Giacomini: **Patent-Defeating Date based on Provisional App'n Priority**

Today in *In re Giacomini,* __ F.3d __ (Fed. Cir. 2010)(Rader, C.J.), the Court held that the patent-defeating date of a United States patent claiming priority based upon a provisional application disclosing the same invention is the filing date of the provisional.

Hilmer **has no Application to Domestic Priority**: Appellant unsuccessfully argued that because under *In re Hilmer,* 359 F.2d 859 (CCPA 1966)(Rich, J.), the patent-defeating date of a United States patent claiming priority under the Paris Convention is *not* dated back to the priority date, the same result should apply for priority based upon a provisional application.

(*Hilmer* is indeed an unfortunate precedent, but the answer to curing the "Hilmer problem" is legislative and not to create yet a still further misinterpretation of statutory law. The *Giacomini* case obviously is not an appropriate vehicle to deal with *Hilmer.*)

An excerpt of the Court's decision is attached.

Regards,

Hal

July 7, 2010

United States Court of Appeals for the Federal Circuit

(Serial No. 09/725,737)

IN RE PETER JOSEPH GIACOMINI, WALTER MICHAEL PITIO, HECTOR FRANCISCO RODRIGUEZ, AND DONALD DAVID SCHUGARD

2009-1400

Appeal from the United States Patent and Trademark Office, Board of Patent Appeals and Interferences.

Decided: July 7, 2010

JASON PAUL DEMONT, DeMont & Breyer, LLC, of Holmdel, New Jersey, argued for appellants. With him on the brief was ROBERT L. GREENBERG. Of counsel was JOSEPHINE A. PALTIN.

THOMAS L. STOLL, Associate Solicitor, Office of the Solicitor, United States Patent and Trademark Office, of Arlington, Virginia, argued for the Director of the United States Patent and Trademark Office. With him on the brief were RAYMOND T. CHEN, Solicitor, and THOMAS W. KRAUSE, Associate Solicitor.

Before RADER*, *Chief Judge*, GAJARSA and DYK, *Circuit Judges*.

RADER, *Chief Judge*.

Peter Joseph Giacomini, Walter Michael Pitio, Hector Francisco Rodriguez, and Donald David Shugard (collectively, "Giacomini") appeal from a decision of the Board of Patent Appeals and Interferences ("Board") rejecting certain claims of U.S. Patent Application No. 09/725,737 as anticipated under 35 U.S.C. § 102. *Ex parte Giacomini*, No. 2009-0139 (B.P.A.I. Apr. 15, 2009). Giacomini argues that the anticipatory reference, U.S. Patent No. 7,039,683 ("the Tran patent"), does not qualify as prior art because Giacomini's filing date antedates the Tran patent's filing date. Because the Tran patent has a patent-defeating effect as of the filing date of the provisional application to which it claims priority and which was filed before Giacomini's application, this court affirms.

I.

Giacomini's application—"Method and Apparatus for Economical Cache Population"—was filed on November 29, 2000. The application claims a technique for selectively storing electronic data in a readily accessible memory called a "cache." When a system retrieves requested data from a source, it stores the data in its cache so that it can retrieve the data more quickly next time. Because the cache has a limited space, the system must selectively store data. Giacomini's technique populates the cache with data only when the system receives a certain number of requests for that data. Claim 1 is representative:

A method comprising:

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* Randall R. Rader assumed the position of Chief Judge on June 1, 2010.

was the first to invent the claimed subject matter. Allowing Giacomini's application would create an anomalous result where someone who was not the first to invent in the United States receives a patent.

Giacomini argues that 35 U.S.C. § 119(e) shifts a patent's priority date but not its effective reference date to the filing date of an earlier provisional application. In other words, Giacomini contends that although the Tran patent claims the benefit of priority to the Tran provisional, the Tran patent does not have a patent-defeating effect as of the Tran provisional's filing date.

Giacomini's distinction between priority date and effective reference date largely stems from *In re Hilmer*, 359 F.2d 859 (CCPA 1966). The issue in *Hilmer* was whether a U.S. patent, cited as a section 102(e) prior art reference, was effective as of its foreign filing date under section 119. *Id.* at 862. This court's predecessor rejected the Board's conclusion that "the foreign priority date of a U.S. patent is its effective date as a reference." *Id.* at 870. The court instead held that "Section 119 only deals with 'right of priority.' The section does not provide for the use of a U.S. patent as an anticipatory reference as of its foreign filing date." *Id.* at 862. Thus, *Hilmer* distinguished a patent's priority date under section 119 and effective reference date under section 102(e) in cases involving an earlier foreign application. Giacomini equates a U.S. provisional application to a foreign patent application to argue that the Tran provisional's filing date is not the Tran patent's effective date as a prior art reference.

But at the time this court's predecessor decided *Hilmer*, section 119 only governed the benefit of claiming priority to an earlier filing date in foreign countries. *Id.* at 862. Congress added section 119(e) along with the

enactment of provisional applications in 1994. *See* Uruguay Round Agreements Act, Pub. L. 103-465, 108 Stat. 4809 (1994). Therefore, broad language in *Hilmer* concerning section 119 is not applicable to provisional applications. Also, Giacomini misses an important distinction between *Hilmer* and the present case. *Hilmer* involved an earlier foreign application while the present case deals with an earlier U.S. provisional application. *See Klesper*, 397 F.2d at 885 (*Hilmer* clarified that "domestic and foreign filing dates stand on entirely different footings.").

Section 102(e) codified the "history of treating the disclosure of *a U.S. patent as prior art as of the filing date of the earliest U.S. application* to which the patent is entitled, provided the disclosure was contained in substance in the said earliest application." *Id.* (emphasis added). According to *Hilmer*, an earlier foreign application does not shift a corresponding patent's effective reference date because section 102(e) explicitly requires the earlier application to be "filed in the United States." *Hilmer*, 359 F.2d at 862 (quoting 35 U.S.C. § 102(e)). This court's predecessor warned that section 119 cannot be read with section 102(e) to modify the express domestic limitation. *Id.* In contrast, an earlier provisional application is an application "filed in the United States." 35 U.S.C. § 102(e). Treating a provisional application's filing date as both the patent's priority date and its effective reference date does not raise the alleged tension between sections 102(e) and 119. Given the "clear distinction between acts abroad and acts here," *Hilmer*, 359 F.2d at 879, Giacomini's reliance on *Hilmer* is misplaced. *Id.*

Accordingly, the Tran patent has a patent-defeating effect as of the filing date of the Tran provisional, or September 25, 2000. Giacomini did not file his application until months after Tran filed his provisional application. Giacomini is not the first to invent in the United

States and thus is not entitled to a patent. Because this court affirms the Board's finding of anticipation based on the Tran patent, this court will not review the Board's finding with respect to the Teoman patent.

V.

Because the Board correctly rejected Giacomini's application under 35 U.S.C. § 102(e) on the basis that the invention was described in a patent claiming priority to a U.S. provisional application filed before Giacomini's filing date, this court affirms.

AFFIRMED