

# Federal Circuit confirms use of ‘secret springing’ prior art in inter partes patent challenges

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Establishing that a reference qualifies as prior art is a crucial threshold inquiry in challenging the validity of a patent. That is especially true at the Patent Trial and Appeal Board, a special quasi-judicial agency that hears challenges to issued patents at the Patent and Trademark Office. These challenges, which include inter partes reviews (IPRs) and post grant reviews (PGRs), have a lower standard of proof than that required to invalidate a patent in district court, making them attractive to potential infringers who wish to take out patents asserted against them.

On the other hand, the PTAB has limited jurisdiction, and patent challenges in IPRs are limited to anticipation and obviousness grounds based on prior art patents and printed publications. See 35 U.S.C. § 311(b). Evidence of prior-art products on the market or prior use of a claimed invention is not admissible in IPRs.

Parties have long disputed, however, whether patent applications that were filed before the challenged patent, but were not made public until after, should qualify as prior art. These references are identified as a kind of prior art under the pre-AIA version of 35 U.S.C. § 102 for purposes of patent prosecution, but they arguably are not “printed publications” as of the time of the challenged patent under § 311(b).

This is the so-called “secret springing” prior art of pre-AIA 35 U.S.C. § 102(e)(1), i.e., patent applications that, although *published after* the challenged patent, were *filed by another, before* the challenged patent. Such applications are “secret” until they are published, at which time they “spring” into existence as prior art, back-dated to the time of their filing.

In *Lynk Labs, Inc. v. Samsung Electronics Co.*, Appeal No. 23-2346 (Fed. Cir. Jan. 14, 2025), a patent owner defending against a challenge at the PTAB argued that such prior art was not appropriate for IPRs. Lynk argued that, under 35 U.S.C. § 311(b), IPRs may only be based on “prior art consisting of patents or printed publications,” which must necessarily be publicly accessible as of the priority date of the challenged patent. Secret springing prior art is not.

The U.S. Court of Appeals for the Federal Circuit has long held that, to qualify as a “printed publication,” a reference must be sufficiently accessible to the public interested in the art *before* the challenged

patent’s critical date. *Voter Verified, Inc. v. Premier Elections Sols., Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012). Indeed, the court has explained that “public accessibility” *before* the critical date is the “touchstone” of the “printed publication” inquiry. *Samsung Elecs. Co. v. Infobridge Pte.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019). Why then should secret-springing prior art be the exception, when it clearly was not publicly accessible before the challenged patent was filed?

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According to Lynk, § 102(e)(1) patent applications should not qualify as printed publications in IPR proceedings because, even though such applications indisputably qualify as prior art, they are not publicly accessible before the challenged patent’s critical date. Other provisions of pre-AIA § 102 (sub-sections (a) and (b)) expressly refer to “printed publications,” thus reinforcing the notion that patent applications falling under sub-section (e)(1) (which does not use the term “printed publications”) do *not* qualify as printed publications.

The court ultimately rejected those arguments. Published patent applications, the court noted, indisputably qualify as “printed publications” in the literal sense of that phrase — they are “printed” and “published.” They are not published until after the challenged patent’s critical date, to be sure, but that is irrelevant because, according to the court, the meaning of “printed publication” is “temporally agnostic” — any temporal requirement as to when a reference must be published “is drawn from other language” in § 102.

In this case, published patent applications are prior art as of their filing date by virtue of § 102(e)(1), which the court noted creates “a special rule for published patent applications.” Consequently, such

applications fall within the scope of § 311(b). In so holding, the court rejected Lynk's distinction between § 102(e)(1)'s use of the phrase "applications for patent" and sub-sections (a)'s and (b)'s use of the phrase "printed publications," noting that the former is simply a specific instance of the latter.

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The court also rejected Lynk's legislative history arguments based on longstanding precedent emphasizing the importance of public accessibility for determining whether a reference qualifies as a printed publication. Those "older cases," the court noted, focused on non-patent application publications (e.g., books, articles, and the like) which, before the American Inventors Protection Act (AIPA) of 1999, were the *only* forms of printed publications that qualified as prior art. Slip Op. at 14.

In the context of *those* references, the requirement that a reference be publicly accessible before the challenged patent's critical date makes sense. But in the context of published patent applications, the court held, that requirement is inapposite. In short, "Congress chose to afford published patent applications a prior-art effect different from the effect given to" other types of printed publications. *Id.* at 18-19.

Finally, the court noted that under Lynk's theory, an IPR petitioner would have to withhold § 102(e)(1) invalidity challenges grounds from a petition and pursue such grounds in district court, which would undermine some of the efficiencies that it appears Congress may have intended to achieve with IPRs. While Congress may have intended for *some* invalidity challenges to be primarily adjudicated in district court — e.g., public-use-based defenses, which typically involve difficult evidentiary issues — § 102(e)(1) art does not fall within the scope of such challenges.

The Federal Circuit thus held that printed patents and publications that qualify as prior art only under pre-AIA 35 U.S.C. § 102(e) can in fact be considered by the PTAB in assessing post-grant patentability challenges. In doing so, the court upheld the Patent Office's practice of treating so-called secret springing art as "prior art patents and printed publications" under 35 U.S.C. § 311(b) in IPRs. This decision thus brings certainty to a longstanding but recently contested practice.

## About the authors



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