

**Keywords: Incorporation by Reference, Priority, Continuity of Disclosure**

**General: A later filed patent may not be entitled to priority from an earlier filed patent if there is not continuity of disclosure in any intervening patents between the earlier filed patent and the later filed patent. Such discontinuity may arise if an intervening patent fails to properly incorporate by reference an aspect of an earlier filed patent that is relied upon by a later filed patent which claims priority to the earlier filed patent.**

*Zenon Env'tl. Inc. v. United States Filter Corp.*  
No. 2006-1266, -1267 (Fed. Cir. 2007)  
November 7, 2007

**I. Facts**

Zenon Environmental Inc. (“Zenon”) brought suit against U.S. Filter Corporation (“U.S. Filter”) alleging infringement of U.S. Patent No. 6,620,319 (the ‘319 patent), as well as other patents relating to water filtration. The ‘319 patent, through a series of intervening patents, claims priority to U.S. Patent No. 5,639,373 (the ‘373 patent), which issued more than one year before the filing of the ‘319 patent and which, the parties agreed, discloses each and every element of the invention of the ‘319 patent.

In particular, the ‘373 patent discloses both a vertical skein, which includes vertical fibers held between a pair of headers, and a gas distribution means that discharges air near the base of the skein to produce bubbles which act to keep the fibers clean. Asserted independent claim 7 of the ‘319 patent recites such subject matter, including “(d) a gas distribution system having through-passages through the lower header to discharge bubbles into the substrate above the lower header.”

An intervening patent, U.S. Patent No. 5,910,250 (the ‘250 patent), through which the ‘319 patent claims priority to the ‘373 patent, does not explicitly disclose the same gas distribution system that is disclosed in both the ‘319 and ‘373 patents. In particular, the gas distribution system disclosed in the ‘250 patent uses a baffle to produce fine or coarse bubbles. Based on this aspect of the ‘250 patent, the inventors clarified in the Background section that:

The vertical skein is not the subject matter of this invention and any prior art vertical skein may be used. Further details relating to the construction and deployment of a most preferred skein are found in the parent U.S. Pat. No. 5,639,373, and in Ser. No. 08/690,045, the relevant disclosures of each of which are included by reference thereto as if fully set forth herein.

At trial, the court issued a claim construction ruling, after which Zenon conceded that the accused product did not infringe the claims of the ‘319 patent as constructed. In addition, U.S. Filter moved for summary judgment of invalidity of the ‘319 patent, which the court denied. Subsequently, the court held a bench trial as to the validity of the ‘319 patent, at which time U.S. Filter argued that the ‘319 patent was not entitled to claim priority from the

'373 patent based on the failure of the '250 patent to incorporate by reference the gas distribution system disclosed in the '373 patent, thereby breaking the chain of priority. As argued by U.S. Filter, if the '319 patent was not entitled to claim priority to the '373 patent, the '319 patent was anticipated by the '373 patent, and thus invalid.

The court rejected U.S. Filter's position. U.S. Filter subsequently moved for summary judgment of noninfringement of the '319 patent, which the court granted. Subsequently, U.S. Filter timely appealed the court's decision with regard to the validity of the '319 patent and Zenon cross-appealed the court's claim construction and grant of summary judgment of noninfringement.

## II. Issues

A. Was the chain of priority between the '319 and the '373 patent broken?

## III. Discussion

A. Yes. The majority of the panel decided that the district court erred in concluding that the '319 patent was entitled to the priority date of the '373 patent. The majority noted that a priority claim under 35 U.S.C. § 120 requires that each application in the chain must comply with the written description requirement of 35 U.S.C. § 112 and that, therefore, for the '319 patent to be entitled to priority from the '373 patent, continuity of the disclosure must have been maintained throughout the intervening chain.

In the present case, the majority determined that the incorporation by reference statement of the intervening '250 patent (reproduced above) did not incorporate the entirety of the disclosure of the '373 patent based on the plain language of the incorporation statement. In particular, the majority noted that the plain language "expressly limits the incorporation to only relevant disclosures of the patents" thereby indicating that the disclosures were not incorporated in their entirety. In addition, the portion of the disclosure of the '373 that was incorporated was related to the vertical skein, not to the gas distribution system.

Thus, the '373 patent did describe the gas distribution system as claimed in the later filed '319 patent. However, the intervening '250 patent failed to explicitly describe the gas distribution system of the '373 patent or to incorporate by reference the portions of the disclosure of the '373 patent related to the later claimed gas distribution system. As a result, the chain of continuity was broken. Therefore, the '319 patent was not entitled to claim priority to the '373 patent. Further, absent a valid claim to priority, the '319 patent was anticipated by the '373 patent and was, therefore, invalid.