



## The most prudent course

### Will your non-US Paris Convention application be prior art under the AIA? Danny Huntington of Rothwell, Figg, Ernst & Manbeck takes a look

Until the recent Court of Appeal for the Federal Circuit decision in *Dynamic Drinkware, LLC v National Graphics* (No 2015-1214, 4 September 2015), everyone would have said 'yes' to the above question, provided the earlier application describes the subject matter at issue. However, after that decision, the answer is not so clear.

In *Dynamic Drinkware*, *Dynamic* filed a petition for inter partes review (IPR) against a patent owned by *National Graphics*. The primary reference was a patent issued on an application filed before the *National Graphics* patent application was filed. *National Graphics* had evidence that it made the invention prior to the filing date of the primary reference, but not before the filing date of an earlier provisional from which the primary reference claimed priority. Thus, the question was whether the disclosure in the provisional application was prior art.

The petition included tables showing where the invention claimed in the *National Graphics* patent was disclosed in both the issued primary reference patent and in the earlier provisional application. However, it did not include a table showing where the invention claimed in the issued primary reference patent was disclosed in the provisional application. The Federal Circuit affirmed the decision of the US Patent and Trademark Office's Patent Trial and Appeal Board, holding that the provisional application was only prior art as of its filing date if it disclosed the invention claimed in the primary reference.

This decision is surprising given the Federal Circuit's earlier ruling in *Re Giacomini* (612 F.3d 1380, 1384–85, 2010), which held that under §102(e)(2) and §119(e)(1), a patent that claimed the benefit of an earlier filed provisional application qualified as prior art, as of the filing date of the provisional application, for all commonly disclosed subject matter. Thus, everyone assumed that as long as the reference was a patent or an application for patent published under 35 USC §122(b), ie, one of the two types of documents that may be relied upon under 35 USC §102(e) to show that claims are unpatentable, a provisional application whose benefit was claimed was prior art for everything it disclosed.

Prior to the entry into force of the America Invents Act (AIA) on 16 March 2013, this issue was not relevant to priority applications filed outside of the US because, under the Hilmer doctrine, they were not prior art. In *re Hilmer* (359 F.2d 859, CCPA 1966), a US application's §102(e) priority date does not extend to its Section 119 foreign filing date.

But that all changed with the new 35 USC §102(d), which provides that: "For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application."

The second subsection adds: **"If the patent or application for patent is entitled to claim a right of priority under Section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under Section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter [Emphasis added]."**

The language in bold means that priority applications filed outside the US can be prior art as of their filing date. While *Giacomini* would have led everyone to believe that describing subject matter in the earlier application would be sufficient, *Dynamic* appears to hold that disclosure by itself will not be sufficient. Instead, it may well be that the claims in the later published US application or US patent must be disclosed in the earlier filed non-US application. To be safe, care should be taken to make certain as much as possible that at least one claim, and preferably all of the claims, of the published application or patent are disclosed in the earlier non-US application.

Nevertheless, this may ultimately prove to be unnecessary because the decision in *Dynamic* explained in a footnote: "Because we refer to the pre-AIA version of §102, we do not interpret here the AIA's impact on *Wertheim* in newly designated §102(d)."

The court based its decision in part on the *Wertheim* decision (646 F.2d 527, 537, CCPA 1981), stating: "A 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".

It is not clear why *Wertheim* should still be applicable. It was decided before pending applications were published, and provided that an earlier unpublished application was only prior art as of its filing date if it supported the claims of the later-issued continuation-in-part patent, because otherwise it would never have become publicly available.

Applications are now published after 18 months without regard to whether the claims of the application are patentable.

So we will not know how new §102(d) will be interpreted until an appropriate case is decided by the Federal Circuit. In the meantime, drafting claims using the disclosure of the earliest application, whether a US provisional application or non-US application whose priority is claimed under 35 USC §119, is the prudent course. **IPPro**



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