

## There's the Devil Federal Circuit Reiterates: No Room for Error in Priority Claims

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**Introduction** | The late Chief Judge Giles S. Rich, in an oft-quoted précis of U.S. patent law, remarked that “the name of the game is the claim.” Giles S. Rich, “The Extent of the Protection and Interpretation of Claims — American Perspectives,” 21 *Int'l Rev. Indus. Prop. & Copyright L.*, 497, 499 (1990). The U.S. Court of Appeals for the Federal Circuit's recent decision in **Medtronic CoreValve, LLC v. Edwards Lifesciences Corp. (CoreValve)** serves as a reminder that the claims at the beginning of a patent can be just as important as those at the end.

In **CoreValve**, the Federal Circuit affirmed an invalidity determination, declined to adopt a proposed “reasonable person” test for interpreting the sufficiency of a priority claim, and reiterated that the burden of properly claiming priority rests squarely on the patentee. **CoreValve**, No. 2013-1117, slip op. at 12-13 (Fed. Cir. Jan. 22, 2014).

**The CoreValve Family** | At issue in **CoreValve** was Medtronic's U.S. Patent No. 7,892,281, entitled “Prosthetic Valve for Transluminal Delivery.” The '281 patent issued from U.S. Application Serial Number 12/348,892 (referred to in the opinion as “U.S. Application 10”). U.S. Application 10 and, in turn, the '281 patent, included two separate priority chains, only one of which was at issue in **CoreValve**. The priority chain at issue included a claim to U.S. Application Serial Number 12/029,031 (U.S. Application 8), U.S. Application Serial Number 11/352,614 (U.S. Application 6), U.S. Application Serial Number 10/412,634 (U.S. Application 4), and International Application Number PCT/FR 01/03258 (International Application 2b); International Application 2b claimed priority to French Application Number FR 00/14028 (French Application 1b). *Id.* at 3.

**The Gap** | U.S. Application 10 recited a priority chain that included claims to U.S. Applications 6 and 8, each of which included the following priority claim: “[T]his application is also a continuation-in-part of International Application No. PCT/FR 01/03258 [International Application 2b]. . . .” *Id.* at 9. The district court found that the phrase “this application” must mean “the present application” (i.e., U.S. Applications 6 and 8, respectively), and thus the priority claims in U.S. Applications 6 and 8 were defective as not expressly identifying U.S. Application 4 as the continuation-in-part. *Id.* at 10. The **CoreValve** panel deduced that Medtronic apparently “recycled the priority claim in [U.S. Application 4] for use in U.S. Applications 6 and 8.” *Id.*

**Game Changer** | Edwards contended that, due to the improper priority claims in intermediate U.S. Applications 6 and 8, the '281 patent should not be entitled to the benefit of French Application 1b and International Application 2b's filing dates, that patents issued from French Application 1b and International Application 2b constitute prior art under 35 U.S.C. section 102, and that their disclosures anticipate the claims of the '281 patent asserted by Medtronic. *See id.* at 6.

**Medtronic's Position** | Declining to contest the substance of Edwards' invalidity contentions, Medtronic focused on the priority date issue. Specifically, Medtronic argued: (1) “that the phrase ‘this application’ is not self-referential from application to application; rather, it always refers to U.S. Application 4, whether it is being used in U.S. Application 4, 6, or 8”; and (2) “that the meaning of the phrase ‘this application’ should not be rigidly determined, but instead should be based on what a reasonable person would understand it to disclose within the context.” *Id.* at 10-11.

**The Federal Circuit's Response** | Noting that Medtronic's priority date position hinged on a determination that the '281 patent's priority chain complied with the strictures of both 35 U.S.C. section 119 and 120, the **CoreValve** panel opted to address only the latter route—the one paved with precedent. *See id.* at 7 (“[W]e choose [section] 120”). The Federal Circuit explained that they had “recently clarified that the ‘specific reference’ requirement [of section 120] mandates ‘each [intermediate] application in the chain of priority to refer to the prior applications.’” *Id.* at 7-8 (quoting **Encyclopaedia Britannica, Inc. v. Alpine Elec. of Am., Inc.**, 609 F.3d 1345, 1352 (Fed. Cir. 2010)).

The panel concluded that, due to the failure of U.S. Applications 6 and 8 to “specifically reference the earlier filed applications in the priority chain, the '281 patent is not entitled to claim the priority date of International Application 2b under [section] 120.” **CoreValve**, slip op. at 8. Referring to the priority chain of U.S. Applications 6 and 8, the panel dryly noted that “[m]ore is required.” *Id.* at 9.

Citing the Manual of Patent Examining Procedure's instructions for claiming priority to an earlier filed application, as well as its own prior opinions' use of the phrase “this application,” the court dismissed “Medtronic's proposed meaning of ‘this application’ [as] an attempt at linguistic gymnastics [that] makes little sense relative to the straightforward, plain language meaning of the phrase.” *Id.* at 10 (citing M.P.E.P. § 201.11).

The court then declined to adopt Medtronic's proffered “reasonable person” approach for interpreting the disclosure of priority claims. *Id.* at 12. Emphasizing at the outset that Medtronic's “reasonable person” approach “runs afoul” of the section 120 requirement that a priority claim include “a specific reference” to each earlier filed application, the panel buttressed its stance by pointing out that the regulation implementing section 120 prescribes a level of detail that includes both the series code and serial number. *Id.* (citing 37 C.F.R. § 1.78(a)(2)(i)).

The court then shifted to the public policy underlying section 120's stringent requirements, concluding that Medtronic's “reasonable person” approach “improperly places the burden of deciphering a priority claim upon the reader or the public,” rather than the patentee, who is “best suited to understand the genealogy and relationship of her applications.” *Id.* at 13.

**The Increased Importance of an ADS** | Among the deluge of changes aimed at implementing the America Invents Act (AIA) is a requirement that priority claims be made in an application data sheet (ADS). *See* 37 C.F.R. §§ 1.55(d), 1.76(b)(5)-(6), and 1.78(a)(3). The requirement applies to U.S. non-provisional applications filed on or after Sept. 16, 2012, and Patent Cooperation Treaty (PCT) national stage applications with international filing dates on or after Sept. 16, 2012. The deadline for making priority claims remains unchanged. Priority claims must be made within four months of filing, or, if longer, within 16 months of the earliest priority date claimed. *See id.* §§ 1.55(d) and 1.78(a)(4).

**Conclusion** | Students of U.S. patent law should not be surprised to find the onus to draft proper priority claims placed squarely on the applicant's shoulders. Patent claims—the ones that come at the end—have long been construed against their authors. See, e.g., **Chef America, Inc. v. Lamb-Weston, Inc.**, 358 F.3d 1371, 1373 (Fed. Cir. 2004) (“It is the job of the patentee, and not the court, to write patents carefully and consistently.”). As the Federal Circuit's decision in **CoreValve** demonstrates, applicants and practitioners should carefully draft and review not only the claims found at the end of an application, but also those traditionally found at the beginning. Moreover, in light of the relatively recent requirement that priority claims be made in an ADS, practitioners would be well served to reconsider who within their organization is responsible for ensuring that ADSs are properly populated and reviewed.

As is so often the case: the devil is in the details. Or, as the late Chief Judge once quipped: “The life of a patent solicitor has always been a hard one.” **In re Ruschig**, 379 F.2d 990, 993 (C.C.P.A. 1967).

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