

PATENT PROTECTION FOR IMPROVEMENTS MADE OVER YOUR PREVIOUSLY FILED PATENT APPLICATION

Introduction

Inventions result from continuous research and innovation, which may be patented. After patenting an invention, scope of further improvement or modification over the previous patent may still exist, at later stages. Under such a scenario, the improvement or modification over the original patented product or process may be protected by what is known as "Patent of Addition" in India and several other jurisdictions, and "Continuation-in-Part" (CIP) application in the United States.

Patents of Addition or CIP applications may be filed in circumstances where a patent application (patent application) has been filed for an invention, and where another related invention, which may be a variation of the earlier filed patent application, is later developed, but the variation may not be distinct or inventive enough to qualify for an independent patent in light of the earlier filed parent application.

Brief overview of Patent of Addition under the Indian Patent System

Filing Patent of Addition in India

A patentee can file an application separately for a patent of addition in a prescribed manner for any improvement or modification over an invention for which he has already filed a patent application or for which a patent has been granted.

According to Rule 13(3) of the Patents Rule, a patent of addition includes in its specification a serial number of the Application for Patent in respect of the original invention, and, at the beginning of the description, a definite statement that the invention comprises an improvement in, or a modification of, the invention claimed in the specification of the main patent granted/applied for. The Specifications should also include a short statement of the invention as disclosed in the earlier Specification. The date of filing of a patent of addition shall be the date on which the application for patent of addition has been filed.

According to Section 56 of the Patents Act, the patent of addition cannot be revoked or invalidated for lack of inventive step in light of the parent application. Thus the main patent or patent application cannot be cited by the examiner to show lack of inventive step in the patent of

addition. The Examiner, however, can cite the main patent or patent application to establish lack of novelty.

Patents of addition are granted after the grant of the main patent and expire along with the main patent.

Advantages associated with filing a Patent of Addition

The inclusion of Patents of Addition in the Indian Patent Act, 1970 was based on the recommendation of the Ayyangar Committee through the Report on the Revision of the Patents Law of 1959, mainly influenced by the U.K. Patents Act of 1949 which was based on the recommendations of the Swan Committee.

The inclusion of the clause “Patents of Addition” was basically to provide opportunities to patentees to adequately claim their inventions in a way that would cover variations or amplifications of the monopoly claimed in respect of their basic invention.

A patent of addition comes with an economic benefit. In India, one does not have to pay a separate renewal fee for the patent(s) of addition unless the parent patent is revoked and the patent of addition is converted into an independent patent, on request by the patentee.

Another benefit is that the improvement over the main patent covered by the patent of addition cannot be invalidated by the main patent or patent application on grounds of lack of inventive step.

Disadvantages associated with filing a Patent of Addition

As a patent of addition expires along with the main patent, the term for which the patent of addition will remain in force is reduced even though the patent of addition gets a new filing date.

Another issue of concern associated with filing the patent of addition is that as the patent of addition will be entitled to a new filing date and as such an application may not claim benefit from the earlier filed parent application, any application (other than the parent application) that may have been filed or published before the filing date of the patent of addition may be used to negate the challenge the patentability of the patent of addition.

Continuation-in-part (CIP) applications under US patent system

The United States Patent and Trademark office also, like the Indian Patent Office, has provision to protect improvements or modifications over an invention for which patent application has

been already filed. Such patent applications that are filed to protect improvements or modifications over an invention, for which a patent application has been already filed, are known as CIP applications.

A CIP application may be filed during the lifetime of an earlier non provisional application. A CIP application differs from the patent of addition in the following aspects:

- Maintenance fee/renewal fee is to be paid for a CIP application.
- The CIP application should be filed during the pendency of the parent application (before issue of patent or abandoning of the parent application).
- A patent of addition can be filed even after a patent is issued

Claiming priority by a continuation-in-part application

Under the provisions of 35 U.S.C 120, during the pendency of a patent application, the filing of a continuation-in-part application is entitled to the benefit of the filing date of the earlier filed parent provided the parent includes in its specification adequate written description so as to support the continuation-in-part application's claims. The new claims included in the continuation-in-part application, not present in the parent application, will be entitled to claim benefits/priority from the continuation-in-part application and not from the main application. As such, a continuation-in-part application may only partially claim benefit from the parent application.

We shall have a look at the case ***Santarus, Inc., and the Curators of the University of Missouri, v. Par Pharmaceutical, Inc*** to have a clear understanding of the parent application providing benefits to a CIP application. The decision of the district court was partially affirmed, partially reversed and remanded by the Federal Circuit.

Plaintiff Santarus, Inc. was the exclusive licensee of the patents that were for the inventions of Dr. Jeffrey Phillips, assigned to the University of Missouri. Par Pharmaceutical, the defendant, filed an Abbreviated New Drug Application (ANDA) for FDA approval to sell a generic counterpart of the Santarus products requesting permission to market the same formulations describing the Par products as bioequivalent to the products marketed by Santarus. Santarus charged Par with infringement for which Par asserted unenforceability and invalidity of all of the claims of the Phillips patents. Each of the Phillips patents in question was a continuation or continuation-in-part in a chain that originated with Patent No. 5,840,737 (the '737 patent) filed on January 4, 1996.

The district court found Par's ANDA products to be infringing on the Phillips patents, but held the entire asserted claims of one or more of the Philip's patent invalid on grounds of obviousness and inadequate written description. The district court, however, established that there was no inequitable conduct by Dr. Phillips and the assignee, the University of Missouri, inequitable conduct being one of the grounds for invalidating the Philips patents. The district court also held certain claims invalid on a new ground that the common disclosure in a parent patent is prior art to the chain of continuing patents, which was reversed by the Federal Circuit. While this article will not go into the details of the other grounds, a discussion on the new ground raised, that the common disclosure in a parent patent is prior art to the chain of continuing patents, will be presented.

While supporting Par's argument that Dr. Phillips's own '737 patent had rendered obvious the claims to which it was prior art, the district court had held that the parent '737 patent that issued to Dr. Phillips "is an invalidating reference based on the common subject matter that has priority to the parent patent's filing date."

The district court stated that the claims of one of the patents Patent No. 6,699,885 ('885 patent), which was a continuation-in-part of the '737 patent include subject matter disclosed in the '737 patent and hence the claims in the '885 patent were rendered obvious by the parent '737 patent. However, priority for the '885 patent was properly claimed, in accordance with 35 U.S.C. §120.

The Federal Circuit reversed this ruling of the district court stating that a continuation-in-part is entitled to the parent's filing date as to any subject matter in common, but only to its own filing date as to the new matter. In words of the circuit judge, the panel majority had "forgotten" that "matter disclosed in the parent application is entitled to the benefit of the filing date of the parent application." The Circuit Judge, therefore, dissented from the district Court's incorrect ruling.

Another case where the entitlement to benefits becomes clear is the ***PowerOasis, Inc. v. T-Mobile USA, Inc.*** Here, the decision of the district court was affirmed by the Federal Circuit.

PowerOasis, the Plaintiff, filed their first application in the patent chain on February 6, 1997 and issued as U.S. Patent No. 5,812,643 ('643 patent). Subsequently, on June 15, 2000, PowerOasis filed a continuation-in-part application, which issued as U.S. Patent No. 6,314,169 ('169 patent). The patents in question ('658 patent and '400 patent) in this case

were filed subsequent to the '169 patent. The district court found that the '169 patent had added “substantial new matter” in its specification.

PowerOasis sued T-Mobile for patent infringement, alleging that T-Mobile’s wireless “HotSpot Network” infringed the claims of the PowerOasis patents in question ('658 patent and '400 patent). T-Mobile filed a motion for summary judgment that the asserted claims were anticipated by MobileStar Network, a product developed, deployed, publicly used, and offered for sale by MobileStar Networks, Inc. (a company acquired by T-Mobile in 2002). PowerOasis responded by claiming that the asserted claims had the benefit of priority of the filing date of its Original application ('643 patent) which would antedate the MobileStar Network.

On summary judgment, the district court determined that the asserted claims were not entitled to the priority date of the original application because the written description of the original application did not support the later issued claims. To this judgment, PowerOasis argued that the district court erred in concluding that the disclosure of the Original application did not provide a written description adequate to support the asserted claims of the two patents. PowerOasis also argued that the district court erred by placing the “burden of proof” on PowerOasis to show that it is entitled to the priority date of the Original application. The district court concluded that when a dispute concerning whether a CIP patent is entitled to priority to the date of the original application arises and when the Patent Office has not addressed the issue, the “burden of proof” ordinarily should rest with the party claiming priority to the date of the original application.

The Federal Circuit in their decision stated, “it is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application.” Also, to be entitled to the filing date of the original application, the missing descriptive matter must necessarily be present in the original application’s specification. PowerOasis provided, as evidence, the Original Application and the declaration of its expert witness, after analysis of which, the district court held that the asserted claims of the patents in question are only entitled to the filing date of the CIP application.

The original application disclosed a vending machine with a “user interface” as part of the vending machine. However, the 2000 CIP application introduced a vending machine with a

“user interface” located remotely from the vending machine. All embodiments of the original application were directed to user interfaces which were part of the unitary vending machine apparatus without any disclosure of a user interface located separate from the vending machine itself. Since the Original Application did not support a “customer interface” located separate from the vending machine, the asserted claims were not entitled to the effective filing date of the original application. Because the asserted claims were limited to the filing date of the CIP application, they were found to be anticipated by the MobileStar Network. The Federal Circuit affirmed the judgment passed by the district court in favour of the defendant.

Issues associated with filing a CIP application

As it became evident from the case law cited above, benefits can be claimed only partially while filing a CIP application. Moreover, the later added subject matter has a new priority date which means that any application filed or published before the new priority date could be used as prior art to invalidate the new claims covered by the CIP application.

The term of 20 years, from the filing date of the earliest application for which a benefit is claimed, still remains the same. The new claims will not be entitled to the benefits of extended patent term despite having varying priority dates.

Another lesser known but important matter of concern might be using the CIP application to question the inadequacy in the written description of the parent application. If new matter is added in a CIP application, potential infringers, and Examiners may question the non fulfillment of the enablement requirement in the parent application by establishing that if the new matter in the CIP application includes information necessary to make and use the invention, such information should have been included in the main application. Since the main application failed to provide such information, the main application may not be an enabled disclosure.

Under the circumstances discussed above, a patentee has to wisely decide whether to file a CIP application or not.

Conclusion

Patents of addition in India and the CIP applications in the US are directed to protect improvements and modifications over an invention. However, both are different from one

another in some aspects as discussed earlier. It is advisable to file a Patent of addition or CIP application in case the improvement over the main application does not qualify for an independent patent. However, if the improvement over the main application is patentably distinct enough to qualify for an independent patent, then the patentee may consider filing a new and separate application for that invention, which will at least ensure the usual term of 20 years.

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