

# Continuing Application Strategy

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# Successive Prosecution Premise

- Claims that issue in one application may not be sufficient to protect client's position
- May be necessary/desirable to present claims of different scope in:
  - Continuation/CIP/Divisional (35 USC §120)
  - Broadening Reissue (35 USC §251)

# When? Why?

- Ongoing or Anticipated Litigation
- Licensing Negotiations
- Selective Strengthening of Portfolio
- Evolving Competition
  - Structural/Design Evolution
  - Reorganization/Relocation of "Infringements"
- Insufficient Coverage Achieved to-date

# Motivating Trends

- Literalism/Notice in Claim Construction
- Presumptive Unavailability of Equivalents (Festo)
- “Dedication” of Unclaimed Subject Matter (Johnson & Johnson)
- Foreseeability
- Hyper-Restriction

# *Foreseeability* (Festo)

- The first criterion requires a patentee to show that an alleged equivalent would have been "unforeseeable at the time of the amendment and thus beyond a fair interpretation of what was surrendered." ... This criterion presents an objective inquiry, asking whether the alleged equivalent would have been unforeseeable to one of ordinary skill in the art at the time of the amendment. Usually, if the alleged equivalent represents later-developed technology (e.g., transistors in relation to vacuum tubes, or Velcro (R) in relation to fasteners) or technology that was not known in the relevant art, then it would not have been **foreseeable**. In contrast, old technology, while not always **foreseeable**, would more likely have been **foreseeable**. Indeed, if the alleged equivalent were known in the prior art in the field of the invention, it certainly should have been **foreseeable** at the time of the amendment.

**Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.**, 344 F.3d 1359, 2003 U.S. App. LEXIS 19867, 19-21 (U.S. App. , 2003)

# *Dedication* (Johnson & Johnston)

- “[W]hen a patent drafter discloses but declines to claim subject matter ... this action dedicates that unclaimed subject matter to the public.”

**Johnson & Johnston Assocs. v. R.E. Serv. Co., 285 F.3d 1046, 1054 (Fed. Cir. 2002)**

- “[The] patent specifically limited the claims to “a sheet of aluminum” and “the aluminum sheet.” The specification of the ... patent, however, reads: ‘While aluminum is currently the preferred material for the substrate, other metals, such as stainless steel or nickel alloys may be used.’ ... Having disclosed without claiming the steel substrates, Johnston cannot now invoke the doctrine of equivalents to extend its aluminum limitation to encompass steel.

**Johnson & Johnston Assocs., 285 F.3d at 1055.**

# *Dedication* (the remedy)

- “A patentee who inadvertently fails to claim disclosed subject matter, however, is not left without remedy. Within two years from the grant of the original patent, a patentee may file a reissue application and attempt to enlarge the scope of the original claims to include the disclosed but previously unclaimed subject matter. 35 U.S.C. § 251 (2000). In addition, a patentee can file a separate application claiming the disclosed subject matter under 35 U.S.C. § 120 (2000) (allowing filing as a continuation application if filed before all applications in the chain issue).”

**Johnson & Johnston Assocs., 285 F.3d at 1055.**

# Foreseeability (next steps?)

- “[T]he doctrine of equivalents does not embrace subject matter that the patent drafter could have foreseen during the application process and thus could have included in the claims. Thus, the literal scope of the claims alone defines invention scope in any **foreseeable** circumstances.” *Festo*, 344 F.3d 1359, 2003 U.S. App. LEXIS 19867, 19-21 (U.S. App. , 2003) (Rader concurring)
- “At this point the Supreme Court has only applied foreseeability to identify the scope of surrendered subject matter for an estoppel. But applying the foreseeability principle directly to bar **foreseeable** equivalents outside an amendment and estoppel context is very consistent with the Supreme Court's holding. This principle in operation promises to preserve drafting expectations while honoring the notice function of claims.” *Id.*

# Foreseeability Scorecard

- Foreseeable surrender by amendment  
(Festo, Pioneer Magnetics, Sage Products)
- Foreseeable dedication by unclaimed disclosure (Johnson & Johnston)
- Limitation on Equivalents for failure to cover to literally cover all reasonably foreseeable ways to practice the invention

# Claiming More: Your Options

- Continuing Application (CON/DIV/CIP) under (35 USC §120)
  - As Long as Continuity Exists
  - Most Flexible
- Broadening Reissue (35 USC §251)
  - Within 2-Years after Grant
  - Must be "Error" as Contemplated by Statute
  - But No Recapture

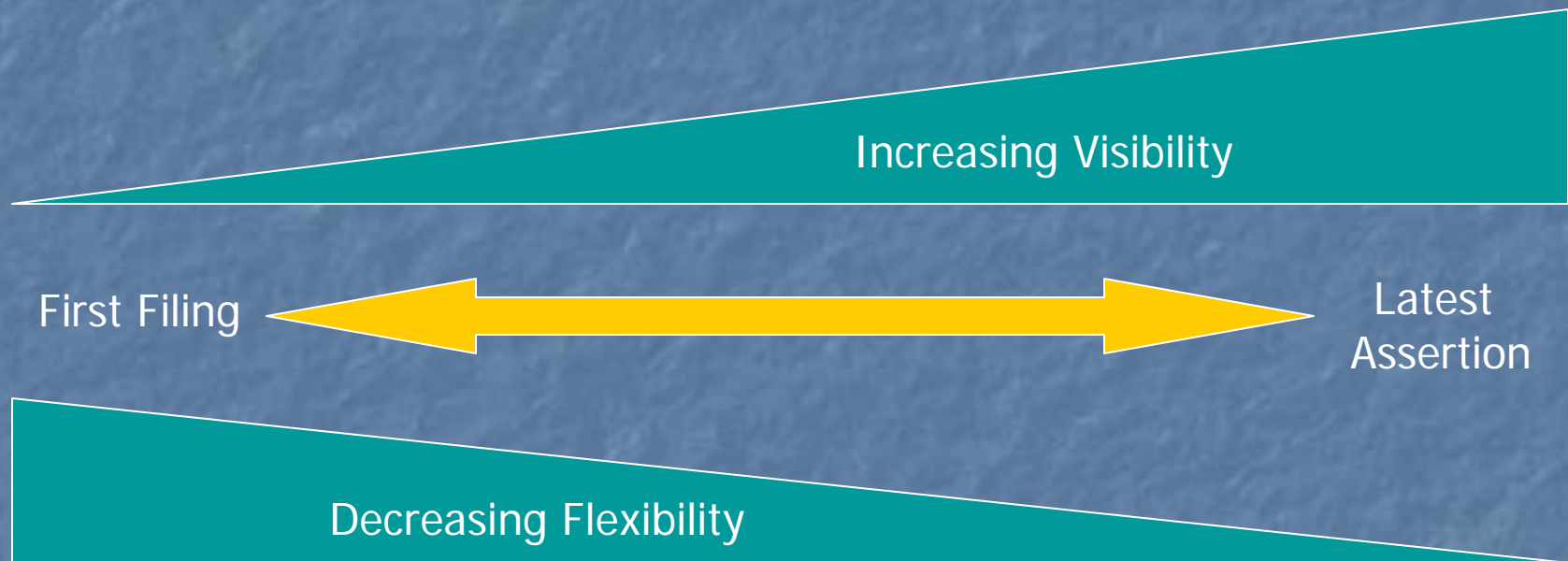
# Important Considerations

- Subject Matter Desired/Required
- Timing
- Written Description (Gentry, Tronzo PIN/NIP)
- Disclosure Obligations (Dayco Prods.)
- Priority Claims
- Prosecution Laches (Symbol Tech)

# Additional Coverage to Seek ?

- Broader/Narrower
- Elimination of Missing Element(s)
- Festo-Free Language
- “Recapture” of Foreclosed Range of Equivalents
- Previously Unclaimed/Restricted Subject Matter
- Additional Modes of Infringement (e.g., 271(f),(g))
- Statutory Equivalents
- Just Keeping Options Open

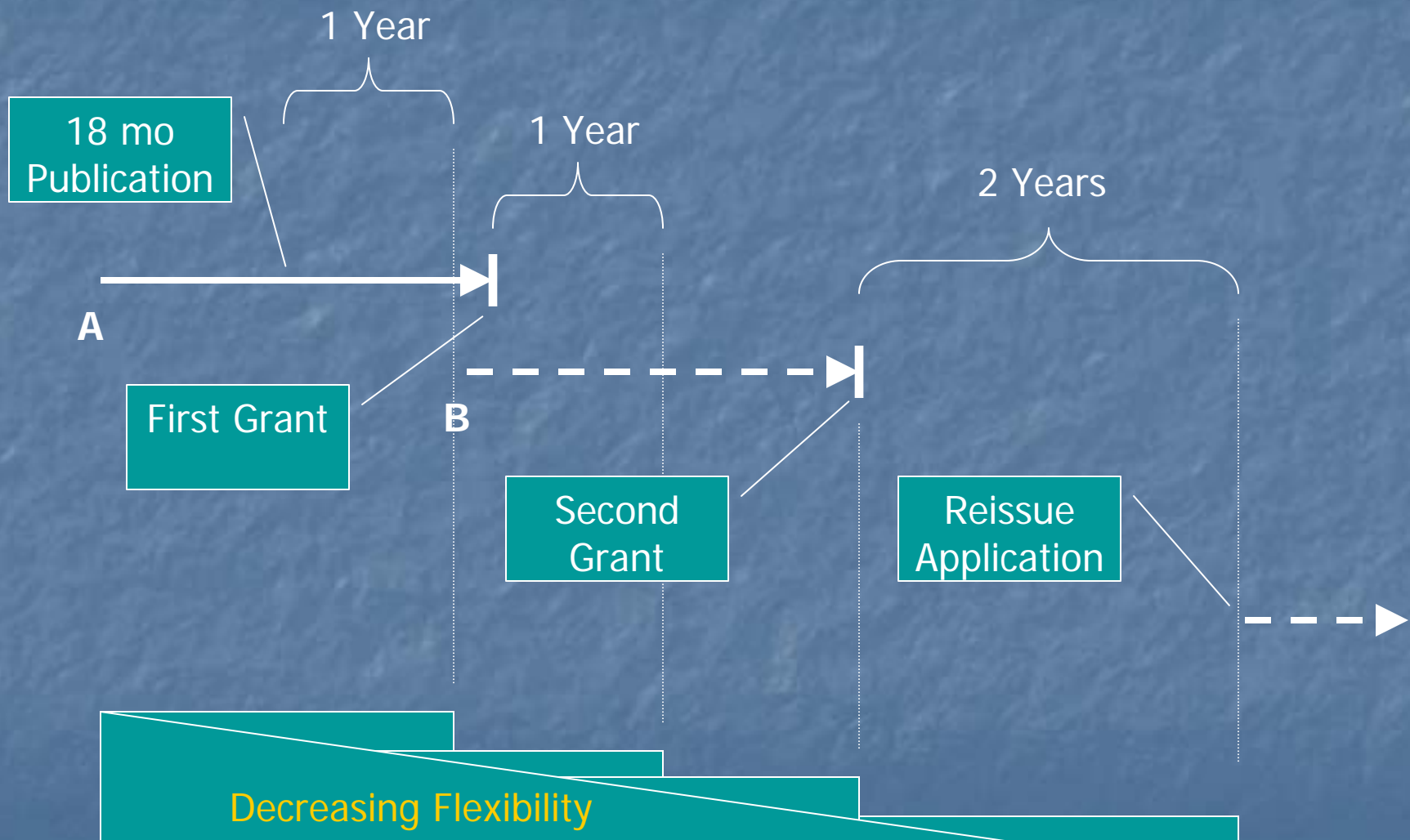
# Knowledge vs. Options



# Own Published/Granted Patent as Prior Art: Important Waypoints

- More than 1 Year after of:
  - Foreign/International Publication
  - Section 122 Publication
  - Grant
- Remember to Consider:
  - §102(b)/103 (Tronzo) and
  - §135(b) (*see In re McGrew*)

# Timeline



# Written Description (5 years after *Gentry*)

- After *Gentry* scare,
  - No Omitted Element Test (*Rieffin v. Microsoft*, 214 F.3d 1342 (Fed. Cir. 2000))
  - No new Essential Element Test (*See Amgen Inc. v. Hoechst Marion Roussel*, 314 F.3d 1313, 1333 (Fed. Cir. 2003))
  - *Gentry* routinely limited/explained/distinguished.
- “In *Gentry*, we applied and merely expounded upon the unremarkable proposition that a broad claim is invalid when the entirety of the specification clearly indicates that the invention is of a much narrower scope.” (*PIN/NIP, Inc. v. Platte Chem. Co.*, 304 F.3d 1235, 1248 (Fed. Cir., 2002) quoting *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317 (Fed. Cir. 2002); see also *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1365 (Fed. Cir. 2003).

# Consider Written Description

- Don't overtly recite undisclosed features
- Don't omit that which the specification unambiguously requires as essential
- UNLESS, you do so in an originally presented claim AND
- Beware the *Tronzo* trap:
  - No Support (in priority app) under 112; BUT
  - Anticipation and/or Obviousness based on your priority app (or its counterpart)

# 35 USC § 135(b) - McGrew

- 35 USC §135(b) is not limited to inter partes interference proceedings but may be used, in accordance with its literal terms, as a basis for ex parte rejections. In re McGrew, 120 F.3d 1236, 1237 (Fed. Cir. 1997)
- “A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.” 35 USC § 135 (b) (1) (2002)
- “A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.” 35 USC § 135 (b) (2) (2002)

# Consider 135(b)

- Same/Substantially Same as:
  - 3<sup>rd</sup> Party Claim
  - Your Own Claim
- Bar based on own claim unlikely, but ...
  - Probably not differing inventorship
  - Consider Apparatus vs. M+F claim

# Duty to Disclose Prior Rejection of Substantially Similar Claim

- Prior rejection of a substantially similar claim in a co-pending US application is material under the reasonable examiner standard (old rule 56). The information also meets the threshold level of materiality under new Rule 56, in that 'it refutes, or is inconsistent with, a position the applicant takes in . . . asserting an argument of patentability.'

Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1368 (Fed. Cir. 2003)

- Without such a disclosure requirement applicants may surreptitiously file repeated or multiple applications in an attempt to find a 'friendly' Examiner.

# Duty to Disclose Information from Related Litigation

- Existence and Material Information (MPEP 2001.06(c))
- Material Information (e.g., evidence/ allegations) with respect to:
  - prior art, public use, on sale
  - Inventorship
  - fraud, inequitable conduct
  - Arguments in litigation
- Pleadings, admissions, discovery, testimony, orders, etc.
- Failure to Disclose (in reexamination) Court's prior claim construction rendered patent unenforceable. *Marlow Indus. v. Igloo Prods. Corp.*, 65 Fed. Appx. 313 (Fed. Cir. 2003) (NONPRECEDENTIAL)

# Priority Claiming Formalities

- Subsequent application must contain or be amended to contain specific reference to the earlier filed application. 35 USC § 120
- Reference must be submitted:
  - during pendency of application (35 USC § 120)
  - and within 4 months (or 16 months of claimed priority) 37 CFR 1.78(2)(ii)
- Failure to timely submit constitutes waiver of priority claim unless *UNINTENTIONALLY* delayed
- PTO will not recognize claim that fails to recite relationship (CON/CIP/DIV) as a proper claim under the statute (1268 OG 89)

# Prosecution Laches

- Equitable doctrine of laches applicable to bar enforcement of patent claims that issued after an unreasonable and unexplained delay in prosecution, even though the applicant complied with pertinent statutes and rules. *Symbol Techs. Inc. v. Lemelson Med.*, 277 F.3d 1361 (Fed. Cir. 2002)
- Prosecution Laches may be relied upon by PTO in ex parte prosecution. *In re Bogese*, 303 F.3d 1362, 1367 (Fed. Cir. 2002) (11 FWCs in eight years)

# Additional Considerations

- Publication under 35 USC § 122
  - Consider that Provisional Rights (i.e., a reasonable royalty) may be available if:
    - Invention as claimed in the patent is substantially identical to the invention as claimed in the published patent application.  
35 USC § 154(d) (2002).
  - Consider that File Wrapper of Published Application is open to public. *See* 37 CFR 1.14(c)(2) (2002).
- Terminal Disclaimer Risks

# Reissue Basics

- “Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender ..., reissue the patent for the invention disclosed in the original patent ....”  
35 USC § 251
- Reissue may broaden if applied for within 2-Years after grant.

# Limitations of Broadening Reissue

- Requires an “Error” as Contemplated by Statute
  - Reissue “Error” Law Highly Technical
  - Failure to File Divisional Application is not Inadvertent Error Correctable by Reissue. *See In re Orita*, 550 F.2d 1277 (CCPA 1977)
  - But Failure to Present Linking Claim Broad Enough to Link Groups of Claims that were Subject to a prior Restriction is Contemplated by the statute. *In re Doyle*, 293 F.3d 1355, (Fed. Cir. 2002)
- New Rules Relax Requirements for Oath (37 CFR 1.175(a))
  - Single error
  - General statement regarding no deceptive intent
  - Don’t mistake streamlined rule for change in substantive law

# Limitations of Broadening Reissue

- **Recapture Rule** prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366 (Fed. Cir. 2001)
- **Intervening Rights:** reissued patent shall not abridge or affect the right of any person ... who, prior to the grant of a reissue, made, purchased, offered to sell, or used within the United States, or imported into the United States, anything patented by the reissued patent, to continue the use of, to offer to sell, or to sell to others to be used, offered for sale, or sold, the specific thing so made, purchased, offered for sale, used, or imported unless the making, using, offering for sale, or selling of such thing infringes a valid claim of the reissued patent which was in the original patent.

# Wrap Up

- Importance of Review before Grant:
  - Foreseeable Equivalents May Easily Be Foreclosed
  - Disclosed but Unclaimed Subject Matter Gone
  - Don't Count On Reissue
- Make Informed Decisions
- Recognize that Substantial Divisional Filing Overhead may be Imposed by Aggressive PTO Restriction Practice
- Develop a Strategy
- Execute

# Final Thoughts

- Continuations Costly, but ...
- Recommendations:
  - Consider Substantive (e.g., Patent Committee) Review Coincident with Grant
  - Police Portfolio and be Proactive about Continuing Application Strategy
  - Consider Postponing Competitor Investigations until just after Issuance