

Patent Prosecution Tips in Light of New Prior Art Rule From *Dental Monitoring v. Align Tech*

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Imagine this: You invent a product that is going to revolutionize your business. To protect your product, you file a patent application at the United States Patent and Trademark Office that claims the distinctive properties of your product and fully describes each of those claims. Then comes bad news. The USPTO rejects the claims in your patent application based on a second, different patent application that was filed after yours, but that claims priority to an earlier patent application that was filed before yours. The catch here is that the earlier patent application does not provide written description

support for any claim in that second, different patent application. That is, while you fully described each of the claims in your patent application, you are now being rejected based on another patent application that did not do the same.

For the past three years, this was a reality at the USPTO. Under the precedential opinion in *Penumbra, Inc. v. Rapidpulse, Inc.*, a later-filed application was entitled to the priority date of an earlier application for prior art purposes under the Leahy-Smith America Invents Act (AIA), regardless of whether that earlier application included a description of the claims of the later-filed application. *Penumbra, Inc. v. Rapidpulse, Inc.*, No. IPR2021-01466, 2023 WL 2605070, at *12-14 (P.T.A.B., Mar. 10, 2023) (precedential).

However, the Federal Circuit's recent decision in *Dental Monitoring SAS v. Align Tech., Inc.*, 25-1752 (Fed. Cir. Aug. 10, 2026) rejected that approach. In *Dental Monitoring*, the Patent Trial and Appeal Board had previously held that U.S. Patent No. 10,755,409 was invalid over various references, one of which was U.S. Patent Publication No. 2021/0068923 (Carrier Publication). In doing so, the Board determined that the Carrier Publication qualified as prior art to the '409 Patent under AIA 35 U.S.C. § 102 because the Carrier Publication was entitled to the filing date of an earlier provisional application to which it claimed priority (Earlier Carrier Provisional Application). Specifically, the Board applied the *Penumbra* decision and held that "for purposes of AIA § 102(d)(2), a reference patent receives the filing date of an earlier application as long as it satisfies the 'ministerial requirements' of §§ 119 and 120 and the earlier application 'describes the subject matter relied upon in the reference patent.'" *Id.*

On appeal, the Federal Circuit disagreed, finding that the Board's reliance on "a less demanding 'ministerial' standard" was inappropriate. *Id.* at 6. Instead, the Federal Circuit held that the Carrier Publication was only entitled to the filing date of the

Earlier Carrier Provisional Application if the Earlier Carrier Provisional Application “provides written description support for at least one claim” in the Carrier Publication. *Id.* at 10. Per the Federal Circuit, (i) “the statutory text is clear that a claim of priority must comply with § 119, which in turn requires written description support under § 112(a),” and (ii) “[a]llowing a patent to claim an earlier priority date based on a provisional that does not support the patent’s claims would ... create uncertainty about what constitutes prior art.” *Id.* at 7 and 9. The Federal Circuit therefore vacated the Board’s decision and remanded the case back to the Board to determine whether the Earlier Carrier Provisional Application provides sufficient written description support for at least one claim of the Carrier Publication. *Id.* at 9-10.

Accordingly, as held by the Federal Circuit, a later-filed application is only entitled to the filing date of an earlier application, for the purposes of qualifying as prior art under AIA 35 U.S.C. § 102, when the earlier application provides written description support for at least one claim of the later-filed application. This decision further aligns prior art priority claims under AIA 35 U.S.C. § 102 with that of pre-AIA 35 U.S.C. § 102. *See In re Riggs*, 22-1945, at 12 (Fed. Cir. Mar. 24, 2025) (noting that a pre-AIA 35 U.S.C. § 102 “prior art patent or published application cannot be accorded the benefit of its provisional application’s filing date absent a showing that the provisional application provides support for the claims of the patent or published application”).

Based on this new ruling, it may be appropriate to reevaluate prosecution strategies going forward, such as for:

- (1) Patent Prosecution: When a USPTO Examiner relies on a reference that needs the priority date of one or more earlier-filed applications, it may be helpful to review the earlier-filed application(s) to determine whether they provide written description support for at least one claim of the

reference. If they do not, that reference would likely not qualify as prior art as of the asserted earlier filing date.

(2) Defensive Publications: When combining multiple provisional applications (and/or foreign applications) into a single filing (e.g., a single U.S. non-provisional filing or a single PCT filing), it may be helpful to include at least one fully supported claim from each provisional application. This may help create a defensive publication that does not miss out on the priority date of one or more of these provisional applications.