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Prior Art Date for Patent Can Go Back to Provisional Filing Date

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In a recent decision, *In re Giacomini,* (Fed. Cir. 2010), the Federal Circuit confirmed that a patent can be considered prior art as of the filing date of an earlier-filed provisional application from which it claims priority. In arriving at this conclusion, the court first looked at 35 U.S.C. 111(b)(8) which states that other sections in Title 35 describing “applications . . . shall apply to provisional applications.” The court next looked at 35 U.S.C. 102(e)(2), which establishes as prior art “an application” which describes the invention and later leads to an issued patent. Reading these together, the court held that subject matter described in a patent can be considered anticipatory as early as the date its provisional application was filed.

In order for subject matter in a patent to be considered anticipatory as of its provisional application filing date, the provisional application must provide written description support for the claimed subject matter in accordance with section 35 U.S.C. 119(e). That is, the subject matter described in the patent must have been sufficiently described in the provisional application in order for it to be anticipatory as of the provisional filing date.

While the *Giacomini* decision only explicitly addressed the effective reference date for patents that issued from provisional applications, it is likely that the holding would also apply to a published application claiming the benefit of a preceding provisional application. In other words, subject matter described in a published application could have an effective anticipatory reference date as of the filing date of an earlier-filed provisional application from which it claims priority, even though no patent has been granted for the published application.

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