

No. 12-1245

In the Supreme Court of the United States

FINJAN, INC., PETITIONER

v.

UNITED STATES PATENT AND TRADEMARK OFFICE

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT*

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Whether, in proceedings to determine whether a patent application should be granted, the United States Patent and Trademark Office bears the burden of demonstrating that a prior art printed publication that anticipates the invention for which the patent is sought enables a person of skill in the art to practice the invention.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1-2) is not published in the *Federal Reporter* but is reprinted in 491 Fed. Appx. 194. The opinion of the Board of Patent Appeals and Interferences (Pet. App. 3-9) is not reported but is available at 2011 WL 2259106.

JURISDICTION

The judgment of the court of appeals was entered on January 11, 2013. The petition for a writ of certiorari was filed on April 11, 2013. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. The United States Patent and Trademark Office (PTO) is “responsible for the granting and issuing of patents.” 35 U.S.C. 2(a)(1). When an inventor applies for a patent, the PTO undertakes an examination pro-

cess to determine whether a patent should issue. 35 U.S.C. 131. A number of statutory prerequisites must be satisfied before a patent may issue. *Inter alia*, an invention must be novel. 35 U.S.C. 102. Under Section 102, an invention is not novel, and thus does not qualify for patent protection, if it is “anticipated” by a reference in the prior art. An invention is anticipated if a single prior art reference discloses each and every limitation of the claimed invention. *American Calcar, Inc. v. American Honda Motor Co., Inc.*, 651 F.3d 1318, 1341 (Fed. Cir. 2011); 35 U.S.C. 102(a)(1).¹

If the examiner concludes that a patent should not be granted, he must inform the applicant of “the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.” 35 U.S.C. 132. These elements constitute the examiner’s *prima facie* case that the invention is not patentable. *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990). The examiner complies with Section 132 if he provides sufficient information to allow the applicant to “determine what the issues are on which he can or should produce evidence.” *Ibid.* The burden then shifts to the applicant to demonstrate that the invention is patentable. When the examiner issues an initial rejection on anticipation grounds, one way in

¹ In September 2011, Congress passed the Leahy-Smith America Invents Act, which amended many provisions of the Patent Act of 1952, 35 U.S.C. 1 *et seq.*, including Section 102. Pub. L. No. 112-29, § 3(b), 125 Stat. 285. The proceedings in this case were conducted under the prior version of Section 102. Because petitioner refers to the current version of the provision, 35 U.S.C. 102(a)(1), and that version does not differ in any relevant respect from the prior version, this brief also refers to the current version of Section 102.

which the applicant may overcome the rejection is to demonstrate that the cited disclosures would not enable one skilled in the art to practice the invention without undue experimentation. See *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. 2003) (if a prior art reference is not enabling, it cannot anticipate the claimed invention).

Certain aspects of patentability may also be assessed by the PTO after a patent has been granted. “Any person at any time may file a request for reexamination by the [PTO] of any claim of a patent on the basis of” prior art reflected in another patent or a printed publication. 35 U.S.C. 302; see 35 U.S.C. 301. The purpose of the reexamination proceeding is “to increase the reliability of the PTO’s action in issuing a patent by reexamination of patents thought doubtful.” *In re Etter*, 756 F.2d 852, 857 (Fed. Cir.) (en banc) (citation and internal quotation marks omitted), cert. denied, 474 U.S. 828 (1985). The reexamination proceeding is “conducted according to the procedures established for initial examination,” 35 U.S.C. 305, including Section 132. *Etter*, 756 F.2d at 857.

2. In 2000, the PTO issued U.S. Patent No. 6,167,520 (filed Jan. 29, 1997) (the ’520 patent). In 2007, the PTO granted a request for ex parte reexamination of the ’520 patent. In 2009, the examiner rejected all claims as anticipated by *Rx PC: The Anti-Virus Handbook*, written by Janet Endrijonas and published in 1993 (Endrijonas). The examiner concluded that the anti-virus program described in Endrijonas included the same elements as the claimed invention. See Pet. App. 3-4, 19.

Petitioner appealed the examiner’s rejection to the Board of Patent Appeals and Interferences (Board).

Petitioner challenged the anticipation rejection, primarily on the ground that Endrijonas did not disclose all of the limitations in the '520 patent. In a single paragraph at the end of his brief, petitioner argued that Endrijonas did not enable persons of skill in the art to practice the invention. See Pet. Board Br. 16 (“There is nothing in the reference which would allow a skilled artisan to make the Virex Programs without undue experimentation.”).

In 2011, the Board affirmed the examiner’s rejections, holding that petitioner’s claims were anticipated by Endrijonas. Pet. App. 3-9. The Board also held that petitioner had failed to establish that Endrijonas was not enabling. *Id.* at 8. The Board observed that petitioner “does not appear to fully assess [the relevant] factors at all,” and that “[i]n the absence of a discussion and analysis” of the enablement inquiry, petitioner had not satisfied its burden. *Ibid.*

3. The court of appeals affirmed. Pet. App. 1-2.

In the Federal Circuit, petitioner contended that the examiner’s initial rejection had not established that Endrijonas was enabling, and that the burden of demonstrating that Endrijonas was not enabling should not have been placed on petitioner. Pet. C.A. Br. 26-28. The court of appeals held the appeal in abeyance pending its decision in *In re Antor Media Corp.*, 689 F.3d 1282 (Fed. Cir. 2012) (*Antor*), which the court viewed as raising similar issues.

In July 2012, the court of appeals issued its decision in *Antor*. The court explained that it had long held that when an examiner rejects a claim on anticipation grounds based on a prior art patent, the patent is presumed enabling for purposes of the examiner’s prima facie showing. 689 F.3d at 1287-1288. In other words,

the examiner need not analyze enablement before issuing the rejection. The *Antor* court held that the same rule should apply when the cited prior art is a printed publication, because the rationale for the presumption—that requiring the PTO to engage in the experimentation and analysis necessary to preemptively verify enablement for every anticipating reference would be unduly burdensome and inefficient—applied equally to printed publications. *Id.* at 1288-1289. The court also noted that, as with initial rejections on other grounds, once the examiner has initially rejected the claim based on an anticipatory printed publication, “the burden shifts to the applicant to submit rebuttal evidence of nonenablement.” *Id.* at 1289.

After issuing its decision in *Antor*, the court of appeals affirmed the Board’s decision in this case without opinion. Pet. App. 1-2.

ARGUMENT

Petitioner contends (Pet. 2-9) that “the examiner should bear the burden of proving that an alleged anticipatory reference is enabled” when that reference is a printed publication. Pet. 3. That contention lacks merit, and petitioner does not contend that the court of appeals’ decision conflicts with any decision of this Court or the Federal Circuit. Further review is not warranted.

1. a. The process of examining a patent application or reexamining a granted patent consists of iterative exchanges between the examiner and the applicant (or patentee), as the examiner issues initial rejections and the applicant addresses the examiner’s invalidity concerns. 35 U.S.C. 131-132; 35 U.S.C. 305 (reexamination is conducted according to procedures governing examination). Section 132 governs the examiner’s initial re-

jection of some or all of the claims of the patent. That provision requires the examiner to provide the applicant the reasons for the rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.” 35 U.S.C. 132(a). Section 132 serves to ensure that the applicant receives adequate “notification” of the grounds of rejection. *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012); see *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). Accordingly, the Federal Circuit has long held that the examiner’s burden in setting forth a prima facie case under Section 132 is not onerous. The examiner need only inform the applicant of the “broad statutory basis for the rejection of his claims, so that [the applicant] may determine what the issues are on which he can or should produce evidence.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (brackets omitted); *In re Hughes*, 345 F.2d 184, 185 (C.C.P.A. 1965).

Once the examiner has issued an initial rejection consistent with Section 132, “the burden shifts to the applicant to come forward with evidence or argument in rebuttal.” *In re Kumar*, 418 F.3d 1361, 1366 (Fed. Cir. 2005). The applicant must persuade the examiner and, on appeal, the Board, that the rejection was erroneous and that the invention is patentable. *Ibid.* If, after considering the applicant’s submissions, the PTO determines that the whole record indicates by a preponderance of the evidence that the claimed invention is patentable, it must issue the patent. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

b. When the examiner initially rejects a patent claim on the ground that it is anticipated by a prior art reference, the examiner may fulfill his Section 132 obligation

to notify the applicant of the statutory basis for the rejection by explaining that “the reference or references relied upon” are anticipatory, and by identifying where each limitation of the rejected claim is reflected in the prior art reference. *Jung*, 637 F.3d at 1363; see *Antor*, 689 F.3d at 1289. Once the examiner makes an anticipation rejection in compliance with Section 132, the burden is on the applicant to demonstrate that the rejection was erroneous. One way in which the applicant may do so is by establishing that the prior art reference’s disclosure would not enable one skilled in the art, without undue experimentation, to practice the invention for which the applicant seeks a patent. See *Jung*, 637 F.3d at 1361-1362, 1363. Thus, although the presumption of enablement relieves the examiner of the obligation to assert in the initial rejection that he has found the prior art reference to be enabling, the subsequent examination proceeds as it would with any other ground of rejection. If the applicant presents evidence or credible argument in support of his contention that the reference is not enabling, the examiner and the Board must determine whether the applicant has overcome the presumption of enablement and, if so, whether the prior art reference is anticipatory. *Id.* at 1363, 1365.

The presumption of enablement is consistent with the general rule that the examiner need not raise and explain every possible issue surrounding each ground of rejection. Because the primary purpose of the prima facie showing is to provide notice, an examiner “is not required to anticipate every possible response to a rejection, including showing that a cited reference is enabling.” *Antor*, 689 F.3d at 1289; see also *Chester*, 906 F.2d at 1578. When an examiner identifies anticipation as a ground of rejection, that notification informs the

applicant that he may raise lack of enablement in his response.

The presumption of enablement also reflects the Federal Circuit's recognition that requiring the examiner preemptively to make the detailed findings necessary to verify enablement would be "manifestly inefficient," "burdensome," and "entirely unnecessary." *Jung*, 637 F.3d at 1363. Because the enablement inquiry requires an analysis of the degree of experimentation necessary to implement an invention, "an examiner, who has no access to experts or laboratories, is not in a position to test each piece of prior art for enablement in citing it, and requiring him to do so would be onerous, if not impossible." *Antor*, 689 F.3d at 1288. Placing that burden on examiners is not justified because Section 132's purpose of providing sufficient information to enable the applicant to decide whether to challenge the anticipation rejection is fulfilled when the examiner simply identifies the reference that predates the application and teaches each and every element of the claim. See *Chester*, 906 F.2d at 1578.

2. That approach applies regardless of whether the prior art reference is a patent or a printed publication. In *Antor*, the court of appeals held that the justifications for applying the presumption of enablement to prior art patents also support applying the presumption when the prior art reference is a printed publication. 689 F.3d at 1288-1289. Petitioner contends (Pet. 4) that *Antor*'s holding that "all prior art is presumed enabled should be reversed." *Antor*'s primary holding was that an examiner need not demonstrate in the initial rejection that a prior art printed publication is enabling. Petitioner also appears to argue, however, that rejections based on anticipatory printed publications should be treated as an

exception to the general rule that the applicant has the burden of demonstrating error in the initial rejection. Petitioner's arguments with respect to both issues lack merit.

a. Petitioner contends (Pet. 7) that examiners should be required to make an enablement determination before initially rejecting a claim on the ground that it is anticipated by a prior printed publication. Petitioner recognizes that the presumption of enablement is justified when the allegedly anticipatory reference is an existing patent because an issued patent necessarily reflects the PTO's determination that the patent's disclosures enable the invention. 35 U.S.C. 112. By contrast, petitioner contends, printed publications "do not go through the same scrutiny." Pet. 3.

Contrary to petitioner's argument, the rationale for presuming enablement for purposes of the initial anticipation rejection is present whether the allegedly anticipating prior art is a patent or a printed publication. The presumption embodies a judgment about the most efficient way of allocating the parties' burdens during the examination process, and those considerations are the same regardless of the type of prior art at issue. See *Antor*, 689 F.3d at 1288-1289 (explaining that the presumption of enablement accorded to prior art patents was not based on the requirement that patents be enabling); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) (extending presumption to unclaimed disclosures in a patent, which also do not receive PTO scrutiny). In both cases, the examiner's identification of the allegedly anticipatory reference gives the applicant notice that he may contest whether those references are enabling. Whether the prior art is a patent or a printed publication, requiring the examiner

to determine whether the prior art enables the creation of the invention without undue experimentation would force the PTO to engage in burdensome preemptive investigation and experimentation in order to anticipate and address enablement issues that the applicant might choose not to dispute. And when the applicant does dispute enablement, he “is in a better position to show, by experiment or argument, why the disclosure in question is not enabling or operative.” *Antor*, 689 F.3d at 1288.

To be sure, the prior PTO scrutiny accorded to an issued patent makes that patent likely, as a practical matter, to be enabling. Because a patent’s specification must describe the invention in such a way “as to enable any person skilled in the art * * * to make and use the same,” 35 U.S.C. 112, the PTO’s grant of a patent necessarily reflects a determination that the patent is enabling. Granted patents, moreover, are entitled to a presumption of validity in subsequent infringement suits. 35 U.S.C. 282. By contrast, the issuance of a printed publication need not reflect a determination by anyone—let alone a determination by the federal agency charged with administering the Patent Act—that the publication will enable one skilled in the art to practice, without undue experimentation, any invention that the publication describes.

At most, however, this distinction suggests that, when a particular prior art reference is a patent, there is an *additional* justification for requiring a patent applicant who challenges an initial anticipation rejection to show that the prior art reference was not enabling. But even when the prior art reference is a printed publication, and that additional justification for the rule is absent, the rationale identified by the Federal Circuit in

Antor applies with full force. In any event, if the applicant chooses to dispute enablement, the PTO must address that issue before denying the patent on anticipation grounds.

Petitioner contends (Pet. 7-8) that it would not be “overly cumbersome” for the examiner to address enablement in the context of prior art printed publications because many publications will clearly not be enabling, and because PTO regulations already require the examiner to undertake a thorough study of prior art. But while some printed publications may contain such sparse discussions that lack of enablement is clear, many publications—such as scientific and technical articles, research proposals, textbooks—contain detailed discussions that require significantly more analysis and experimentation that the applicant is better positioned to perform. If it is facially evident that a printed publication does not enable the invention, moreover, the applicant should easily be able to satisfy his burden of establishing that the prior art is not enabling and does not anticipate his claim. In addition, although an examiner must make a “thorough investigation” of “available” prior art as part of the examination process, 37 C.F.R. 1.104(a)(1), performing the experimentation that is often necessary to determine enablement would be a significant additional burden that is different in kind, as it may require scientific and technical facilities and resources that the PTO does not have.

b. Petitioner challenges (Pet. 5) the *Antor* court’s holding that, after the initial rejection, the applicant bears the burden of demonstrating that the prior art reference is not enabled. See 689 F.3d at 1289. That holding, however, is simply an application of the longstanding rule that, when the examiner initially re-

jects a claim, the applicant must demonstrate that the rejection is erroneous and the invention is patentable. See *Oetiker*, 977 F.2d at 1445. Petitioner also suggests that placing the burden on the applicant will “destroy[] entire industries that rely on patent protection” by allowing “any blogger’s speculation [to] preclude patent protection.” Pet. 5-6. But if the prior art reference is speculative, the applicant should easily be able to overcome the presumption of enablement in his response to the examiner’s rejection.

The placement of such a rebuttal burden on the applicant is justified for the same reasons it makes sense to excuse the examiner from preemptively analyzing enablement. The applicant is better positioned than the PTO to gather evidence supporting his contention that the prior art is not enabling. Cf. *Campbell v. United States*, 365 U.S. 85, 96 (1961) (“[T]he ordinary rule * * * does not place the burden upon a litigant of establishing facts peculiarly within the knowledge of his adversary.”); *National Commc’ns Ass’n v. AT & T Corp.*, 238 F.3d 124, 130 (2d Cir. 2001) (“[A]ll else being equal, the burden is better placed on the party with easier access to relevant information.”). Petitioner does not suggest otherwise or contend that it is impracticable for applicants to demonstrate non-enablement with respect to anticipatory printed publications. Thus, whether the ground of rejection is anticipation by a prior printed publication or by a prior patent, “the PTO’s authority to shift the burden to obtain this information [rebutting the initial rejection] is crucial to ensure that the PTO is not mak[ing] patentability determinations on insufficient facts and information.” *Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007) (citation omitted).

CONCLUSION

The petition for writ of certiorari should be denied.
Respectfully submitted.

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