Use of Incorporation By Reference in Patents

A Shortcut Tool and Possible Consequences

By Kevin W. King and Kar Yee Tse

In drafting a U.S. patent application, the patent applicant may refer to a prior publication to aid in describing the background or some other facet of his or her invention. The applicant may incorporate this prior public information expressly into the specification of his or her application, or as a shortcut may incorporate this information by explicit reference. This seemingly innocuous shortcut may be a useful tool for the patent applicant or patentee; however, patent infringement litigants — whether plaintiff or defendant — should be keenly aware not to overlook subject matter that has been incorporated by reference either in the patent at issue or in relevant prior art when validity of the patent is challenged.

Incorporation By Reference to Blame for Finding of No Infringement

In a 2006 case, a patentee trying to enforce his patent found out the hard way how a problem could arise from subject matter incorporated by reference in its patent. In Cook Biotech Inc. v. ACell Inc., the patentee, Cook Biotech, asserted infringement against ACell of a patent claiming a “composition comprising urinary bladder submucosa delaminated from ... at least the luminal portion of the tunica mucosa of a segment of a urinary bladder.” 460 F.3d 1365 (Fed. Cir. 2006). The appellate court, the Court of Appeals for the Federal Circuit, overturned the district court’s finding of patent infringement. In reviewing Cook Biotech’s patent, the appellate court looked to the specification of the patent and found it incorporated by reference a previous patent that defined the luminal portion of the tunica mucosa as including the lamina epithelialis mucosa, its lamina propria and the basement membrane sandwiched between. With this interpretation of the claim limitation, ACell’s product was found to be non-infringing because rather than being “delaminated from … the luminal portion of the tunica,” it retained part of the luminal portion of the tunica, namely, the basement membrane and the lamina propria. To its detriment, Cook Biotech failed to appreciate the principle, affirmed by the appellate court, that by incorporating material by reference, the material may be effectively considered part of the host document as if it were explicitly stated therein. Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272 (Fed. Cir. 2000).

Considerations for the Patent Practitioner

A patent practitioner drafting a new patent application may find it convenient to cite earlier patents or publications of the inventor or others to help describe certain known components of the invention, to describe the state of the prior art over which the instant invention improves, or to indicate support for a particular assertion. The citation may occur with or without incorporation by reference. Under the patent rules, a reference may be incorporated into a patent specification by expressing a clear intent to incorporate the reference and

Kevin W. King is partner at Sutherland Asbill & Brennan LLP. He is a registered patent attorney and concentrates his practice on patent prosecution, intellectual property counseling, and strategic portfolio management for corporations and universities, with a particular focus in medical device, pharmaceutical, and other chemical and mechanical technologies. Kar Yee Tse is an associate at Sutherland Asbill & Brennan LLP. She is a registered patent attorney and focuses her practice on patent prosecution and patent opinions in chemical and engineering technologies.
clearly identifying the reference. 37 C.F.R. §1.57. This clear intent is generally considered to require some form of the words “incorporate” and “by reference.” Without these magic words, the reference generally would be considered a mere citation. The U.S. patent rules prohibit incorporation by reference by hyperlink or other browser executable code. The prior document may or may not be one on which the patent or application at issue relies for a priority (filing) date. There are other nuances, which are beyond the scope of this writing, that one may need to consider when the incorporated by reference document is being relied upon for a priority benefit.

Benefits of Using Incorporation By Reference

Material that is incorporated by reference can be considered to be literally contained within the four corners of the patent document, such that one effectively can include substantial amounts of information in the patent specification using a single sentence. This drafting tool may be advantageous to avoid cumbersome specifications, to streamline the patent drafting process and lessen the attendant costs, to avoid a U.S. Patent Office surcharge for filing a patent application exceeding 100 pages in length, and to decrease the costs for obtaining foreign language translations of the patent application. (Translation costs can be a surprisingly large portion of the costs to extend patent protection to jurisdictions outside the United States.) The information incorporated may be from a published patent, published patent application, or non-patent literature.

One set of circumstances where it may be particularly beneficial to incorporate material by reference is when it is necessary to draft and file an improvement patent application on very short notice (e.g., only a day or two) and where much of the detailed description of the invention can be found in the client’s own earlier published patents and applications. If one can presume knowledge of and agreement with the content of those earlier patent documents, then there generally would be little risk in quickly crafting a short provisional patent application that explicitly describes the new improved elements or features of the invention and incorporates by reference the documents that describe the remaining elements or features of the client’s invention.

In another aspect, a patent applicant may determine, perhaps years after filing his application and while it is undergoing examination, that it would be highly advantageous to explicitly claim some previously unappreciated facet or embodiment of the invention (e.g., a particular species of a previously claimed genus). In order to amend the claims to recite this particular feature, the applicant must identify where support for this feature is found in the application as it was originally filed. In such a situation, it may be useful to have incorporated by reference one or more U.S. patent publications that describe seemingly unimportant or tangential information, as one may rely on such documents later to support a claim amendment. In addition, the applicant can amend his or her patent specification to add selected information from the document. That is, subject matter that is incorporated by reference can be moved to be expressly included in the patent application. See M.P.E.P. §2163.07(b).

Limitations on Using Incorporation By Reference

Other considerations must be made in determining whether and when it is proper to incorporate information by reference or to rely on such information to support claims of the patent. First, it would be prudent to assess whether the incorporated material is “essential material,” which is material necessary to provide the necessary written description, best mode, enablement, and definiteness of the claimed invention may only be incorporated by reference if that matter is in another U.S. patent or U.S. patent application publication. One may not incorporate by reference essential matter found in non-patent literature or non-U.S. patent documents. In addition, the referenced U.S. patent or U.S. patent application publication must not itself incorporate the essential material by reference. 37 C.F.R. §1.57(c) and M.P.E.P. §608.01(p). Second, when the patent applicant’s invention is claimed using means-plus-function or step-plus-function claim language, one should ensure that the description of the structure, material, or acts corresponding to means-plus-function or step-plus-function claim limitations that enable a skilled artisan to identify them as performing the recited function are not incorporated by reference. See M.P.E.P. §2181.

It is noted that the use of incorporation by reference is not permissible in Europe, Japan, and other jurisdictions outside of the United States. Thus, the entire explanation of necessary features of the invention must be discussed in the patent specification. Therefore, one should be careful in relying on incorporation by reference,
particularly for essential matter, in drafting patent applications for the U.S. that likely will also be filed abroad. Of course, one’s patent filing strategy could easily include tailoring separate domestic and foreign patent applications that account for this difference.

In view of the holding in Cook Biotech Inc. and the straightforward principle that material incorporated by reference is part of the patent specification, the patent drafter should be aware of how incorporated material may be used to construe the scope of the claims of a patent. In view of the possibility of inadvertently incorporating material that limits the claims of a patent, the patent practitioner generally should be cautious when incorporating material by reference or consider not using it at all. Obviously when material is incorporated by reference, the patent practitioner should carefully review the incorporated document to be sure that it is consistent with the patent application and in particular would not be contradictory to the intended meaning of any claim term. An alternative, prudent approach may be to incorporate by reference only select portions of the prior document (e.g., by page numbers or topic) rather than incorporating by reference the entire document.

**Considerations for the Patent Litigant**

The Cook Biotech Inc. case serves to remind patent litigants and litigators not to overlook the potential implications of material incorporated by reference into litigated patents or prior art patents. One should avoid ignoring the incorporated by reference document as if it were merely a case citation; it should be considered part of the patent and scrutinized as such.

The incorporation by reference may be in the patent at issue, as in the Cook Biotech Inc. case. For a patent infringement defendant, text found in the incorporated by reference document may beneficially support a narrower interpretation of a key claim limitation to avoid infringement. Alternatively, the document incorporated by reference may suggest a broader interpretation of the claims than the patentee would like, opening up the patent claim to invalidity challenges.

The incorporation by reference also may be in prior art to the patent at issue. This may be significant, since invalidity of a patent claim based on anticipation over a single reference may be easier to prove than invalidity based only on obviousness over two or more separate prior art documents. For instance, the validity of a patent may be challenged based on a single anticipatory prior art reference, where that reference incorporates by reference key information from another patent. For an illustrative hypothetical scenario, assume the patent claim at issue claims the combination of elements A, B, and C, and a close prior art reference (Patent X) explicitly discloses elements A and B. If Patent X incorporates by reference another prior document (Patent Y) that teaches element C, then Patent X can be considered to disclose within its four corners all three of the claim elements to evidence invalidity based on a lack of novelty over Patent X, rather than having to argue obviousness over Patents X and Y and motivation to combine the two patents if Patent Y were not incorporated by reference. The patentee should be cognizant of and ready for such potential challenges.

Conversely, the patentee may find details in documents incorporated by reference that bolster its desired claim construction and infringement arguments. For example, the material incorporated by reference in the patentee’s patent may include definitions or examples of claim elements that effectively broaden the scope of a key claim term beyond an interpretation one might otherwise make based solely on the explicit disclosure in the patentee’s patent.

**Conclusion**

Incorporation by reference in U.S. patent practice can be a useful tool for saving time and money. It is, however, a tool that should be used judiciously by patent applicants. Careless use of incorporation by reference may come back to haunt a patentee seeking to enforce a patent when material incorporated by reference either should have been explicitly recited in the patent or should have been excluded from the patent entirely. Patent litigants also should be aware that prior art patents may incorporate by reference material helpful or harmful to their cases.