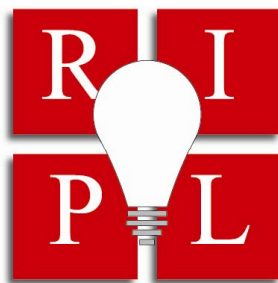


# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## THE GOLDEN CLAIMS: NECESSARY SUPPORT FOR NONPROVISIONAL APPLICATION PRIOR ART REFERENCES TO BE GRANTED PROVISIONAL APPLICATION FILING DATES DURING INTER PARTES REVIEW PROCEEDINGS

MADISON MAKEEVER

### ABSTRACT

Whether to beat an impending disclosure, disclose the most information possible, or simply to get the earliest possible filing date, provisional patent applications are a beneficial way to protect your patent rights. The few formal and statutory requirements allow provisionals to be prepared on a rush basis. The Federal Circuit held in 2017 that published nonprovisional applications can constitute prior art as of its provisional filing date but only as to elements in the application. However, ambiguity regarding published applications in the Federal Circuit's 2015 precedent for awarding a patent its provisional filing date may lead to increased patent invalidation through *Inter Partes* Review proceedings.

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MADISON MAKEEVER\*

## I. INTRODUCTION

Imagine after years of hard work, you finally create a ground-breaking invention. You want to share your invention with the world, yet still profit from all your hard work, so you file a nonprovisional patent application with the United States Patent and Trademark Office (“USPTO”) seeking patent protection.<sup>1</sup> During prosecution, the examiner cites as prior art a later-filed nonprovisional application (“Prior Art A”) that claims priority to an earlier-filed provisional application.<sup>2</sup> This claim of priority, if proper, entitles Prior Art A to the benefit of the filing date of the provisional application.<sup>3</sup> The examiner assesses the provisional application for the requisite support of Prior Art A’s *published claims*. The examiner, having not found adequate support, determines that Prior Art A does not antedate your application and grants you a patent.

Now imagine, after all the time, money, and effort you spent in patent prosecution, that a third party initiates an *Inter Partes* Review (“IPR”) proceeding against your patent. The petitioner cites Prior Art A against you.<sup>4</sup> However, the petitioner examines the provisional for the requisite support of Prior Art A’s *claims as originally filed*. Upon finding the necessary support for the claims as originally filed, Prior Art A is entitled to the filing date of the provisional application. The petitioner then uses Prior Art A to invalidate your patent.

It hardly seems fair that petitioners would be able to use any set of claims—claims as originally filed, claims as published, claims as pending—to establish priority while the USPTO, the organization in charge of priority examination, only allows the claims

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\* © Madison Makeever 2019. Juris Doctor Candidate, May 2020, at The John Marshall Law School; B.S. in Biology, University of Iowa (2016).

<sup>1</sup> 35 U.S.C. § 111(a) (2012) (requiring nonprovisional patent applications to have one or more claims).

<sup>2</sup> 35 U.S.C. § 119(e) (2012) (allowing nonprovisional applications to claim priority to an earlier-filed provisional application).

<sup>3</sup> *Id.*

<sup>4</sup> 35 U.S.C. § 325(d) (2012) (“In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”); see Neil Ziegman, N.P.Z., Inc. v. Stephens, No. IPR2015-01860, 2016 Pat. App. Filings LEXIS 5938, \*6 n.9, 16-17 (P.T.A.B. Feb. 24, 2016) (citing 35 U.S.C. § 325(d)). In discussing 35 U.S.C. § 325(d), the PTAB states that while § 325(d) “appears in Chapter 32 of the Patent Act, which is directed to post-grant reviews, by its terms it is applicable also to proceedings under Chapter 31, which covers *inter partes* review proceedings.” The PTAB is instructed by § 325(d) to take into consideration whether a petition for IPR “raises the same or substantially the same prior art and arguments as those previously presented to the [USPTO].” The PTAB is to use its discretion in deciding whether to deny a petition, “after weighing the particular circumstances of [the] proceeding, the interests of the parties, and the needs of the [PTAB].”

as published to determine whether priority is valid under 35 U.S.C. § 119(e).<sup>5</sup> However, the ambiguity in the current precedent for awarding a provisional filing date to a prior art reference, set out in *Dynamic Drinkware, LLC v. National Graphics, Inc.* (“*Dynamic Drinkware*”), gives petitioners this ability.<sup>6</sup>

The Federal Circuit needs to adopt a clear interpretation of “the claims” of a nonprovisional application prior art reference that requires support in a provisional application in order to be entitled to priority during an IPR proceeding.

Part II of this comment provides the necessary background on the Federal Circuit’s landmark decisions in *Dynamic Drinkware* and *Amgen Inc. v. Sanofi*<sup>7</sup> (“*Amgen*”), as well as amendments to the Manual of Patent Examining Procedure (“MPEP”), relevant statutes, and legislation. Part III provides an in-depth analysis of the *Dynamic Drinkware* and *Amgen* decisions, MPEP § 2136.03, and the effects on IPR proceedings. Part IV proposes a clear interpretation of “the claims” in nonprovisional application prior art references that require support in a provisional application to be awarded the provisional filing date.

## II. BACKGROUND

Provisional applications (“provisionals”) are a special type of patent application proscribed in 35 U.S.C. § 111.<sup>8</sup> There are many differences between provisionals and nonprovisional applications (“nonprovisionals”). The main differences are in regard to application requirements, examination, priority, and protection.

Provisionals do not have the same application requirements as nonprovisionals.<sup>9</sup> The specification of a provisional does not have any formal requirements as to format or scope.<sup>10</sup> The main requirement difference is that provisionals do not require any claims.<sup>11</sup> Provisionals are never published.<sup>12</sup> However, nonprovisionals published eighteen months after their filing dates.<sup>13</sup>

Only nonprovisionals are examined by the USPTO.<sup>14</sup> Oftentimes, the claims of a nonprovisional are changed throughout patent prosecution. Each claim amendment can be thought of as a new set of claims. The claims that are first filed with the specification and drawings of a nonprovisional are considered “the claims as originally filed.”<sup>15</sup> Frequently, claims are amended to overcome rejections.<sup>16</sup> Claims can be

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<sup>5</sup> 35 U.S.C. § 119(e) (2012).

<sup>6</sup> *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

<sup>7</sup> *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

<sup>8</sup> 35 U.S.C. § 111 (2012).

<sup>9</sup> *Id.* (stating that nonprovisional applications require, amongst other things, claims, adequate written description, enablement of a person skilled in the art to make and use the invention, indication as to the best mode, drawings, and an oath or declaration).

<sup>10</sup> *Id.*

<sup>11</sup> 35 U.S.C. § 111(b).

<sup>12</sup> 35 U.S.C. § 122(b).

<sup>13</sup> *Id.*

<sup>14</sup> 35 U.S.C. § 111(b).

<sup>15</sup> *Id.*

<sup>16</sup> 35 U.S.C. § 132(b) (2012) (overcoming a rejection can be done by amending claims); *see also In re Brandt*, 886 F.3d 1171, 1175-1176 (Fed. Cir. 2018) (discussing patent prosecution). “Patent examination usually involves a negotiation between the Patent Office and an applicant about the

amended before publication, which would result in a new set of claims—“claims as published”.<sup>17</sup> Claims can also be amended after publication, which would result in a different set of claims in the pending application—“claims as pending.”<sup>18</sup> Thus, nonprovisionals may have three different sets of claims: claims as originally filed, claims as published, and claims as pending.

Provisionals cannot claim priority.<sup>19</sup> However, nonprovisionals can claim priority to provisionals.<sup>20</sup> A priority claim entitles a nonprovisional to the filing date of a provisional.<sup>21</sup> An applicant has twelve months from the filing date of a provisional to file a nonprovisional that claims priority back to the provisional.<sup>22</sup> Otherwise, the provisional will be abandoned and cannot be used to claim priority.<sup>23</sup> Claiming priority to an earlier-filed provisional does not start the twenty year patent term for the nonprovisional.<sup>24</sup>

A priority claims is the only way to protect the disclosure of a provisional<sup>25</sup> because a patent will never issue from a provisional.<sup>26</sup> To claim priority to a provisional, a nonprovisional must contain a specific reference to the provisional.<sup>27</sup> However, a specific reference alone is not enough to indicate that the claims of the nonprovisional are supported by the provisional.<sup>28</sup>

A priority claim entitles a nonprovisional to the filing date of a provisional only if the invention claimed in the nonprovisional is disclosed in the provisional in compliance with the first paragraph of 35 U.S.C. § 112.<sup>29</sup> The disclosure in the

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metes and bounds of a potential property right.” “During the course of examination, the examiner issues initial rejections for application claims it considers unpatentable, and the applicant in turn may try to traverse those rejections through, *inter alia*, legal argument, evidence, and claim amendments.”

<sup>17</sup> 35 U.S.C. § 122(b)(1)(A) (2012) (stating that nonprovisional patent applications are to be published eighteen months from the earliest filing date).

<sup>18</sup> U.S. PAT. & TRADEMARK OFFICE, U.S. DEPT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE § 714(I) (9th ed. Rev. 8, Jan. 2018) [hereinafter MPEP]; *see also* Michael J. Flibbert & Pier D. DeRoo, *Using Provisional Patent Applications in Invalidity Challenges*, WESTLAW J. INTELL. PROP. (Feb. 28, 2018), <https://www.finnegan.com/en/insights/using-provisional-patent-applications-in-invalidity-challenges.html>. A published nonprovisional application that is still pending could have amended its published claims. This creates another set of claims, claims as pending. These claims would be the most accurate claims according to the USPTO. However, the claims as pending can be amended at any time, which makes them an undesirable choice.

<sup>19</sup> 35 U.S.C. § 119(e) (2012).

<sup>20</sup> *Id.*

<sup>21</sup> *Id.*

<sup>22</sup> 35 U.S.C. § 111(b).

<sup>23</sup> *Id.*

<sup>24</sup> 35 U.S.C. § 154(a)(3) (2012).

<sup>25</sup> 35 U.S.C. § 119(e).

<sup>26</sup> 35 U.S.C. § 111(b).

<sup>27</sup> *Id.*; *see also* Ariosa Diagnostics, Inc. v. Illumina, Inc., No. IPR2014-01093, 2016 Pat. App. LEXIS 197, \*17 (P.T.A.B. Jan. 7, 2016), *aff'd*, 705 F. App'x 1002 (Fed. Cir. 2017) (nonprecedential) (“[I]ncorporation by reference, by itself, however, does not meet the requirement that the claims of the Fan application are supported by the ‘810 provisional in compliance with 35 U.S.C. § 112, first paragraph.”).

<sup>28</sup> *Ariosa*, 2016 Pat. App. LEXIS 197, at \*17.

<sup>29</sup> 35 U.S.C. § 112(a) (1952); *see also* PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299, 1303 (Fed. Cir. 2008) (stating that the requirement of the written description in a provisional must “actually or inherently disclose the claim element” of the nonprovisional application); *Ex parte* Gurevich, No.

provisional must satisfy the written description and enablement requirements of § 112.<sup>30</sup> There is no assumption that there is adequate disclosure.<sup>31</sup> The provisional does not need to contain the exact same words as the nonprovisional to satisfy this requirement.<sup>32</sup>

Provisionals cannot qualify as prior art.<sup>33</sup> However, nonprovisionals filed before March 16, 2013, and patents that issue therefrom, can be cited as prior art as of their provisional filing date.<sup>34</sup> If the provisional filing date is necessary for a nonprovisional to qualify as prior art, “care must be taken to ensure that the disclosure filed as the provisional application adequately” satisfies the written description and enablement requirements.<sup>35</sup>

In *Dynamic Drinkware*, the Federal Circuit affirmed the decision of the Patent Trial and Appeal Board (“PTAB”) that to claim benefit to the filing date of a provisional “the specification of the *provisional* must ‘contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,’ 35 U.S.C. § 112, ¶ 1, to enable an ordinarily skilled artisan to practice the invention *claimed* in the *nonprovisional* application.”<sup>36</sup> The Federal Circuit held that a patent does not qualify as prior art as of its provisional filing date unless “the disclosure of the provisional application provides support for the claims in the reference patent.”<sup>37</sup>

In January of 2018, the USPTO revised the MPEP to incorporate the *Dynamic Drinkware* decision.<sup>38</sup> The revision of MPEP § 2136.03 indicated that

for a U.S. patent that claims benefit of a prior U.S. provisional application, the critical reference date under pre-AIA 35 U.S.C. § 102(e) of the patent may

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2017-010769, 2018 Pat. App. LEXIS 3768, \*5 (P.T.A.B. May 18, 2018) (quoting *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017)).

<sup>30</sup> *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (quoting *New Railhead Mfg., LLC v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002)); *see also* 35 U.S.C. § 119(e) (discussing claiming priority to patents and nonprovisional applications).

For a patent application filed under 35 U.S.C. § 111(a) or 35 U.S.C. § 363 to have the benefit of the filing date of the provisional, the application must disclose the invention in the manner provided by the first paragraph of 35 U.S.C. § 112 in a provisional application filed under § 111(b) and must name an inventor or inventors named in the provisional application.

<sup>31</sup> *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996)).

<sup>32</sup> *Ex parte O’Sullivan*, No. 2018-001684, 2018 Pat. App. LEXIS 8231, \*10 (P.T.A.B. Oct. 1, 2018) (citing *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995)).

<sup>33</sup> 35 U.S.C. § 102(e) (2012).

<sup>34</sup> *Id.* (adopting the America Invents Act later substituted this section).

<sup>35</sup> MPEP, *supra* note 16, § 211.05(I)(A).

<sup>36</sup> *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (emphasis in original) (quoting *New Railhead Mfg., LLC v. Vermeer Mfg., Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002)).

<sup>37</sup> *Dynamic Drinkware*, 800 F.3d at 1382 (citing *In re Wertheim*, 646 F.2d 527, 537 (C.C.P.A. 1981)) (discussing that the petitioner failed to meet its burden of proving that the asserted prior art patent (“Raymond patent”) was entitled to the benefit of its earlier-filed provisional (“Raymond provisional”) filing date).

<sup>38</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. & TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author); *see also Dynamic Drinkware*, 800 F.3d at 1382 (“A provisional application’s effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional.”).

be the filing date of the provisional application only if at least one of the claims in the patent is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph.<sup>39</sup>

In 2017, the Federal Circuit extended their holding in *Dynamic Drinkware* to published nonprovisionals.<sup>40</sup> *Amgen* held that for a nonprovisional to claim priority to a provisional for prior art purposes, “the specification of the provisional must contain a written description of the invention” and “enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application.”<sup>41</sup> The Federal Circuit further stated that “for the nonprovisional utility application to be afforded the priority date of the provisional application, . . . the written description of the provisional must adequately support the claims of the nonprovisional application.”<sup>42</sup>

In April of 2018, the USPTO further revised the MPEP to account for the Federal Circuit’s decision in *Amgen*.<sup>43</sup> The revision of MPEP § 2136.03 states that

the critical reference date under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent, a U.S. patent application publication . . . may be the filing date of a relied upon provisional application only if at least one of the claims in the reference patent [or] patent application publication . . . is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph.<sup>44</sup>

There is no presumption that a patent or application is entitled to an earlier provisional filing date because the USPTO does not examine provisionals as a matter of course.<sup>45</sup> “[T]he presumption of validity does not . . . create a presumption that all claims issuing from [an] application” are entitled to a provisional filing date.<sup>46</sup> Priority

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<sup>39</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. & TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author).

<sup>40</sup> Michael J. Flibbert & Pier D. DeRoo, *Using Provisional Patent Applications in Invalidity Challenges*, WESTLAW J. INTELL. PROP. (Feb. 28, 2018), <https://www.finnegan.com/en/insights/using-provisional-patent-applications-in-invalidity-challenges.html>.

<sup>41</sup> *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017) (quoting *Dynamic Drinkware*, 800 F.3d at 1378).

<sup>42</sup> *Amgen*, 872 F.3d at 1380 (quoting *New Railhead Mfg., LLC v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002)).

<sup>43</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. & TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author).

<sup>44</sup> *Id.*

<sup>45</sup> *D Three Enters., LLC v. Rillito River Solar LLC*, Civil Action No. 15-cv-1148-CBS, 2017 U.S. Dist. LEXIS 37137, \*13 (D. Colo. Mar. 15, 2017), *aff’d*, 2018 U.S. App. LEXIS 13175 (Fed. Cir. 2018) (citing *Dynamic Drinkware*, 800 F.3d at 1380); *see also* *Focal Therapeutics, Inc. v. Senorx, Inc.*, No. IPR2014-00116, 2014 Pat. App. Filings LEXIS 1269, \*13 (P.T.A.B Apr. 22, 2014) (“With respect to entitlement to any earlier effective filing date, however, a patent owner is not presumed to be entitled to the earlier filing dates of ancestral applications that do not share the same disclosure.”).

<sup>46</sup> *D Three*, 2017 U.S. Dist. LEXIS 37137, \*13 (quoting ROBERT A. MATTHEWS, JR., 3 ANNOTATED PATENT DIGEST § 16:31.50 (Feb. 2017)); *see also* *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1305 (Fed. Cir. 2008) (discussing the presumption of priority).

“When neither the PTO nor the Board has previously considered priority, there is simply no reason to presume that claims in [an] application are entitled to the effective filing date of an earlier-filed application.” “Since the PTO did not make a determination regarding priority, there is no finding for the district court to defer to.”

cannot be shown simply from “information and inferences drawn from uncited references.”<sup>47</sup>

There are different burdens of proof for priority claims during patent prosecution and IPR proceedings. The MPEP governs the examination protocol for examiners during patent prosecution.<sup>48</sup> The *Dynamic Drinkware* decision sets forth what petitioners must prove to prevail on a priority claim for § 102(e) prior art during IPR proceedings.<sup>49</sup>

During patent prosecution, the prima facie case is a procedural device that shifts the burden of production.<sup>50</sup> The initial burden of presenting a prima facie case of unpatentability on review of the prior art is on the examiner.<sup>51</sup> The examiner is not required to provide the applicant with a copy of any underlying provisionals.<sup>52</sup> If that burden is met, the burden shifts to the applicant to present evidence or arguments.<sup>53</sup>

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<sup>47</sup> L.A. Biomedical Res. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co., 849 F.3d 1049, 1058 (Fed. Cir. 2017).

<sup>48</sup> MPEP, *supra* note 16, *Foreword*.

<sup>49</sup> *Dynamic Drinkware*, 800 F.3d at 1378-1380; *see also* Heather R. Kissling, *Failure to Establish Published U.S. Application is Prior Art Dooms IPR under Dynamic Drinkware*, PTABWATCH (Apr. 7, 2016), <https://www.ptabwatch.com/2016/04/failure-to-establish-published-u-s-application-is-prior-art-dooms-ipr-under-dynamic-drinkware/> (stating that the petition must prove that the reference is entitled to the benefit of the earlier filing date by showing support for the reference claims in the provisional and that the anticipatory disclosure of the reference is shared by the provisional).

<sup>50</sup> *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)); *see also In re Brandt*, 886 F.3d 1171, 1177 (Fed. Cir. 2018) (“This burden-shifting framework makes sense during patent examination because an examiner typically has no knowledge of objective considerations, and those considerations ‘may not be available until years after an application is filed.’” (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1080 n.7 (Fed. Cir. 2012))); *In re Oetiker*, 977 F.2d at 1445 (“The term ‘prima facie case’ refers only to the initial examination step.”).

<sup>51</sup> *In re Oetiker*, 977 F.2d at 1445 (citing *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984)); *see also Ex parte Yamaguchi*, No. 2007-4412, 2008 Pat. App. LEXIS 34 (B.P.A.I. Aug. 29, 2008) (“The USPTO must demonstrate that the earlier filed application contains § 112 [sic] support for the invention claimed in the reference patent.” (quoting *In re Wertheim*, 646 F.2d 527, 528 (C.C.P.A. 1981))); *In re Oetiker*, 977 F.2d at 1449 (Plager, J., concurring) (“In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct.” (citing *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985))); MPEP (9th ed. Rev. 8, Jan. 2018) § 706.02(a) (“In order to determine which paragraph of 35 U.S.C. § 102 applies, the effective filing date of the application and each claimed invention must be determined and compared with the date of the reference.”).

<sup>52</sup> *Ex parte Yamaguchi*, 2008 Pat. App. LEXIS 34, \*26 (“[E]nhancements to Public PAIR have obviated the need to supply copies of provisional applications relied upon to give prior art effect under § 102(e) to references applied in rejections.”); *see also Ex parte Gurevich*, No. 2017-010769, 2018 Pat. App. LEXIS 3768 (P.T.A.B. May 18, 2018) (“[R]egardless of whether the Examiner’s rejection relied upon the limitations of the claims in the published [nonprovisional] application, for the Examiner to rely upon the filing date of the provisional application, the claims of the published application (a nonprovisional application) must be supported by the provisional application.”).

<sup>53</sup> *In re Oetiker*, 977 F.2d at 1445 (citing *In re Piasecki*, 745 F.2d at 1472); *see also Hyatt*, 492 F.3d at 1370 (citing *In re Oetiker*, 977 F.2d at 1445) (“[I]t is important to require the PTO to adequately explain the shortcomings it perceives so that the applicant is properly notified and able to respond.”); *Ex parte Yamaguchi*, 2008 Pat. App. LEXIS 34, \*25 (“By making this factual finding, the Examiner then shifted the burden to Applicants to show why such a factual finding was erroneous.”).



Patentability is determined “by a preponderance of evidence with due consideration to persuasiveness of argument” based on all the evidence on the record.<sup>54</sup>

During IPR proceedings, “there are two distinct burdens of proof: a burden of persuasion and a burden of production.”<sup>55</sup> The petitioner bears the burden of persuasion to prove unpatentability by a preponderance of the evidence and never shifts to the patent owner.<sup>56</sup> To be entitled to a provisional filing date, the petitioner must establish that he relies on subject matter from a nonprovisional that is present in and supported by its provisional.<sup>57</sup>

However, the burden of production is a shifting burden.<sup>58</sup> This burden initially falls on the petitioner.<sup>59</sup> The petitioner must “specify where each element of [a] claim is found in the prior art.”<sup>60</sup> The burden then shifts to the patent owner “to argue or produce evidence that either [the alleged prior art] does not actually anticipate” or does not qualify as prior art because the asserted claims in the at-issue patent predate the filing date of the alleged prior art.<sup>61</sup> The burden then returns to the petitioner “to prove that either the invention was not actually reduced to practice or that the

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<sup>54</sup> *In re Oetiker*, 977 F.2d at 1445; see also *Ex parte Zhouyue Pi*, No. 2017-009007, 2018 Pat. App. LEXIS 6071 (P.T.A.B. Aug. 1, 2018) (“[T]he record would need to show that at least one of the claims in [the alleged prior art application] is supported by the provisional application.”).

<sup>55</sup> *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326-1327 (Fed. Cir. 2008)); see also *Subaru of Am., Inc. v. Blitzsafe Tex., LLC*, No. IPR2018-00090, 2018 Pat. App. LEXIS 5849, \*9 (P.T.A.B. April 20, 2018) (stating that the petitioner cannot satisfy its burden of proof by employing “mere conclusory statements” (quoting *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016))).

<sup>56</sup> 35 U.S.C. § 316(e) (2012); see also *Dynamic Drinkware*, 800 F.3d at 1378 (“The burden of persuasion ‘is the ultimate burden assigned to a party who must prove something to a specified degree of certainty,’ such as by a preponderance of the evidence or by clear and convincing evidence.” (quoting *Tech. Licensing*, 545 F.3d at 1326-27)).

<sup>57</sup> *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, No. IPR2013-00131, 2014 Pat. App. LEXIS 6251, \*7 (P.T.A.B. Sept. 12, 2014) (citing *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010)); see *Ex parte Yamaguchi*, 2008 Pat. App. LEXIS 34, \*24-25; see also *Subaru*, 2018 Pat. App. LEXIS 5849, \*18 (citing *Dynamic Drinkware*, 800 F.3d at 1381) (stating that “the burden of establishing that the asserted reference is prior art as of any particular priority date” is on the petitioner during IPR proceedings).

<sup>58</sup> *Dynamic Drinkware*, 800 F.3d at 1379 (citing *Tech. Licensing*, 545 F.3d at 1327).

<sup>59</sup> *Dynamic Drinkware*, 800 F.3d at 1378-1379; see also *Securus Tech., Inc. v. Glob. Tel\*Link Corp.*, No. IPR2015-00153, 2015 Pat. App. Filings LEXIS 6049, \*8-9 (P.T.A.B. May 1, 2015) (“When the qualification of a reference as prior art depends on the existence of adequate support in another reference, this mandate requires that Petitioner explain where such support for its challenge can be found.”).

<sup>60</sup> *Securus Tech.*, 2015 Pat. App. Filings LEXIS 6049, \*8 (quoting 37 C.F.R. § 42.104(b)(4) (2012)); see also *Dynamic Drinkware*, 800 F.3d at 1380 (“Dynamic [as the petitioner] had the initial burden of production, and it satisfied that burden by arguing that Raymond [cited as prior art patent] anticipated the asserted claims of the ‘196 patent under § 102(e)(2).”).

<sup>61</sup> *Dynamic Drinkware*, 800 F.3d at 1380 (“National Graphics produced evidence that the invention claimed in the ‘196 patent was reduced to practice prior to the filing date of Raymond, and thus contended that the asserted claims were entitled to a date of invention prior to that of the Raymond patent.”); see also *Dynamic Drinkware*, 2014 Pat. App. LEXIS 6251, \*9 (stating that a patent owner can antedate a piece of prior art and eliminate it as a reference if the patent owner can prove actual or constructive reduction to practice of the invention claimed in the at-issue patent prior to the effective prior art date).

[alleged] prior art was entitled to the benefit of a filing date prior to the date of [the patent owner's] reduction to practice.”<sup>62</sup>

### III. ANALYSIS

Provisionals can be very beneficial to applicants. Applicants are able to submit a provisional to the USPTO with as much or as little detail as desired, due to the lack of formal requirements.<sup>63</sup> This allows provisionals to be prepared and filed on a rush basis to beat an impending disclosure. It has become a common strategy for applicants to include “extensive detailed disclosures within their provisional[s],” and then refine the disclosure when they file a nonprovisional.<sup>64</sup>

Provisionals are commonly filed for the purpose of securing an earlier filing date for later-filed applications that will claim priority back to the provisional.<sup>65</sup> The additional year of patent protection from claiming priority to a provisional allows applicants to obtain a priority date while still in the process of assessing commercial interest or value of the invention to determine whether pursuing patent protection by filing a nonprovisional would be beneficial.<sup>66</sup> Provisionals also allow applicants to obtain a priority date while continuing experimental work on the invention to make further advancements.<sup>67</sup> These advancements may then replace aspects of the invention in the later-filed nonprovisional.<sup>68</sup> This, in turn, causes details from the provisional to be left out of the later filings.<sup>69</sup>

The Federal Circuit’s decision in *Dynamic Drinkware* set forth new guidelines for determining an effective prior art date for patents and nonprovisionals that claim priority to provisionals during IPR proceedings.<sup>70</sup> The *Dynamic Drinkware* decision established the support necessary in a provisional for a U.S. patent claiming priority and what actions are sufficient to satisfy the burden of proof.<sup>71</sup>

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<sup>62</sup> *Dynamic Drinkware*, 800 F.3d at 1380 (“Dynamic failed to carry its burden of proving that Raymond’s effective date was earlier than the date that the invention claimed in the ‘196 patent was reduced to practice.”).

<sup>63</sup> Dennis Crouch, *Provisional Patent Applications as Prior Art*, BERKELEY TECH. L.J. (2016), <http://btlj.org/2016/03/provisional-patent-applications-as-prior-art/> (discussing that “[a]lthough preliminary, my analysis of several hundred provisional applications suggests that patent applications regularly include disclosures in provisional applications that are not disclosed in the follow-on published documents”).

<sup>64</sup> *Id.*

<sup>65</sup> 35 U.S.C. § 111(b) (2012); *see also Ex parte Yamaguchi*, No. 2007-4412, 2008 Pat. App. LEXIS 34, \*22 (B.P.A.I. Aug. 29, 2008) (stating the function of provisionals is to claim the benefit of “priority under § 119(e), which is a “patent saving’ provision similar to other priority provisions under § 119”).

<sup>66</sup> 4 DONALD S. CHISUM, CHISUM ON PATENTS § 11.02[g] (2001) (citing 35 U.S.C. § 154(a)(2)-(3) (2012)).

<sup>67</sup> Dennis Crouch, *Provisional Patent Applications as Prior Art*, BERKELEY TECH. L.J. (2016), <http://btlj.org/2016/03/provisional-patent-applications-as-prior-art/>.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> Marc Richards, *Publicly Available Provisional Patent Applications May Not Be Prior Art*, THINK FORWARD (Oct. 30, 2015), <https://www.brinksgilson.com/publicly-available-provisional-patent-applications-may-not-be-prior-art>.

<sup>71</sup> *See generally Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015) (discussing the framework for the burden of production required to establish priority).

However, the decision in *Dynamic Drinkware* leaves a few questions unanswered.<sup>72</sup> The Federal Circuit did not specify “whether support in the provisional is required for all claims, any claim, or something in between.”<sup>73</sup> This issue does not cause much concern regarding patents because patents only have one set of claims—issued claims. The January 2018 MPEP § 2136.03 revision later clarified that for granted patents to qualify as § 102(e) prior art as of a provisional filing date during patent prosecution, at least one of the issued claims must be supported in the provisional.<sup>74</sup> The *Dynamic Drinkware* decision and the MPEP indicate that it is the *issued* claims that demands requisite support in a provisional.<sup>75</sup>

The Federal Circuit’s lack of clarity regarding which claims need support does, however, create an issue when the *Dynamic Drinkware* decision is applied to nonprovisionals. The *Dynamic Drinkware* decision and the April 2018 MPEP § 2136.03 revision create more ambiguity as to the requisite support necessary for a nonprovisional to be entitled to a provisional filing date. For patent prosecution, MPEP § 2136.03 refers to support of at least one claim in a “patent application publication,” which indicates that support of the claims as published is required.<sup>76</sup> However for IPR proceedings, the Federal Circuit’s decision in *Dynamic Drinkware*, that the provisional must support “the invention claimed in the *nonprovisional* application,” does not specify which claims of a nonprovisional are required.<sup>77</sup>

The Federal Circuit increased the probability of invalidating a patent by failing to define “the claims.” This ambiguity gives petitioners multiple chances to find a claim that has the requisite support in any one of the sets of claims. The provisional can be evaluated against the claims of a nonprovisional as originally filed, as published, and as pending to find the requisite support. This lack of clarity leads to inconsistent interpretations of the *Dynamic Drinkware* decision when applied to nonprovisionals during IPR proceedings.

The Federal Circuit has been inconsistent in its decisions regarding which claims of a nonprovisional require support in a provisional during IPR proceedings. The *Amgen* decision, although not explicitly stated, has been interpreted as requiring support of the claims as published to prove priority to a provisional.<sup>78</sup> However in

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<sup>72</sup> *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017) (quoting *Dynamic Drinkware*, 800 F.3d at 1378).

<sup>73</sup> *Ex parte Mann*, No. 2015-003571, 2016 Pat. App. LEXIS 12592, \*14 (P.T.A.B Dec. 23, 2016).

<sup>74</sup> Amanda K. Murphy, *MPEP Update: New Guidance Regarding Effective Prior Art Dates Under § 102(e)*, PROSECUTION FIRST BLOG (Apr. 19, 2018) (emphasis added), <https://www.finnegan.com/en/insights/blogs/prosecution-first/mpep-update-new-guidance-regarding-effective-prior-art-dates-under-102e.html>.

<sup>75</sup> *Dynamic Drinkware*, 800 F.3d at 1382; see also Amanda K. Murphy, *MPEP Update: New Guidance Regarding Effective Prior Art Dates Under § 102(e)*, PROSECUTION FIRST BLOG (Apr. 19, 2018), <https://www.finnegan.com/en/insights/blogs/prosecution-first/mpep-update-new-guidance-regarding-effective-prior-art-dates-under-102e.html>.

<sup>76</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. & TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author) (using the *Amgen* decision to determine the support required of a nonprovisional application during patent prosecution).

<sup>77</sup> *Dynamic Drinkware*, 800 F.3d at 1378.

<sup>78</sup> *Amgen*, 872 F.3d at 1380; see also Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. & TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author) (citing *Amgen*, 872 F.3d at 1380) (using the decision in *Amgen* to revise MPEP § 2136.03 to require support of the claims as published of a nonprovisional application claiming

*Ariosa v. Illumina*, the Court did not discuss which claims of a nonprovisional required support.<sup>79</sup>

While there has been a lack of clarity from the Federal Circuit in regards to IPR proceedings, the PTAB has consistently held that support for claims as published is necessary during patent prosecution.<sup>80</sup> The PTAB has interpreted the *Dynamic Drinkware* decision to indicate that a published nonprovisional can be entitled to the benefit of the filing date of a provisional if the provisional provides sufficient support for the nonprovisional.<sup>81</sup> This is consistent with the USPTO's requirement for patent examiners in MPEP § 2136.03.<sup>82</sup>

An issue arises from the inconsistent treatment of nonprovisionals by examiners and petitioners. Examiners are requiring support of published claims in patent prosecution yet petitioners are able to choose which set of claims to find support for in

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priority during patent prosecution); *Forty Seven, Inc. v. Stichting Sanquin Bloedvoorziening*, No. IPR2016-01529, at 8 (P.T.A.B. Feb. 9, 2017) (discussing that the petitioner needs to prove support in the provisional of “claim 10 or any other claim in the ‘547 publication”).

<sup>79</sup> *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, 705 F. App'x 1002, 1002 (Fed. Cir. 2017) (nonprecedential); see Dennis Crouch, *Federal Circuit Ducks Major Prior Art Analysis: Affirms Weird PTAB Prior Art Holding*, PATENTLY-O (Dec. 11, 2017), <https://patentlyo.com/patent/2017/12/federal-circuit-analysis.html> (citing *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. IPR2014-01093, 2016 Pat. App. LEXIS 197, \*9 (P.T.A.B. Jan. 7, 2016), *aff'd*, 705 F. App'x 1002 (Fed. Cir. 2017) (nonprecedential)) (discussing that the provisional “does not fully support any of the claims pending in the *Fan* application as published”); *Subaru of Am., Inc. v. Blitzsafe Tex., LLC*, No. IPR2018-00090, 2018 Pat. App. LEXIS 5849, \*19 (P.T.A.B. Apr. 20, 2018) (discussing “the required mapping of a claim in Clayton with supporting disclosure in the Clayton Provisional”); *SPTS Tech. Ltd. v. Plasma-Therm LLC*, No. IPR2017-02164, 2018 Pat. App. LEXIS 5816, \*9-10 (P.T.A.B. Apr. 3, 2018) (discussing that the petitioner’s “burden of demonstrating that Lei’s claims are supported sufficiently by the ‘031 provisional”); *Activision Blizzard, Inc. v. Game & Tech. Co.*, No. IPR2016-01885, 2018 Pat. App. LEXIS 5176, \*81-82 (P.T.A.B. Mar. 14, 2018) (discussing that “the Rogers provisional provides written description support for at least one claim of Rogers”); *Huawei Tech. Co. v. Samsung Elec. Co.*, No. IPR2017-01980, 2018 Pat. App. LEXIS 5639, \*15 (P.T.A.B. Feb. 27, 2018) (stating that “each claim limitation must be expressly, implicitly, or inherently supported in the earlier-filed disclosure”); *Growlerwerks, Inc. v. Drink Tanks Corp.*, No. IPR2017-00262, 2018 Pat. App. LEXIS 7284, \*67 (P.T.A.B. Feb. 21, 2018) (citing *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1381 (Fed. Cir. 2015)) (stating that the petitioner “must show the Mociak Provisional’s disclosure supports the claims of Mociak”).

<sup>80</sup> *Ex parte Mann*, No. 2015-003571, 2016 Pat. App. LEXIS 12592, \*15-16 (P.T.A.B. Dec. 23, 2016); see also *Ex parte Zhouyue Pi*, No. 2017-009007, 2018 Pat. App. LEXIS 6071, \*20 (P.T.A.B. Aug. 1, 2018) (requiring support of “at least one of the claims in Kim,” which is a published application); *Ex parte Bridge*, No. 2018-000795, 2018 Pat. App. LEXIS 5516, \*7 (P.T.A.B. July 23, 2018) (requiring “support for the particular relied-upon subject matter in Sorden’s published application”); *Ex parte Gurevich*, No. 2017-010769, 2018 Pat. App. LEXIS 3768, \*6 (P.T.A.B. May 18, 2018) (stating that “the claims of the published application must be supported by the provisional application”); *Ex parte Madhukar Budagavi*, No. 2017-009482, 2018 Pat. App. LEXIS 2022, \*4 (P.T.A.B. Mar. 26, 2018) (discussing “whether the provisional applications support the subject matter relied on in the Van Der Auwera et al. publication”); *Ex parte Lee*, No. 2014-009364, 2017 Pat. App. LEXIS 2357, \*13 (P.T.A.B. Mar. 20, 2017) (requiring “support for the subject matter of Davies’ claimed invention in Davies’ published utility application”); *Ex parte Cropper*, No. 2014-001403, 2016 Pat. App. LEXIS 4427, \*10 (P.T.A.B. June 24, 2016) (discussing “whether the Jakobsson provisional application provides written description support for the claimed subject matter of the published Jakobsson application”).

<sup>81</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. & TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author).

<sup>82</sup> *Id.*

IPR proceedings.<sup>83</sup> This creates discrepancies when petitioners choose to find support for the claims as originally filed or the claims as pending, rather than the claims as published. It hardly seems fair that an examiner, who is specifically trained to analyze prior art and determine priority, is required to analyze the claims as published for support while a petitioner is given a wider scope, and in turn, a higher chance to invalidate an issued patent. The MPEP and PTAB case law outlines what examiners and applicants must prove to prevail on a priority claim for § 102(e) prior art during patent prosecution. The *Dynamic Drinkware* decision sets forth what petitioners must prove to prevail on a priority claim during IPR proceedings.<sup>84</sup>

In patent prosecution, case law determines whether *Dynamic Drinkware*'s burden of proof analysis applies to published nonprovisionals and what the PTAB has deemed adequate.<sup>85</sup> An examiner needs to do more than “merely point at a reference’s claim of priority” because there is no presumption of priority.<sup>86</sup> An examiner would need to compare the part of the alleged prior art that he relied on in the rejection with the disclosure of the provisional.<sup>87</sup> Therefore differences between the alleged prior art and its provisional are acceptable, as long as no differences exist in the portion that the examiner relied on.<sup>88</sup> This distinction is important because differences usually exist due to the different requirements of a provisional and a nonprovisional.<sup>89</sup> An examiner’s showing that only one claim of a nonprovisional prior art was supported was deemed sufficient as long as the supported part was relied on in the rejection.<sup>90</sup> An examiner may show support by comparing a provisional to claims of the alleged prior art.<sup>91</sup> This support can be shown in a claim chart comparing each element of the claims.<sup>92</sup> An examiner may provide page numbers and discussions of necessary support and disclosures.<sup>93</sup>

Case law from the PTAB also shows what is considered unacceptable to meet the burden of proof. Merely asserting that alleged prior art predates the applicant’s application because of the alleged prior art’s provisional filing date, has been held to

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<sup>83</sup> *Id.*

<sup>84</sup> *Dynamic Drinkware*, 800 F.3d at 1378-1380; see also Heather R. Kissling, *Failure to Establish Published U.S. Application is Prior Art Dooms IPR under Dynamic Drinkware*, PTABWATCH (Apr. 7, 2016), <https://www.ptabwatch.com/2016/04/failure-to-establish-published-u-s-application-is-prior-art-dooms-ipr-under-dynamic-drinkware/> (stating that the petition must prove that the reference is entitled to the benefit of the earlier filing date by showing support for the reference claims in the provisional and that the anticipatory disclosure of the reference is shared by the provisional).

<sup>85</sup> *Ex parte Mann*, 2016 Pat. App. LEXIS 12592, \*9.

<sup>86</sup> *Id.* at \*10-11 (“[T]he examiner is currently bound to apply the *Dynamic Drinkware* test and show the prior art reference’s claims are supposed by the provisional application.”).

<sup>87</sup> *Ex parte Yamaguchi*, No. 2007-4412, 2008 Pat. App. LEXIS 34, \*27 (B.P.A.I. Aug. 29, 2008).

<sup>88</sup> *Id.*

<sup>89</sup> See *Ex parte Cropper*, No. 2014-001403, 2016 Pat. App. LEXIS 4427, \*10 (P.T.A.B. June 24, 2016) (discussing that the provisional “appears much shorter” and has “fewer figures that also differ” compared to the alleged nonprovisional prior art).

<sup>90</sup> *Ex parte Gurevich*, No. 2017-010769, 2018 Pat. App. LEXIS 3768, \*4-5 (P.T.A.B. May 18, 2018) (discussing that the applicant’s argument that “features of [some] claims in Das published application are not supported by Das provisional” is insufficient because the examiner did not rely on those claims in the final rejection).

<sup>91</sup> *Ex parte Ravi Kumar Reddy Kanamatareddy*, No. 2017-006692, 2015 Pat. App. LEXIS 13020, \*14 (P.T.A.B. Apr. 23, 2015).

<sup>92</sup> *Id.* at \*15-18.

<sup>93</sup> *Id.* at \*20.

be insufficient.<sup>94</sup> An examiner cannot meet his burden of proof by remaining silent.<sup>95</sup> The PTAB held that an examiner comparing the elements of an applicant's claim to the disclosure of a provisional has not met the burden of proof because the issue is whether the provisional supports the subject matter relied on in the alleged prior art.<sup>96</sup> It is also insufficient for an examiner to show support in a provisional for a paragraph in the specification of the alleged prior art if he does not also show support for one of the claims of the alleged prior art.<sup>97</sup> The PTAB also found it insufficient to show that alleged prior art and disclosure in a provisional disclose the elements of a claim in an applicant's application if the functionality is described in connection with different embodiments.<sup>98</sup>

*Dynamic Drinkware* outlined the burden of proof necessary in IPR proceedings to prove that a prior art reference is entitled to the benefit of a provisional filing date.<sup>99</sup> Case law illustrates how the PTAB and the Federal Circuit have applied this to nonprovisional prior art references. The disclosure in a provisional may be compared to the claims of the alleged nonprovisional prior art by using a claim chart.<sup>100</sup> The PTAB has also deemed testimony by an expert witness acceptable to show written description support for at least one claim of the alleged nonprovisional prior art.<sup>101</sup>

Case law from the Federal Circuit and the PTAB also shows what is considered unacceptable to meet the burden of proof for IPR proceedings. A petitioner who does not specify that the alleged nonprovisional prior art is being applied under § 102(e), but rather states that it generally applies under § 102 has not meet his burden.<sup>102</sup> As

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<sup>94</sup> *Ex parte* Lee, No. 2014-009364, 2017 Pat. App. LEXIS 2357, \*14 (P.T.A.B. Mar. 20, 2017).

<sup>95</sup> *Ex parte* Bridge, No. 2018-000795, 2018 Pat. App. LEXIS 5516, \*10 (P.T.A.B. July 23, 2018).

<sup>96</sup> *Ex parte* Madhukar Budagavi, No. 2017-009482, 2018 Pat. App. LEXIS 2022, \*3-4 (P.T.A.B. Mar. 26, 2018).

<sup>97</sup> *Ex parte* Zhouyue Pi, No. 2017-009007, 2018 Pat. App. LEXIS 6071, \*20 (P.T.A.B. Aug. 1, 2018).

<sup>98</sup> *Ex parte* Bridge, 2018 Pat. App. LEXIS 5516, \*13.

<sup>99</sup> *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015) (stating the burden of establishing that the asserted prior art is entitled to benefit of the filing date of the earlier-filed provisional comes only after the patent owner has satisfied his burden and shifted the burden back to the petitioner).

In *Dynamic Drinkware*, the petitioner failed to meet its burden of proving that the Raymond patent was entitled to the Raymond provisional filing date. The petitioner produced a claim chart comparing claim 1 of the at-issue patent to the Raymond provisional. To meet this burden, the petitioner would have needed to establish that it relied on subject matter from the Raymond patent that is disclosed and supported by the Raymond provisional. This could be evidenced by a claim chart comparing the relied-upon portions of the asserted prior art to its provisional application to indicate that "those portions were carried over from the provisional."

<sup>100</sup> *Subaru, Inc. v. Blitzsafe Tex., LLC*, No. IPR2018-00090, 2018 Pat. App. LEXIS 5849, \*19 (P.T.A.B. Apr. 20, 2018) (finding the petitioner did not satisfy the burden because no claim chart was provided).

<sup>101</sup> *Activision Blizzard, Inc. v. Game & Tech. Co.*, No. IPR2016-01885, 2018 Pat. App. LEXIS 5176, \*81-82 (P.T.A.B. Mar. 14, 2018) (discussing that the petitioner has meet the burden by providing an expert witness's testimony that described the provisional application and its disclosure and then compared the disclosure to the claims of the alleged nonprovisional prior art).

<sup>102</sup> *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. IPR2014-01093, 2016 Pat. App. LEXIS 197, \*9 (P.T.A.B. Jan. 7, 2016), *aff'd*, 705 F. App'x 1002 (Fed. Cir. 2017) (nonprecedential); *see also* McDermott Will & Emery, *In the Wake of Dynamic Drinkware, PTAB Rejects Prior Art Due to Petitioner's Failure to Establish Earlier Priority Dates (VMware, Inc. v. Clouding Corp.)*, JD SUPRA (Mar. 1, 2016), <https://www.jdsupra.com/legalnews/in-the-wake-of-dynamic-drinkware-ptab-35434/> (citing *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. IPR2014-01093, 2016 Pat. App. LEXIS 197 (P.T.A.B. Jan. 7, 2016), *aff'd*, 705 F. App'x 1002 (Fed. Cir. 2017) (nonprecedential)) (discussing that the petitioner failed

with patent prosecution, a petitioner will not satisfy his burden by simply stating that the alleged nonprovisional prior art is entitled to the filing date of a provisional without offering any evidence.<sup>103</sup>

It also would not be sufficient for a petitioner to compare the disclosure of alleged nonprovisional prior art with a provisional without comparing the claims of the nonprovisional with the provisional.<sup>104</sup> A petitioner who shows support for the elements of the claims of the alleged nonprovisional prior art in the disclosure of the nonprovisional, as opposed to the disclosure of a provisional, will not meet his burden.<sup>105</sup> It is not enough that a claim in an alleged nonprovisional prior art reference be identical to a claim in a provisional.<sup>106</sup> There must still be adequate written description support for the claim in the alleged nonprovisional prior art in the provisional.<sup>107</sup>

The necessary support to satisfy the burden of proof for provisional priority of a nonprovisional is similar for patent prosecution and IPR proceedings. However, it is much more likely that the requisite support will be found during IPR proceedings because of the lack of clarity of the *Dynamic Drinkware* decision as applied to nonprovisionals and the scarcity of case law defining what is and what is not acceptable. This puts patent owners at a disadvantage because this makes it fairly easy to invalidate a patent.

#### IV. PROPOSAL

The Federal Circuit needs to present a clear interpretation of the *Dynamic Drinkware* decision as it relates to “the claims” of a nonprovisional prior art reference that require support in a provisional.<sup>108</sup> This would lead to the consistent application of the *Dynamic Drinkware* decision and a more level playing field between petitioners and patent owners in IPR proceedings. Further, the Federal Circuit should interpret “the claims” that require support as the claims as published. Although it could be argued that “the claims” could be interpreted as the claims as originally filed, requiring support of the claims as published is more manageable and practical.

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to “explain how the application met the prior art requirements under § 102(e)” and that “without explicitly stating how the application qualified as prior art under § 102(e), the patent owner was never put on notice of the petitioner’s contentions”).

<sup>103</sup> *Amgen Inc. v. Sanofi*, 872 F.3d 1367, 1380 (Fed. Cir. 2017).

<sup>104</sup> *SPTS Tech. Ltd. v. Plasma-Therm LLC*, No. IPR2017-02164, 2018 Pat. App. LEXIS 5816, \*9 (P.T.A.B. Apr. 3, 2018); *see also* *Subaru, Inc. v. Blitzsafe Tex., LLC*, No. IPR2018-00090, 2018 Pat. App. LEXIS 5849, \*19 (P.T.A.B. Apr. 20, 2018) (analyzing that the petition did not offer “any explanation” of the disclosure of the alleged nonprovisional prior art and “instead merely repeat[ed] the claim language and provide[d] string citations to” the alleged nonprovisional prior art).

<sup>105</sup> *Huawei Tech. Co. v. Samsung Elec. Co.*, No. IPR2017-01980, 2018 Pat. App. LEXIS 5639, \*18 (P.T.A.B. Feb. 27, 2018).

<sup>106</sup> *Forty Seven, Inc. v. Stichting Sanquin Bloedvoorziening*, No. IPR2016-01529, at 10 (P.T.A.B. Feb. 9, 2017) (stating that “it is not enough that claim 10 be identical across the Majeti applications” and discussing a demonstration that the disclosure of the specification of the Majeti provisional application supports “claim 10 of the Majeti publication”).

<sup>107</sup> *Id.* (“Although many original claims will satisfy the written description requirement, certain claims may not.” (quoting *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1349 (Fed. Cir. 2010))).

<sup>108</sup> *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (quoting *New Railhead Mfg., LLC v. Vermeer Mfg., Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002)).

The Federal Circuit needs to set forth a clear interpretation of “the claims” of a nonprovisional that require support in a provisional. The *Dynamic Drinkware* decision does not specifically address the requisite support of nonprovisionals in provisionals.<sup>109</sup> However, the PTAB has held that the *Dynamic Drinkware* decision applies equally to published nonprovisionals and issued patents.<sup>110</sup> Because *Dynamic Drinkware* does not specifically reference nonprovisionals, it does not specify which type of claims requires support.

A clear interpretation of “the claims” would lead to consistent application of the *Dynamic Drinkware* decision. Currently, the *Dynamic Drinkware* decision can be interpreted to require support of the claims as published, the claims as originally filed, or the claims as pending.<sup>111</sup> The *Dynamic Drinkware* decision would be applied

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<sup>109</sup> *Ex parte Mann*, No. 2015-003571, 2016 Pat. App. LEXIS 12592, \*14 (P.T.A.B. Dec. 23, 2016); see also Clarke Stavinoha, *Priority in Prior Art: Requirements for Using Priority Dates of § 102(e) References*, BAKER BOTTS: IDEAS (Oct. 31, 2018), <http://www.bakerbotts.com/ideas/publications/2018/11/priority-in-prior-art>.

In discussing a petition to the Supreme Court for certiorari filed earlier this year in *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, the petition argues that the *Dynamic Drinkware* and *Amgen* create “uncertainty about what constitutes prior art (given that the prior art status of a published application would depend on the content of draft patent claims that are subject to amendment).” This shows that the *Dynamic Drinkware* decision and even the *Amgen* decision do not clarify which claims of a nonprovisional application require support in a provisional.

<sup>110</sup> *Ex parte Mann*, 2016 Pat. App. LEXIS 12592, \*8 (stating that “both statute and case law suggest that the holding in *Dynamic Drinkware* applied equally to any application, regardless of whether a published application or an issued patent”).

<sup>111</sup> *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, 705 F. App’x 1002, 1002 (Fed. Cir. 2017) (nonprecedential); see Dennis Crouch, *Federal Circuit Ducks Major Prior Art Analysis: Affirms Weird PTAB Prior Art Holding*, PATENTLY-O (Dec. 11, 2017), <https://patentlyo.com/patent/2017/12/federal-circuit-analysis.html> (citing *Ariosa Diagnostics, Inc. v. Illumina, Inc.*, No. IPR2014-01093, 2016 Pat. App. LEXIS 197, \*9 (P.T.A.B. Jan. 7, 2016), *aff’d*, 705 F. App’x 1002 (Fed. Cir. 2017) (nonprecedential)) (discussing that the provisional “does not fully support any of the claims pending in the Fan application as published”); see also *Subaru, Inc. v. Blitzsafe Tex., LLC*, No. IPR2018-00090, 2018 Pat. App. LEXIS 5849, \*19 (P.T.A.B. Apr. 20, 2018) (discussing “the required mapping of a claim in Clayton with supporting disclosure in the Clayton Provisional”); *SPTS Tech. Ltd. v. Plasma-Therm LLC*, No. IPR2017-02164, 2018 Pat. App. LEXIS 5816, \*9-10 (P.T.A.B. Apr. 3, 2018) (discussing that the petitioner’s “burden of demonstrating that Lei’s claims are supported sufficiently by the ‘031 provisional”); *Activision Blizzard, Inc. v. Game & Tech. Co.*, No. IPR2016-01885, 2018 Pat. App. LEXIS 5176, \*81-82 (P.T.A.B. Mar. 14, 2018) (discussing that “the Rogers provisional provides written description support for at least one claim of Rogers”); *Huawei Tech. Co. Ltd. v. Samsung Elec. Co. Ltd.*, No. IPR2017-01980, 2018 Pat. App. LEXIS 5639, \*15 (P.T.A.B. Feb. 27, 2018) (stating that “each claim limitation must be expressly, implicitly, or inherently supported in the earlier-filed disclosure”); *Growlerwerks, Inc. v. Drink Tanks Corp.*, No. IPR2017-00262, 2018 Pat. App. LEXIS 7284, \*67 (P.T.A.B. Feb. 21, 2018) (citing *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1381 (Fed. Cir. 2015)) (stating that the petitioner “must show the Mociak Provisional’s disclosure supports the claims of Mociak”); contra *Ex parte Mann*, 2016 Pat. App. LEXIS 12592, \*15-16; see also *Ex parte Zhouyue Pi*, No. 2017-009007, 2018 Pat. App. LEXIS 6071, \*20 (P.T.A.B. Aug. 1, 2018) (requiring support of “at least one of the claims in Kim,” which is a published application); *Ex parte Bridge*, No. 2018-000795, 2018 Pat. App. LEXIS 5516, \*7 (P.T.A.B. July 23, 2018) (requiring “support for the particular relied-upon subject matter in Sorden’s published application”); *Ex parte Gurevich*, No. 2017-010769, 2018 Pat. App. LEXIS 3768, \*6 (P.T.A.B. May 18, 2018) (stating that “the claims of the published application must be supported by the provisional application”); *Ex parte Madhukar Budagavi*, No. 2017-009482, 2018 Pat. App. LEXIS 2022, \*4 (P.T.A.B. Mar. 26, 2018) (discussing “whether the provisional applications support the subject matter relied on in the Van Der Auwera et al. publication”); *Ex parte Lee*, No. 2014-009364, 2017 Pat. App. LEXIS 2357, \*13 (P.T.A.B. Mar. 20, 2017) (requiring “support for the subject matter of Davies’ claimed invention in Davies’ published



consistently to nonprovisionals cited during IPR proceedings, if the Federal Circuit were to set forth which set of claims require support.

Setting forth a clear interpretation would also create a level playing field for petitioners and patent owners during IPR proceedings. However, without a clear interpretation, petitioners are able to examine any and all sets of claims for the requisite support. This gives petitioners a higher chance of finding claims that are supported in a provisional. Specifying which claims a petitioner must find support for in a provisional will give petitioners and patent owners equal chances of finding support and rebutting the support, respectively.

Further, the Federal Circuit should interpret “the claims” of a nonprovisional that require support in a provisional as the claims as published. Nonprovisionals, including their claims, are not available to the public until the applications are published.<sup>112</sup> It is not possible to find a copy of a nonprovisional before it has been published.<sup>113</sup> It is sensible to require support of the claims that are available to the public.

Interpreting the *Dynamic Drinkware* decision to require support of the claims as published in a provisional would be consistent with MPEP § 2136.03.<sup>114</sup> This would standardize the claims that require support in a provisional across patent prosecution and IPR proceedings.<sup>115</sup> Requiring support of the claims as published will give examiners and petitioners equal chances to bar issuance of a patent or invalidate an issued patent, respectively.

Alternatively, it could be argued that the Federal Circuit should interpret “the claims” as the claims as originally filed. The claims as originally filed are the claims that were drafted specifically to claim priority to a provisional. It could also be argued that support of the claims as originally filed should be required because the prior art date of a nonprovisional is the filing date. For this reason, the claims that existed on the filing date should be the ones that are examined.<sup>116</sup>

However, amendments can be made, after a nonprovisional is filed, that are considered part of the original filing. Examination of the prosecution history of a nonprovisional would be required to determine what is actually considered part of the original filing, if the claims as originally filed required support. It is easier to determine which claims are considered the claims as published due to the availability of application publication documents.

An additional counterargument is that the Federal Circuit could require support of the claims as pending. If the cited nonprovisional prior art reference is currently pending, then a petitioner could examine the pending claims for provisional support

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utility application”); *Ex parte Cropper*, No. 2014-001403, 2016 Pat. App. LEXIS 4427, \*10 (P.T.A.B. June 24, 2016) (discussing “whether the Jakobsson provisional application provides written description support for the claimed subject matter of the published Jakobsson application”).

<sup>112</sup> 35 U.S.C. § 122(b) (2012).

<sup>113</sup> 35 U.S.C. § 122(a).

<sup>114</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. AND TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author) (discussing the 2018 revision of MPEP 2136.03, which states that at least one of the published claims in a nonprovisional must be supported in a provisional).

<sup>115</sup> *Id.*

<sup>116</sup> 35 U.S.C. § 102(e) (2012).

because those claims would be the most up-to-date. However, pending claims can change at “nearly any time,” which makes them a volatile choice.<sup>117</sup>

Interpreting “the claims” as the claims as published is the most practical and manageable interpretation of the *Dynamic Drinkware* decision. Nonprovisionals do not qualify as prior art until they have been published.<sup>118</sup> The claims as published are the ones that are first available and most accessible to the public. The claims that appear in the actual prior art reference should be the ones that are analyzed for the requisite support in a provisional.

## V. CONCLUSION

Imagine that you have filed a patent application for examination before the USPTO to protect your invention. During patent prosecution, the examiner assesses many prior art references, including nonprovisional application (“Prior Art A”). Prior Art A was filed after your application, but it claims priority to a provisional, which predates your application. While analyzing Prior Art A and its provisional for the requisite support, the examiner is unable to find the requisite support for the claims as published as required by MPEP § 2136.03.<sup>119</sup> In finding inadequate support in the provisional, the examiner issues you a patent.

During an IPR proceeding, a petitioner, seeking to invalidate your patent, cites Prior Art A as prior art.<sup>120</sup> After examining the provisional, the petitioner is able to find the requisite support for the claims as originally filed. Prior Art A is then awarded its provisional filing date and antedates and invalidates your patent.

Without a clear interpretation of “the claims” of a nonprovisional prior art reference that require support in a provisional, the *Dynamic Drinkware* decision can be applied to any set of claims in a nonprovisional. This puts patent owners at a severe disadvantage because petitioners are given a wider range of material to use to try to invalidate a patent.

The Federal Circuit should interpret the *Dynamic Drinkware* decision to require support for the claims as published of a nonprovisional prior art reference in a provisional in order for the nonprovisional to be entitled to the provisional filing date. The claims as published are the claims that are first available to the public. This interpretation would create a consistent standard for both patent prosecution and IPR proceedings.<sup>121</sup> Nonprovisionals do not qualify as prior art until they are published. It is also easier to determine which claims are considered published, due to the availability of application publication documents. Therefore, requiring support of the

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<sup>117</sup> Michael J. Flibbert & Pier D. DeRoo, *Using Provisional Patent Applications in Invalidity Challenges*, WESTLAW J. INTELL. PROP. (Feb. 28, 2018), <https://www.finnegan.com/en/insights/using-provisional-patent-applications-in-invalidity-challenges.html>.

<sup>118</sup> 35 U.S.C. § 102(e).

<sup>119</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. AND TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author).

<sup>120</sup> 35 U.S.C. § 325(d) (2012); see Neil Ziegman, N.P.Z., Inc. v. Stephens, IPR2015-01860, 2016 Pat. App. Fillings LEXIS 5938, \*7 n.9, 16-17 (P.T.A.B. Feb. 24, 2016) (citing 35 U.S.C. § 325(d)).

<sup>121</sup> Memorandum from Robert W. Bahr, Deputy Comm’r for Patent Examination Policy, U.S. PAT. AND TRADEMARK OFFICE, to Patent Examining Corp. (Apr. 5, 2018) (on file with author).

claims as published during IPR proceedings is the most logical and practical interpretation of the *Dynamic Drinkware* decision.