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# Advisory

August 27, 2002

## INTELLECTUAL PROPERTY

### Patent Appeals Court Ruling Highlights Potential Pitfalls of Over-reliance on Provisional Patent Applications

#### Introduction

A recent case decided by the Court of Appeals for the Federal Circuit (CAFC), the highest specialized court of appeal for intellectual property, highlights some potential pitfalls of filing provisional applications and the widespread over-reliance on filing provisional applications. Too often, companies file a provisional application with sketchy details of the invention (*e.g.*, the text of a speech, a poster/slide presentation, a nucleic acid or amino acid sequence, a chemical structure, or a proposed manuscript for publication) and wait the permitted year to convert the application to a non-provisional (utility) application. As highlighted by this recent case, this can be perilous. If the provisional application does not contain sufficient detail to meet the statutory requirements (discussed below), the subsequent non-provisional application will not be accorded the benefit of the filing date of the provisional application. If that happens, any applications *filed by others* between the provisional and non-provisional filings may constitute prior art to the non-provisional application.

Even worse, and as happened in this case, an applicant's *own activity* can prevent issuance of the non-provisional application. For example, if an applicant publicly discloses or offers for sale its invention prior to filing a provisional, then waits a full year to convert the provisional to a utility application, that public disclosure or offer for sale will constitute prior art to the utility application if the utility application does not get accorded the benefit of the provisional application. The reason is that an applicant's own activity more than one year before the filing date exceeds the one year grace period afforded applicants for U.S. patents.

The lesson to be learned is that filing a sketchy provisional application may provide nothing more than a false sense of security. As discussed below, provisional applications may be beneficial in certain circumstances, if handled properly.

#### Discussion

*New Railhead Mfg. v. Vermeer Mfg. Co.*, No. 02-1028, decided July 30, 2002, articulates the standard for claiming priority to provisional applications.

Under U.S. patent practice, a patent application (whether provisional or non-provisional) must satisfy the requirements under 35 U.S.C. § 112, ¶ 1, which recites, in relevant part, that:

“[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same...”

Unlike a non-provisional application, which requires one or more claims, amongst other requirements, to be considered complete and to be accorded a filing date, a provisional application does not require any claims to be accorded a filing date. *Compare* 35 U.S.C. § 111(a) with 35 U.S.C. § 111(b).

In an effort to establish the earliest possible priority filing date, an applicant may file a provisional application with the U.S. Patent Office. Prior to the expiration of one year from the filing date of the provisional application, the applicant will generally then file a much more detailed and descriptive, non-provisional application in accordance with § 111(a), and claim priority back to the filing date of the provisional application. However, for the non-provisional application to be afforded the priority date of the provisional application, the two applications must share at least one common inventor and the written description of the provisional application must adequately support the claims of the non-provisional application. *See* 35 U.S.C. § 119(e)(1).

In *New Railhead*, the CAFC affirmed the District Court's (N.D. Tex.) summary judgment decision to invalidate certain claims of New Railhead's patent, U.S. Patent No. 5,899,283 (hereinafter "the '283 patent"), directed to a drill bit for horizontal directional drilling of rock formations. Although invalidity of the '283 patent was ultimately based upon the on-sale bar, it resulted from a utility application not being accorded the filing date of a provisional application upon which it was based. In relevant part, the representative claim of the '283 patent directed that the drill bit be angled with respect to the sonde housing of the drill. However, the provisional application did not describe the bit as being angled with respect to the housing, nor did the drawings show the bit attached to the housing. Since commercial embodiments of the patented drill bit were sold more than one year before the filing date of the non-provisional application, but not more than one year before the filing date of the provisional application to which it claimed priority, the '283 patent would be invalid under 35 U.S.C. § 102(b) if it was not afforded the priority date of

the provisional application.

In ruling that the '283 patent was not entitled to the filing date of the provisional application, the Court relied on 35 U.S.C. § 119(e)(1), which was added as part of the Uruguay Round Agreements Act in 1994, allowing applicants for U.S. patents to file provisional applications. The Court interpreted this section to say that the specification of the provisional application 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 as to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application. In meeting these requirements, the applicant must convey to those skilled in the art that, *as of the filing date sought*, there was possession of the invention, and that what is claimed in the patent application is the same as what is described in the specification. Thus, the *provisional application* must comport with § 112, ¶ 1 requirements in order for the *claimed invention contained in the non-provisional application* to be afforded the earlier filing date of the priority provisional application.

*New Railhead* points to considerations that applicants and companies alike should bear in mind when preparing provisional patent applications or in formulating an IP corporate program. Moreover, applicants and companies should, therefore, take note that courts and competitors will be reviewing patents with a more critical eye toward the written description of the provisional to which they may claim the benefit of priority. If the lessons of *New Railhead* are not heeded, the intended advantage of using provisional applications may become a pitfall that compromises business assets. To avoid such pitfalls, consider the following strategy points:

1. Whenever possible, avoid filing sketchy provisional applications. Instead, file a fully-supported "non-provisional-like" application as a provisional application. Only in very time-sensitive circumstances, or other limited circumstances, should a sketchy provisional appli-

cation be filed, which should then be followed shortly thereafter with the filing of a more substantive provisional application.

2. If a provisional application must be filed, it should be as complete as possible given the time allotted. Since the § 112, ¶ 1 standard is the same for a provisional and a non-provisional application, the written description in a proper provisional application should be very similar to that in a complete non-provisional application.
3. If a provisional application is filed, in accordance with point 2 above, do not wait the full year to convert it to a non-provisional application. It should be noted that in certain circumstances (*e.g.*, in biotech or pharmaceutical patent applications) a series of provisional applications may be filed with each one building upon the previous, such that the non-provisional application filed before the expiration of one year from the first-filed provisional application claims priority to the entire series of provisional applications filed within the year.

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*If you would like further information about the topic covered in this Advisory, or any Intellectual Property issue, please contact the Mintz Levin attorney who ordinarily handles your legal affairs, or one of the attorney authors below:*

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