

## PROVISIONAL PATENT APPLICATIONS: TO CLAIM OR NOT TO CLAIM

Drafting and filing a “bare-bones” provisional patent application out of expediency or as a cost-savings measure is not always wise. In particular, a complete set of claims is often the basis from which one determines whether the provisional application provides adequate support. Putting off this important claim-drafting effort until after filing the provisional application may raise the risk of failing to provide support for such yet-to-be drafted claims. While effective in saving time and money in the short term, the consequences may involve costly recovery efforts in order to secure the full value of your intellectual property. Early efforts to ascertain why, how and what to claim can thus directly impact a patentee’s ability to claim the filing-date benefit of the provisional application for later-filed applications and their ensuing patents.

### *“Old School” Provisional Applications and the Written Description Requirement*

Soon after the introduction of provisional applications in 1995, many believed that an applicant could secure an early filing date with minimal disclosure and effort, at a low cost relative to a non-provisional application. At first glance it appears that only minimal disclosure would be required. However, the approach of submitting minimal disclosure, without caution, may have implications relating to the statutory requirements of 35 U.S.C. § 111(b). This law requires that a provisional patent application satisfy the written description, enablement and best mode requirements of 35 U.S.C. § 112 in order for a later filed, non-provisional patent application to claim the benefit of the provisional application’s filing date. The pitfalls of not meeting these requirements are illustrated in the Federal Circuit case *New Railhead Mfg. v. Vermeer Mfg. Co.*<sup>1</sup>

The *Vermeer* case dealt squarely with the issue of the sufficiency of a provisional application disclosure under § 112 for priority purposes. In its opinion, the Federal Circuit confirmed the requirement that (emphasis in original):

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 non-provisional application.<sup>2</sup>

In *Vermeer*, the Federal Circuit held that the provisional application failed to meet the written description and enablement requirements of § 112 as relative to key limitations of the non-provisional patent’s claims. As a result, the claims were not afforded the benefit of the provisional application’s filing date, and were further held invalid under § 102(b) in view of a commercial sale that had occurred more than one year before the non-provisional application was filed. The patentee’s reliance upon its provisional application was fatal.

The written description and enablement requirements are effectively the same for both provisional and non-provisional patent applications. In *LizardTech, Inc. v. Earth Resource*

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<sup>1</sup> 298 F.3d 1290 (Fed. Cir. 2002)

<sup>2</sup> *Id.* at 1294.

*Mapping, Inc.*, the Federal Circuit dealt with both the written description and enablement requirements.<sup>3</sup> The claim at issue was directed at creating a seamless discrete wavelet transformation (“DWT”) of an image. The specification disclosed only one method of creating a seamless DWT, which was recited in its first claim. The problem arose regarding claim 21, which was directed to creating a seamless DWT not only by the method described in the specification, but to all methods of producing a seamless DWT.<sup>4</sup> The court found that there was no support in the specification for such a broad claim.

“Whether the flaw in the specification is regarded as a failure to demonstrate that the patentee possessed the full scope of the invention recited in claim 21 or a failure to enable the full breadth of that claim, the specification provides inadequate support for the claim under *section 112*, paragraph one.”<sup>5</sup>

While a claim will not be invalidated under § 112 simply because the embodiments of the specification do not contain examples that explicitly cover the full scope of the claim language,<sup>6</sup> *LizardTech* and other cases such as *AK Steel Corp. v. Sollac*<sup>7</sup> illustrate the dangers of relying on too few embodiments.

[A]s part of the *quid pro quo* of the patent bargain, the applicant's specification must enable one of ordinary skill in the art to practice the full scope of the claimed invention. That is not to say that the specification itself must necessarily describe how to make and use every possible variant of the claimed invention, for the artisan's knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art. But it does mean that, when a range is claimed, there must be reasonable enablement of the scope of the range.<sup>8</sup>

### ***Why, How and What to Claim***

So how does the above discussion relate to provisional applications and the use of claim sets when filing a provisional application? When preparing a provisional application, it is important to look ahead to the scope and types of claims expected to be included in any subsequently-filed application that is expected to claim the benefit of the provisional application's filing date. This is consistent with the strategy of drafting patents relative to the defined claims, rather than the other way around. While there is no penalty for simply adding claims to a later-filed non-provisional application, the additional claims must comply with all statutes and regulations.<sup>9</sup> In order to secure the benefit of the non-provisional filing date, new claims must be supported by the provisional application. Because the adequacy of this support may not be tested until many

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<sup>3</sup> 424 F.3d 1336 (Fed. Cir. 2005)

<sup>4</sup> “performing one or more discrete wavelet transformation (DWT)-based compression processes”

<sup>5</sup> *Id.* at 1345.

<sup>6</sup> See *Union Oil Co. v. Atl. Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000)

<sup>7</sup> 344 F.3d 1234 (Fed. Circ. 2003)

<sup>8</sup> *Id.* at 1244 (internal citations omitted)

<sup>9</sup> *Kingsdown Medical Consultants, Ltd. V. Hollister inc.*, 863 F.2d 867, 874 (Fed. Circ. 1988)

years later during prosecution or litigation, considering the scope of such new claims as part of the provisional application drafting process can be very important.

As an additional consideration, some have expressed concern that including claims within a provisional application could lead to the prosecution estoppel effects of *Festo*<sup>10</sup> in the event that claims of different scope are presented in a subsequent non-provisional application claiming the benefit of the provisional application. However, it is far from clear as to whether prosecution history estoppel would apply in this situation, nor is it clear as to whether having no provisional claims would avoid such estoppel. As no examination is made or prior art cited with respect to the provisional application, mindful communications during the process of preparing subsequent applications claiming the benefit of the provisional application can prevent the creation of such estoppel issues. Moreover, language in the provisional application itself can assist in this manner, such as by identifying the provisional claims as “contemplated.”

### ***International Impact***

While the focus here is upon U.S. law, ensuring that the § 112 written description and enablement requirements have been met is applicable to international applications claiming the benefit of the provisional application. While the relevance of a provisional application varies under different laws, the written description and enablement requirements are generally applicable to all venues. Using the European Patent Office as an example, the ability to claim priority to a U.S. provisional application is implicit from the Guidelines concerning such a priority application under Rule 53(2) (See EPC Guidelines, A-III: 6.7). Article 87(1) of the EPC sets forth relevant disclosure requirements of the provisional application.<sup>11</sup> Accordingly, international filings benefit from claim-drafting efforts at the provisional stage as well.

### ***In Practice***

When time and funding permits, drafting a combination of claims of broad, narrow and otherwise reasonably-tailored scope can bolster the value of your intellectual property and further mitigate potential issues that may arise under § 112. Moreover, such claims can be used as a guide when preparing any subsequent application that claims the benefit of the provisional application. This strategy can help avoid the *Vermeer* problem, and creating a variety of claim sets can help avoid any possible *Festo* implications.

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<sup>10</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002)

<sup>11</sup> *The writers thank Mr. Iain Russell of Brookes Batchellor - London for his insights and contributions.*