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Intellectual Property Alert

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Federal Circuit resolves US published patent application prior art date in *inter partes* reviews

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The court's decision could significantly expand the number of US published applications and patents that can be used as prior art references in an *inter partes* review (IPR).

What's the impact?

- The court resolved that the IPR rules governed under 35 U.S.C. § 311(b) do not exclude the prior art rule of 35 U.S.C. § 102(e)(1).
- The court held that the prior art date of a US published application in an IPR is the application's filing date, rather than its publication date.

In *Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.*, the Federal Circuit resolved that 35 U.S.C. §§ 102(e)(1) and 311(b) permit IPR challenges based upon published patent applications, and such published patent applications can be deemed prior art in IPRs as of their filing dates. This ruling applies for pre-America Invents Act (AIA) invalidity challenges in IPRs.

The Federal Circuit's decision comes on the heels of a precedential opinion of the USPTO Patent Trial and Appeal Board (PTAB) in *Penumbra, Inc. v. RapidPulse, Inc*. where the PTAB held that the

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prior art date of a U.S. published application or patent can be the filing date of its provisional application. The PTAB's ruling applies in IPRs for AIA invalidity challenges.

Impact of the *Lynk Labs* and *Penumbra* decisions

The impact of Lynk Labs and Penumbra is profound because these decisions may significantly expand the number of U.S. published applications and patents that can be used as prior art references in pre-AIA and AIA invalidity challenges in IPRs. As a result of these decisions, clients should be aware of the following changes/clarifications in the law involving IPRs.

- For pre-AIA patent challenges in IPRs, the filing date of a U.S. published patent application will serve as its prior art date, rather than its publication date.
- For AIA patent challenges in IPRs, the filing date of the provisional application of a U.S. published application or patent can serve as the prior art date when certain conditions are met, including that the provisional application describes the subject matter relied upon in the published application or patent.

Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.

On January 14, 2025, the U.S. Court of Appeals for the Federal Circuit, in *Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.*, affirmed the final written decision of the PTAB invalidating Lynk Labs' patent as obvious under (pre-AIA) 35 U.S.C. § 102(e)(1). Samsung had challenged the validity of Lynk Labs' patent based on a U.S. published patent application ("Martin"). Martin was filed before the priority date of Lynk Labs' patent, but had not published until after Lynk Labs filed its patent application.

The decision of the Federal Circuit turned on its interpretation of two federal statutes: 35 U.S.C. § 102(e)(1) and 35 U.S.C. § 311(b). 35 U.S.C. § 102(e)(1) states, in relevant part, that "[a] person shall be entitled to a patent unless … (e) the invention was described in … (1) an application for patent, published under [35 U.S.C. § 122(b)], by another filed in the United States before the invention by the applicant for patent … or (2) a patent granted on an application for patent by another filed in the United States before the invention by the application for patent …." 35 U.S.C. § 311(b) states, in relevant part, that "[a] petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent … only on the basis of prior art consisting of patents or printed publications."

Lynk Labs argued that Martin cannot be deemed a prior art printed publication under 35 U.S.C. § 311(b) before it became publicly accessible. However, the Federal Circuit held that 35 U.S.C. § 102(e)(1) provides "a special rule for published patent applications." The Federal Circuit resolved that 35 U.S.C. § 311(b) does not exclude the prior art rule of 35 U.S.C. § 102(e)(1), reasoning that "when § 311(b) permits IPR challenges based upon 'prior art … printed publications,' it includes

within its literal scope challenges based upon a published patent application. And, by virtue of § 102(e)(1), a published patent application—this specific type of 'printed publication'—is deemed prior art as of its filing date." Consequently, the Federal Circuit rejected Lynk Labs' argument that the prior art date of Martin should be its publication date rather than its filing date.

Decision comes on the heels of *Penumbra*

In a precedential decision issued in March 2023 in *Penumbra, Inc. v. RapidPulse, Inc.*, the PTAB determined that the filing date of a provisional application of a patent or published application can serve as its priority date for prior art purposes. According to the PTAB, "AIA § 102 draws a distinction between actually being entitled to a right of priority to, or the benefit of, a prior-filed application for prior-art purposes according to the use of 'effectively filed' in AIA 35 U.S.C. § 102(d)." The PTAB stated that under the AIA, the patent application or patent need only meet the "ministerial requirements" of §§ 119 and 120, and the provisional must describe the subject matter relied upon in the patent or published application.

Takeaways for patent inventors/owners and challengers

- In determining whether a U.S. published application or patent qualifies as prior art for pre-AIA invalidity challenges in an *inter partes* review, consider the filing date of the application.
- In determining whether a U.S. published application or patent qualifies as prior art for post-AIA invalidity challenges in an *inter partes* review, consider the filing date of its provisional application, whether the patent or published application claiming priority to the provisional application meets the ministerial requirements of 35 U.S.C. §§ 119 and 120, and whether the provisional application describes the subject matter relied upon in the published application or patent.

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