

**From:** Assistant Deputy Comm (ADCs)  
**Sent:** Thursday, April 5, 2018 10:16:23 AM  
**Subject:** Dynamic Drinkware-Amgen II memorandum [102(e)]

*This email is being sent to all Directors, SPEs, and Examiners Employees in the Technology Centers.*

The attached memorandum concerns the situation in which a U.S. patent application publication or a published PCT application is being used as prior art under pre-AIA 35 U.S.C. § 102(e).

The January 2018 publication of the MPEP revised § 2136.03 to indicate a new requirement that: for a U.S. patent that claims benefit of a prior provisional application, the critical reference date under pre-AIA 35 U.S.C. § 102(e) of the patent (i.e., the date the U.S. patent is effective as prior art under pre-AIA 35 U.S.C. § 102(e)) may be the filing date of the provisional application **only** if at least one of the claims in the U.S. patent being used as a prior art under pre-AIA 35 U.S.C. § 102(e) is supported by the written description of the provisional application in compliance with pre-AIA 35 U.S.C. § 112, first paragraph. This requirement is based upon a 2015 decision by the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) in *Dynamic Drinkware, LLC, v. National Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015). The January 2018 publication of the MPEP is current as of August 31, 2017.

The attached memorandum indicates that this new requirement is also applicable when a U.S. patent application publication or a published PCT application is being used as prior art under pre-AIA 35 U.S.C. § 102(e). This is a change in practice from what is stated in MPEP § 2136.03, and is the consequence of a Federal Circuit decision (*Amgen v. Sanofi*, 872 F.3d 1367 (Fed. Cir. 2017)), which was decided after the revision date of the January 2018 publication of the MPEP.

Robert Bahr  
Deputy Commissioner  
for Patent Examination Policy