

Federal Circuit: Published Patent Application Filed Before Challenged Patent's Priority Date Deemed Prior Art in IPRs under 35 U.S.C. § 102(e).

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In a significant decision dated January 14, 2025, the Federal Circuit addressed a recurring issue in Patent Trial and Appeal Board proceedings: whether a published patent application, filed before the challenged patent's priority date but published afterward, can be used as prior art. The court's decision in *Lynk Labs, Inc. v. Samsung Electronics Co., Ltd.*, 2023-2346, Slip. Op. (Fed. Cir. Jan. 14, 2025) affirmed that such applications qualify as prior art under 35 U.S.C. § 102(e) for use in *Inter Partes* Reviews (IPR).

The challenged patent at issue in *Lynk Labs* is U.S. Patent No. 10,687,400, which generally relates to light-emitting diodes and related drivers. Samsung Electronics had filed an IPR petition challenging several claims of the '400 patent as unpatentable under 35 U.S.C. § 103 based on a U.S. Patent Application Publication No. 2004/0206970 to Martin. The essential facts are familiar to PTAB practitioners and were not in dispute—Martin was filed before the challenged patent's priority date but was published after that date. Given that the touchstone of whether a reference qualifies as a printed publication is public accessibility as of the critical date, Lynk Labs asserted that Martin—having been properly filed as a U.S. Patent Application but not otherwise accessible to the public until it was published—did not qualify as prior art in the context of 35 U.S.C. § 311(b), which restricts IPR challenges to “**prior art** consisting of patents or printed publications.”

The PTAB rejected Lynk Labs' argument and concluded that the challenged claims would have been obvious in view of Martin and other references. Lynk Labs appealed to the Federal Circuit. After considering the plain language of the relevant statutes, in addition to their historical context and legislative history, the Federal Circuit affirmed the PTAB's decision and concluded that Sections 311(b) and 102(e)(1) permit IPR challenges based upon published patent applications, even those where the publication did not occur until after the challenged patent's priority date, holding that such published patent applications are deemed prior art in IPRs **as of their filing date**.

The court began by examining the plain language of Section 102(e), which states:

(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 applicant for patent . . .

The statute provides that a U.S. patent application “published under [§] 122(b)” qualifies as prior art to a claimed invention if the application was “filed ... before the [claimed] invention.” Therefore, the court reasoned that “under § 102(e)(1), even if a patent application was published **after** a claimed invention, it may serve as prior art to the invention if the application was filed **before** the invention.”

Next, 35 U.S.C. § 311(b) restricts IPR challenges to “prior art consisting of patents or printed publications.” The court held that, although other provisions in Section 102, such as subsections 102(a) and 102(b), also mention “printed publications,” a published patent application is a specific type of “printed publication” governed by Section 102(e)(1). Therefore, “the plain language of §§ 311(b) and 102(e)(1) permits IPR challenges based upon published patent applications, and such published patent applications can be deemed prior art in IPRs as of their filing date.”

Lynk Labs invoked the historical context behind Section 311(b), arguing that when Congress established published patent applications as prior art under Section 102(e)(1) and limited IPRs to challenges based on “printed publications” under Section 311(b), Congress intended to incorporate the legal term “printed publication” from established case law, invoking the doctrine of “old soil” (i.e., when a statutory term is transplanted from another legal source, it brings the old meaning with it). According to Lynk Labs, this “old soil” (coming from cases addressing subsections 102(a) or 102(b) or their predecessors) means that patent applications can never be “printed publications” under the IPR statute. The court disagreed, pointing out that many of the cases relied on by Lynk Labs predated when patent applications were published. Specifically, some cases even suggested that the reason that patent applications were not deemed printed publications is that, at the time, they were not published at all.

Lynk Labs further asserted that the case law established two requirements for “printed publications”: (1) they must be publicly accessible, and (2) the timing of their public accessibility determines their status as prior art. The Federal Circuit disagreed, explaining that the “when” aspect was governed by other, temporal provisions in the statutes, such as “before the invention thereof by the applicant for patent” in Section 102(a) and “more than one year prior to the date of the application for patent in the United States” in Section 102(b). The term “printed publication” itself does not inherently include any temporal prior-art-status requirement. Instead, Congress set up a distinct timing framework for a published patent application in Section 102(e)(1), which bars patentability based on a published patent application if that application was **filed before** the invention.

Finally, the court held that its interpretation aligns with the “congressional purpose in restricting reexamination”—and later, IPRs—to printed documents. That purpose was “to provide a cheaper and less time-consuming alternative to challenge patent validity on certain issues.” With this goal in mind, Congress permitted certain prior art, such as printed documents, to be asserted in IPRs, while excluding others, such as evidence of sale or public use. Treating published patent applications, as governed by Section 102(e)(1), as available prior art under Section 311(b) is thus fully consistent with Congress’s intent to limit the types of patentability challenges in IPRs.

The Federal Circuit’s decision is important, as it maintains the status quo for PTAB practitioners who frequently relied on Section 102(e) in drafting IPR petitions.

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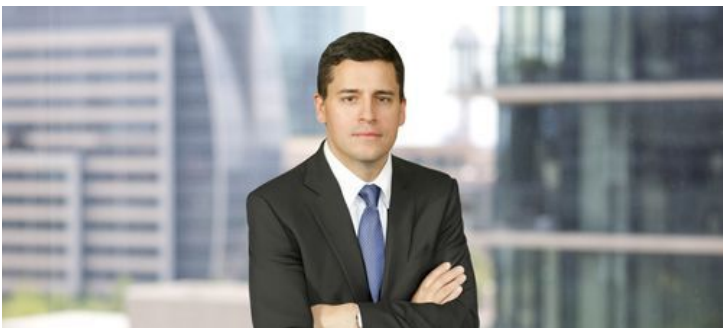
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