

“Priority Claims, Incorporation By Reference, and how to fix errors, big and small.”

March 9, 2016

ALLEN

DYER

DOPPELT

MILBRATH &

GILCHRIST, P.A.

INTELLECTUAL PROPERTY ATTORNEYS

Jack G. Abid

Orlando,
Florida

Roadmap

- I. Introduction**
 - A. What?**
 - B. Why**
 - C. Yes, People Screw This Up**
- II. Priority Claims**
- III. Incorporation By Reference**
- IV. Conclusions And Questions**

Priority Claims: You had one job to do!

35 U.S.C. 120 Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385 which names an inventor or joint inventor 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. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the requirement for payment of the fee specified in section 41(a)(7), to accept an unintentionally delayed submission of an amendment under this section.

Behold, the related applications paragraph!

“This application is a continuation of pending Patent Application Serial No. 13/199,009, filed August 17, 2011, which is a continuation-in-part of Parent Application Serial No. 12/800,983 from which priority is claimed, the contents of these applications are hereby incorporated by reference in their entirety.”

More robust like example

VEHICLE TRACKING UNIT WITH DOWNLOADABLE CODES AND ASSOCIATED METHODS

Related Applications

[0001] The present application is a continuation-in-part of U.S. Patent Application Serial No. 11/076,259 filed March 9, 2005, which is a continuation of U.S. Patent Application Serial No. 10/383,496 filed March 7, 2003, which is a continuation of U.S. Patent Application Serial No. 09/859,972 filed on May 17, 2001 now U.S. Patent 6,606,561 which, in turn, was based upon provisional patent application Serial Nos. 60/264,811 filed on January 29, 2001; 60/258,005, filed December 22, 2000; 60/251,552, filed December 6, 2000; 60/252,125, filed November 20, 2000; 60/236,890, filed September 29, 2000; 60/246,463, filed November 7, 2000; 60/222,777, filed August 3, 2000; and 60/205,178, filed May 17, 2000, the entire contents of each of which are incorporated herein by reference.



Basic Training: Priority Claims

- **Foreign**
 - Paris Convention (utility patents 1 year, design patents 6 months)
 - PCT (national stage 30 months from first priority date)
- **Domestic**
 - Parent application still pending
 - At least one joint inventor
 - Specific reference in the application

So, how does this get fouled up by trained seasoned patent professionals?

- **Plain incompetence**
- **Lack of capacity**
- **Inadvertent error**
- **More typical, inherited from the former attorney**

How to fix?

- **Domestic**

- **Delayed filing i.e. you missed the date**
 - File within 2 months of deadline
 - Delay was unintentional
 - Petition under 37 CFR §1.54
- **You filed the application, but did not claim priority**
 - **Within the later of**
 - 4 months of actual filing of application or
 - 16 months from the foreign filing date
 - **Amend the application to include the claim**
 - **National stage application, 30 months from earliest priority date**
 - **Otherwise**
 - Delay was unintentional
 - Petition under 37 CFR §1.54

International?

- **PCT Application claiming priority to national filing**
 - **PCT Rule 26 bis.1**
 - Within the earlier of 16 months of the new/old priority date
 - Need to withdraw early publication request
 - **PCT Rule 26 bis.3 (miss the date in 26 bis.1) Restoration of the right to priority**
 - Within 2 months of the bis.1 date
 - Unintentional delay
 - Due care?

Incorporation by Reference

37 CFR §1.57 (a)

Subject to the conditions and requirements of this paragraph, a reference made in the English language in an application data sheet in accordance with § 1.76 upon the filing of an application under 35 U.S.C. 111(a) to a previously filed application, indicating that the specification and any drawings of the application under 35 U.S.C. 111(a) are replaced by the reference to the previously filed application, and specifying the previously filed application by application number, filing date, and the intellectual property authority or country in which the previously filed application was filed, shall constitute the specification and any drawings of the application under 35 U.S.C. 111(a) for purposes of a filing date under § 1.53(b).

What the heck does that mean?

- **ADS appears to be an option?**
- **3 months from filing date to file a copy with the USPTO**
- **An application abandoned under paragraph (a)(1) or (a)(2) of this section shall be treated as having never been filed, unless:**
 - **application is revived ; and**
 - **A copy of the specification and any drawings of the previously filed application are filed in the Office.**

Yes, there is more

- **Certified copy must be filed, unless the prior application is a domestic application or a foreign application for which priority was perfected.**
- **All seems related to priority (i.e. a priority claim in the ADS is an incorporation by reference)**

Incorporation by Reference

37 CFR §1.57 (b)

Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, international application, or international design application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

Simplification

- **This is the classic page/figure drop**
- **Foreign priority application**
- **Attorney loses a page/sheet**
- **This can be fixed**
 - **Error must be inadvertent**
 - **Priority claim at the time of filing**
 - **Considered incorporation by reference as to only the omitted material**
 - **Must amend application while pending**
 - **Supply copy of priority document**
 - **Identify where the material was omitted**

Incorporation by Reference

37 CFR §1.57 (c)

Except as provided in paragraph (a) or (b) of this section, an incorporation by reference must be set forth in the specification and must:

(1) Express a clear intent to incorporate by reference by using the root words “incorporat(e)” and “reference” (e.g., “incorporate by reference”); and

(2) Clearly identify the referenced patent, application, or publication

Incorporation by Reference

37 CFR §1.57 (d)

“Essential material” may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference.

Incorporation by Reference

37 CFR §1.57 (d)

“Essential material” is material that is necessary to:

- (1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by 35 U.S.C. 112(a);
- (2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by 35 U.S.C. 112(b); or
- (3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by 35 U.S.C. 112(f).

Incorporation by Reference

37 CFR §1.57 (e)

Other material (“Nonessential material”) may be incorporated by reference to U.S. patents, U.S. patent application publications, foreign patents, foreign published applications, prior and concurrently filed commonly owned U.S. applications, or non-patent publications. An incorporation by reference by hyperlink or other form of browser executable code is not permitted.

- How most practitioners believe the rule works
- Non-essential matter only
- Because we operate based upon the state of technology in 1885

Spare me the remaining 285 words

- **Examiner may require you to submit a copy with statement that the copy is accurate**
- **If you want to expressly add this material into the application, must do it by amendment and expressly note the incorporation by reference**
- **You can correct a defective incorporation by reference while the application is pending**
 - **IBR needs to still be clear, cannot fix that flaw**
 - **only permitted for material that was sufficiently described to uniquely identify the document.**

Some examples of what not to do.



This invention claims the benefit of priority to U.S. Provisional Patent

Application



5

FIELD OF INVENTION

This invention relates to electronic books, in particular to interactive electronic book operating systems and methods, primarily for use with scientific, engineering and any other technical topic books.

Cover Sheet Problems


- **The dangers of the cover sheet provisional application**
- **If you cannot do it the right way (client budget does not allow for it), you need to mitigate**
 - **Disclaim to client at drafting**
 - **Before payment of issue fee, discuss adding the subject matter back in if continuation applications are possible**

Some examples of what not to do.



CROSS REFERENCE TO RELATED APPLICATIONS

This application is a continuation-in-part application of patent

 from which priority is claimed.

The Recue

- **Parent and CIP abandoned**
- **Client comes to us with matters looking for rescue**
- **Revive the CIP and bring back the parent**
- **Never assume IBR, always verify**

Conclusion

Questions?

**Thank you for your
attention.**