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Patent Drafters Beware: Omitted Provisional Language Can Alter Claim Scope

Key Takeaways:

- The Federal Circuit held that provisional application language omitted from the final patent cannot support broader claim interpretations.
- Courts may treat changes and omissions between provisional and non-provisional applications as an indication of the applicant's intended claim scope.
- Applicants should avoid relying on provisional disclosures to define key terms unless that language is clearly carried forward into the issued patent.

In the race to obtain the all-important filing date, patent applicants and inventors rely on provisional applications as a relatively easy and cost-efficient strategy to establish the earliest filing date without needing to develop a full application. The applicants and inventors can then use the ensuing year to supplement and revise the disclosure for a non-provisional or PCT application with all the bells and whistles required by 35 U.S.C. § 111(a). However, as two recent Federal Circuit Court of Appeals decisions highlight, converting the provisional application to a non-provisional application is not a trivial task. The practitioner needs to consider how changes between the provisional and non-provisional applications might be interpreted by a court to determine the applicant's intent in defining the invention. In *DDR Holdings, LLC v. Priceline.com LLC*[1] and *FMC Corporation v. Sharda USA, LLC*[2] the Courts rejected patent holders' attempts to use provisional disclosures for claim term definitions absent in the subsequently issued patents. The holdings emphasize that even subtle shifts between provisional and non-provisional applications may influence claim construction.

What's Said — and Unsaid — Between Filings Can Shape Claim Scope

The decisions in both *DDR* and *FMC* revolve around whether and how disclosures within provisional applications influence how claim terms are interpreted in the later-issued patents. In both cases, the patent holders relied on disclosures that were within the provisional applications but absent from the final patents. The Federal Circuit consistently held that any changes between the provisional application and non-provisional application indicate a "meaningful evolution" of the Applicant's intended scope and that patent holders

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cannot rely on a provisional disclosure to cure deficiencies in the patent specification.

A cardinal rule of claim construction[3] is that, absent an express definition of a term or disavowal of the claim scope, claim terms are to be given their plain and ordinary meaning. At the same time, changes or omissions from a provisional disclosure to a non-provisional disclosure become part of the prosecution history: "a deletion made by the patent drafter between the provisional application and the patent specification is highly significant" and indicative of "an evolution of the applicant's intended meaning of the claim term."[4]

Patent Language – Not Provisional Language – Determine Claim Scope

In *DDR*, the patent holder changed the definition of the term "merchants" between the provisional application and the patent. In the provisional application, "merchants" was broadly defined as parties that make or distribute "products or services." In contrast, the patent provided a narrower interpretation of "merchant" to mean those who make or distribute "goods."[5] The Federal Circuit upheld the district court's claim construction that the term "merchant" in the patent at issue only related to parties that offer goods and does not include parties that offer services. According to the Federal Circuit, if the patent holder intended the term "merchant" to cover those that provide goods *and* services, then the patent drafter would not have omitted the term "services" from the definition of "merchant" in the patent at issue. The broader language within a provisional application does not expand a narrower interpretation of the same term in the patent.

In *FMC*, the district court relied on disclosures in the provisional patent and in a separate patent (US 8,153,145)[6] to find that prior art submitted by the alleged infringer did not anticipate the granted claims or render them obvious. The district court agreed with the patent holder's interpretation that the term "composition" should be interpreted in light of the provisional application disclosure as well as the unrelated '145 patent to exclude "well-known unstable compositions."[7] The district court made this decision despite the absence of any definition in the patent disclosure.[8]

The Federal Circuit disagreed. It held that, regardless of the disclosures of the provisional application and unrelated '145 patent, the term "composition" should be accorded its "plain and ordinary meaning" rather than the narrower construction adopted by the district court.[9] As in *DDR*, the Federal Circuit identified the omission of key language from the provisional application[10] in the later patent and found this omission to be a "meaningful evolution" of the applicant's intent. Thus, the term "composition" should be accorded its plain and ordinary meaning, and that the patent was not intended to cover only stable compositions.[11] According to the Court, any "meaningful alteration" of the provisional application—whether broadening or narrowing—shows the applicant's intended scope of the term.[12] The Court also interpreted the patent holder's decision to include stability disclosure in the '145 patent but not in the patent at issue as a further indication that omission in the patent at issue was intentional.[13]

The Takeaway: Provisional Applications Are Not Risk-Free Disclosures of Inventions

The Federal Circuit's message in both *DDR* and *FMC* is clear: every word matters in a provisional application. The court (and examiners) will view any deviation (including omissions) from the provisional application as intentional decisions by the Applicant to define terms and potentially limit claim scope.

Despite the rush to get provisional applications filed quickly and efficiently, it is worthwhile to identify all key terms that define the invention. This can be particularly relevant for so-

called “paper clip provisional applications” that rely on a minimal disclosure and require significant alterations to meet the requirements of 35 U.S.C. § 111(a) during conversion to the non-provisional application. If possible, the provisional application should be drafted to include descriptions of the full scope of the important terms. Any changes, especially omissions, from the disclosure of the provisional application should be made intentionally and deliberately because the Applicant cannot reach back to the provisional application to justify a particular claim construction during subsequent prosecution or litigation.[14] Drafters of non-provisional applications should always be very thoughtful about making such changes and carefully consider the possible consequences to claim construction in doing so.

[1] 122 F.4th 911 (Fed. Cir. 2024)

[2] No. 2024-2335

[3] See e.g., *Golden Bridge Tech., Inc. v. Apple Inc.,* 758 F.3d 1362 (Fed. Cir. 2014).

[4] *DDR* 122 F.4th at 916. This holding echoes a previous decision in *MPHJ Technology Invs., LLC v. Ricoh Americas Corp.,* 847 F.3d 1363 (Fed. Cir. 2017) (“We conclude that a person of skill in this field would deem the removal of these limiting clauses [from the text of the provisional application] to be significant.”) (Emphasis added.)

[5] *Id.*, at 915-916.

[6] US 8,153,145 claims the benefit of the same provisional application as the patent at issue, but is otherwise unrelated to the patent at issue.

[7] *FMC* slip op. at 4.

[8] The district court’s claim construction was related to a grant of a temporary restraining order (which matured into a preliminary injunction) against the alleged infringer. Litigation between the two parties continues in the district court.

[9] *Id*. at 11.

[10] The key language related to the extensive discussion of stability described in the provisional application.

[11] *Id*. at 7. See also *DDR* 112 F.4th at 916.

[12] *FMC* slip op. at 8.

[13] *Id.*

[14] Incorporation by reference of an earlier application “does not reinstate that term in a later patent that purposely deletes the term.” *Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022).