar is limited by the phrase “in this country.”² 35 U.S.C. § 102(b).

²See also *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, 357 F.3d 1319, 1337-38 (Fed. Cir. 2004)(motivation to combine for purposes of obviousness need not be found in prior art references, but may be found in the knowledge generally available to one of ordinary skill in the art).

The instant case presents the analogous issue of whether evidence of foreign sales of a claimed reproducible plant variety, which sales do not themselves constitute prior art, may nevertheless enable an otherwise non-enabled printed publication. The Court narrowly held that for the purpose of assessing patentability of a plant patent application, foreign sales of the claimed plants may be considered within the knowledge of the skilled artisan.³ In effect, the information (here foreign sales) indirectly may become an integral part of an invalidity analysis, although it cannot be directly used as prior art.

If the foreign sales/enablement issue is an ultimate legal question, the Panel opinion, as well as § 161 and *LeGrice*, suggest the answer to that legal question must be the same for all classes of patents. Even if the applicability of foreign sales to enablement is part of the underlying factual analysis, *LeGrice* suggests this inquiry is also appropriate in utility patent cases. 301 F.2d at 939.

³ The Court, however, remanded because factual issues remained with respect to, *inter alia*, the accessibility of the foreign sales of the claimed plants. Slip Op. at 10.

This case presents the Court with the opportunity to answer the important question of whether information that does not itself constitute § 102 prior art may nevertheless be considered in determining whether other information constitutes a statutory bar. Any change in the scope of prior art would materially impact, among others, AIPLA's membership. Such a change could impact patentability opinions, patent prosecution, patent interference proceedings, pre-litigation opinions of counsel for patentees, opinions of invalidity by counsel in the course of due diligence, and litigation. This is not merely a hypothetical concern, since at least one treatise teaches that “[l]ike the holding in *Howarth*, the result in [*In re Glass*, 492 F.2d 1231 (C.C.P.A. 1974)] can be explained only by admitting that the sources available under the enablement requirement are more limited than those available when dealing with prior art.” 2 R. Carl Moy, Moy's Walker On Patents, §7:18 at 7-64-65 (4th ed. 2003). AIPLA is mindful of the burdens imposed on the Court by the *en banc* process, but believes this issue to be of such importance that the Court should consider it *en banc*.

CONCLUSION

In view of the foregoing, the Court is urged to grant rehearing *en banc*.

Respectfully submitted,

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October 12, 2004

CERTIFICATE OF SERVICE

I hereby certify that on October 12, 2004, I caused the foregoing
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