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Significant Federal Circuit Decision Revises Prior Art Requirements

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This week a remarkably interesting Federal Circuit case was decided concerning whether an asserted reference, a published non-provisional patent application, was properly shown to qualify as prior art in the rejection of another pending patent application. *In re Riggs*, Case No. 2022-1945 (Fed. Cir. Mar. 24, 2025). The pending patent application was allegedly anticipated under pre-AIA, 35 U.S.C. § 102(e) and obvious under 35 U.S.C. § 103 in view of the published non-provisional patent application.

Specifically, the issue was whether the asserted prior art reference, the published non-provisional patent application, was entitled to the priority date of its corresponding earlier-filed provisional patent application, so that it could properly be used as prior art against the pending patent application.

Here the court provided that, in general, a reference constitutes prior art for all that it teaches, as of its earliest accorded filing date. However, the court also indicated that a reference, a published non-provisional patent application, is not entitled to the filing date of its earlier-filed provisional application just because one particular claim of the reference is demonstrated to be supported by the provisional application.

Rather, the court explained that the provisional application must also provide written description support for the specific portions of that asserted reference, the published non-provisional patent application, which were relied upon in the prior art rejection made by the Patent Office.

For example, during prosecution of the pending patent application, the examiner demonstrated support for one claim of reference published non-provisional patent application in its provisional application. However, the examiner then relied on other portions of the specification of the reference published non-provisional patent application to support the non-patentability rejections that were made, without demonstrating support for those other portions of the reference published non-provisional patent application in the provisional application.

The court mentioned that it made no sense to suggest that when a single claim of the reference non-provisional patent application is demonstrated to be supported

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by the provisional application, then everything in that reference non-provisional patent application is entitled to its provisional application's filing date.

Thus, there is now an additional requirement for determining whether a prior art patent or published patent application is entitled to its earlier provisional patent application's filing date, which full requirement is:

1. demonstrate that the provisional application provides written description support for at least one claim of the reference patent or published application; and
2. demonstrate that the provisional application provides written description support for the specific portions of the reference patent or published application that were relied upon in the prior art rejection made by the Patent Office during prosecution.

The court referenced its earlier holdings in *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015), and *Amgen Inc. v. Sanofi*, 872 F.3d 1367 (Fed. Cir. 2017), as well as MPEP § 2136.03.

For further information, the patent application at issue is U.S. Patent Application No. 11/005,678, which was filed on December 7, 2004, and claims priority to a provisional application filed July 28, 2000 (U.S. Provisional Application No. 60/221,541). The asserted reference published non-provisional application is U.S. Patent Application Publication No. 2002/0049622, which was filed on April 26, 2001, published April 25, 2002, and claims priority to a provisional filed April 27, 2000 (US Provisional Application No. 60/200,035).

Stay tuned for future developments as to whether this reasoning likewise will be applied to matters related to post-AIA, 35 U.S.C. § 102(a)(2), which is the successor of pre-AIA, 35 U.S.C. § 102(e).

If you have questions about the impact of this Federal Circuit decision, please contact [Laura Labeots](#).