

# “CIP’S ARE USELESS”

BY LOUIS J. HOFFMAN

HOFFMAN PATENT FIRM

PHOENIX, ARIZONA

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## I. REFRESHER ON PRIORITY

### A. WHEN IN DOUBT, START WITH THE STATUTE

Section 120 of the Patent Act lists (a) the *prerequisites* for priority, and (b) the *consequences* of priority:

“An application for patent for **an invention** disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States [or a PCT application], which is filed by an inventor or inventors named in the previously filed application **shall have the same effect, as to such invention, as though filed on the date of the prior application,** if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.”

✓ Section 119 contains parallel requirements for foreign or provisional applications. *See also, e.g., In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989) (foreign); *New Railhead Mfg’g LLC v. Vermeer Mfg’g Co.*, 298 F.3d 1290 (Fed. Cir. 2000) (provisional). Section 121 contains parallel requirements for divisional applications.

## B. PREREQUISITES FOR PRIORITY

✓ Section 120 thus contains three (now four) “mechanical” requirements ...

- (1) Copendency between sequential applications – filed before abandoning or patenting
- (2) Common inventorship – at least one person in common; *see In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995)
- (3) Specific reference to parent application – *see* 37 CFR §1.78, which interprets the “specific reference” requirement:
  - a) Serial number: *e.g.*, “Serial No. 12/345,678”

*Note that Rule 78 specifies series code, but no known case denies priority for failure to include series code.*

- b) Filing date: *e.g.*, “January 1, 2005”
  - c) Relationship: *e.g.*, “is a continuation-in-part”
- (4) [*For applications filed on or after 11/29/2000:*] Timely filing of specific reference. *See* Section 120 (second through fourth sentences); 37 CFR §1.78 (essentially must be filed during pendency; stiff fees if filed after original application date)

... and one “substantive” requirement,

- (5) Section 112(1) disclosure of the invention in the parent

### C. THE SUBSTANTIVE REQUIREMENT FOR PRIORITY

Section 120 ensures that the earlier application affords priority *only* for:

“...an invention disclosed in the manner provided by the first paragraph of section 112 of this title ...”

- ✓ Section 112(1) lists three requirements of disclosure:
  - (1) “The specification shall contain a written description of the invention, and of the manner and process of making and using it ...”
  - (2) “... in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same ...”
  - (3) “... and shall set forth the best mode contemplated by the inventor of carrying out his invention.”
  
- ✓ The policy behind the substantive priority requirement ensures that an inventor will be given priority to a prior application if and only if:
  - (a) the claimed invention was made before the filing date, and
  - (b) the claimed invention was disclosed in the prior application

#### D. “THE INVENTION” THAT IS MEASURED FOR PRIORITY

Note the references, in both Section 120 and Section 112(1) to “an invention.”

- ✓ The term “invention” is one often disputed. What is its meaning, in context, here?
  
- ✓ The Patent Act contains a definition: “When used in this title unless the context otherwise indicates, [t]he term ‘invention’ means invention or discovery.” 35 U.S.C. §100(a). This is circular, ambiguous, and unhelpful.
  
- ✓ Better is to look at the second paragraph of Section 112(2): “The specification shall conclude with one or more **claims** particularly pointing out and distinctly claiming the subject matter which the applicant regards as his **invention.**”

E. CONSEQUENCES OF SATISFYING SECTION 120

- ✓ If all five conditions are met, priority is granted, meaning: the new application “shall have the same effect, as to such invention, as though filed on the date of the prior application.”
  
- ✓ So, the term “invention” in Section 120 is defined by a claim, read as a whole, and priority is granted if all conditions are satisfied *as to that claim*. See, e.g., *Waldemar Link GmbH v. Osteonics Corp.*, 32 F.3d 556, 559 (Fed. Cir. 1994) (“when a priority date dispute arises, the trial court must examine closely the prosecution history to discover the priority date for each claim at issue”) (emphasis added); *Lemelson v. TRW. Inc.*, 760 F.2d 1254, 1267 (Fed. Cir. 1985) (in determining priority, on remand, “the scope of each individual claim must be examined on its merits, apart from that of other claims, even in the same patent”) (emphasis added).
  
- ✓ Priority can be granted recursively, provided that all later applications refer to sufficient prior applications to create a chain of overlapping pendency (*i.e.*, it can’t just refer to the immediately previous application). E.g., *Hovlid v. Asari*, 305 F.2d 747, 750-52 (9<sup>th</sup> Cir. 1962); *Sticker Industrial Corp. v. Blaw-Knox Co.*, 405 F.2d 90, 92 (7<sup>th</sup> Cir. 1968); *In re Henriksen*, 399 F.2d 253, 262 (CCPA 1968) (no limit on number of applications).

F. THE CONDITIONS SPECIFIED IN SECTION 120 ARE EXCLUSIVE

- ✓ In our view, §120 gives to any applicant for a patent *complying with its terms* the right to have the benefit of the filing date of an earlier application,” additional requirements should be ignored.

*Racing Strollers, Inc. v. TRI Industries, Inc.*, 878 F.2d 1418, 1420-21 (Fed. Cir. 1989) (*en banc*) (emphasis original).

- ✓ If “all statutory requirements for receiving the benefit of the filing date of the earlier application have been satisfied,” there is no “nonstatutory exception to the clear language of section 120.”

*In re Bauman*, 683 F.2d 405, 407 (C.C.P.A. 1982).

G. THE ADMINISTRATIVE DEFINITION OF “CIP”

- ✓ Section 120 nowhere mentions “continuation” or “continuation-in-part” status.
- ✓ “The PTO has noted that the expressions ‘continuation,’ ‘divisional,’ and ‘continuation-in-part’ are merely **terms used for administrative convenience.**” *Transco Products Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 556 (Fed. Cir. 1994).
- ✓ A neutral term used to describe an application without deciding whether it is a CIP or a CON is “**a continuing application.**” This term covers continuations and CIPs (and probably even DIVs).
- ✓ PTO’s administrative definition of CIP:

“A continuation-in-part is an application filed during the lifetime of an earlier nonprovisional application, **repeating** some substantial portion or all of the earlier application and *adding matter not disclosed* in the said [sic] earlier nonprovisional application.”

*See* MPEP 201.08 (italics original) (8<sup>th</sup> ed., Rev. 2).



- ✓ Contrast with administrative definition of a continuation:

“A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented.... The disclosure presented in the continuation must be the same as that of the original application, i.e., the continuation should not include anything which would constitute new matter if inserted in the original application.”

See MPEP 201.07.

- ✓ Note the troublesome phrase “... for the same invention ...” in the definition of continuation. Does this mean that the *claims* in a continuation must be the same? Clearly not:

“At any time before the patenting or abandonment of or termination of proceedings on his or her earlier nonprovisional application, an applicant may have recourse to filing a continuation in order to introduce into the application a new set of claims and to establish a right to further examination by the primary examiner.”

See MPEP 201.07; see also, e.g., *Kennecott Corp. v. Kyocera Int’l, Inc.*, 835 F.2d 1419, 1422 (Fed. Cir. 1987) (“an invention may be described in *different* ways and still be the *same* invention”) (emphasis added).

## H. NOT EVERY CHANGE MAKES A CIP

- ✓ “The specification and drawings of a continuation or divisional application filed under 37 CFR 1.53(b) are not limited to a reproduction or ‘true copy’ of the prior application, i.e., the applicant may revise the specification for clarity or contextual purposes *vis-à-vis* the specification originally filed in the prior application ... so long as it does not result in the introduction of new matter.”

*See* MPEP 201.06(c).

- ✓ “Amendments to an application which are supported in the original description are NOT new matter. Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible.”

*See* MPEP §2163.07(I) (emphasis original).

- ✓ Section 120 “does not require that the invention be described in the same way, or comply with section 112 in the same way, in both applications.”

*In re Kirchner*, 305 F.2d 897, 904 (C.C.P.A. 1962).

- ✓ “The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. When the original specification accomplishes that, *regardless of how it accomplishes it*, the essential goal of the description requirement is realized.”

*In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989) (emphasis added; citation omitted).

- ✓ To comply with the description requirement it is **not necessary** that the [parent] application describe the claimed invention *in ipsius verbis* [Latin for **“in the same words”**]; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had **possession of the subject matter later claimed** by him.

*In re Edwards*, 568 F.2d 1349, 1351-52 (C.C.P.A. 1978).

## I. THE DIFFERENCE BETWEEN “CIP STATUS” AND “PRIORITY”

A later application may qualify as a “continuation-in-part” of its parent, yet not be entitled to priority to the parent. Conversely, priority may be granted even in the absence of “CIP” status:

✓ *In re Clarke*, 97 U.S.P.Q. 165, 172 (Pat. Off. Bd. App. 1953):

“We agree with the examiner that ... the instant application cannot properly be called a continuation-in-part of application [X]. However, we do not consider that the particular name applied to the relationship between the two cases is important. It is the relationship which exists in fact that is controlling.”

Holding: Grants priority to parent even though application was not a “CIP” of parent.

✓ *In re Wiener*, 125 U.S.P.Q. 594 (Pat. Off. Sup. Exmr. 1958):

Denies “petition [for] a reversal of the examiner’s requirement for cancelation [sic] of the designation ‘continuation-in-part’ from the specification....” However, “this holding does not prejudice any rights applicant may have to the benefit of the earlier filing date for any invention

common to the two applications since such rights are in no way dependent on the *name* given to the applications.”

✓ *Transco Products Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 556 (Fed. Cir. 1994):

“[T]he bottom line is that, no matter what term is used to describe a continuing application, that application is entitled to the benefit of the filing date of an earlier application only as to common subject matter.”

✓ *Waldemar Link GmbH v. Osteonics Corp.*, 32 F.3d 556, 558-59 (Fed. Cir. 1994):

“A CIP application can be entitled to different priority dates for different claims.... The CIP application thus does not explicitly memorialize the filing date accorded particular claims”).

## II. REFRESHER ON PATENT TERM

- ✓ For any U.S. utility non-design application filed in the past ten years, the patent term ends (ignoring patent term adjustments):  
“20 years from the date on which the application for the patent was filed in the United States or, **if the application contains a specific reference** to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the **earlier** such application was filed.”

35 U.S.C. §154(a)(2) (eff. 5/29/2000); *see also* Pub. L. 103-465, §534 (eff. 6/8/95) (to similar effect).

- ✓ Note that the statute refers to “specific reference to an earlier filed application.” This is **only one of the five** requirements for priority.  
Lesson: Patent term expires 20 years from first referenced application, *regardless of whether the application supports priority* of all claims, some claims, or no claims.
- ✓ This does not apply to provisional applications or foreign priority applications, per 35 U.S.C. §154(a)(3):  
“Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.”

### III. IMPACT OF INTERVENING PRIOR ART

#### Section 102:

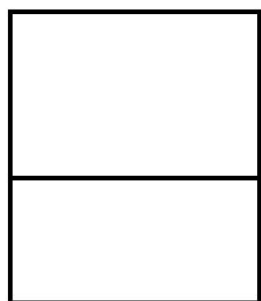
102(b): Bar if “the invention was **patented or described in a printed publication** in this in a foreign country or **in public use or on sale** in this country, more than one year prior to the date of the application for patent in the United States” [Emphasis added]

102(e): Bar if “the invention was described in ... an application for patent **by another** filed in the United States before the invention by the applicant for patent ...” [Emphasis added] *But see* 103(c) (exceptions for commonly assigned applications or joint research agreements)

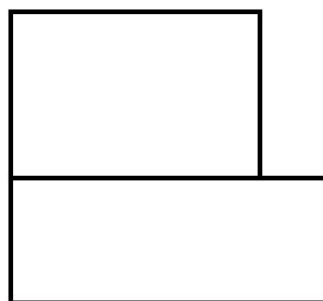
#### Discussion Cases:

- ✓ *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998)
- ✓ *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995)
- ✓ *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997) (re: nature of disclosure in parent needed to avoid intervening prior art – note particularly not sufficient that one “can” practice the later-claimed invention with the earlier disclosure, or that it would be known to an ordinary artisan)
- ✓ *Augustine Medical, Inc. v. Gaymar Industries, Inc.*, 181 F.3d 1291, 1302-03 (Fed. Cir. 1999) (where disclosure in parent insufficient to support claims, patent anticipated by display of prototypes more than one year before filing of CIP)

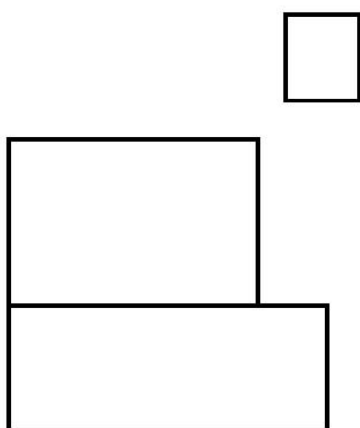
(a)



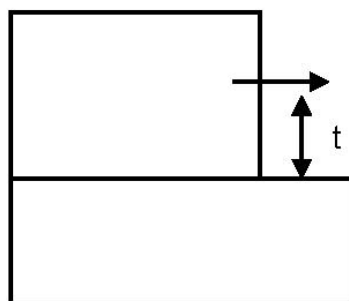
(b)



(c)



(d)





#### IV. RESULTING CIP STRATEGY

- ✓ Scenario: Suppose your client alerts you to an improvement to a patent application already on file, or a redesign of an existing product related to a prior application, and you think of a new claim that is potentially patentable. How should you file the claim?
  
- ✓ Your choices: You can recommend that your client:
  - ✚ File a CIP, *i.e.*, add new matter to the pending application and make “specific reference” to it as a parent
  - ✚ File a CON, *i.e.*, file a copy of the pending application (no new matter) and make “specific reference” to it as a parent
  - ✚ File a new application containing the “old matter” and the “new matter,” but with no “specific reference”
  
- ✓ If you make specific reference to the application already on file, for any particular claim, there are two cases:
  - (1) You can meet all five requirements of priority,
  - or
  - (2) Not.

✓ Suppose you *can* get priority?

<u>Issue</u>	<u>File a CIP</u>	<u>File a CON</u>
Patent Term	Shortened	Shortened
Priority	Will be challenged	Won't be argued
Intervening Prior Art	Ineffective, if you win	Ineffective
Prosecution Cost	High (new matter)	Low (copy)

Conclusion: File a CON

✓ Suppose you *cannot* get priority?

<u>Issue</u>	<u>File a CIP</u>	<u>File a New App</u>
Patent Term	Shortened	Not Shortened
Priority	Won't be argued	Won't be argued
Intervening Prior Art	Effective	Effective
Prosecution Cost	High (new matter)	High (new matter)

Conclusion: File a New Application

✓ Suppose you are *unsure* whether you can get priority?

<u>Issue</u>	<u>File a CIP</u>	<u>File a CON</u>
Patent Term	Shortened	Shortened
Priority	Will be challenged	Will be tested in PTO
Intervening Prior Art	Ineffective if you win	Ineffective if you win
Prosecution Cost	High (new matter)	High (PTO debate)

Conclusion: File a CON and try; move to a New Application if refused

✓ Suppose *only some claims* can get priority?

<u>Issue</u>	<u>File a CIP</u>	<u>File CON &amp; New App</u>	
Patent Term	Shortened	Shortened	Not
Priority	Will be debated	Yes	No
Intervening Prior Art	Ineffective if you win	Ineffective	Effective
Prosecution Cost	High (new matter)	Higher (new matter, choice, 2 apps)	

Conclusion: File both a CON and a New Application; split the claims

## V. PROVISIONAL OR FOREIGN PRIORITY APPLICATION STRATEGY

- ✓ Does this strategy change if the prior application is a U.S. provisional or a foreign priority application (i.e., Section 119 instead of Section 120)?
  
- ✓ Your choices:
  - ✚ File a “CIP,” meaning a modified version of the prior application with “new matter” added
  - ✚ File a Copy, meaning a version of the prior application with no new matter added
  - ✚ File a New App, meaning a modified version of the prior application with “new matter” added, but without making reference to the priority application under Section 119

✓ Suppose you *can* get priority?

<u>Issue</u>	<u>File a "CIP"</u>	<u>File a Copy</u>
Patent Term	Not Shortened	Not Shortened
Priority	Will be challenged	Won't be argued
Intervening Prior Art	Ineffective, if you win	Ineffective
Prosecution Cost	High (new matter)	Low (copy)

Conclusion: File a Copy

✓ Suppose you *cannot* get priority?

<u>Issue</u>	<u>File a "CIP"</u>	<u>File a New App</u>
Patent Term	Not Shortened	Not Shortened
Priority	Won't be argued	Won't be argued
Intervening Prior Art	Effective	Effective
Prosecution Cost	High (new matter)	High (new matter)

Conclusion: It really doesn't matter, but might as well include the priority claim anyway

## CONCLUSIONS

Under the new patent laws, CIP's are useless ...

... for any client without significant financial constraints on patent prosecution,

... although there remains a role for "quasi-CIP" filings (nonprovisional U.S. applications that modify U.S. provisionals or foreign applications).