

Continuations and incorporation by reference: Beware

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Continuation applications and incorporation are common tools used by patent practitioners. A continuation application enables claims of a later-filed application to obtain the benefit of the earlier-filed application's priority date. Co-pendency, co-inventorship and a priority claim are the three requirements of 35 U.S.C. §120, so what could possibly go wrong? As one patentee recently found out, plenty.

In *Zenon Environmental, Inc. v. United States Filter Corp.*, a patentee's patent was invalid as anticipated by an earlier filed application in the continuity chain.¹ Three patents were at the center of the dispute: U.S. Patent 5,639,373 (the '373 patent or the "grandparent"); U.S. Patent No. 5,910,250 (the '250 patent or the "parent"); and U.S. Patent No. 6,620,319 (the '319 patent or the "child").² There was no dispute that that the grandparent patent disclosed each and every element of the claims of the child patent and that the requirements of overlapping pendency and specific reference to the earlier filed application were met.³ What doomed the child patent was an incorporation by reference statement in the parent patent.

To gain the benefit of the filing date of an earlier application under 35 U.S.C. §120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. §112.⁴ The parent patent disclosed a gas distribution system that was different from the system disclosed in the child patent.

What apparently occurred is that, in filing the parent patent application, the gas distribution system disclosed in the grandparent patent was replaced with a different gas distribution system; but when the child patent application was filed, the original gas distribution system was restored.⁵

Moreover, the parent patent contained the following incorporation by reference statement:

The vertical skein is not the subject matter of this invention and any prior art vertical skein may be used. Further details regarding the construction and deployment of a most preferred skein are found in the parent U.S. Pat. No. 5,639,373 and in Ser. No. 08/690,045, the relevant disclosures of each which are included by reference thereto as if fully set forth herein.⁶

According to the Court, "[t]he plain language expressly limits the incorporation to only relevant disclosures of patents, indicating that the disclosures are not being incorporated in their entirety." Consequently, the child patent was anticipated by the grandparent

patent because the incorporation by reference statement in the parent patent failed to incorporate by reference the entire grandparent patent.

The easy answer to avoid the problem the patentee in *Zenon* encountered would be to always incorporate by reference entire documents. A review of the Court's analysis in *Zenon*, however, reveals this solution may also be risky. According to the Court, "[t]o incorporate material by reference, the host document must identify with *detailed particularity* what specific material it incorporates and *clearly indicate where* the material is found in the various documents." (Emphasis by the Court.)⁷

Moreover, whether material has been incorporated by reference into a host document, and to what extent is now a question of law, subject to de novo review (and we all know how well that has worked for claim construction).⁸

Therefore, an incorporation by reference of a document in its entirety may now raise questions (that are subject to de novo review) of whether specific material was identified with detailed particularity and whether a clear indication was given where the material can be found.

Unfortunately, the best solution appears to be to reproduce the subject matter in all continuing applications (as well as reproducing any other material incorporated by reference). Even though, as Judge Newman noted in a dissenting opinion that reproducing all of the subject matter "adds nothing to the knowledge disclosed to the public, adds nothing to the information provided to the patent examiner, and adds nothing to compliance with 35 U.S.C. §120; it simply adds costs and pitfalls to inventors [and their patent attorneys], as they attempt to walk new judicial tightropes."⁹

Endnotes

¹85 USPQ 2nd 1119 (Fed. Cir. 2007).

²The '319 was the sixth patent to issue from a series of connected applications that were filed by the same assignee. The '319 patent sets forth that it is a continuation-in-part of Ser. No. 09/507,438, filed Feb. 19, 2000, issued as U.S. Pat. No. 6,294,039; which is a division of Ser. No. 09/258,999, filed Feb. 26, 1999, issued as U.S. Pat. No. 6,042,677; which is a division of Ser. No. 08/896,517, filed June 16, 1997, issued as U.S. Pat. No. 5,910,250 (the '250 patent); which is a continuation-in-part of Ser. No. 08/690,045, filed July 31, 1996, issued as U.S. Pat. No. 5,783,083, which is a nonprovisional of provisional application Ser. No. 60/012,921, filed March 5, 1996, and a continuation-in-part of Ser. No. 08/514,119, filed Aug. 11, 1995, issued as U.S. Patent No. 5,639,373 (the '373 patent).

³*Zenon* at 1126-1127.

⁴*Zenon* at 1123; See also, *Lockwood v. Am. Airlines, Inc.*, 107 F.3d, 1565, 1571; 41 USPQ 2d 1961 (Fed Cir. 1997); *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1346; 54

USPQ2d 1915 (Fed. Cir. 2000) (“claims to subject matter in a later-filed application not supported by an ancestor application in terms of §112 ¶1 ... do not receive the benefit of an earlier application’s filing date.”); and *In re Hogan*, 559 F.2d 595; 194 USPQ 527 (CCPA 1997) (“There has to be a continuous chain of co-pending applications each of which satisfies the requirements of §112 with respect to the subject matter presently claimed. ... There must be continuing disclosure through the chain of applications, without hiatus to ultimately secure the benefit of the earliest filing date.”)

⁵*Zenon* 1125-1126.

⁶Col. 2, lines 30-36 of the ‘250 patent.

⁷*Zenon* at 1124.

⁸*Zenon* at 1124; 1129.

⁹*Zenon* at 1129.