Keywords: provisional application; priority; Section 112; prior art; Section 102(e).

General: A patent claiming priority to a provisional application can be a prior art reference under § 102(e) when all subject matter relied upon for a rejection is found in both the patent and the provisional application.

Ex parte Yamaguchi
No. 2007-4412 (B.P.A.I. August 29, 2008)
Application No. 10/862,079

I. Facts

Appellants invented a method relating to flip-chip semiconductor techniques, as claimed in Application Serial No. 10/862,079 ("the present application"). The present application is a divisional application of Application Serial No. 10/087,556 filed March 1, 2002, and claims the benefit of foreign priority under § 119(d) to Japanese Patent Application No. 2001-061381 filed March 6, 2001. Accordingly, Appellants asserted that the present application has an effective filing date of March 6, 2001.

During prosecution, the Examiner rejected claims 7-23 of the present application. Particularly, the Examiner rejected claims 9-23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,596,618 ("Narayanan"), and rejected claims 7 and 8 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,057,453 ("Endo") and Narayanan. Though filed on December 7, 2001, after the effective filing date of the present application, Narayanan claims the benefit under § 119(e) of Provisional Application 60/254,437 ("the provisional application") filed December 8, 2000. In making the rejections, the Examiner relied on subject matter disclosed in both Narayanan and the provisional application.

Appellants argued that the rejections based on Narayanan were improper, stating that Narayanan should not have been available as a reference because (1) the Examiner did not furnish a copy of the provisional application, and (2) the Examiner did not show how the provisional application supports the subject matter relied upon to make the rejection. In response, the Examiner found that the provisional application "clearly show[ed] the same subject matter as applied from the Narayanan et al. patent in the art rejections of the present application." *Ex parte Yamaguchi*, at 4. Further, the Examiner stated that Appellants failed to show any inconsistencies between the subject matter relied upon in making the rejections and the provisional application. Appellants then admitted in the Reply Brief that they had obtained a copy of the provisional application, but argued that "a cursory review of the provisional application…immediately indicate[s] that *it does not identically track* the Narayanan et al. patent." *Id.*

II. Issues

A. Can a patent claiming priority to a provisional application be a prior art reference under 35 U.S.C. § 102(e), when all of the subject matter relied upon for a rejection is found in both the patent and the provisional application?

III. Discussion

A. Yes. Under 35 U.S.C. § 102(e), a provisional application is an "application for patent." Furthermore, such a provisional application does not represent inapplicable "secret prior art" under *In re Wertheim*. *In re Wertheim*, 646 F.2d 527 (C.C.P.A. 1981). Section 102(e)(2) states that "[a] person shall be entitled to a patent unless . . . the invention was described in . . . a patent granted on an *application for patent* by another filed in the United States before the invention by

the applicant for patent . . . ." 35 U.S.C. § 102(e)(2) (2002) (emphasis added). Section 111(b), which provides for the filing of a provisional application, states that "[t]he provisions of this title relating to *applications for patent* shall apply to *provisional applications for patent*." 35 U.S.C. § 111(b)(8) (2002) (emphases added). Accordingly, the Board concluded that under the plain meaning of the above provisions of Title 35, a provisional application can reasonably be considered an "application for patent" within the meaning of 35 U.S.C. § 102(e).

The Board further announced that the "secret prior art" rationale of *Wertheim* is no longer generally applicable to U.S. patents and published applications that rely on provisional applications. Under *Wertheim*, if a patent claiming the benefit of priority to a prior-filed application included new matter "critical to the patentability of the claimed invention," the patent was considered "secret prior art." *See Wertheim*, 646 F.2d at 527. As such, for purposes of anticipation, the patent would not be applicable as an anticipating reference as of the filing date of the parent, but rather would be applicable as an anticipating reference as of the filing date of the patent itself. The *Wertheim* court stated that an Examiner "must demonstrate that the earlier-filed application contains § 120/112 support for the invention *claimed* in the reference patent." *Wertheim*, 646 F.2d at 537. Notably, the *Wertheim* court stated that "if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art,'" as the disclosure "cannot be said to have been incipient public knowledge as of that date 'but for' the delays of the Patent and Trademark Office." *Id.* at 537, 538.

The Board based its finding that *Wertheim* is no longer applicable to determining the critical reference date of a U.S. patent or published application on changes in the statutory scheme that have occurred since the case was decided in 1981. Such changes include 1) the publication of an application eighteen months after the filing date, under § 122(b) and 2) the establishment of provisional applications under § 111(b). Because a provisional application will be publicly accessible when a non-provisional application that claims priority to the provisional application is issued or published, the concerns underlying *Wertheim* no longer apply to publicly-available applications.

In the present case, Appellants argued that the Examiner failed to show whether the provisional application properly supported the subject matter for the rejection. In response, the Examiner made a "somewhat terse and conclusory" statement that both Narayanan and its underlying provisional application "clearly show[ed] the same subject matter." As such, the Board found that the Examiner had shifted the burden to Appellants to show why the factual finding was erroneous. Though the provisional application did "not identically track" Narayanan, the Board noted the differences were "not germane" to the facts relied upon by the Examiner to make the rejection, and further noted that Appellants had not met their burden. Accordingly, the Board held that Narayanan served as prior art as of the filing date of the provisional application.

In a concurrence, Administrative Patent Judge Torczon reasoned that, under the statutory analysis by the majority, *Wertheim* is "no longer tenable authority." Judge Torczon stated that *Alexander Milburn Co. v. Davis-Bournonville Co.*, which preceded *Wertheim* by fifty-five years, did not allow for the *Wertheim* holding in the first place and, moreover, that the subsequently-enacted legislation based on the *Milburn* holding, § 102(e), accordingly provided no basis for the *Wertheim* "but-for" test. *See Wertheim*, 646 F.2d at 538; *Alexander Milburn Co.*, 270 U.S. 390 (1926).

IV. Conclusion

A patent claiming priority to a provisional application can be a prior art reference under § 102(e), when all subject matter relied upon for a rejection is found in both the patent and the provisional application.