

# CONSIDERATIONS FOR HANDLING CLOSELY RELATED SUBJECT MATTER IN PATENT PORTFOLIOS IN LIGHT OF *THERASENSE* AND THE AMERICA INVENTS ACT OF 2011

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## ABSTRACT

Patent practitioners and owners often have more than one application or issued patent that is directed to similar subject matter. Sometimes these cases are not formally related. Recent case law suggests that owners and attorneys should exercise caution in handling these cases to comply with the United States Patent Office's duty of disclosure, and in some instances the courts have required disclosure that is not intuitive. There are also unique prosecution issues that arise in portfolios of closely related subject matter. The law governing some of these issues, such as attribution and derivation is not particularly clear, and the newly enacted America Invents Act simplifies some issues but further complicates others. While this Article is primarily directed to handling large patent portfolios that include numerous related cases, the content is relevant to prosecuting groups of related cases as small as two.

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The views set forth in this article are the personal views of the authors and do not reflect those of Medley, Behrens, & Lewis LLC, Cummins Inc., Myers Bigel Sibley & Sajovec, P.A., or any of their clients.

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## I. INTRODUCTION

Inventors and companies often file multiple patent applications in the PTO directed to similar subject matter. These related applications may present unique issues related to the duty of disclosure and can present additional challenges in overcoming commonly owned prior art. This Article discusses certain key issues and suggests approaches that are useful in resolving difficulties that

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may arise. While this Article is of particular interest to practitioners handling large portfolios, many of the approaches discussed herein will be relevant to prosecuting smaller portfolios as well.

When an inventor or group of inventors have more than one invention directed to similar subject matter, a patent prosecutor has some options in how to pursue patent protection on the inventions. One option is to disclose multiple inventions in one application and direct separate independent claims to each invention. Often this will result in a restriction requirement being issued by the examiner, in which case the applicant will have to elect the claims directed to one of the inventions, and withdraw the other claims.<sup>1</sup> These withdrawn claims may then be pursued in one or more divisional applications.<sup>2</sup> An alternative approach is to file the application disclosing multiple inventions, but initially only claim one invention. The additional inventions may then be claimed in one or more continuing applications filed while the initial application is still pending.<sup>3</sup> If either of these filing strategies is adopted, the applications will be formally related in the Patent Office and this relationship will be printed on the published applications and any patents that may issue.<sup>4</sup> The relationship between the applications will also be indexed at the United States Patent and Trademark Office's ("PTO") Patent Application Information Retrieval ("PAIR") website.<sup>5</sup> Such related applications are often referred to by patent practitioners in genealogical terms, such as being in the same "patent family" and as "parent," "child," or "grandchild" applications.

Another option available to patent practitioners is to file separate applications for each related invention at the outset. This option may be beneficial in speeding up prosecution and in reducing extra claim fees, although it will cost more in filing fees at the outset as all of the filing and examination fees will be paid at once upon the filing of multiple applications.<sup>6</sup> Applications filed in this manner will not be formally related to any of the other nominally related appli-

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<sup>1</sup> 37 C.F.R. § 1.142 (2011); MPEP § 802 (8th ed. Rev. 8, July 2010).

<sup>2</sup> 35 U.S.C. § 121 (2006); MPEP § 802.

<sup>3</sup> 35 U.S.C. § 121; MPEP § 201.07.

<sup>4</sup> 37 C.F.R. § 1.78(a); MPEP §§ 201.11, 202.02.

<sup>5</sup> *Patent Application Information Retrieval*, USPTO, <http://portal.uspto.gov/external/portal/pair> (last visited Oct. 18, 2012).

<sup>6</sup> This is in contrast to prosecuting applications serially as part of the same family of related applications, where the filing and examination fees will be due over time, as divisional and continuation applications may be filed at any time during the pendency of a related application to which priority is claimed. 35 U.S.C. § 120.

cations, and there will not be any public record that the application is related to any other application containing similar or related subject matter.<sup>7</sup>

Additionally, as inventors pursue ongoing lines of research, new inventions may be made after a patent application with similar subject matter has already been filed. A continuation-in-part application (“CIP”) may be filed to claim the additional invention,<sup>8</sup> which will formally link the CIP to its parent application.<sup>9</sup> More commonly, however, a new application will be filed that does not result in any public record of a formal relationship to the earlier application.<sup>10</sup>

Patent applications claiming similar subject matter—whether formally related or not—can cause potential difficulties in prosecution and in complying with the duty of disclosure.<sup>11</sup> If adequate precautions are not taken, a patent can be found invalid or unenforceable during an ensuing patent litigation, or be precluded from issuing because of earlier published or filed applications in the same subject matter area. These difficulties are identified and explained below in conjunction with some approaches to resolve these difficulties.

## II. INEQUITABLE CONDUCT ISSUES

Although the Federal Circuit’s recent decision in *Therasense, Inc. v. Becton, Dickinson and Co.*<sup>12</sup> limited the availability of an inequitable conduct defense in litigation, it is still an available remedy for patent owners.<sup>13</sup> Section II discusses post-*Therasense* prosecution strategies to protect against an inequitable conduct attack that may arise in future litigation.

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<sup>7</sup> See *supra* note 4.

<sup>8</sup> 37 C.F.R. § 1.53(b)(2); MPEP § 201.08. The CIP practice is now a relatively rare approach since the seventeen-year-from-issue patent term was abolished in favor of the 20-year-from-first-filing term. This is because the CIP’s patent term will begin running from the date of the earliest parent application that it claims priority to. Thus, a CIP will have a shortened patent term. See generally Kirk Teska, *The False Security of Continuation-in-Part Applications*, 83 J. PAT. & TRADEMARK OFF. SOC’Y 223, 223–29 (2001).

<sup>9</sup> See *supra* note 4.

<sup>10</sup> See *supra* note 4.

<sup>11</sup> See 37 C.F.R. § 1.56(a).

<sup>12</sup> 649 F.3d 1276 (Fed. Cir. 2011) (en banc).

<sup>13</sup> *Id.* at 1288 (“Moreover, the taint of a finding of inequitable conduct can spread from a single patent to render unenforceable other related patents and applications in the same technology family.”).

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### A. *The Duty of Disclosure*

The duty of candor and good faith is defined in 37 C.F.R. § 1.56(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. Each 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 as defined in this section.<sup>14</sup>

A breach of the duty of disclosure may constitute inequitable conduct if the “applicant misrepresented or omitted material information with the specific intent to deceive the PTO.”<sup>15</sup> A party challenging a patent as unenforceable due to inequitable conduct must establish materiality and intent by clear and convincing evidence.<sup>16</sup> When a court determines inequitable conduct has occurred, the entire patent—or, under certain circumstances, even a patent family—may be rendered unenforceable.<sup>17</sup>

The Federal Circuit’s opinion in *Therasense* clarified the standard for determining whether the information that was misrepresented or omitted is material to patentability. The court held that, in general, “but-for” materiality is required to establish a defense of inequitable conduct.<sup>18</sup> Thus, a court must determine whether the PTO would have allowed the claim if it had been aware of the undisclosed reference.<sup>19</sup>

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<sup>14</sup> The duty of disclosure is discussed at length in MPEP chapter 2000. 37 C.F.R. § 1.56(a); MPEP § 2000 (8th ed. Rev. 8, July 2010). Numerous court opinions deal with the duty of disclosure and inequitable conduct for failing to comply with the duty of disclosure. See generally David McGowan, *Inequitable Conduct*, 43 LOY. L.A. L. REV. 945 (2010).

<sup>15</sup> *Therasense*, 649 F.3d at 1287.

<sup>16</sup> *Honeywell Int’l Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982, 999 (2007); see also *Therasense*, 649 F.3d at 1287 (“The accused infringer must prove both elements—intent and materiality—by clear and convincing evidence.”).

<sup>17</sup> *Kingsdown Med. Consultants, Ltd. v. Hollister Inc.*, 863 F.2d 867, 877 (Fed. Cir. 1988); see also *Therasense*, 649 F.3d at 1287, 1292 (“If the accused infringer meets its burden, then the district court must weigh the equities to determine whether the applicant’s conduct before the PTO warrants rendering the entire patent unenforceable. . . . Because inequitable conduct renders an entire patent (or even a patent family) unenforceable, as a general rule, this doctrine should only be applied in instances where the patentee’s misconduct resulted in the unfair benefit of receiving an unwarranted claim.”); *Aptix Corp. v. Quickturn Design Sys., Inc.*, 269 F.3d 1369, 1377 (Fed. Cir. 2001).

<sup>18</sup> *Therasense*, 649 F.3d at 1291.

<sup>19</sup> *Id.*

The court also recognized an exception to a showing of “but-for” materiality in cases where “the patentee has engaged in affirmative acts of egregious misconduct, such as the filing of an unmistakably false affidavit.”<sup>20</sup> “After all, a patentee is unlikely to go to great lengths to deceive the PTO with a falsehood unless it believes that the falsehood will affect issuance of the patent.”<sup>21</sup>

The previous standard for materiality, and for the moment, the standard that is still referred to in the MPEP is that information is considered material to patentability when it is not cumulative to information already of record and (1) it establishes a showing of unpatentability of a claim or (2) it refutes or is inconsistent with the applicant's position opposing an argument of unpatentability or asserting an argument of patentability.<sup>22</sup> The materiality of the information withheld is judged by the “reasonable examiner” standard.<sup>23</sup> The “reasonable examiner” standard embraces any information a reasonable examiner would consider in deciding whether to allow an application to issue as a patent.<sup>24</sup>

Under *Therasense*, however, a finding that an undisclosed reference is material does not automatically create a presumption of an intent to deceive.<sup>25</sup> There must also be a separate showing of a specific intent to deceive the PTO.<sup>26</sup> The accused infringer must prove “that the applicant knew of the reference, knew that it was material, and made a deliberate decision to withhold it.”<sup>27</sup> This requires more than merely an “absence of a good faith explanation for withholding a material reference,” and it cannot be inferred from a strong showing of

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<sup>20</sup> *Id.* at 1292.

<sup>21</sup> *Id.*

<sup>22</sup> *Purdue Pharma L.P. v. Endo Pharms. Inc.*, 410 F.3d 690, 696 (Fed. Cir. 2005) (citing 37 C.F.R. § 1.56(b) (2004)). This definition of materiality applies to all patent applications pending or filed after March 16, 1992. *Bruno Indep. Living Aids, Inc. v. Acorn Mobility Servs., Ltd.*, 394 F.3d 1348, 1352 (Fed. Cir. 2005). The court will evaluate materiality giving “deference to the [Patent and Trademark Office’s] formulation at the time an application is being prosecuted before an examiner of the standard of conduct it expects to be followed in proceedings in the Office.” *Id.* at 1353. The pre-1992 rule defined information as material when there was “substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent.” *Halliburton v. Schlumberger Tech. Corp.*, 925 F.2d 1435, 1440 (Fed. Cir. 1991) (citing 37 C.F.R. § 1.56 (1989)).

<sup>23</sup> *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*, 487 F.3d 897, 913 (Fed. Cir. 2007).

<sup>24</sup> *Id.*

<sup>25</sup> *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1352 (Fed. Cir. 2002).

<sup>26</sup> *Therasense*, 649 F.3d at 1290.

<sup>27</sup> *Id.*

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materiality, as some courts have previously held.<sup>28</sup> The Federal Circuit recently stressed this point, stating:

With regard to the deceptive intent prong, we have emphasized that “materiality does not presume intent, which is a separate and essential component of inequitable conduct.” . . . Thus, the fact that information later found material was not disclosed cannot, by itself, satisfy the deceptive intent element of inequitable conduct. . . . Rather, to prevail on the defense, the accused infringer must prove by clear and convincing evidence that the material information was withheld with the specific intent to deceive the PTO.<sup>29</sup>

The Federal Circuit also recognized that proving intent to deceive by inference is often necessary to meet the clear and convincing standard; such an inference must be “the single most reasonable inference able to be drawn from the evidence.”<sup>30</sup>

Once threshold levels of materiality and intent have been established, the court must then balance them to determine whether the equities warrant a conclusion that inequitable conduct occurred.<sup>31</sup> “While the facts of materiality and intent to deceive must be proven by clear and convincing evidence, the district court must balance the substance of those now-proven facts and all the equities of the case to determine whether the severe penalty of unenforceability should be imposed.”<sup>32</sup> Thus, while both intent and materiality must pass the initial threshold for the court to find inequitable conduct, the fact that both pass the threshold does not obligate the court to hold the patent unenforceable.<sup>33</sup> However, if the court determines that an applicant’s conduct renders a patent unenforceable, the taint of such a finding “can spread from a single patent to render unenforceable other related patents and applications in the same technology family.”<sup>34</sup>

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<sup>28</sup> *Id.* at 1290–91.

<sup>29</sup> *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366 (Fed. Cir. 2008).

<sup>30</sup> *Therasense*, 649 F.3d at 1290.

<sup>31</sup> *Star Scientific*, 537 F.3d at 1367.

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*; see also *Therasense*, 649 F.3d at 1287 (“If the accused infringer meets its burden, then the district court must weigh the equities to determine whether the applicant’s conduct before the PTO warrants rendering the entire patent unenforceable.”).

<sup>34</sup> *Therasense*, 649 F.3d at 1287.

### B. Dayco Products and McKesson

An overview of the Federal Circuit's opinions in *Dayco Products, Inc. v. Total Containment, Inc.*<sup>35</sup> and *McKesson Information Solutions, Inc. v. Bridge Medical, Inc.*<sup>36</sup> provides a foundation for understanding issues that can arise with the duty of disclosure and inequitable conduct when prosecuting patents containing closely related subject matter.<sup>37</sup>

In the *Dayco Products* case, Dayco owned two patent families.<sup>38</sup> Although the two families were not formally related to one another, the Court found that they were drawn to “substantially similar” subject matter.<sup>39</sup> Both families related to flexible hoses and coupling assemblies, and the patent claims were “in some respects substantially identical.”<sup>40</sup> The applications were prosecuted by the same attorney, but the families were examined by two different examiners.<sup>41</sup> The attorney made the first examiner aware of the second family of applications,<sup>42</sup> but failed to notify the second examiner about the first family of applications.<sup>43</sup> The defendant argued that the second family should be held to be unenforceable due to inequitable conduct because the attorney did not disclose the following items of information: (1) the pendency of the first family of applications; (2) a reference, “Wilson” that was cited by the examiner during prosecution of the first family; and (3) an Office Action that set forth an obviousness rejection of substantially similar claims in the first family of applications based upon the Wilson reference.<sup>44</sup>

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<sup>35</sup> 329 F.3d 1358 (Fed. Cir. 2003).

<sup>36</sup> 487 F.3d 897 (Fed. Cir. 2007).

<sup>37</sup> For a more detailed discussion of the *Dayco Products* case, see Tom Brody, *Duty to Disclose: Dayco Products v. Total Containment*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 692 (2008). For a more complete discussion of the *McKesson* case, see Sean M. O'Connor, *Defusing the "Atomic Bomb" of Patent Litigation: Avoiding and Defending Against Allegations of Inequitable Conduct After McKesson et al.*, 9 J. MARSHALL REV. INTEL. PROP. L. 330, 364–66 (2009).

<sup>38</sup> *Dayco Prods.*, 329 F.3d at 1361.

<sup>39</sup> *Id.*

<sup>40</sup> *Id.* at 1360–61.

<sup>41</sup> *Id.* at 1361, 1365.

<sup>42</sup> It is not clear from the opinion whether an Information Disclosure Statement that cited these materials was filed with the U.S. Patent & Trademark Office.

<sup>43</sup> *Dayco Prods.*, 329 F.3d at 1364.

<sup>44</sup> *Id.*



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The Federal Circuit held that all three items of information met the threshold of materiality, but remanded for trial on the issue of intent to deceive.<sup>45</sup> In reaching its decision, the court stated:

Patent disclosures are often very complicated, and different examiners with different technical backgrounds and levels of understanding may often differ when interpreting such documents. Although examiners are not bound to follow other examiners' interpretations, knowledge of a potentially different interpretation is clearly information that an examiner could consider important when examining an application.<sup>46</sup>

Unlike *Dayco Products*, which came to the Federal Circuit after the District Court granted summary judgment,<sup>47</sup> the Federal Circuit in *McKesson* upheld the District Court's finding of deceptive intent after trial.<sup>48</sup> *McKesson* owned two patent families,<sup>49</sup> and both related to identification systems for indexing certain items to patients.<sup>50</sup> Although most of the independent claims varied in scope, the purported points of novelty were substantially similar.<sup>51</sup> Additionally, many claims were similar in scope, and some claims contained elements that were identical when viewed together with the dependent claims.<sup>52</sup>

The applications had been prosecuted by the same attorney, but the families were examined by two different examiners.<sup>53</sup> Although the attorney disclosed the co-pendency of the applications to the examiners,<sup>54</sup> the Federal Circuit upheld the District Court's finding that the following additional items were material to prosecution of the application that issued as the patent in the second family: (1) a reference, "Baker" cited against the first family during prosecution;<sup>55</sup> (2) an Office Action containing a rejection based upon the Baker reference;<sup>56</sup> and (3) the allowance of one of the applications in the first family, even

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<sup>45</sup> *Id.* at 1365–68.

<sup>46</sup> *Id.* at 1368.

<sup>47</sup> *Id.* at 1362.

<sup>48</sup> *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*, 487 F.3d 897, 901–02 (Fed. Cir. 2007).

<sup>49</sup> One of the two patent families consisted of a single patent. *See id.* at 904–06 (the '009 patent is the only patent in its family).

<sup>50</sup> *Id.* at 902–04 (noting that the '716 patent and the '909 patent (issuing from the '149 application) were similar).

<sup>51</sup> *See, e.g., id.* at 911, 918.

<sup>52</sup> *Id.*

<sup>53</sup> *Id.* at 904.

<sup>54</sup> *McKesson*, 487 F.3d at 905, 917, 922.

<sup>55</sup> *Id.* at 916.

<sup>56</sup> *Id.* at 922.

though the attorney had previously disclosed the existence of the pending application that later issued.<sup>57</sup>

In its reasoning for upholding the finding of intent to deceive, the court emphasized that the patents had been prosecuted simultaneously,<sup>58</sup> that an examiner interview had been proximate in time with filing an amendment in the first family's application,<sup>59</sup> and that the attorney failed to disclose the interview or amendment during prosecution of the second family application.<sup>60</sup>

A notable aspect of the opinion in *McKesson* is that the Federal Circuit did not comment on, but nonetheless repeated, the District Court's ruling rejecting the attorney's explanation that his firm lacked policies or procedures for evaluating or cross-citing Office Actions in similar applications.<sup>61</sup> The Federal Circuit stated:

The court also discounted as not credible and the "product of newly developed hindsight," Schumann's testimony that his firm at the time did not have procedures in place for citing office actions in co-pending applications. . . . And even if Schumann's former firm did have such procedures in place (a matter not decided in fact), the court held that our decision in *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp.*, 267 F.3d 1370 (Fed. Cir. 2001), prevents firms from "insulat[ing] [their attorneys] against charges of inequitable conduct by instituting policies that prevent [the attorneys] from complying with the law."<sup>62</sup>

Even after *Therasense*, district courts will likely follow the holdings in *Dayco Products* and *McKesson* when faced with a patentee who failed to notify the PTO of "material" adverse Office Actions occurring in co-pending applications directed to closely related subject matter. The holdings of *Dayco Products* and *McKesson* survive to define a class of documents that previously were not considered to be information that one would cite to the PTO, particularly in applications that were not formally related.<sup>63</sup> However, *Therasense* dictates a new "but-for" materiality standard that significantly restricts the number of adverse actions that will truly be considered material.<sup>64</sup>

The class of prosecution documents that courts following *Dayco Products* and *McKesson* may conclude are potentially material information to be

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<sup>57</sup> *Id.* at 925–26.

<sup>58</sup> *Id.* at 916.

<sup>59</sup> *Id.* at 917.

<sup>60</sup> *McKesson*, 487 F.3d at 918.

<sup>61</sup> *Id.* at 911.

<sup>62</sup> *Id.*

<sup>63</sup> See *infra* notes 65–68 and accompanying text.

<sup>64</sup> *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276, 1296 (Fed. Cir. 2007).

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disclosed to an examiner include: (1) references cited by the examiner in cases that claim substantially similar subject matter;<sup>65</sup> (2) the existence of applications or patents that claim substantially similar subject matter (because of the possibility of a double patenting issue);<sup>66</sup> (3) the allowance of any such applications;<sup>67</sup> and (4) Office Actions for applications that claim substantially similar subject matter.<sup>68</sup>

### C. Dealing with Prior Art and Office Actions from Substantially Similar Cases

A question arises as to how to determine which cases claim “substantially similar” subject matter. In *Dayco Products*, the independent claims of the separate families had similar scope and many terms that were exactly the same.<sup>69</sup> The court ruled that the material Office Action dealt with claims that were “in some respects substantially identical.”<sup>70</sup> The court in *McKesson*, however, declined to adopt the *Dayco Products* test and instead stated that the standards of “some respects identical,” “substantially similar,” or “substantial similarity ‘in content and scope’” are irrelevant.<sup>71</sup> Rather, the important and underlying question was whether the evidence “clearly and convincingly prove[d] materiality.”<sup>72</sup>

The *McKesson* court went on to say that, “in the same way that prior art need not be substantially similar in order to be material . . . rejected claims in a co-pending application also need not be substantially similar in order to be material.”<sup>73</sup> The *McKesson* court also highlighted the omitted Baker reference, which was directed to a phone system, and explained that while the reference would not be considered substantially similar to the pending claims, which were directed to a patient identification system, the reference was still material to the co-pending application.<sup>74</sup>

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<sup>65</sup> *McKesson*, 487 F.3d at 908; *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1364 (Fed. Cir. 2003).

<sup>66</sup> *Dayco Prods.*, 329 F.3d at 1364.

<sup>67</sup> *McKesson*, 487 F.3d at 925–26.

<sup>68</sup> *Id.* at 919; *Dayco Prods.*, 329 F.3d at 1364.

<sup>69</sup> *Dayco Prods.*, 329 F.3d at 1361.

<sup>70</sup> *Id.*

<sup>71</sup> *McKesson*, 487 F.3d at 919–20.

<sup>72</sup> *Id.* at 920.

<sup>73</sup> *Id.* at 919.

<sup>74</sup> *Id.* at 920–21.

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Each of the independent claims in *McKesson* had a different scope.<sup>75</sup> For example, one case claimed a system, and another case claimed a method and individual parts of the system.<sup>76</sup> Still, elements added in dependent claims made the claims in the second case very similar to the system claims of the first case.<sup>77</sup> Furthermore, the point of novelty, three-node communication, appeared to be the same in each case.<sup>78</sup> Despite these observations, the standard in *McKesson* is not based on the similarity of the claims, but rather reflects a broader inquiry that defers to what a reasonable examiner would consider material.<sup>79</sup> Nonetheless, while cases with unrelated claims may receive Office Actions that contain reasoning or other information that potentially could be material to another examiner in another case,<sup>80</sup> this should be a rare occurrence and the intent prong of inequitable conduct may be difficult to prove if the cases are dissimilar.

Therefore, identification of cases that claim closely related subject matter may be of some aid in dealing with the duty of disclosure after *McKesson*.<sup>81</sup> Some factors for identifying such cases are the following:

### *a. Do the Cases Have a Common Inventor?*

If you have multiple invention disclosures involving similar subject matter from the same inventor, then additional scrutiny is suggested. Not only because this indicates a greater likelihood of similar subject matter, but also because the inventor may be subject to accusations of inequitable conduct if he or she becomes aware of materials cited in each case.

### *b. Are the Cases Building from the Same Core Technology or Point of Novelty?*

Another inquiry is whether inventors are improving or building off of the same core technology, which may have been an incremental improvement over the prior art. Even if the inventions come from different functional groups and have different configurations, combinations, and materials, they still may

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<sup>75</sup> *Id.* at 920–21.

<sup>76</sup> *Id.*

<sup>77</sup> *McKesson*, 487 F.3d at 905.

<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 913.

<sup>80</sup> Additionally, there will be a public record that shows an attorney had such information in his or her possession.

<sup>81</sup> See *supra* notes 65–68 and accompanying text.

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have been derived from the same core technology, and in some cases the points of novelty may be the same.<sup>82</sup>

### *c. How Broad Are the Claims?*

Another consideration is the breadth of the claims in each case. If claims are broad in one case, the cited art or Office Actions could be substantially similar to many other cases that the practitioner or inventor is associated with. If claims are broad in one case and co-pending applications in the same general field of technology also seek broad claims, prior art that is relevant to both cases likely will be cited at some point during prosecution. If the claims are sufficiently broad, the cited art may even extend into other fields of endeavor.

### *d. Has a Double Patenting Rejection Been Made or Should One Have Been Made?*

Both *Dayco Products* and *McKesson* held that patents or patent applications that a reasonable examiner would consider to be relevant for double patenting are material.<sup>83</sup> Thus, if a double patenting rejection is received in one case over a reference case, then both the rejected case and the reference case should be considered substantially similar.<sup>84</sup> As a precaution, it may be advisable to consider whether an examiner *should* have made a double patenting rejection in any cases involving closely related subject matter. If so, the cases should be treated as substantially similar.

Once cases are determined to be substantially similar, the next step is to determine what items must be disclosed among substantially similar cases.

First, the prior art cited in each substantially similar case should at least be considered for disclosure in each related case. While some prior art will not be relevant to all other substantially similar cases, it can be a difficult and time-consuming analysis to make this determination. In some situations, citing all prior art from each case may be the preferred course of action.<sup>85</sup>

Second, the substantive Office Action rejections for double patenting or rejections over prior art in substantially similar U.S. cases should generally be

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<sup>82</sup> This is essentially the fact pattern in *McKesson*; the three-node communication element was present in each case. *McKesson*, 487 F.3d at 907.

<sup>83</sup> *Id.* at 925; *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1365 (Fed. Cir. 2003).

<sup>84</sup> See *McKesson*, 487 F.3d at 925; *Dayco Prods.*, 329 F.3d at 1365.

<sup>85</sup> See *supra* note 65 and accompanying text.

disclosed. In *Dayco Products* the court stated that the reason Office Actions were material was that a first examiner with a “different technical background[] and level[] of understanding” from a second examiner could more fully and accurately recognize the applicability of the prior art to similar claims.<sup>86</sup> Generally, Office Actions that only object to informalities or that outline restriction requirements (which are based solely on the claims of the immediate case) do not need to be disclosed because they generally are not relevant beyond the case in which they are issued.

If an amendment was filed to overcome prior art in one case, then the prior art and Office Action are even more likely to be material. In *McKesson*, the court held that intent to deceive could be inferred where an amendment was required to overcome the prior art and the prior art and Office Action were not cited in a similar pending case.<sup>87</sup>

Third, the court in *McKesson* credited the attorney for disclosing the existence of “substantially similar” applications.<sup>88</sup> Citing pending cases alerts an examiner to double patenting issues and also provides a basis for arguing that the examiner had access to the cases through direct contact with the other assigned examiners or through internal systems, and therefore, was positioned to obtain relevant Office Actions. A substantially similar case may be cited by issued patent number, publication number, and/or the application number.<sup>89</sup> If possible, cite an issued patent number to inform the examiner of the potential for a non-provisional double patenting rejection and of any prior art issues under 35 U.S.C. § 102. Alternatively, if the application has published, then cite the publication number to notify the examiner of the potential for a provisional double patenting rejection and of any § 102 prior art issues.

In some cases there may be an issue with disclosing the application number in an Information Disclosure Statement (“IDS”) because it will be part of the publicly available file history for a published application.<sup>90</sup> A client may wish to keep the application number private prior to publication for a number of reasons, including avoiding a protest under 37 C.F.R. § 1.291.<sup>91</sup> In such cases, the disclosure can be filed under seal pursuant to the procedures set forth in sections 724.04 through 724.06 of the MPEP.<sup>92</sup> Similar to the preceding situations,

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<sup>86</sup> *Dayco Prods.*, 329 F.3d at 1368.

<sup>87</sup> *McKesson*, 487 F.3d at 917–19.

<sup>88</sup> *Id.* at 917.

<sup>89</sup> See 37 C.F.R. § 1.98 (2011); MPEP § 609 (8th ed. Rev. 8, July 2010).

<sup>90</sup> See MPEP § 609 (noting that IDSs are “placed in the file”).

<sup>91</sup> See 37 C.F.R. § 1.291.

<sup>92</sup> See MPEP §§ 724.02–724.06.

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citing the application number informs the examiner of the potential for a non-provisional double patenting rejection, and of any § 102 prior art issues, other than any under § 102(b).

In *McKesson*, the attorney informed the PTO of the existence of the similar application but did not later inform the same examiner of the issuance of that application.<sup>93</sup> According to *McKesson*, issuance of a similar application must be disclosed in addition to previously having disclosed the existence of the application.<sup>94</sup> This seems overly harsh, because a provisional double patenting rejection could have been made by the examiner at any time after disclosure of the co-pending application, unless the claims were substantially changed since the application was first cited.<sup>95</sup> Nonetheless, *McKesson* suggests that disclosure of both the pendency of a substantially similar application and its subsequent issuance as a patent is advisable.<sup>96</sup>

Finally, neither *Dayco Products* nor *McKesson* address inventor-written articles. However, articles written by inventors on substantially similar subject matter may potentially be material to patentability in two ways. First, the article itself may be prior art for later filed applications.<sup>97</sup> While articles may be substantially cumulative of what has already been disclosed and cited in previous patent applications, there is a potential for non-cumulative subject matter to be relevant. The second and more challenging issue is that the references cited by the inventor/author in the article may potentially be relevant prior art to any or all substantially similar applications.<sup>98</sup> With the publication of an article, there is a dated public record of numerous relevant sources that the inventor has cited in the article, and these references most likely will pre-date some, if not all, of the other related pending cases. Compounding the problem is that the article publication date may indicate that the inventor/author has known about references for more than three months, which may trigger a late fee or prevent submission without reopening prosecution.<sup>99</sup>

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<sup>93</sup> *McKesson*, 487 F.3d at 925.

<sup>94</sup> *Id.* at 925–26.

<sup>95</sup> See MPEP § 804(I)(B).

<sup>96</sup> *McKesson*, 487 F.3d at 925–26.

<sup>97</sup> 35 U.S.C. §§ 102(a)–(b) (2006) (stating that material “described in a printed publication” can be prior art).

<sup>98</sup> *Id.*

<sup>99</sup> 37 C.F.R. §§ 1.97(c)–(e) (2011).

*D. Strategies for Citing Prior Art from Substantially Similar Cases*

The process of disclosing prior art determined to be material based on the general categories discussed above will present a prosecuting attorney with some decisions to make on how to efficiently submit the material prior art.<sup>100</sup> Because *Dayco Products* and *McKesson* have clarified what information courts will consider to be material under the duty of disclosure, costs for IDS preparation will likely increase due to additional efforts involved with determining whether cases are substantially similar and reviewing documents for materiality.

Disclosure strategy options include the following: (1) citing all documents that appear in the sources above without making a time-consuming, in-depth evaluation of materiality; (2) closely reviewing all documents for materiality; or (3) closely reviewing pertinent documents for materiality where time or cost savings will likely be realized, e.g., if payment of a late fee would be required (as discussed below), if an application has been allowed, or when an issue fee has been paid.

The third option is probably the most reasonable as it presents a balance of risk and costs. It seeks to submit the bulk of potentially material references thereby limiting the risk of failing to submit a material document, and limits attorney review time to situations where cost or time savings can be achieved by avoiding PTO late fees. Appropriate times for evaluating the references and Office Actions for materiality are when an application has been allowed, when the issue fee has been paid, or any other time where a request for continued examination (“RCE”) is required to have identified documents considered by the examiner. In each of these cases cost-savings can be achieved and/or patent pendency time decreased if the attorney can determine that the references are not material.

If a final Office Action issues or references surface after allowance or issue fee payment, material prior art must still be submitted; the duty of disclosure does not end until the patent issues, and the attorney accordingly remains obligated to submit for consideration any information that would be material to a reasonable examiner.<sup>101</sup>

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<sup>100</sup> Though somewhat dated, see generally Stephen C. Shear & William S. Galliani, *Patent Practice: Strategies for Submitting Newly Discovered Prior Art After Allowance of an Application*, 7 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1 (1991).

<sup>101</sup> MPEP § 2001.04 (8th ed. Rev. 8, July 2010) (“37 CFR § 1.56(a) states that the duty to disclose information exists until the application becomes abandoned. The duty to disclose information, however, does not end when an application becomes allowed but extends until a patent is granted on that application.”).



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If a notice of allowance has issued, payment of a late fee is required for submission of an IDS at this stage, and issuance of the patent will be delayed.<sup>102</sup> Furthermore, if the prosecuting attorney or applicant knew about the reference for three months or more, then filing of an RCE is typically required.<sup>103</sup> If an issue fee has already been paid, then the procedure for disclosure involves petitioning to withdraw from issue and filing an RCE.<sup>104</sup> In either situation, additional fees will be incurred.<sup>105</sup>

It is therefore advisable to pay the issue fee immediately upon receipt of the notice of allowance in an effort to shorten the time until issuance, unless a relevant Office Action is imminent in a substantially similar case.<sup>106</sup> Examiners may be sympathetic to requests to consider references without having filed an RCE; however, examiners are not obligated to consider disclosures after the issue fee has been paid or if the application has been allowed, if the attorney of record cannot make the statement that he or she learned about the reference within the prior three months.<sup>107</sup>

It is in these situations that the “but-for” materiality test from *Therasense* is most helpful to the patent practitioner, i.e., when a document surfaces that cannot be submitted in an IDS without additional fees or without delaying the issuance of the application.<sup>108</sup> In this case, the practitioner has a clearer and broader rule to determine that a document is not material.<sup>109</sup>

After reviewing any prior art or Office Actions after allowance for materiality, it may be prudent to draft a carefully considered memorandum to the prosecution file to explain why any undisclosed items that surfaced after allowance did not appear to be material. While patent attorneys reasonably may disagree on the value of adding memoranda to the master prosecution file, it is worth observing the court’s statement in *McKesson*:

The court recognized Schumann’s testimony that although “he has no recollection whatsoever of prosecuting the ‘716 patent,” he believes, “looking at the Baker reference now, [that] it is cumulative.” However, the court found this explanation incredible both because it would have been unreasonable, in the

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<sup>102</sup> 37 C.F.R. § 1.97(d); MPEP § 609.04(b)(III).

<sup>103</sup> 37 C.F.R. §§ 1.97(c)-(e).

<sup>104</sup> MPEP § 609.04(b)(IV).

<sup>105</sup> 37 C.F.R. §§ 1.97(c)-(e); MPEP § 609.04(b)(IV).

<sup>106</sup> See MPEP § 609.04(b)(IV).

<sup>107</sup> 37 C.F.R. § 1.97(e).

<sup>108</sup> *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F.3d 1276, 1291 (Fed. Cir. 2011) (en banc).

<sup>109</sup> See *id.*

court's opinion, to conclude that Baker is cumulative, and because no contemporaneous evidence (e.g., notes, records, files, etc.) was adduced at trial to show that Schumann actually analyzed Baker and arrived at such a conclusion.<sup>110</sup>

The “but-for” materiality standard is probably the best basis for explaining why a reference is not material.<sup>111</sup> However, another rationale for concluding that information is not material to patentability is that it is cumulative to information already of record.<sup>112</sup> However, caution is advised in concluding that references are cumulative. In *McKesson*, the Federal Circuit upheld the District Court's finding that the Baker reference was not cumulative because the examiner in a substantially similar case found the Baker reference to be material enough to cite in view of the same body of prior art.<sup>113</sup> While other references generally disclosed the “three node” communication element, the Baker reference disclosed it in much more detail.<sup>114</sup>

If a very large group of co-pending substantially similar cases are involved, a patent attorney will almost certainly have to exercise some judgment with respect to materiality so that cases can pass to issuance. This is because there is a delay, typically of at least a month between the time an application issue fee is paid, and the time the patent issues.<sup>115</sup> In very large groups of co-pending substantially similar cases, some new Office Action or piece of prior art is likely to be issued in the intervening period.

After allowance, if there is no basis for excluding information as immaterial, then appropriate measures must be taken so that the references will be considered.<sup>116</sup> This may include filing an IDS after the notice of allowance, which requires a fee and a statement that the information was only known about

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<sup>110</sup> *McKesson Info. Solutions, Inc. v. Bridge Med., Inc.*, 487 F.3d 897, 910 (Fed. Cir. 2007) (citations omitted).

<sup>111</sup> *See Therasense*, 649 F.3d at 1291.

<sup>112</sup> 37 C.F.R. § 1.56(b) (“Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application”); *see also* *Semiconductor Energy Lab. Co. v. Samsung Elecs. Co.*, 204 F.3d 1368, 1374 (Fed. Cir. 2000) (finding a reference not to be cumulative because it contained a more complete combination of the claimed elements than the references of record: “A withheld reference may be highly material when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references.”).

<sup>113</sup> *McKesson*, 487 F.3d at 908–10.

<sup>114</sup> *Id.* at 909.

<sup>115</sup> *Timing of the Notice of Allowance, Issue Fee Payment, and Patent Issuance*, PATENTLY-O (June 9, 2010, 3:53 PM), <http://www.patentlyo.com/patent/2010/06/timing-of-the-notice-of-allowance-issue-fee-payment-and-patent-issuance.html>.

<sup>116</sup> MPEP § 2001.04 (8th ed. Rev. 8, July 2010).

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for three months or less.<sup>117</sup> After allowance, if the material information has been known by a person under the duty of disclosure for more than three months, then an RCE must be filed in order to get the prior art considered in an IDS.<sup>118</sup> If the issue fee has already been paid, then a petition for withdrawal from issue and an RCE must be filed along with the IDS.<sup>119</sup> A paid issue fee can be credited to the application if a second allowance is obtained.<sup>120</sup>

Another obstacle frequently encountered by patent attorneys and agents is that examiners may resist adding review of foreign or domestic prosecution documents submitted in IDSs to their already burdensome workloads. Avoidance tactics can include pointing out errors in the citation form for publications under 37 C.F.R. § 1.98 (b)(5), which requires identification by publisher, author, title, relevant pages, date, and place of publication.<sup>121</sup> This is particularly true with respect to Office Actions, which some examiners may argue are not publications.<sup>122</sup> However, this is generally incorrect because most Office Actions are publicly available after eighteen months from the earliest priority date through the Patent Office's online PAIR database, and it is rare that an Office Action issues before its eighteen month publication date.<sup>123</sup> In addition, while applications under reexamination are limited to documents that are published,<sup>124</sup> standard examination is not.<sup>125</sup> Furthermore, it cannot be argued that an Office Action is not prior art as a reason for not considering it, because the duty of disclosure is not limited to prior art. MPEP § 609 states that:

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. There is no requirement that the information must be prior art references in order to be considered by the examiner.<sup>126</sup>

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<sup>117</sup> 37 C.F.R. § 1.97; MPEP § 609.01.

<sup>118</sup> 37 C.F.R. §§ 1.97, 1.114; MPEP § 609.01.

<sup>119</sup> 37 C.F.R. § 1.313; MPEP § 1308.

<sup>120</sup> MPEP §§ 1306, 1308.

<sup>121</sup> 37 C.F.R. § 1.98(b)(5). None of this is to say that examiners are not justified in refusing to consider submissions if they fail to comply with technical requirements or if copies of cited references are not submitted.

<sup>122</sup> *See id.*

<sup>123</sup> *See* 37 C.F.R. § 1.211.

<sup>124</sup> *Id.* §§ 1.501, 1.510; MPEP § 2210.

<sup>125</sup> The duty of disclosure includes "all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. § 1.56; MPEP § 2001.

<sup>126</sup> MPEP § 609.

MPEP § 609 further states that “[m]ultiple information disclosure statements may be filed in a single application, and they will be considered, provided each is in compliance with the appropriate requirements of 37 CFR 1.97 and 37 CFR 1.98.”<sup>127</sup>

In summary, the considerations and suggested precautions discussed in this Section II are to help guard a patent from being held unenforceable for inequitable conduct during an ensuing patent litigation. In addition, in the course of submitting all material documents during prosecution, those documents will be published on the front of the patent as evidence that they were considered by the Patent Office.<sup>128</sup> This will make it more difficult for a future potential infringer to use any of those documents as a basis to attack the validity of the patent for lack of novelty, obviousness, or double-patenting.<sup>129</sup>

### III. DEALING WITH A CLIENT’S OWN SIMILAR PRIOR ART

While Section II dealt with precautions for guarding a patent that is part of a portfolio of related applications or patents from attack after it issues; Section III discusses the related concern of dealing with rejections from the PTO prior to issuance, because of earlier filed applications or publications in the same portfolio that have become part of the prior art.

Portfolios of patent applications with similar subject matter often involve special issues concerning prior applications, patents, or publications that are owned by the same client, in that such prior art can become an obstacle to issuance of a patent. In this regard, the America Invents Act of 2011 (“AIA”) has made some substantial changes in how patent practitioners may handle rejections over their client’s own prior filings. Section A below discusses how such issues can be handled for patents and applications that are filed under the current law. Section B deals with applications filed on or after March 16, 2013 that are subject to the new provisions of the AIA.<sup>130</sup>

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<sup>127</sup> *Id.*

<sup>128</sup> *Id.* § 1302.12.

<sup>129</sup> Matthew C. Phillips & Kevin B. Laurence, *The Presumption of Validity After Reexamination or Reissue*, INTELLECTUAL PROPERTY TODAY, <http://www.iptoday.com/issues/2010/11/the-presumption-validity-after-reexamination-or-reissue.asp> (last visited Dec. 18, 2012) (“The fact that a reference has been considered by the PTO strengthens the presumption that the patent’s claims are valid over that reference. That is true whether the PTO’s consideration of the reference was during original prosecution, reexamination or reissue.”) (referencing *Sanofi-Synthelabo v. Apotex, Inc.*, 470 F.3d 1368, 1375 (Fed. Cir. 2006)).

<sup>130</sup> Applications subject to the applicable provisions of the AIA will be those filed on or after March 16, 2013. It should be noted that any continuing applications with priority dates prior

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### A. *Issues Associated with a Client's Own Prior Art Under Current Law*

#### 1. Inventorship

Naming inventors correctly is particularly important when working with large portfolios of similar subject matter.<sup>131</sup> If a prior art patent names the same inventors as in a pending case, then the patent is not prior art “by another” or “by others.”<sup>132</sup> The effect of this is that the prior art cannot be applied in a rejection under 35 U.S.C. §§ 102(a) or (e).<sup>133</sup> If a client’s application is rejected over their own similar prior art under §§ 102(a) or (e), and the prior art has a common inventor but does not name the same inventive entity, then, provided there is no deceptive intent involved, there may be an option to amend inventorship in the application such that the inventive entities are the same (thereby eliminating the reference as prior art).<sup>134</sup> In such cases, the claims of the application should be reviewed for correspondence with the inventors’ contributions. However, correcting inventorship should be explored only when it is appropriate to do so, because, although errors in inventorship are not typically a reason for invalidating a patent, a court might scrutinize inventorship in cases where a change in the named inventors was made to obtain some advantage.<sup>135</sup>

#### 2. Attribution

As mentioned in the previous section, when handling portfolios of applications or patents with similar subject matter, a common difficulty in prosecution is that the patent may be rejected under §§ 102(a) or (e) over a client’s

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to March 16, 2013 with all claims fully supported by the priority application will be treated under the pre-AIA law. Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3(n)(1), 125 Stat. 284, 293 (2011).

<sup>131</sup> See generally Rivka Monheit, *The Importance of Correct Inventorship*, 7 J. INTELL. PROP. L. 191 (1999) (discussing the importance of correct inventorship).

<sup>132</sup> 35 U.S.C. §§ 102(a), (e) (2006).

<sup>133</sup> *Id.* However, the prior art could still be available for a rejection under § 102(b) if it were after the one year grace period provided for in that section.

<sup>134</sup> *Id.* § 116; 37 C.F.R. § 1.48 (2011); MPEP § 201.03 (8th ed. Rev. 8, July 2010).

<sup>135</sup> See, e.g., *Checkpoint Sys., Inc. v. U.S. Int’l Trade Comm’n*, 54 F.3d 756, 763 (Fed. Cir. 1995) (upholding an International Trade Commission decision of invalidity due to incorrect inventorship: “We do not of course hold that a good faith error in a designation of inventorship renders a patent invalid. Absent deceptive intent in the misdesignation of inventors, an error may be corrected before or after issuance of a patent.”).

own similar prior art. One way to combat this is through the doctrine of attribution. MPEP § 716.10 provides as follows:

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute an activity, a reference or part of a reference to the applicant. If successful, the activity or the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application filed jointly by S and another, is claimed in a later application filed by S, the joint patent or joint patent application publication is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by ... an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent or published application.<sup>136</sup>

This provision distinguishes between originators of subject matter in the claims of a reference, that is, the named inventors, and originators of disclosed subject matter that may have originated from others in addition to the named inventors.<sup>137</sup> For example, if an inventor, S, is named in a reference along with another inventor, A, and a later application lists S as the sole inventor, then it may be appropriate to file a declaration that S was the sole inventor of the subject matter of the reference cited against the new application.<sup>138</sup> The underlying assumption in the MPEP is that the pending subject matter was disclosed, but not claimed, in the prior art.<sup>139</sup> The MPEP does not make clear whether attribution would be permissible if part of the subject matter that S solely originated was also reflected in the claims of a prior patent application.<sup>140</sup>

The MPEP provides further explanation by way of examples:

Example 1

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1-year time requirement of 35 U.S.C. 102(b).

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<sup>136</sup> MPEP § 716.10; *see also id.* § 715.01(a) (briefly mentioning affidavit practice to show that “subject matter relied on in the patent or application publication was the invention of the applicant”); *Id.* § 715.01(c) (discussing in less detail an approach for attribution of a publication or portion of a publication which names the inventor as a co-author).

<sup>137</sup> *Id.* § 716.10.

<sup>138</sup> *See id.*

<sup>139</sup> *Id.*

<sup>140</sup> An example situation that might produce this set of facts is a publication or application that is directed to a combination of a chemical composition with a mechanical application. S contributes to the chemical portion of the invention and A contributes to the mechanical portion of the invention. Later, the client wants to file an application on the same or similar chemical composition developed by S apart from the mechanical invention of A.

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### Example 2

Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).<sup>141</sup>

Example 1 presents a standard situation where the examiner finds an anticipating reference by the same inventive entity, but the reference cannot be used as a basis for rejection because the reference does not meet the bar under 35 U.S.C. § 102(b) and cannot be cited under §§ 102(a) or (e) as prior art “by another” or “by others.”<sup>142</sup>

Under Example 2, the anticipating reference is a valid reference under §§ 102(a) or (e) because a different inventive entity is listed on the reference. In such cases, the MPEP states:

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the *relevant portions* of the reference originated with or were obtained from the applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.<sup>143</sup>

The foregoing examples seem to open possibilities for broader application to situations where a later application includes an inventor who is not listed as an inventor or author of the reference.<sup>144</sup> In light of this, a prosecuting attorney might want to consider whether attribution is appropriate in the following scenarios:

### a. $AB \rightarrow AC$

In the first scenario A and B are listed as the authors or inventors of the reference, and A and C are named as the inventors on the rejected application. In this case, A and C could declare that they were the inventors or originators of the portion of the reference that was cited against the application. The only difference between this scenario and the example set forth in the MPEP is that the declaration would involve swearing that the portion of the reference cited against the claims originated with either A or C, instead of A alone.

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<sup>141</sup> MPEP § 716.10; *see also In re Katz*, 687 F.2d 450, 455 (C.C.P.A. 1982).

<sup>142</sup> MPEP § 716.10.

<sup>143</sup> *Id.* (emphasis added).

<sup>144</sup> *See id.*

*b. A → AB*

In another scenario, A is the sole author or inventor of the prior art reference, and both A and B are named inventors of the rejected application. In this case, as in the first scenario, the applicant would swear that the portion of the reference cited against the application originated with either A or B.<sup>145</sup>

*c. AB → C*

In the final scenario, A and B are the authors or inventors of the prior art reference, and C is the sole inventor named on the rejected application. This scenario also represents any case where there is no common inventor. Following the example set forth in *In re Katz*,<sup>146</sup> C could technically declare that he was the sole inventor of the portion of the reference cited against the rejected application, which directly opposes the notion that “by another” means the exact same inventive entity.<sup>147</sup> Applicable case law suggests this possibility, but additional evidence may be required beyond submission of the attribution declaration.<sup>148</sup> Courts have yet to address this question.

### 3. Derivation

Another possible way to combat § 102(e) rejections based on a client’s own similar prior art is by showing that the subject matter of the cited reference was derived from the inventor named on the application. The MPEP mentions derivation in § 715.01(c), but the topic is primarily addressed in § 2136.05 with respect to § 102(e) rejections only.<sup>149</sup> The section describes several Court of Customs and Patent Appeals (“CCPA”)<sup>150</sup> cases that involve a situation where the reference’s named inventor purportedly derived the cited portion of the disclosure from the inventor of the rejected application.<sup>151</sup> Other cited cases seem

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<sup>145</sup> Others have concluded that the MPEP does not address this situation. Nelson R. Capes & Rebecca D. Hess, *Different Inventive Entities Under 35 U.S.C. § 102(e) and Affidavit Practice Under 37 C.F.R. § 1.132*, 81 J. PAT. & TRADEMARK OFF. SOC’Y 33, 38 (1999).

<sup>146</sup> 687 F.2d 450 (C.C.P.A. 1982).

<sup>147</sup> *Id.* at 455.

<sup>148</sup> See Capes & Hess, *supra* note 145, at 35–37.

<sup>149</sup> MPEP §§ 715.01(c), 2136.05.

<sup>150</sup> A predecessor court of the Court of Appeals for the Federal Circuit.

<sup>151</sup> *In re DeBaun*, 687 F.2d 459, 460 (C.C.P.A. 1982); *In re Whittle*, 454 F.2d 1193, 1194–95 (C.C.P.A. 1972); *In re Mathews*, 408 F.2d 1393, 1395 (C.C.P.A. 1969); *In re Land*, 368 F.2d



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to require a showing by the applicant that he first invented the subject matter not only before the § 102(e) date of the reference, but also before the inventor named on the § 102(e) reference derived the invention from the inventor, and also, that the showing be made with particularity and corroboration.<sup>152</sup> Other cited cases indicate that such a showing is not required, but rather, that a totality of evidence must show that the reference's disclosure was actually derived from the inventor.<sup>153</sup>

In *In re Mathews*,<sup>154</sup> Dewey and Mathews were co-workers at General Electric Company.<sup>155</sup> Dewey had an earlier filed patent that Mathews' later filed application was being rejected over.<sup>156</sup> The Dewey patent anticipated the Mathews application's claims.<sup>157</sup> Dewey submitted an affidavit stating that he was not the inventor of the subject matter disclosed (but not claimed) in his patent that was relevant to the Mathews application.<sup>158</sup> The Court stated that "the Dewey patent ... is prima facie evidence that Mathews was not the first inventor. But here, ... there is further evidence, uncontroverted by the Patent Office, that Mathews was not only the first inventor but also the only inventor, so far as the record shows."<sup>159</sup> The court held that:

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866, 810 (C.C.P.A. 1966); see also *In re Carreira*, 532 F.2d 1356, 1357–58 (C.C.P.A. 1976) (discussing differences between prior disclosure of a genus and species).

<sup>152</sup> *In re Whittle*, 454 F.2d at 1195 (citing *Egnot v. Looker*, 387 F.2d 680 (C.C.P.A. 1967); *Driggs v. Clark*, 140 F.2d 994 (C.C.P.A. 1944); *O'Donnell v. Hartt*, 75 F.2d 195 (C.C.P.A. 1935)) (The applicant, Whittle, failed to show that his prior disclosure to Claxton, the inventor named on the previously-filed application Whittle was being rejected over, was derived from him because he did not show with particularity that he was in possession of the "critical features" of the invention prior to the alleged disclosure, or that his disclosure to Claxton included these "critical features").

<sup>153</sup> *In re DeBaun*, 687 F.2d at 463 (An inventor's declaration by DeBaun stated that he was the inventor of the subject matter disclosed in the U.S. patent reference of DeBaun and Noll. Exhibits were attached to the declaration showing conception and included drawings DeBaun had prepared and given to counsel for purposes of preparing the application that issued as the reference patent. While this evidence was not sufficient to antedate the prior art patent under 37 C.F.R. § 1.131 because diligence and/or reduction to practice was not shown, this was not required to show that DeBaun was the sole inventor of the subject matter. The inventor's statement that he conceived the invention first was enough to overcome the 35 U.S.C. § 102(e) rejection.).

<sup>154</sup> 408 F.2d 1393 (C.C.P.A. 1969).

<sup>155</sup> *Id.* at 1394.

<sup>156</sup> *Id.*

<sup>157</sup> *Id.*

<sup>158</sup> *Id.*

<sup>159</sup> *Id.* at 1396.

a rejection under 35 U.S.C. 102(e) may be overcome by [an affidavit under 37 CFR 1.132] of the reference patentee averring that the relevant, unclaimed subject matter disclosed in his patent was not invented by the patentee but was first disclosed to him by the appellant, particularly in light of certain acknowledgments in the patent and in the instant application.<sup>160</sup>

An example illustrating the rigidity of one court's approach is *In re Land*.<sup>161</sup> In *In re Land*, two references were cited in a rejection against an application naming Rogers and Land as inventors.<sup>162</sup> The references were a patent listing Rogers as the sole inventor, and a patent listing Land as the sole inventor, which were cited under 35 U.S.C. §§ 102(e) and 103.<sup>163</sup> The patents were owned by the same company, and the inventors worked in the same laboratory.<sup>164</sup> The patents and patent application contained cross-references to each other.<sup>165</sup> The court affirmed the rejection because: (1) the inventive entities of the patents (one to Rogers and one to Land) were different from the inventive entity of the joint application (Rogers and Land); and (2) Land and Rogers brought their knowledge of their individual work with them when they made the joint invention.<sup>166</sup> There was no evidence that the parts of the references relied on in the rejection were disclosures of anything the inventors did jointly.<sup>167</sup> There was also no evidence that their joint action was done before the filing of the reference patents.<sup>168</sup>

In this case, neither Rogers nor Land derived anything from the other, so derivation was not available.<sup>169</sup> In addition, they could not attribute the earlier disclosure to their joint effort.<sup>170</sup> Thus the rejection over their own prior art was upheld, even though it was not a § 102(b) statutory bar.<sup>171</sup> This case stands for the proposition that the inventive entity must be exactly the same to rely on the maxim that the prior activity was not “by another.”<sup>172</sup> Presumably, however, if Rogers and Land could have declared that the disclosure in their prior patents

<sup>160</sup> *In re Mathews*, 408 F.2d at 1393–94.

<sup>161</sup> 368 F.2d 866 (C.C.P.A. 1966) (discussed in MPEP § 2136.05 (8th ed. Rev. 8, July 2010)).

<sup>162</sup> *Id.* at 868.

<sup>163</sup> *Id.*

<sup>164</sup> *Id.* at 878.

<sup>165</sup> *Id.*

<sup>166</sup> *Id.* at 879.

<sup>167</sup> *In re Land*, 368 F.2d at 881.

<sup>168</sup> *Id.*

<sup>169</sup> *Id.* at 879–81.

<sup>170</sup> *Id.* at 881.

<sup>171</sup> *Id.* at 884.

<sup>172</sup> *See id.*

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was from their joint efforts, or if they could have sworn behind the filing date of the reference patents, then the joint patent to Rogers and Land could have avoided the references.<sup>173</sup>

A more recent Federal Circuit case, not addressed in the MPEP, is *Riverwood Int'l Corp. v. R.A. Jones & Co.*<sup>174</sup> In *Riverwood*, the validity of patents to Ziegler and to Ziegler, Olson, and Lovold was in question over an earlier patent to Ziegler, Lashyro, and Vulgamore.<sup>175</sup> The Court held that, despite the earlier patent being to a different inventive entity:

the district court must look beyond the superficial fact that the references were issued to different inventive entities. What is significant is not merely the differences in the listed inventors, but whether the portions of the reference relied on as prior art, and the subject matter of the claims in question, represent the work of a common inventive entity.<sup>176</sup>

According to one commentator, these issues will not be encountered often, particularly in view of the 1999 amendment to 35 U.S.C. § 103(c) (discussed in the next section).<sup>177</sup> This may also explain the dearth of case law on this subject.<sup>178</sup>

A question arises as to why the derivation doctrine does not apply to § 102(a) rejections as well. Presumably, this is because of the origin of § 102(e), which was a codification of the 1926 Supreme Court decision in *Alexander Milburn Co. v. Davis-Bournonville Co.*<sup>179</sup> In *Milburn*, the validity of a patent to Whitford was in question over an earlier-filed patent granted to Clifford, which disclosed but did not claim the invention claimed in the Whitford patent.<sup>180</sup> The Supreme Court noted the absence of “evidence carrying Whitford’s invention further back” than his filing date, and held that the existence of Clifford’s earlier filed United States application indicated that Whitford was not the first inventor.<sup>181</sup> It is clear from the legislative history that the “Milburn Rule” was the origin of § 102(e).<sup>182</sup> Since § 102(a) has no such origin, i.e., case law that notes a possible exception if there is evidence carrying the inven-

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<sup>173</sup> See *In re Land*, 368 F.2d at 884.

<sup>174</sup> 324 F.3d 1346 (Fed. Cir. 2003); see also ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT 130 n. 148 (9th ed. 2009).

<sup>175</sup> *Riverwood Int'l Corp.*, 324 F.3d at 1350-51.

<sup>176</sup> *Id.* at 1356.

<sup>177</sup> HARMON, *supra* note 174.

<sup>178</sup> See *id.*

<sup>179</sup> 270 U.S. 390 (1926).

<sup>180</sup> *Id.* at 390.

<sup>181</sup> *Id.* at 399.

<sup>182</sup> See *In re Mathews*, 408 F.2d 1393, 1395-96 (C.C.P.A. 1969).

tion further back from the disclosure, derivation has not traditionally been applicable to avoiding rejections under § 102(a).<sup>183</sup>

#### 4. 35 U.S.C. § 103(c)

While changing inventorship and submitting declarations for attribution may be necessary in some cases, for many obviousness rejections, namely, obviousness rejections based on prior art under §§ 102(e), (f), and (g), a patent prosecutor may rely on § 103(c), which prevents an examiner from citing a co-owned reference against the applicant as the basis for an obviousness rejection. In pertinent part, § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.<sup>184</sup>

If the prior art also qualifies under § 102(a), then attribution and changing inventorship may remain as options. However, in a situation where a client's own prior art is asserted in an obviousness rejection under both § 102(a) and § 102(e), a problem arises if the applicant can swear behind the § 102(a) date but not the § 102(e) date. In such cases, the applicant cannot rely on § 103(c) to overcome the reference asserted under § 102(e) because the reference does not qualify under §§ 102(e), (f), and (g) *only*, which is what is required by § 103(c).<sup>185</sup>

#### 5. Situations Where a Parent is Cited Against its CIP

Another difficulty that can arise is where an examiner cites a parent case against its CIP application in an anticipation rejection. In this situation the applicant may argue in some cases that the CIP claims are entitled to the priority date of the parent, because the parent provides support for the CIP's claims in its written description.<sup>186</sup> This argument essentially attempts to eliminate the parent

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<sup>183</sup> In addition, § 102(a) requires a public disclosure, whereas in § 102(e) the disclosure is only made to the patent office.

<sup>184</sup> 35 U.S.C. § 103(c) (2006).

<sup>185</sup> *Id.*

<sup>186</sup> MPEP § 201.08 (8th ed. Rev. 8, July 2010) ("an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional appli-

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as prior art. However, it is not appropriate ipso facto in all situations, because the test for written description under 35 U.S.C. § 112 is not the same as the test for anticipation under § 102.<sup>187</sup> The scope of the claim and the earlier filed specification will determine whether such an argument is appropriate. For example, if a parent reference includes certain data points, then the data points might anticipate a later claimed range but might not provide an enabling written description for that range.<sup>188</sup>

### 6. Late Claim for Priority/Continuation

In the situation where an examiner rejects an application over the client's own prior art reference with a common inventor, an option may be to make a late claim for priority. If priority is claimed, then the application may be designated as a CIP of the cited reference and the applicant can make the written description argument discussed above.<sup>189</sup> However, a late claim for priority carries a large fee and requires a declaration that the entire delay was unintentional.<sup>190</sup> Thus, this option has limited practicality.

If the cited reference is still pending and its disclosure supports the claims, another option may be to file a continuation or CIP of the cited reference with the claims of the separately filed rejected application.

### 7. Avoid Arguing Against One's Own Prior Art

When prosecuting applications in a portfolio of related subject matter, a particularly difficult situation is presented when there is the option to argue for patentability against a client's own co-pending application or issued patent. Ultimately, a patent prosecutor should take all reasonable measures to avoid arguing against a client's own prior art. Seeking a way to remove the reference

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cation if the alleged continuation-in-part application complies with the other requirements of 35 U.S.C. 120 and 37 CFR 1.78 . . .").

<sup>187</sup> Compare 35 U.S.C. § 112 (requiring that the description "enable any person skilled in the art to which it pertains . . . to make and use the same), with MPEP § 2131 (discussing 35 U.S.C. § 102: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.") (citing *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

<sup>188</sup> See MPEP § 2163.05(III) (discussing written description support for range limitations).

<sup>189</sup> See *Patentee has no "Presumption of Priority" Unless Specifically Adjudged by the PTO During Prosecution*, PATENTLY-O (Apr. 14, 2008, 3:03AM), <http://www.patentlyo.com/patent/2008/04/patentee-has-no.html>.

<sup>190</sup> 37 C.F.R. § 1.78(a)(3) (2011).

as prior art is preferable, either through the provisions of § 103(c), attribution, or swearing behind the reference under 37 C.F.R. § 131.<sup>191</sup> If these options are not available, care should be taken to limit characterizations and avoid disparagement of the reference. In some cases, of course, making distinctions over the client's own prior art is unavoidable.

***B. Issues Associated with a Client's Own Prior Art Under the AIA***

When the AIA goes into full effect and § 102 is amended on March 16, 2013, several of the situations mentioned in section A above will require different treatment. New §§ 102(a) and (b) recite:

(a) NOVELTY; PRIOR ART.-- A person shall be entitled to a patent unless--

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

(b) EXCEPTIONS.--

(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.-- A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if--

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.-- A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if--

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

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<sup>191</sup> See 35 U.S.C. § 103(c); 37 C.F.R. § 1.131; *supra* Section III(A)(2).

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(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.<sup>192</sup>

The new law appears to simplify some of the issues discussed above where a client's own prior art is used against them.<sup>193</sup> Particularly in § 102(e)-type situations, i.e., where an application or patent is filed before the application date of a client's application, but published after the filing date.<sup>194</sup> However, the text of the new law leaves some open questions and some potentially difficult determinations of fact that will have to be made when dealing with § 102(a)-type situations, i.e., where the client-owned reference (patent or non-patent) is published in the year prior to the client's new application date. This Article will now explore a few of these issues in more detail.

### 1. Attribution-Type Situations

Consider under the AIA, the instances discussed above where attribution would be an option for dealing with the client's own similar prior art:

#### *a. AB → AC*

In this situation, recall that A and B are listed as the authors or inventors of the reference, and A and C are named as the inventors on the rejected application. In this case, the reference would be prior art under § 102(a)(1) if it were a publication (patent or non-patent) published before the filing date of A and C's application; or it would be prior art under § 102(a)(2) if it were a patent or application published after A and C's filing date with an effective filing date prior to the filing of A and C's application.<sup>195</sup> However, new § 102 provides several exceptions that can remove this reference from being considered prior art.<sup>196</sup>

In the case of the reference being a publication that is published prior to A and C's filing date, so long as it is within one year of the filing date, it would

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<sup>192</sup> Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 3(b), 125 Stat. 284, 285–86 (2011).

<sup>193</sup> *See id.*

<sup>194</sup> *See id.*

<sup>195</sup> *Id.* §§ 102(a)(1)–(a)(2).

<sup>196</sup> *Id.* § 102(b).

ostensibly fall under the exception of § 102(b)(1)(A) because a joint inventor A made the disclosure.<sup>197</sup> However, the effect of there being a second author on the publication is unclear from the text of the AIA. Whether the term “subject matter disclosed” refers to the entire subject matter disclosed in the publication or only the subject matter that is being cited against the claims of the application is not clear.<sup>198</sup> Presumably, if inventorship was done properly, then any disclosure from A and B that is relevant to the claims of A and C’s application would be based on A’s contribution to the publication. But how this gets sorted out by the PTO or the courts is not immediately clear. Perhaps the PTO will require an affidavit by A stating that his contribution to the reference publication was the subject matter that is relevant to the claims; a process similar to the current attribution process.<sup>199</sup>

In the case of the reference being a patent or patent application that was published after the filing date of A and C’s application, but filed before it, it will be excepted from being prior art under § 102(b)(2)(C).<sup>200</sup> This is because the application would be owned or under obligation of assignment to the same client at the time of filing.<sup>201</sup> Thus, the AIA appears to simplify this second situation.

*b. A → AB*

In this situation, A is the sole author or inventor of the prior art reference, and both A and B are named inventors of the rejected application. In this case, whether the reference is an application pre-dating the filing date of A and B’s application, or a publication published within a year prior to A and B’s filing date, the reference should be excepted from being prior art under either § 102(b)(1)(A) or § 102(B)(2)(C).<sup>202</sup> There is no complicating issue in this instance with the second author of the publication. Thus, the AIA also simplifies this situation.

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<sup>197</sup> *Id.* § 102(b)(1)(A).

<sup>198</sup> *See* Leahy-Smith America Invents Act § 102(b)(1)(A).

<sup>199</sup> *See* MPEP § 716.10 (8th ed. Rev. 8, July 2010).

<sup>200</sup> Leahy-Smith America Invents Act § 102(b)(2)(C).

<sup>201</sup> *See id.*

<sup>202</sup> *Id.* §§ 102(b)(1)(A), 102(B)(2)(C).



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### c. $AB \rightarrow C$

In this situation, A and B are the authors or inventors of the prior art reference, and C is the sole inventor named on the rejected application. In this case, A and B's reference application or publication would be prior art under § 102(a)(1) or § 102(a)(2).<sup>203</sup>

If A and B's reference was a publication (patent or non-patent) within one year of C's filing date, then the only way C can overcome it is to show either: (1) that A and B "obtained the subject matter disclosed directly or indirectly from" C under § 102(b)(1)(A);<sup>204</sup> or (2) that C had made a prior public disclosure that predated A and B's disclosure under § 102(b)(1)(B).<sup>205</sup>

Again in the case of A and B's disclosure being a patent application or patent filed but not published prior to the filing of C's application, then all that would need to be shown is that the applications were co-owned or subject to an obligation of co-ownership to the same client at the time of filing. This would exempt A and B's application from being considered prior art under § 102(b)(2)(C).<sup>206</sup>

In summary, the AIA greatly simplifies the § 102(e)-type situations for clients that have similar subject matter. The identity of the inventors in this situation no longer matters. All that is important is that the applications are commonly owned or subject to an obligation of assignment at the time of filing.<sup>207</sup> There are, however, still some complicated fact issues and obscurities in the § 102(a)-type situations.

## 2. Derivation Proceedings

The AIA's changes to derivation proceedings will also affect dealing with a client's own similar prior art when prosecuting patent portfolios of related subject matter. The AIA provides for a derivation proceeding in which the true inventor can institute a proceeding to show that a prior filed application by another was derived from information obtained from the true inventor.<sup>208</sup> This is unlike the derivation discussed in the current MPEP and would not present an

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<sup>203</sup> *Id.* §§ 102(a)(1)–(a)(2).

<sup>204</sup> *Id.* § 102(b)(1)(A).

<sup>205</sup> *Id.* § 102(b)(1)(B).

<sup>206</sup> Leahy-Smith America Invents Act § 102(b)(2)(C).

<sup>207</sup> *Id.* § 102(b)(2)(C).

<sup>208</sup> *Id.* § 102(b).

issue with applications owned by the same client because of the AIA's revisions to § 102.<sup>209</sup>

### 3. Public Use or Commercial Sale or Offer for Sale

Public use and commercial sales are often events that occur from a client's own activities. This can be especially complicated where there are follow-on applications that have closely related subject matter to an initial filing. If a client made a first application filing prior to their public use or commercial sale, later filings on related subject matter need to take into account the prior art status of the public use or commercial sale.

Whereas, under the AIA's revisions to § 102, there are several exceptions for "disclosures" that occur one year prior to the filing of an application, there is no one year grace period for public use or commercial sales that are not "disclosures." While it is possible that a court may later conclude that such activity falls under the meaning of "disclosure," this is not clear or even intuitive from the text of the new law.<sup>210</sup> Until the Federal Circuit rules on this or the law is revised, it should be considered to be a difference between the old law and the new law. Thus, care should be taken in considering whether a similar but related application is barred by an earlier public use or commercial sale, even if the application is filed within one year of such event.

### 4. 35 U.S.C. § 103(c) and New § 102

Additionally, the AIA's changes to § 103(c) might affect the prosecution of patent portfolios of related subject matter.<sup>211</sup> Section 103(c) will be repealed sub silentio by a new section that does not include the previous provisions of § 103(c) that did not allow co-owned prior art under § 102(e) to be applied for obviousness purposes.<sup>212</sup> However, new § 102, as discussed above, effectively expands the § 103(c) type practice to exclude commonly owned applications that were filed, but not published, prior to the filing date of the subject application, not just for obviousness purposes, but also for novelty purposes.<sup>213</sup>

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<sup>209</sup> *Id.* § 102(b); see MPEP § 2137 (8th ed. Rev. 8, July 2010).

<sup>210</sup> See Leahy-Smith America Invents Act § 102(b).

<sup>211</sup> *Id.* § 103.

<sup>212</sup> *Id.*

<sup>213</sup> *Id.* § 102(b).

## 5. Previous Practice with Continuing Viability

The practices for dealing with a client's similar prior art mentioned in Sections III.A.1, 5, 6, and 7 above, should continue to be viable even after the AIA is fully implemented.

### IV. DRAFTING AND FILING STRATEGIES

Parts II and III of this article discussed difficulties that can arise when prosecuting a patent that is part of a portfolio of applications and patents with related subject matter. This section will suggest some additional filing and drafting strategies that can be employed to avoid these difficulties.

#### A. *Consider Drafting Claims More Narrowly If There is Ongoing Research*

If there is ongoing research in the subject matter area and additional invention disclosures in the same area are likely, then a patent prosecutor should consider a narrower disclosure to prevent prior art problems for later applications. On the other hand, a broad disclosure may provide means for obtaining priority for new claims, if other aspects of the invention later become important. A suggested approach that seeks middle ground is to survey ongoing projects and take care not to disclose information about projects for which future filings are likely, but otherwise to disclose as broadly as normal practice dictates.<sup>214</sup>

#### B. *Consider Using CIPs*

Another option is to use one or more CIPs in the portfolio. While CIPs shorten the patent term and are typically avoided, they may provide some added value in cases that claim similar subject matter for a few reasons.<sup>215</sup> First, filing a CIP based on an earlier case with a broad disclosure allows the applicant to keep options open for new claims that the original filing supports and that new research shows to have promise.<sup>216</sup> The CIP can claim new subject matter as well.<sup>217</sup> For example, certain properties may have greater significance than originally thought. If there is support for claims specifying a range of values for the

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<sup>214</sup> One must also be careful to comply with the best mode requirement of 35 U.S.C. § 112.

<sup>215</sup> See MPEP § 2133.01 (8th ed. Rev. 8, July 2010).

<sup>216</sup> See *id.* § 201.08.

<sup>217</sup> *Id.*

properties in examples and elsewhere, then an applicant has the option of filing new claims directed to the subject matter and getting priority back to the original filing date.<sup>218</sup> Second, a CIP is more likely to be assigned to the same examiner than a new filing.<sup>219</sup> The examiner's familiarity with the case and subject matter should facilitate prosecution, and it can be helpful to continue a dialogue with the examiner. Finally, if it becomes apparent that the CIP priority claim is not going to provide any benefit, then the priority claim can be deleted during prosecution to preserve the patent term.<sup>220</sup>

### *C. Reuse Relevant Portions of Previous Specifications with Caution*

In the course of prosecuting large portfolios having similar subject matter, efforts to be efficient result in relevant portions of prior specifications being reused when drafting similar new applications. However, care should be taken to appropriately eliminate words such as “preferably” and similar language that may teach away from the true best mode. What was preferable for an earlier application may no longer be preferable in a later application.

Claim terms also should be varied to avoid infectious prosecution history estoppel. In *Jonsson v. Stanley Works*,<sup>221</sup> the Federal Circuit set forth the rule that the prosecution history of a parent application and the construction of a claim term in that application is relevant to an understanding of how that term is used in a child patent.<sup>222</sup> The Federal Circuit later explicitly stated the converse rule that “[c]laims in a child case that do not recite the amended term [from the parent case] are not subject to an estoppel.”<sup>223</sup> Thus, it is advisable to vary claim terms in order to avoid prosecution history estoppel from earlier cases.<sup>224</sup>

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<sup>218</sup> *Id.*

<sup>219</sup> Deepak Hegde et al., *Pioneers, Submariners, or Thicket-Builders: Which Firms Use Continuations in Patenting?* 6 n.3 (Nat'l Bureau of Econ. Research, Working Paper No. 13153, 2007), available at <http://www.nber.org/papers/w13153.pdf> (referencing a personal communication).

<sup>220</sup> The MPEP states that “[a]s a result of the 20-year patent term, it is expected, in certain circumstances, that applicants may cancel their claim to priority by amending the specification or submitting a new application data sheet.” MPEP § 201.11(III)(G).

<sup>221</sup> 903 F.2d 812 (Fed. Cir. 1990).

<sup>222</sup> *Id.* at 818 (“the prosecution history of the '251 patent [(the parent application)] and the construction of the term “diffuse light” contained in that patent, is relevant to an understanding of “diffuse light” as that term is used in the '912 patent [(the child application)]”).

<sup>223</sup> *Glaxo Wellcome, Inc. v. Impax Labs., Inc.*, 356 F.3d 1348, 1356 (Fed. Cir. 2004) (citing *Fiskars, Inc. v. Hunt Mfg. Co.*, –23 (Fed. Cir. 2000)).

<sup>224</sup> *See id.*

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**V. CONCLUSION**

In light of recent case law and the forthcoming changes to the patent laws under the AIA, patent owners and practitioners should exercise caution in handling portfolios of applications and patents with related subject matter. There are special considerations with the duty of disclosure that arise in portfolios of closely related subject matter. There are also unique prosecution issues that arise. The newly enacted AIA simplifies some of these issues but further complicates and provokes uncertainty with others.