

When Is a Published Patent Application Prior Art?

by Robert J.M. Lee

In a precedential opinion entered on January 14, 2025, the United States Court of Appeals for the Federal Circuit affirmed a decision of the Patent Trial and Appeal Board (“PTAB”) invalidating claims of a patent on obviousness grounds under 35 U.S.C. § 103. A key issue in the case was the date upon which a published United States patent application became prior art. The case is *Lynk Labs, Inc. v. Samsung Electronics Co. Ltd.*

Samsung petitioned the PTAB for *inter partes* review of Lynk’s U.S. Patent No. 10,687,400 (“the ’400 patent”), arguing that claims of the ’400 patent are invalid for obviousness over prior art references. In a final written decision, the PTAB held that the challenged claims are invalid as obvious over multiple combinations of prior art references. In relevant part, multiple grounds upon which the challenged claims were found obvious relied on U.S. Patent Publication No. 20040206970 to Martin (“Martin”).

Lynk appealed the PTAB’s decision, arguing that Martin is not a prior art printed publication that can be asserted in *inter partes* review under 35 U.S.C. §§ 102 & 311(b). Notably, the version of Section 102 applied by the Federal Circuit is the version *before* the Leahy-Smith America Invents Act (“AIA”), which amended Section 102 for patent applications with an effective filing date on or after March 16, 2013.

In its analysis, the Federal Circuit assumed that the ’400 patent is entitled to its earliest possible priority date of February 25, 2004. Although Martin has an earlier filing date of April 16, 2003, it was published on October 21, 2004, several months after the assumed priority date of the ’400 patent.

Lynk’s arguments centered on pre-AIA 35 U.S.C. §§ 102(a) & (b). Subsection 102(a) provides that an invention is not patentable where it was “described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent...” Subsection 102(b) provides that an invention is not patentable where it was “described in a printed publication in this or a foreign country...more than one year prior

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to the date of the application for patent in the United States...” While acknowledging that Martin is a printed publication, Lynk argued that Martin was not published before the claimed invention of the '400 patent or more than one year prior to the effective filing date of the '400 patent. Lynk contended, therefore, that Martin is not a prior art printed publication that can be asserted in *inter partes* review under 35 U.S.C. § 311(b). Under case law cited by Lynk, the Federal Circuit recognized that “to be a prior art printed publication as to a given patent under one of these subsections, the reference at issue must have been publicly accessible *before* the date indicated in those subsections...” (emphasis in original).

But the Federal Circuit noted that pre-AIA 35 U.S.C. § 102(e) provides a “special rule” that is applicable specifically to published patent applications, which are treated differently from other publications, such as books or articles. Subsection 102(e) provides that an invention is not patentable where it was described in “an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent...” Under this subsection, the Federal Circuit noted, “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” (emphasis in original).

Applying this analysis to the present case, the Federal Circuit held that Martin is deemed prior art as of its filing date, not as of its publication date. Because Martin was filed before the assumed priority date of the '400 patent, Martin was held to be a prior art printed publication to the '400 patent. The Federal Circuit, therefore, affirmed the PTAB's decision.

As discussed above, the holding in *Lynk Labs* is specific to patents with a pre-AIA effective filing date – that is, patents with an effective filing date before March 16, 2013. But post-AIA 35 U.S.C. § 102 contains analogous provisions stating that an invention is not patentable where “the claimed invention was...described in a printed publication... before the effective filing date of the claimed invention” or where “the claimed invention was described...in an application for patent published or deemed published under section 122(b), in which the...application...names another inventor and was effectively filed before the effective filing date of the claimed invention.” 35 U.S.C. § 102(a). However, post-AIA Section 102 focuses on the *effective filing date* of the claimed invention, rather than the date of the invention. This difference is because the AIA transitioned the U.S. patent system from a “first to invent” system to a “first inventor to file” system.

Lynk Labs makes clear that a patent may be invalidated based on prior art published patent applications, even where a patent application was not publicly available until after the effective filing date of the patent, where the published application has an earlier effective filing date. Additionally, *Lynk Labs* clarifies that such prior art published patent applications can be asserted in *inter partes* review under 35 U.S.C. § 311(b).

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