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## Publicly Available Provisional Patent Applications May Not Be Prior Art

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A rejection under 35 USC § 102(e) relying upon the disclosure of a provisional application, which anticipates the rejected claim, may not be as iron-clad as one might think, and a provisional application that one filed may not become effective as prior art. Recently, the Federal Circuit provided new "guidance" (called by some commentators a "reinterpretation") on how to treat prior art patents and published applications that claim priority to provisional applications to determine an effective date of prior art. In *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015), the court held that in order to rely on the provisional filing date of a prior art patent or published application under pre-AIA 35 USC § 102(e), the patent or published application must include a claim that is actually entitled to the benefit of priority of the provisional application.

By itself, a provisional patent application does not qualify as "prior art" under 35 USC § 102. However, a later-filed non-provisional application may be given the benefit of the prior art date of the provisional filing once the non-provisional application is published or patented. According to the Federal Circuit in *Dynamic Drinkware*, "the PTO does not examine provisional applications as a matter of course," and in the context of an IPR proceeding it "would be unsound…[to] create a presumption that a patent is entitled to the benefit of the filing date of its provisional precursor." The court cautioned that a prior art "reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112, ¶ 1."

Based on the *Dynamic Drinkware* decision, a provisional application's effectiveness as prior art depends on its written description support for the claims of the issued patent or published non-provisional patent application. Prior disclosure of another's claimed invention in a provisional application is not enough in itself to qualify the disclosure in the publicly available provisional application as prior art against the other's claimed invention. Rather, in *Dynamic Drinkware* the Federal Circuit held that the petitioner in an IPR asserting prior art has the burden of production and proof that a prior art reference includes claims that are entitled to the earlier filing date of its provisional application. This is in addition to the burden of proof that the provisional application includes the relevant disclosure of the patent sought to be invalidated. Therefore, whether in district court litigation or in a proceeding before the PTAB, a party should be prepared to identify a "claim" in the published prior art reference that is entitled to the provisional filing date and to show that, not only the invalidating disclosure, but also the "claim" finds § 112 support in the priority provisional application.

The PTAB is relying on *Dynamic Drinkware* to dispose IPRs. In *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, IPR2014-01093, Paper 69 (PTAB Jan. 7, 2016), the PTAB issued a final decision upholding the validity of a challenged patent by holding the petitioner failed to prove any claim of the prior art published patent application was supported by the provisional application. This doomed the prior art's priority claim to predate the challenged patent claims under 35 U.S.C. § 102(e). See also, *VMWare v.*

*Clouding Corp.,* IPR2014-1304;-1305, Paper 37 (PTAB Jan. 7, 2016). More recently, the PTAB upheld the validity of a patent for the same reason in *Benitec Biopharma Ltd. v. Cold Spring Harbor Lab.*, IPR2016-00014, Paper 7 (PTAB Mar. 23, 2016). Even though these IPRs were filed before the Federal Circuit decision, it is not clear that the PTAB even gave the petitioner's the opportunity to file supplemental evidence after the *Dynamic Drinkware* decision came down.

The *Dynamic Drinkware* decision is applicable in other contexts. In patent prosecution, when a Section 102(e) reference that relies upon the filing date of a provisional application is applied in a rejection, it is common for the prosecuting attorney to rebut the rejection by pointing out to the Examiner that the provisional application does not disclose the alleged elements of the pending claims. But as equally important, the prosecuting attorney should determine whether it is possible to rebut the rejection by pointing out to the Examiner that the claims of the published application or issued patent being applied do not include any claims supported by the provisional application under 35 USC § 112, which nullifies the use of the disclosure of the provisional application as prior art.

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