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Sent: Tue 5/2/2006 10:38 AM

To: AB93Comments

Cc:

Subject: letter and CIP article from Reg. No. 22180

With a registration 22180 of forty years, I appreciate the opportunity to support the proposed rule changes published at 71 Fed. Reg. 61 (January 3, 2006) in the attached letter and to be published CIP article.

(See attached file: Hon001.PDF)(See attached file:
BLOOMFIELD-#748315-v1-CIP_Article_-_Hal's_Edits.DOC)

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May 2, 2006

Via E-Mail

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark
Office
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P. O. Box 1450
Alexandria, VA 22313-1450

Attn: Robert W. Bahr
Senior Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy

Comments on Proposed Rules: "Changes
to Practice for the Examination of Claims
in Patent Applications"
71 Fed. Reg. 61 (January 3, 2006)

Dear Under Secretary Dudas:

By way of standing, I was an Examiner in USPTO and have been preparing and prosecuting patents around the world for 40 years. I also have extensive experience in the licensing and litigation of patents.

I strongly agree with the objections and nearly all of the proposed rule changes. Although I am a member of the AIPLA, I generally do not agree with the comments in the two letters dated April 24, 2006 and submitted by the Executive Director, Michael K. Kirk.

I have been exposed to the practice of many patent attorneys and can attest to the fact that the USPTO is abused by applications filed without searches followed by serially filed continuations in pursuit of finding inventions. In some instances attorneys merely cancel rejected broad claims to obtain a patent while continuing prosecution of the patentably indistinct broad claims in a continuation.

My article is attached which is nearly ready for publication and which impugns current CIP practice. The article fully supports and relies upon the proposed rule changes but would add even more requirements on specific points.

On these points, I do agree with the AIPLA:

1. that there should be NO double patenting presumption;
2. that there should be NO presumption of patentably indistinct claims in multiple applications; and

C o u n s e l l o r s A t L a w

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The Honorable Jon Dudas
May 2, 2006
Page 2

3. that the rules should in no manner be retroactive to applications filed before the effective date of the rule change.

Too many patent attorneys are acting as administrators by reacting to the USPTO in successive claim amendments to ferret out an invention instead of proactive and skilled patent procedures to present patent applications crafted around prior art in the first instance.

Very truly yours,

DICKINSON WRIGHT PLLC



Harold W. Milton, Jr.
Registration No. 22,180

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C o u n s e l l o r s A t L a w

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WASHINGTON, D.C.

**CIP PRACTICE UNDER & BEYOND THE
PROPOSED RULE CHANGES FOR
CONTINUATIONS**

By: Hal Milton
and student
James P. Bonnamy

TABLE OF CONTENTS

I.	INTRODUCTION	1
A.	A CONTINUATION	1
B.	A CONTINUATION-IN-PART (CIP)	1
C.	THE "CIP" THAT IS NOT A TRUE CIP	2
1.	WHEN ALL CLAIMS RECITE THE NEW SUBJECT MATTER OF "CIP"	2
2.	PARENT INVENTOR NOT INVENTOR OF NEW SUBJECT MATTER OF "CIP"	2
3.	THE "CIP" PRIORITY IS NOT CHALLENGED BY THE USPTO.....	3
4.	THE PUBLIC BURDEN OF A MIS-LABELED "CIP"	3
II.	THE LAW AND NEW SUBJECT MATTER.....	4
A.	THE STATUTES.....	4
B.	THE CASE LAW	5
C.	THE CASES	6
III.	THE RESPONSIBILITY OF APPLICANTS AND THE USPTO TO RELIEVE SOCIETY OF THE BURDEN OF MIS-LABELED "CIP" PATENTS.....	11
A.	APPLICANTS' DUTY OF CANDOR.....	11
B.	INVENTORSHIP ENTITIES.....	12
C.	THE USPTO DUTY TO THE PUBLIC.....	14
D.	THE USPTO RELIANCE UPON A "CIP" DESIGNATION BY THE APPLICANT.....	15
E.	THE USPTO GUIDELINES FOR DETERMINING NEW SUBJECT MATTER	16
IV.	PROPOSED CHANGES TO CURRENT CIP APPLICATION PRACTICE.....	18
A.	APPLICANT SHOULD DESIGNATE THE PRIORITY OF CLAIMS	18

B.	APPLICANT SHOULD ALSO POINT OUT "INHERENCY" FOR PRIORITY.....	19
C.	APPLICANT SHOULD NOTIFY USPTO OF PUBLIC DISCLOSURE	20
D.	NEW INVENTORSHIP ENTITY IN CIP	21
V.	ELECTIVE PROCEDURES TO FACILITATE CIP EXAMINATION	22
A.	A CIP SHOULD SERVE AS AN ADDITION TO A GENERIC INVENTION	22
B.	A CIP COULD BE FILED VIA AMENDMENT TO THE PARENT APPLICATION	23
C.	THE FILING OF A CIP DEMANDS ABANDONMENT OF THE PARENT APPLICATION.....	23
VI.	CONCLUSION.....	24

I. INTRODUCTION

A. A CONTINUATION

The practice of filing a "continuing" patent application containing a disclosure common to a prior filed, parent application and claiming priority to the filing date of the parent application is a concept that is unique to the United States patent system. Under 35 U.S.C. § 120, a continuation patent application filed in the United States Patent and Trademark Office (USPTO) is entitled to the benefit of the earlier filing date of a previously filed parent application if the application contains at least one inventor named in the parent application; contains NO new subject matter; is filed before the parent application's proceedings are terminated, abandoned, or allowed as a patent; and claims the benefit of priority of the parent application.¹ A continuation application can not include anything that would constitute new matter if inserted in the original parent application,² i.e., no new subject matter.

B. A CONTINUATION-IN-PART (CIP)

A type of "continuing" application under § 120 is a continuation-in-part (CIP) application that does add new subject matter. A CIP, under the MPEP, is an application containing "some substantial portion or all of the earlier nonprovisional application and *adding matter not disclosed* in the . . . earlier nonprovisional application."³ A CIP must also satisfy the requirements of a continuation application and can be used to add new technology relating to the specific invention originally disclosed in a pending parent application. It is important to a CIP application that at least one inventor in the parent also be an actual inventor of the new subject matter of the CIP and not just an inventor of the prior art subject matter of the parent. Claims in a CIP that are totally supported by the subject matter disclosed in the parent application receive priority of the filing date of the parent application, thereby overcoming "prior art" that might be applicable to the later CIP filing date but not applicable to the parent filing date, referred to as

¹ 35 U.S.C.A. § 120 (2005), 37 C.F.R. § 1.78(a)(4).

² *Id.*

³ Citations in this paper are to proposed changes in 37 C.F.R. § 1.78.

intervening prior art. However, claims reciting features disclosed for the first time as new subject matter in the CIP are entitled only to the actual CIP filing date and are subject to intervening prior art.

C. THE "CIP" THAT IS NOT A TRUE CIP

1. WHEN ALL CLAIMS RECITE THE NEW SUBJECT MATTER OF "CIP"

Too many patent applications are filed as CIP applications where ALL of the claims recite subject matter disclosed for the first time in the CIP, i.e., none of the claims are entitled to a filing date earlier than the actual filing date of the CIP. Such applications are mis-labeled as "CIP" applications and are not entitled to the benefit of an earlier filing date conferred by a "CIP" designation since all of the claims recite new subject matter and could be rejected over intervening prior art, intervening prior art the USPTO often does not apply. Such later filed applications are often mis-labeled as a "CIP" just to avoid a statutory bar known only to applicant.

2. PARENT INVENTOR NOT INVENTOR OF NEW SUBJECT MATTER OF "CIP"

Many patent applications are filed as CIP applications adding at least one inventor of the parent to a different inventor of a new invention disclosed in the new subject matter of the "CIP." In many situations where a new inventor conceives new subject matter to a prior invention, the prior inventors are combined with the new inventor as the inventorship entity in the "CIP" to prevent the parent application from being applied as prior art to "CIP" claims which recite the old subject matter plus the new subject matter of the "CIP." In other words, the invention of the parent was, in fact, prior art to the new invention of the new subject matter, i.e., the inventor in the parent made no contribution to the new subject matter. Such a "CIP" application is NOT a true CIP and is not entitled to the filing date of the prior application. In fact, the prior application is prior art to the "CIP," again prior art the USPTO often does not apply.

3. THE "CIP" PRIORITY IS NOT CHALLENGED BY THE USPTO

The USPTO normally does not challenge the claim of priority to the filing date of the "parent" application when a "CIP" is filed and frequently does not apply prior art effective against the actual CIP filing date. As pointed out above, there may be intervening prior art, and/or the parent application may, in fact, be prior art to the claims of the mis-labeled "CIP." In other words, the USPTO relies upon the "CIP" designation made by applicants and their attorneys and may not apply the invalidating prior art. This has resulted in defective patents that present fact issues, as distinguished from legal issues, that inhibit commerce and unnecessarily burden the courts.

4. THE PUBLIC BURDEN OF A MIS-LABELED "CIP"

Commerce may be inhibited by the mere existence of a patent that is labeled as a "CIP" alleging an earlier filing date when there is prior art which invalidates the patent, such as a public use unknown to the USPTO. The expense to invalidate such a "CIP" patent in litigation in a U.S. district court is a great hurdle for a competitor desiring to sell the product covered by the invalid claims of a "CIP" patent. Clearly the existence of a mis-labeled "CIP" patent owned by a large company presents a huge financial hurdle to litigate the patent in order for a new company to enter the marketplace. The cloud of a lawsuit also discourages investment in the new company.

In addition, it is an unnecessary burden upon the courts because the priority issues could easily be resolved during prosecution of the CIP application before the USPTO. This "CIP" practice is particularly egregious where an application is labeled a "CIP" to avoid a statutory bar known only to applicant relying upon the fact that the USPTO will not question the "CIP" priority status and allow the application to issue as a patent purporting to have a priority date before the defensive statutory bar.

This paper impugns the current "CIP" practice and suggests procedures for both attorneys and the USPTO to strengthen the examination of patents under 35 U.S.C. § 120 and 37 C.F.R. § 1.78, thereby relieving the Courts of factual issues best resolved by the expertise of the USPTO.

II. THE LAW AND NEW SUBJECT MATTER

A. THE STATUTES

There are essentially two statutes that pertain to the addition of subject matter in a patent application.⁴ The first paragraph of 35 U.S.C. § 112, requires a “specification [to] contain a written description of the invention . . . conclud[ing] with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”⁵ However, 35 U.S.C. § 132 prohibits the addition of new matter in an application by expressly stating, “No amendment shall introduce new matter into the disclosure of the invention.”⁶ While applying these statutes to CIP applications, courts have struggled to consistently determine whether subject matter contained in a CIP is allowable subject matter under § 112 or inadmissible new matter under § 132. If a court finds the new subject matter added and claimed by the CIP was not “inherently” described in the parent application “in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same,”⁷ the court will view that subject matter as new matter and reject the application for priority of that claimed subject matter on a § 132 basis. However, if a court

⁴ The scope of this paper is not intended to deal with new matter in a reissue application, set forth at 35 U.S.C. §251.

⁵ 35 U.S.C. §112 Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

⁶ 35 U.S.C. §132 Notice of rejection; reexamination:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. **No amendment shall introduce new matter into the disclosure of the invention. (Emphasis added).**

7

finds the new subject matter of the CIP was properly disclosed, or was inherent in the original disclosure, the claimed subject matter will be allowable under § 112 and will be given the benefit of the filing date of the earlier disclosure of the parent application as provided under § 120.

The rule to determine whether subject matter is allowable under § 112 or prohibited under § 132 appears to be straight forward: for a claim in a later filed application to be entitled to the filing date of an earlier application under 35 U.S.C. § 120, the disclosure of the earlier application must reasonably convey to one skilled in the art that the inventor possessed the later claimed subject matter at the time the earlier application was filed.⁸ Said in the converse, a claim in the CIP application cannot embrace an invention not described or inherent in the parent application as filed in order to obtain priority to the parent application, at least when adverse rights of the public have intervened.⁹ However, the application of this straight forward rule by the Court of Appeals for the Federal Circuit has resulted in various conclusions arrived at by different methodologies, all technology or fact dependent.

B. THE CASE LAW

The federal courts have held that an invention claimed in a CIP is the same subject matter as that disclosed in the parent and thus is “entitled to the earlier filing date of the parent application when the claimed invention is described in the parent specification in a manner that satisfies, inter alia, the description requirement of 35 U.S.C. § 112.”¹⁰ This ruling has been furthered interpreted to define same subject matter as anything that is not new matter. “In other words, a claim complies with 35 U.S.C. § 120 by satisfying the written description requirement of § 112 and acquires an earlier filing date if, and only if, it could have been added to an earlier application *without* introducing new matter.”¹¹ In other words, subject matter claimed in a CIP is considered the same subject matter as that originally disclosed in the parent application if the subject matter contained within the CIP could additionally be claimed in the parent application,

⁸ *The Gentry Gallery, Inc. v. The Berkline Corporation*, 134 F.3d 1473 (Fed. Cir. 1998).

⁹ *Leathem S. Stearn v. Superior Dist. Co., Aggressive Yacht Sales Co.*, 674 F.2d 539, 544 (6th Cir. 1982).

¹⁰ *Therma-Tru Corp. v. Peachtree Doors Inc.*, 44 F.3d 988, 992 (Fed. Cir. 1995).

¹¹ *Studiengesellschaft Kohle, M.B.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564 (Fed. Cir. 1997).

i.e., the disclosure of the of the parent application adequately supports the claimed subject matter of the CIP in a manner that sufficiently satisfies the § 112 description requirement.

Clearly this leads to a factual determination in determining inherency or equivalents in technical terms, e.g., scientific or engineering terms. The test to determine if subject matter in a CIP is the same subject matter as that depicted by the original application has been stated as “whether the disclosure of the application as originally filed ‘reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter[.]’ rather than the presence or absence of literal support in the specification for the claim language.”¹² The inherency or equivalents test is fact driven in the understanding of a person having ordinary skill in the art. This understanding of a person skilled in the art often results in expensive litigation with experts in the field of art surrounding the converted patent. On the other hand, the USPTO examiners are experts in the pertinent field of art and can decide whether the claims of a CIP application are supported by the parent application and, therefore, entitled to a priority claim.

C. THE CASES

In *Narda Microwave Corp. v. General Microwave Corp.*, Narda filed a patent application, the ‘439 application, for a narrow-band radiation monitor which utilized highly conductive antennas with negligible resistance.¹³ While the Narda ‘439 application was pending, Narda became aware of General’s public invention, and thereafter Narda filed a "CIP," the ‘914 application, for a broad-band radiation monitor that incorporated resistive interaction with incoming radiation and claimed priority of the ‘439 application.¹⁴ Narda’s claim for priority allowed the ‘914 "CIP" application to overcome General’s invention as prior art and issue as the ‘914 "CIP" patent. In this litigation, General challenged the ‘914 "CIP" patent’s claim to priority so that General's invention was prior art to the '914 "CIP" patent, i.e., an intervening statutory bar.

¹² *Cargill, Inc. v. Sears Petroleum & Transport Corp.*, 334 F. Supp. 2d 197, 226 (N.D.N.Y. 2004).

¹³ *Narda Microwave Corp. v. General Microwave Corp.*, 675 F.2d 542 (2d Cir. 1982).

¹⁴ *Id.* at 548-49.

As a result of the USPTO allowing the CIP to issue without determining whether the '914 "CIP" patent satisfied the requirements for a claim of priority to the parent application under § 120, the court had to resolve the factual question of whether the '914 "CIP" patent claimed the "same" subject matter as the parent application. After an in depth study of microwave radiation and a thorough analysis of the parent '439 application's disclosure, the court held "[t]he use of high resistance in the '914 patent distinguished it significantly from Narda's '439 parent application" and therefore was not entitled to the filing date of the '439 parent application.¹⁵ In fact, not a single claim in the '914 "CIP" patent was held to be supported by the '439 parent application, and as a result, the entire '914 "CIP" patent was found to be invalid as having been anticipated by General's intervening invention.¹⁶

The '914 "CIP" patent was initially filed as a "CIP" for the sole purpose of gaining priority over General's intervening invention. It was in no sense a continuation of the invention in the '439 patent, it was an independent invention; an independent invention first made by General, perhaps not even an invention actually made by the Narda inventors because the invention claimed in the '914 "CIP" application had not been made by an actual reduction to practice before filing the "CIP" application. As an additional matter, because the USPTO respected the claimed priority for the '914 "CIP" patent and used it against General, the original claims of the application to General's invention were amended during prosecution in order to distinguish it from the disclosure in the '914 "CIP" patent. Therefore, under the doctrine of file-wrapper estoppel, General was prevented from arguing the invention in the '914 patent infringed the General patent even though the General patent was found to have anticipated the '914 "CIP" patent.¹⁷

As a result of the USPTO issuing the '914 "CIP" patent as a "CIP," when it was not a CIP, General was wrongfully forced to limit the scope of its patent and precluded from collecting damages that resulted from Narda's infringement of the General patent. Narda was allowed to unjustly benefit from its false "CIP" claim by being able to freely use the invention of a competitor. This situation could have been avoided if the USPTO would have made the factual

¹⁵ *Id.* 548.

¹⁶ *Id.*

¹⁷ *Id.* 549.

determination of whether the claims in the '914 "CIP" application were, in fact, supported by the parent application.

In *Augustine Medical, Inc. v. Gaymar Industries, Inc.*, a CIP application was filed and issued as United States Patent No. 5,405,371 (the '371 "CIP" patent) that claimed priority to a parent application filed on June 10, 1990.¹⁸ The '371 "CIP" patent claimed that only a portion of a warming blanket covers a patient.¹⁹ The parent application did not disclose that only a portion of the blanket could be used to cover the patient.²⁰ The applicant argued that the '371 "CIP" patent should be entitled to the priority date of the parent application because the new subject matter was inherent in the parent application since the limitation was reasonably conveyed to one skilled in the art based upon the disclosure of the parent application. Establishing the earlier filing date for the subject matter contained in the '371 "CIP" patent application was necessary because of a public display more than one year before the filing date of the '371 "CIP" application that would have created a 35 U.S.C. 102(b) statutory bar.²¹ If the '371 "CIP" patent was entitled to claim priority, then the October 1989 public display would not be a bar to the '371 "CIP" patent.²²

In holding the judgment of invalidity of the '371 "CIP" patent, the court held there was no inherency between the '371 CIP patent and the parent application.²³ Using a blanket to cover a portion of a person, instead of all of a person, was found not to be inherent and recognizable to persons of ordinary skill in the art.

The court also applied an inherency analysis in *Tronzo v. Biomet*, where a "CIP" application included claims to an artificial hip socket having a cup with a generic shape and issued as United States Patent No. 4,743,262 (the '262 "CIP" patent).²⁴ The '262 "CIP" patent

¹⁸ *Augustine Medical, Inc. v. Gaymar Industries, Inc.*, 181 F.3d 1291 (Fed. Cir. 1999)

¹⁹ *Id.*

²⁰ *Id.* at 1295.

²¹ 35 U.S.C. 102

²² *Id.* at 1302.

²³ *Id.* at 1303.

²⁴ *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998).

was re-examined twice by the PTO resulting in the confirmation of patentability.²⁵ Biomet argued that the parent patent describes only a conically shaped cup and does not provide sufficient support for generic claims as to the shape of the cup. It was conceded that intervening prior art would invalidate these generic claims. The "CIP" application recited the shape as "a spherical, conical, trapezoidal, or other suitable outer surface." The parent patent describes the shape as a "trapezoid," a "truncated core," or a cup of "conical shape;" all used to describe the same cup, and not three different cup species. The court found statements in the parent patent that make it clear that the parent patent discloses only conical shaped cups and nothing broader. Accordingly, the Court of Appeals for the Federal Circuit concluded that the specification of the parent application did not meet the written description requirement of 35 U.S.C. § 112 and that the generic "CIP" claims were not entitled to the parent application's filing date.²⁶ In reaching this conclusion, the court determined the disclosure of the generic shape was not inherently disclosed in the parent application. The court stated, "In order for a disclosure to be inherent, the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure."²⁷ The court additionally went on to state "[a] disclosure in a parent application that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations."²⁸ Therefore, it is not permissible to mis-label a "CIP" just to avoid an obviousness issue over an earlier filed application.

It is submitted that the court erred in *Tronzo* by analogy to a chemical composition wherein equivalent constituents may be claimed generically if proven to work. When *Tronzo* found that other shapes would work, a generic invention was made and entitled to be claimed in the CIP. Perhaps the court believed it to inequitable for *Tronzo* to retroactively extinguish the intervening rights of *Biomet* in what Biomet relied upon to be a non-infringing product. A sound argument for protecting intervening rights is to require all generic claims (patentably indistinct claims) to be in one application, either a prior application or a true CIP claiming priority to an abandoned parent application.

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.* at 1159, citing *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

In *Kennecott Corp. v. Kyocera International*, a CIP application issued as United States Patent No. 4,179,299 (the ‘299 CIP patent) and claimed a sintered ceramic body having a predominately equiaxed structure.²⁹ The ‘299 CIP patent contains a substantial part of the disclosure of the parent application, plus a photomicrograph and a description of the equiaxed microstructure.³⁰ However, the words “equiaxed microstructure” were not present in the parent application.³¹ Maintaining priority was necessary because Kennecott made a sale more than one year before the filing date of the ‘299 CIP patent.³² Kennecott argued that the microstructure claimed in the ‘299 CIP patent was inherent in the structure of the product disclosed in the parent application and that the ‘299 CIP patent should therefore be entitled to the benefit of the earlier filing date.³³ Kyocera claimed the specification of the parent application was silent as to the microstructure of the product and one would not know whether the product had the claimed microstructure merely by reading the specification of the parent application.³⁴

The court concluded that an inherent property of a product first disclosed in a subsequent patent application does not deprive that product of the benefit of an earlier filing date, nor does the inclusion of a recitation of that property in later filed claims change this result.³⁵ Once again, the court determined whether the disclosure of the parent application reasonably conveyed to one skilled in the art that the inventor possessed the later claimed subject matter at the time the parent application was filed by relying on an inherent limitation. In this case, the court stated that one skilled in the art could readily determine that the microstructure was present in the product even though it was not described in the specification of the parent application.³⁶

In *In re Smythe*, the court determined whether the use of the term “inert fluid” in the claim was supported by the specification which described “air or other gas.”³⁷ The court concluded that the use of the “inert fluid” would naturally occur to one skilled in the art upon

²⁸ *Id.* at 1158.

²⁹ *Kennecott Corporation, v. Kyocera International, Inc.*, 835 F.2d 1419 (Fed. Cir. 1987).

³⁰ *Id.* at 1420.

³¹ *Id.*

³² *Id.*

³³ *Id.* at 1421.

³⁴ *Id.*

³⁵ *Id.* at 1423.

³⁶ *Id.* at 1422.

reading the description of the use of “air or other gas.”³⁸ By inference, the court resolved the fact issue by determining that a man skilled in the pertinent art would interpret "air or other gas" to inherently include or be equivalent to an "inert fluid."

As the above decisions indicate, the straight forward inherency rule, that the disclosure of the parent application must reasonably convey to one skilled in the art that the inventor possessed the later claimed subject matter at the time the parent application was filed, is dependent upon the facts of the art in question. The courts apply an inherency analysis to the facts surrounding each invention. In short, the cases are fact driven and dependent upon the particular technology or subject matter involved, and perhaps biased by the equities, i.e., the equities of intervening rights. Such fact questions could be more efficiently and more expertly resolved in the USPTO by the examiners who are most familiar with the terms of the technology being claimed. Resolving the issue during prosecution would eliminate the uncertainty of what constitutes a valid CIP under § 120, and it could prevent "CIP" patents from issuing that share no similar subject matter with their parent application. Of course, this can not be accomplished by the USPTO without the cooperation of applicants.

III. THE RESPONSIBILITY OF APPLICANTS AND THE USPTO TO RELIEVE SOCIETY OF THE BURDEN OF MIS-LABELED "CIP" PATENTS

The mis-labeled "CIP" is the result of two deficiencies in the current practice, the first by applicants and the second by the USPTO. However, in order for the USPTO to fulfill its responsibility to the public, applicants must exercise more candor before the USPTO in the first instance.

A. APPLICANTS' DUTY OF CANDOR

Applicants are in a position to know all of the facts surrounding the filing of a "CIP" but do not advise the USPTO of these facts which are relevant to the examination. For example, a "CIP" is often filed to avoid an intervening statutory bar (prior art) without advising the USPTO

³⁷ *Id.* at 1382.

³⁸ *Id.* at 1383.

of this important fact. On the face of it, the USPTO, has no reason to question a claim of priority to an earlier filing date.

Most often, an application is mis-labeled as a "CIP" to acknowledge the addition of new subject matter yet the applicant treats the new subject as being "inherent" in the disclosure of the parent, an apparent inconsistency. The "CIP" is filed with claims using terminology added as new subject matter whereas the applicant believes or advocates that this new terminology is "inherent" in the subject matter of the parent application. However, the applicant does not advise the USPTO of this inconsistency, nor the statutory bar reason for creating the inconsistency. The issue can be very clouded when the new subject matter co-mingles terminology believed to be "inherent" with terminology clearly new subject matter, e.g., an additional species.

Under Rule 56, an "individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability."³⁹ The USPTO instructs examiners to place importance on this regulation, and it results in the examiners unquestionably relying on many of the designations made by an applicant. In addition to relying on an applicant's designation of what subject matter is entitled to the priority of a parent application, examiners also rely on applicants statements concerning the history of an application or the history of a related application.

The fact that claims presented in a CIP rely on support in the parent application to avoid a statutory bar certainly falls within the "duty to disclose . . . all information . . . material to patentability." This "duty of candor and good faith" inures to the benefit of the public but is only useful to the public if the patent identifies the priority date of each claim in a CIP so that the public can assert intervening prior art. The change to 37 C.F.R. 1.78 addresses this by requiring a designation of claims in a CIP supported by the parent application.

B. INVENTORSHIP ENTITIES

In addition to advising the USPTO of an intervening statutory bar, an Applicant should be required to affirm to the USPTO that the new subject matter of the CIP was at least in

part conceived by an inventor of the parent application. If the alleged "CIP" includes a completely different inventorship than the parent application, the parent application is prior art. A different inventorship resides in a combination of inventors in the new subject matter different from the combination of inventors in the parent. Many applicants are not careful about inventorship.

A typical example of an error in inventorship occurs where inventors Mo and Curly invent a four wheeled, steerable vehicle powered by an internal combustion engine through a manual transmission, and thereafter a co-worker, Larry, invents and substitutes an automatic transmission in the vehicle, i.e., a new species. In many situations where Larry invents the automatic transmission while a U.S. patent application is pending in the names of Mo and Curly, a "CIP" is filed adding the new subject matter of the automatic transmission. The "CIP" frequently names the inventors Mo and Curly of the parent application along with Larry as the inventorship in the "CIP." This is simply inappropriate when neither Mo nor Curly had any input whatsoever in conceiving the automatic transmission. This mis-naming of inventors also avoids the issue in the USPTO of whether the substitution of the automatic transmission is obvious over the manual transmission of Mo and Curly. Clearly, had Larry invented the automatic transmission where Mo and Curly worked for a competitor, neither Mo nor Curly would be added to Larry's automatic transmission application as inventors. To the contrary, Mo and Curly's vehicle with the manual transmission would be prior art to Larry's vehicle with an automatic transmission. Also, if Larry invented the automatic transmission for the vehicle after Mo and Larry's manual transmission was public, e.g., in their issued patent, neither Mo nor Curly would be named as co-inventors with Larry in his application. Larry's automatic transmission is an independent invention made only by Larry as the sole inventor against the prior art of a vehicle with a manual transmission, regardless of whether Larry made his automatic transmission invention thirty seconds or years after Mo and Curly's manual transmission, regardless of whether Larry was a co-worker of Mo and Curly or employed by a competitor. It is only when Larry invents his automatic transmission while the patent application of Mo and Curly is still pending that Mo and Curly can be added to Larry's automatic transmission application to label it as a "CIP" to avoid an issue of patentability over the manual transmission of the parent.

³⁹ 37 C.F.R. § 1.56.

Even if the parent application is abandoned and the generic claims along with the automatic transmission (new subject matter) species claims are in the "CIP," it is still inappropriate because the automatic transmission was invented solely by Larry without inventive input by Mo or Curly except as creators of the most pertinent prior art over which the automatic transmission must be patentable, i.e., not obvious. This is a situation where the "CIP" does not meet the requirement for a continuing application to include at least one "inventor" named in the parent application as an "inventor" in the new subject matter. In other words, an "inventor" from the parent must also truly be an "inventor" in the new subject matter of the CIP.

C. THE USPTO DUTY TO THE PUBLIC

The purpose of a CIP is to add and claim new subject matter that is patentably indistinct and usually falls under generic claims supported by the parent application. Again, a true CIP contains generic claims supported by the parent and patentably indistinct species or more specific claims supported only by the new subject matter. If the parent is not abandoned it should contain all generic claims leaving only new matter claims in the "CIP," which is then not a CIP as the claims therein are not entitled to the filing date of the parent. If the so called "CIP" contains only claims supported by the new subject matter, then there may be an issue of patentability of the new subject matter claims over the disclosure of the parent application.

Currently, the USPTO properly does not challenge the designation of a CIP because it relies upon the affirmations of the applicant. However, this failure to examine the propriety of a CIP designation has placed an undue burden upon the public in general, and the courts, in particular. Accordingly, commensurate with applicants' duty to disclose the use of a CIP to avoid a statutory bar, the USPTO should determine whether the claims to which an applicant seeks to attach the priority of a parent application are, in fact, supported by the subject matter of the parent application under 35 U.S.C. § 112.

D. THE USPTO RELIANCE UPON A "CIP" DESIGNATION BY THE APPLICANT

When a CIP application is filed, the USPTO does not determine whether the requirements of 35 U.S.C. § 120 are met;⁴⁰ i.e., the USPTO does not compare the disclosure of the CIP to the parent but merely accepts the applicant's designation of a CIP. MPEP provides:

There is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 120, that the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion or all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation. Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part application complies with the other requirements of 35 U.S.C. 120.⁴¹

The MPEP guideline allows a CIP to issue as a patent without ever determining the priority date of each claim in the application. A more egregious practice is the filing of a CIP claiming priority of an earlier filed application when, in fact, the two applications share no common subject matter which would support a patentable claim generic to both disclosures (see *Narda* above). By relying upon the practitioner's designation of a CIP, the USPTO might not apply applicable intervening prior art. This procedure has resulted in numerous instances where courts have been required to resolve factual technical issues by determining whether "CIP" claims are supported by (inherent in) the parent application and therefore entitled to an earlier filing date.

⁴⁰ *Pennwalt Corporation v. Akzona Inc. and Armak Co.*, 570 F. Supp. 1097, 1102 (D. Del. 1983).

Whether or not a "CIP" claims subject matter originally disclosed in the application from which it claims priority is a question of fact⁴² and USPTO Examiners are experts in the art and very capable of deciding these factual issues and the MPEP guidelines are already in place.

E. THE USPTO GUIDELINES FOR DETERMINING NEW SUBJECT MATTER

Even though an examiner is instructed NOT to make a determination of whether the earlier application discloses the invention claimed in the CIP in a manner sufficient to satisfy the disclosure requirement of 35 U.S.C. §§ 112 and 120, the filing date of the CIP does come into question in some situations in the USPTO, e.g., in the case of an interference or to overcome a reference, and the USPTO may make an effort to determine the priority date by identifying the new subject matter presented for the first time in the CIP and the claims supported only by the new subject matter.

The USPTO does guide examiners and practitioners by defining what constitutes new subject matter. According to the MPEP, new subject matter is matter involving a departure from or in addition to the original disclosure.⁴³ The disclosure has been defined by the MPEP as comprising of information contained in the specification, drawings, and the original claims.⁴⁴ Therefore, an invention disclosed in a CIP application is entitled to the benefit of an earlier filing date if it is properly disclosed in the specification, drawings, or claims of a prior application, and a claim for priority is made which references the prior application. In order to satisfy the requisite level of disclosure, a patent application may explicitly disclose a device, or disclose a “device that inherently performs a function or has a property, operates according to a theory or has an advantage . . . even though [the application] says nothing explicit concerning [the function, theory, or advantage].”⁴⁵ The MPEP uses the test set forth in *In re Robertson* as its basis for determining whether new matter is inherently described in a prior application.

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference,

⁴² *Augustine Medical, Inc. v. Gaymar Industries, Inc.*, 181 F.3d 1291 (Fed. Cir. 1999).

⁴³ MPEP §2163.

⁴⁴ MPEP § 608.01(I)

⁴⁵ MPEP §2163.07(a), citing *In re Smythe*, 480 F.2d 1376 (CCPA 1973).

and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.⁴⁶

Based on the above analysis, the MPEP has explicitly stated the rephrasing or rewording of a passage does not constitute new matter so long as the original meaning remains intact.⁴⁷ Additionally, corrections of an obvious error in the disclosure do not constitute new matter so long as the error and appropriate correction are readily apparent or “inherent” to one skilled in the art.⁴⁸ An illustrative hypothetical regarding inherency was discussed *In re Smythe*, which is referenced by the MPEP:

If the original specification of a patent application on the scales of justice disclosed only a 1-pound "lead weight" as a counterbalance to determine the weight of a pound of flesh, we do not believe the applicant should be prevented, by the so-called "description requirement" of the first paragraph of § 112, or the prohibition against new matter of § 132, from later claiming the counterbalance as a "metal weight" or simply as a 1-pound "weight," although both "metal weight" and "weight" would indeed be progressively broader than "lead weight," including even such an undisclosed, but obviously art-recognized equivalent "weight" as a pound of feathers. The broader claim language would be permitted because the description of the use and function of the lead weight as a scale counterbalance in the whole disclosure would immediately convey to any person skilled in the scale art the knowledge that the applicant invented a scale with a 1-pound counterbalance weight, regardless of its composition.⁴⁹

Based upon the guidance given by the USPTO in their definition of what constitutes new matter, inherency has been incorporated into the test for determining whether particular subject matter is present in an application. Additionally, it is to be noted that, if the application indicates

⁴⁶ MPEP § 2163.07(a)

⁴⁷ MPEP § 2163.07

⁴⁸ *Id.*

a feature is essential, removal of that feature in a later, broader claim may not be supported in the CIP application regardless of inherency.⁵⁰

Even with the overlying statutory requirement of shared subject matter between a CIP and a parent, the MPEP setting forth an explicit definition of what constitutes new matter, and a clear-cut inherency analysis, an examiner is still not required to determine whether an application satisfies 35 U.S.C. § 120. In other words, even though the USPTO has the expertise and the tools, which it uses in some instances to resolve new subject matter issues, it does not examine CIP applications regarding new subject matter issues vis-à-vis § 120. Therefore, simply because there is an affirmative statement from the applicant setting forth a claim of priority for the CIP, a CIP may issue when it is not entitled to the priority of the earlier filing date. This has often resulted in the courts resolving the issues of new subject matter.

IV. PROPOSED CHANGES TO CURRENT CIP APPLICATION PRACTICE

A proper CIP practice should begin with the practitioner and be supported by the USPTO, leaving the courts to address only legal issues and not the technology issues of whether something is inherent in an art or reasonably conveyed to one skilled in the art.

There are a number of measures applicants can take to facilitate examination by the USPTO.

A. APPLICANT SHOULD DESIGNATE THE PRIORITY OF CLAIMS

As the case law exhibits, many applications are filed as "CIPs" with claims meant to be supported by the parent disclosure and in words that are different but meant to be "inherent" in the original disclosure of the parent, i.e., that the claims meet the requirements of 35 U.S.C. § 112. If the new CIP claim limitations are "inherent," they are entitled to the filing date of the parent. Accordingly, if all of the claims in a "CIP" are meant to rely upon the disclosure of the parent, with the same language or inherent language, the application is really not a "CIP" but is, in fact, a continuation. Therefore, it is incumbent upon the applicant to designate the application

⁴⁹ *In re Smythe*, 480 F.2d 1376, 1384 (CCPA 1973).

⁵⁰ *MPEP* §2163.05.

a continuation if every claim is meant to rely upon the parent disclosure. If not, because the application also includes claims supported only by the new subject matter added to the "CIP," then the application is truly a CIP. This step is facilitated by new rule 37 C.F.R. § 1.78(d)(3), which requires claims supported by the parent to be identified.

By designating an application as a CIP, applicant admits that the application contains new subject matter. It follows, that as a prerequisite to claiming a CIP priority, applicant must identify claims supported only by the newly added subject matter of the CIP. In accordance with new rule 37 C.F.R. § 1.78(d)(3), any claim in a CIP that is not identified as being disclosed in the manner provided by 35 U.S.C. § 112, in the prior application will be treated as entitled only to the filing date of the CIP application.

This election parallels a restriction requirement wherein the applicant must identify the species upon which each claim reads. Such a designation should be repeated for each claim as it may be amended. Designating the claims entitled to an earlier effective filing date would guide examiners by specifically setting forth what prior art is applicable to each claim and would eliminate instances of erroneous "CIP" issuance. This procedure would fall directly under the duty to disclose information material to patentability. In this manner, the issue of whether the alleged claims are supported by the priority date is addressed in the most expertise venue, in the most efficient manner, and long before the public relies on invalid CIP claims.

In summation, the new rule to identify claims supported by the parent will force applicants to properly label an application a continuation when all claims are to be supported by the parent, thereby flagging the issue of inherency.

B. APPLICANT SHOULD ALSO POINT OUT "INHERENCY" FOR PRIORITY

If the applicant wishes to use new subject matter terminology in the claims of a "CIP" and rely upon the priority of the parent filing date, remarks should be submitted as to why and where the new claim terminology is inherently supported by the subject matter of the parent application in accordance with the first paragraph of 35 U.S.C. § 112. Since the examiners are experts in the art being examined, they are certainly qualified to determine if subject matter is

explicitly disclosed or inherent in the parent application. Of course, the applicant would be entitled to submit declarations from those skilled in the art to support the use of alternative and inherent claim terminology. Because it is very difficult for practitioners to foresee variants of an invention or the ultimate scope of an invention, the USPTO should be lenient in allowing alternative or broadening terminology. Clearly, the disclosure of a “lead” weight should support the broadening terminology of a “metal” weight, as “air or other gas” should support “inert fluid.” Additionally, all of a blanket covering a patient clearly supports at least a portion of a blanket covering a patient, and a conical cup supports generic terminology that covers “conical” as well as other geometrical shapes.

C. APPLICANT SHOULD NOTIFY USPTO OF PUBLIC DISCLOSURE

The applicant should also advise the USPTO of any public disclosure more than one year prior to the actual filing date of the CIP covered by any claim of the CIP.

Since “[a] patent by its very nature is affected with a public interest[.]”⁵¹ it is important to make sure that patents that issue from the modified CIP practice spring from backgrounds free from fraud or other inequitable conduct and those patents are kept within their legitimate scope.⁵² The Rule 56 standard is already being applied to various aspects of CIP practice. For example, in *The Li Family Ltd. Partnership*,⁵³ the court applied the standard to an applicant that withheld

⁵¹ 37 C.F.R. §1.56 Duty to disclose information material to patentability

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. ...

...

(e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

⁵² *Arthur W. Langer, Jr. and Erik Tornqvist v Daniel Kaufman and Bryce H. McMullen*, 59 C.C.P.A. 1261, 1265 (1972), citing *Precision Instrument Mfg. Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806, 65 U.S.P.Q. 133 (1945).

⁵³ *The Li Second Family Ltd. Partnership v. Toshiba Corp.*, 231 F.3d 1373, 1378 (Fed. Cir. 2000).

from the examiner a board's adverse findings of no priority for the CIP.⁵⁴ The court determined that the examiner relied on the applicant's omission in allowing the patent to issue and the court held the resultant patent unenforceable for inequitable conduct.⁵⁵

The standard has been applied when the practitioner does not cite intervening prior art. This intervening prior art arises between the time of the filing of the parent application and the CIP. Such a violation of the standard arose in *Fox Industries, Inc. v. Structural Preservation Systems, Inc.*, where the intervening prior art was a sales brochure published by the applicant that disclosed each and every feature of the claimed invention.⁵⁶ The court held that by not submitting the brochure, the applicant knowingly withheld material prior art from the USPTO and the patent was held unenforceable due to the finding of inequitable conduct.⁵⁷ This situation is likely to arise particularly when the prior art is the applicant's own disclosure and when portions of the matter being added are mistakenly relied upon to have priority to the earlier filing date.

D. NEW INVENTORSHIP ENTITY IN CIP

Unless all of the exact same inventors are named in the CIP as are named in the parent application, applicant should identify for the USPTO the contribution made to the new subject matter by the inventors named in the parent. Ideally, there should be an affirmation by the new inventor added in the CIP (not named in the parent) that the other named inventors contributed to the new subject matter, i.e., that they contributed additional claimed subject matter to that which they disclosed in the parent. It must be made clear that the inclusion of the parent inventors in the "CIP" is not just to gain the priority of the parent filing date, and that the prior inventors did, in fact, contribute to the invention of the new subject matter of the CIP, i.e., that all of the inventors named in the CIP did, in fact, invent the new subject matter..

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Fox Indus. Inc. v. Structural Preservation Systems, Inc.*, 922 F.2d 801, 803 (Fed. Cir. 1990).

⁵⁷ *Id.* at 803.

V. ELECTIVE PROCEDURES TO FACILITATE CIP EXAMINATION

A. A CIP SHOULD SERVE AS AN ADDITION TO A GENERIC INVENTION

According to 35 U.S.C. § 112, the claims of a patent application should cover only a single invention. The text of the statute makes it clear that the “specification [of a patent application] shall contain a written description of the invention, . . . [and] the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”⁵⁸ The singular form of “invention” dictates an application should contain only a single invention. Additionally, 35 U.S.C. § 121 allows the Director of the USPTO to restrict a patent application to one invention when “two or more independent and distinct inventions are claimed in one application.”⁵⁹ These statutes indicate a utility patent application should contain only a single invention. In fact, most countries require one claim in a single application to be broader than all other claims, thereby distinctly defining the single invention. This form of claim drafting is most easily accomplished by one independent claim followed by dependent claims. Therefore, if an application contains a single invention and a CIP continues that invention, the sole reason for filing a CIP application should be to add patentably indistinct variants, e.g., species, to the generic invention already claimed.

The parent of a CIP should contain at least one generic claim to a generic invention with the CIP adding new subject matter limitations via claims dependent on the generic claim. When evaluating a CIP, the examiner may find alternative and generic terminology in the broadest claims that was not present in the parent application and such should be given priority to the earlier filing date as a generic and inherent term. In fact, the filing of a CIP application should be accepted as a manner in which to set forth alternative or generic terminology not recognized when the parent application was first filed, so long as the new terminology meets the requirements of 35 U.S.C. § 112.

⁵⁸ 35 usc 112.

⁵⁹ 35 U.S.C. 121.

B. A CIP COULD BE FILED VIA AMENDMENT TO THE PARENT APPLICATION

In order to prevent the filing of CIPs which contain entirely new subject matter and to additionally facilitate examination by the USPTO, an exact copy of the parent application could be filed with a preliminary amendment adding the new subject matter to the end of the description of the parent and a "RELATED APPLICATION" paragraph at the beginning of the CIP. This new subject matter could equate, expand and correlate terminology between that of the parent and the new subject matter. The examiner may then make a simple comparison to assure that the new subject matter contained within the CIP is explicitly or inherently set forth in the parent application.

C. THE FILING OF A CIP DEMANDS ABANDONMENT OF THE PARENT APPLICATION

When an applicant files a CIP continuing the invention claimed in a prior application, the application should not be allowed to receive a second patent covering the same or a patentably indistinct invention. Courts' have interpreted 35 U.S.C. 101 to allow anyone who "invents or discovers [to] obtain a patent."⁶⁰ Additionally, courts have held that a "continuing application must be for the same invention."⁶¹ If the parent application is not abandoned, it will logically contain claims covering the subject matter disclosed in that parent application. If the applicant files a CIP adding new subject matter, and the old subject matter is already covered by the claims of the parent application, only the new subject matter is left to be covered by the claims of the "CIP." However, in this instance the "CIP" application would no longer be a CIP because all of the claims recite new subject matter and would only be entitled to the actual filing date of the alleged "CIP."

No benefit is provided by permitting an applicant to file a CIP and allowing him or her to simultaneously prosecute the CIP contemporaneously with the parent application. The complete spectrum of subject matter contained within the parent application can be claimed in the CIP and

⁶⁰ 35 U.S.C. § 101

⁶¹ *Indiana General Corp. v. Lockheed Aircraft Corp.*, 249 F. Supp. 809 (S.D. Cal. 1966) rev'd on other grounds, 408 F.2d 294 (9th Cir. 1968).

prosecuted in the same application, or the new subject matter can be prosecuted in a new non-continuing patent application, although a terminal disclaimer may be required. The applicant will not be precluded from obtaining a patent by a prior art reference which is his own. Under 37 C.F.R. § 1.130, “[w]hen any claim of an application . . . is rejected under 35 U.S.C. 103 on a U.S. patent or U.S. patent application publication which is not prior art under 35 U.S.C. 102(b), . . . and the inventions are owned by the same party, the applicant . . . may disqualify the patent or patent application publication as prior art” by submitting a terminal disclaimer.⁶²

The requirement to abandon the parent in favor of the CIP would prevent applicants from filing CIPs which have no claims with priority to an earlier filing date and would prevent two patents from issuing with patentably indistinct claims.

VI. CONCLUSION

The public is being burdened by a mis-use of the CIP practice which resides in the mis-labeling of an application as a "CIP" to avoid an issue of patentability before the USPTO. When an application is labeled as a "CIP," the USPTO frequently relies upon the date of the parent application and does not apply intervening prior art that is applicable to the actual filing date of the "CIP" application. The USPTO also relies upon the inventorship set forth in such "CIP" applications when, in fact, inventors from the parent application may be included in the "CIP" simply in order to claim priority via a "CIP" label. Patents issued from such mis-labeled "CIP" applications are great deterrents to competitors even though such competitors know of intervening prior art because of the great expense in litigating and proving that particular claims are not entitled to an earlier filing date and, therefore, do not avoid a statutory bar based upon the intervening prior art. The public at large is entitled to have such issues resolved by their USPTO. At present such "CIP" patents are often an impediment to competition that can only be removed by one adverse party carrying a large litigation burden whereas the public at large carries a lesser burden by resolving the issues during prosecution before the USPTO.

⁶² 37 C.F.R. § 1.130

Accordingly, procedures should be implemented to strengthen the integrity of the CIP practice. Since many practitioners use the CIP practice to obfuscate the priority claims in a CIP, a CIP application should contain an affirmative statement identifying claims reciting only features supported in the parent application in accordance with 35 U.S.C. § 112, i.e., identify claims allegedly supported by the parent and therefore entitled to the filing date of the parent. As a result, practitioners will be forced to recognize that, if all of the claims find support only in the new subject matter, the application is not, in fact, a CIP, and will not label it as such. The Examiner will then apply prior art based upon the actual filing date of the non-CIP application, thereby reducing the burden on the public and the courts. By rigorously following the CIP practice with one invention per patent, a parent of a CIP application will be abandoned and the CIP will contain both claims enjoying the filing date of the parent and patentably indistinct claims enjoying only the later filing date of the CIP.

In addition, to make sure a mis-labeled "CIP" does not include inventors of the parent simply to attain the priority when, in fact, none of the parent inventors is an inventor of the new subject matter of the "CIP," applicant should be forced to sort out the inventorship before filing. To make sure the inventorship issue has been addressed before filing, applicants should affirm to the USPTO that a new inventor named in the "CIP" co-conceived the new subject matter with at least one of the inventors named in the parent.

In addition, the modified CIP practice should encourage the practitioner to 1) submit a copy of the parent application along with the CIP showing amendments made to parent to attain the CIP; 2) claim any new subject matter in dependent claims; and 3) abandon the parent application. CIP applications that issue under the modified CIP practice will have a greater chance of avoiding litigation and/or withstanding validity and enforceability challenges during litigation. If practitioners abuse the modified CIP practice by omitting or misrepresenting information, then the court will hold the patent unenforceable on the grounds of inequitable conduct.

[Part of Paragraph 3, page 12, deleted]

So, an examiner, while searching for relevant prior art, will typically search for art based on what he or she believes to be the effective filing date even though the examiner has made no inquiry into whether similar subject matter is even shared between the applications or whether the material claimed to be entitled to the priority of the original application is even in fact entitled to the benefit of the earlier filing date.

[Paragraphs beginning on page 13, deleted]

The designation of whether a claim in a CIP is supported by the disclosure of the subject matter contained within the parent application or whether it constitutes new matter becomes an even more difficult task as the claims are altered throughout patent application prosecution. In applications containing many claims, it often becomes difficult to keep track of the prosecution history of each claim as well as the priority date applicable to each claim which is necessary for determining qualifying prior art. For example, in *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, an applicant filed a patent application whose prosecution involved more than 100 claims.⁶³ One of these claims in particular, claim 50, was originally rejected for indefiniteness under 35 U.S.C. § 112 but was eventually allowed after amendment.⁶⁴ In due time, a continuation was filed in which the applicant claimed 22 claims from the parent application that were indicated as being previously allowed, but the applicant inadvertently included the original claim 50 instead of the allowed amended version.⁶⁵ The examiner relied on the applicant's designation, and a patent eventually issued including the originally rejected claim 50.⁶⁶ If the examiner would have compared the parent and continuing applications he may have discovered the inadvertent mistake. Instead, an infringement action ensued and the patent had to be litigated to determine its validity.

In addition to relying on previously allowed claim designations, the USPTO will also allow an applicant to amend a claim in a CIP without considering whether that amendment

⁶³ *Kingsdown Medical Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867 (Fed. Cir. 1988).

⁶⁴ *Id.* at 870.

⁶⁵ *Id.*

constitutes new matter in lieu of the parent application. This practice results in additional instances where the courts are forced to interpret whether the amended material constitutes new matter denying it of the earlier filing date of the prior application. If the attorneys would make a mere comparison regarding the amended material and the scope of the parent application it would save the courts a tremendous amount of time and resources.

ALLOWING DOUBLE PATENTING HAS INCREASED THE PROBLEMS ASSOCIATED WITH CIP PRACTICE

THE POLICY AGAINST DOUBLE PATENTING

In the past, many of the problems created by CIP application practices were forbidden under the courts' interpretation of 35 U.S.C. 101 which provides that anyone who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore."⁶⁷ Courts routinely interpreted this statute to grant the express right for "a" patent to anyone who conjures a new and useful invention. This interpretation forbade inventors from attempting to obtain more than one patent for the same invention, a practice recognized by the MPEP as double patenting.⁶⁸ The policy behind the doctrine of double patenting was:

The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.⁶⁹

Allowing double patenting would enable an inventor to secure an exclusive right for a specific technology and sequentially secure exclusive rights to improvements or modifications that arise from that technology. The USPTO enforces the doctrine to avert a competitive advantage by preventing the unwarranted extension of the exclusive property rights granted by a patent. However, the MPEP provides a way of bypassing the doctrine of double patenting. The MPEP

⁶⁶ *Id.* at 871.

⁶⁷ 35 U.S.C. § 101.

⁶⁸ MPEP 804

allows an applicant to file a terminal disclaimer “to obviate a judicially created double patenting rejection in a patent application or in a reexamination proceeding” as long as the applicant “[i]nclude[s] a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.”⁷⁰ Additionally, the Cooperative Research and Technology Enhancement Act of 2004 (CREATE), which came into effect in late December of that year, requires that the “patentably indistinct patent must include a disclaimer that will require the owner of that patent to waive the right to enforce that patent separately from the first-issued patent” and, additionally, “be enforced only during the term of the first-issued patent.”⁷¹ This allows an inventor to receive multiple patents for an invention and the modifications or variants which may have been, or may become, available in light of the invention.

ALLOWING APPLICANTS TO BYPASS THE DOUBLE PATENTING EXCLUSION HAS INCREASED THE NUMBER OF UNSUPPORTED CIPS

A terminal disclaimer can be used in conjunction with a CIP application in several instances. For example, an applicant may attempt to patent a specific technology he or she has conceived of, and when the knowledge and understanding of that technology increases, the applicant may file a CIP along with a terminal disclaimer in an attempt to increase the boundaries of the invention or to prevent others from designing around their new technology. In *Honeywell Int’l, Inc. v. Universal Avionics Sys. Corp.*, Honeywell initially developed and patented, the ‘080 patent, a forward-looking terrain altering system to warn pilots when the danger of having a “controlled flight into terrain” accident increases.⁷² Eventually, after further research, Honeywell wanted to additionally patent the original system along with the ability to visually display the alert to the pilot. Honeywell filed a CIP while the ‘080 patent was pending claiming the new technology along with the old, and the examiner initially rejected a significant

⁶⁹ In re Zickendraht, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring).

⁷⁰ MPEP 1490

⁷¹ [Comments](#) of Senator Orrin Hatch during Senate Consideration of S.2192 (CREATE Act) (CR June 25, 2004, S7521

⁷² *Honeywell Int’l, Inc. v. Universal Avionics Sys. Corp.*, 264 F. Supp. 2d 135 (D. Del. 2003)

portion of the claims in the CIP on a double patenting basis.⁷³ As a result of the rejection, Honeywell filed a terminal disclaimer limiting all aspects of the CIP to the term of the '080 patent, and the claims of the CIP were allowed as the '570 patent.⁷⁴

Honeywell was allowed to receive the '080 patent to cover the original invention, and the '570 patent to cover an improvement to the original application. In this scenario, there is no need to grant two patents to Honeywell. The '570 patent contained the complete disclosure of the original patent application plus the new matter covering the improvement. That single disclosure is capable of covering the claims contained within both patents. A CIP provides for, in fact requires, a portion of the disclosure of the parent application in addition to new matter. There is no reason why the "CIP's" claim scope cannot encompass the entire subject matter of the parent application plus the new matter.

Allowing double patents to issue from a single invention by permitting an applicant to file a CIP while still maintaining prosecution of the parent application results in an increasing amount of CIP applications issuing which do not share similar subject matter with their parent application. On the other hand, eliminating the double patenting exception by requiring the abandonment of a parent application when a CIP is filed would help to instill the court's original interpretation of § 101 and significantly deter applicants from submitting CIPs that are not supported by the disclosure of the parent application.

[Paragraph 2 & 3 from page 20, deleted]

Since the modified CIP practice gives the PTO more authority to require the applicant to make statements on the record, any abuse by the applicant shall be uncovered by either the PTO or the courts. The PTO would uncover the abuse during prosecution of the CIP, while the courts would uncover it during litigation of any patents that result from the CIP. When such abuse is uncovered during prosecution, the applicant shall be prevented from obtaining a patent. When such abuse is uncovered during litigation, the patent will be held unenforceable for inequitable

⁷³ *Id.* at 139.

⁷⁴ *Id.*

conduct. It is to be appreciated that a finding of inequitable conduct is different than a determination that the patent is invalid.

In order to find inequitable conduct in the modified CIP practice, the following must be present: 1) an alleged non-disclosure or misrepresentation must have occurred, 2) the non-disclosure or misrepresentation must be material, and 3) the applicant must have acted with intent to deceive the PTO. The non-disclosure or misrepresentation must meet the threshold levels of both materiality and intent. The more material the information misrepresented or withheld by the applicant, the less evidence of intent will be required in order to find that inequitable conduct has occurred. Each of the three requirements discussed above must be met for a finding of inequitable conduct.

[Paragraph from page 21, deleted]

Based upon the court's familiarity with this test for inequitable conduct, applying the test to the modified CIP practice should result in less uncertainty in the court's decisions as it relates to CIP practice. Furthermore, practitioners will proceed with caution when filing CIPs under the modified CIP practice knowing that the record will be clear to the court, if and when, the court determines whether any omissions or misrepresentations are present.