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PTAB: A Provisional Application Must Provide Written Description Support for Relied Upon

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In a decision issued today, the Federal Circuit addressed the issue of whether an Examiner can rely on the filing date of a provisional application under pre-AIA 102(e) to support a rejection based on a later-filed and published non-provisional application. *In Re Riggs*, Case No: 22-1945 (Fed. Cir. Mar. 24, 2025). The Examiner demonstrated that the provisional application supported at least one claim of the non-provisional application but relied on another portion of the non-provisional application for the rejection. The Federal Circuit held that a provisional application must not only provide support for at least one issued claim in the non-provisional but must also provide support for whatever material forms the basis of the rejection.

In this case, the Examiner issued a rejection, which was affirmed by the Board. Among the issues addressed by the Federal Circuit was the Board's determination that the Lettich prior art reference qualified as prior art under pre-AIA 35 U.S.C. § 102(e). Slip, 10. The Lettich reference on which the Examiner relied was a published non-provisional application that claimed priority to a provisional application. Slip, 10. The only dispute was whether Littich was entitled to the priority date of the provisional application. *Id.* The Examiner and the Board relied on *Dynamic Drinkware, Amgen,* and *MPEP § 2136.033* in determining that at least one claim in the non-provisional application had sufficient written description support in the provisional and thus qualified as prior art. Slip, 11. But the Examiner, and the Board, relied on a different portion of the specification to reject the claims without addressing a second issue, whether the provisional application also supported the disclosures on which the Examiner relied. *Id.* The Court found that it had not addressed this specific question. Slip, 12.

The Court observed that in *Dynamic Drinkware* and *Amgen*, the appellants failed to make the initial showing, whether the claims were supported by written description in the respective provisional applications. Slip, 13. Thus, the Court did not reach the second issue. Here, the Court noted, "It makes no sense to suggest that if a single claim is supported by the provisional application, then everything in the later filed application gets the benefit of the provisional date whether supported or not." Slip, 12. And because the Board did not address the second issue here, the Court vacated the Board's decision and remanded. Slip, 14, 16.

While the Court's decision concerns patent prosecution, it also applies to post-grant proceedings. Petitioners must ensure that to the extent they rely on a provisional filing date, any relied-upon disclosure is supported by the provisional application. And Patent Owners must be aware of this requirement so that they can determine whether to challenge the Petitioner's assertions.