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Get Your Priorities Straight: The Perks and Pitfalls of Patent Priority Claims

By Acacia T. Tam and Usha K.M. Parker

Patent laws in the United States (and in many other countries) provide opportunities to claim an earlier filing date than the actual filing date of a patent application.¹ The earliest filing date to which an application can claim priority is referred to as the effective filing date or priority date. Based on passage of the America Invents Act (AIA) and effective March 16, 2013, the importance of having the earliest possible effective filing date is heightened. This is because, for applications filed on or after that date, the United States (like many other countries) is a first-inventor-to-file country.² First-inventor-to-file means that the application with the earliest effective filing date has priority, regardless of whether another may have reduced the invention to practice earlier. The first (effectively) filed application can be applied as prior art to bar others from obtaining a patent on the same or similar subject matter.

While having the earliest effective filing date has advantages for obtaining a patent over others, it may create limitations for the term during which

the obtained patent can be asserted against others. This is because the term of the patent is based on the effective filing date (with some exceptions), rather than on the actual filing date.³ Thus, filing an application with a priority claim can have the effect of pulling both the filing date and the end of the patent term to be earlier in time as compared to filing an application without a priority claim. This tradeoff between a potentially advantageous earlier filing date and a concomitant potentially disadvantageous earlier end to patent term can lead to decisions about claiming priority that subsequently result in unintended consequences.

In the most straightforward scenario, when the subject matter of a new application is the same as the subject matter of a previously filed application but does not claim priority to that previously filed application, the previous application can become a prior art reference that anticipates the new application.⁴ This scenario is one in which a priority claim is not only proper but also necessary for patentability of the new application. On the other end of the spectrum, claiming priority to a previously filed application that does not include descriptions to support the claims in the new application does not properly establish priority and, if challenged, may not provide the benefit of the earlier filing date.⁵ This scenario is one in which a priority claim may

Acacia T. Tam was a technology specialist at Wolf, Greenfield & Sacks, P.C., in the firm's Electrical & Computer Technologies Practice in patent prosecution. Usha K.M. Parker (usha.parker@wolfgreenfield.com), counsel to the firm, focuses her practice on all aspects of patent prosecution related to electrical and mechanical technologies.

be improper and creates a subsequent hazard for the new application.

Between those two positions, the decisions of whether to claim priority and what to claim priority to are not always easy and must be made and maintained with care. The most complicated situations generally involve multiple branches of applications that claim priority to one or more earlier-filed applications and chains of applications that claim priority to an earlier-filed application through the links of the chain. These situations are further complicated when one or more applications that claim priority add subject matter to the earlier-filed application. In addition to decisions about making a priority claim in a new application, there are decisions about the best way to file an application that will become the priority application for subsequent filings. Understanding both the requirements and the considerations for priority claims can guide decisions to properly protect intellectual property.

HOW IS PRIORITY CLAIMED?

A U.S. application is eligible to claim priority to an earlier-filed application if the claimed invention in the new application is described in the previously

filed application, both applications share at least one common inventor, and the new application is filed within a specified timeframe.⁶

The specified timeframe associated with the eligibility of a new application to make a priority claim may be based on the filing date of the earlier-filed application (referred to as the priority application) or on the pendency of the priority application or another already-filed application that claims priority to the priority application. Table 1 provides an overview of the different bases for eligibility to a priority claim, each of which is further detailed. If the new application is deemed eligible to an earlier effective filing date than the date of filing, an explicit priority claim must be made, as further discussed. By understanding the goals and needs of an applicant, in addition to the laws and rules that govern priority claims, the most appropriate basis for claiming priority can be selected.

Eligibility Based on Filing Date of Priority Application

As Table 1 indicates, there are several types of applications that create a time window within which a new application benefiting from a priority

Table 1. Bases of Priority Claims

PRIORITY BASED ON FILING WITHIN A DEFINED PERIOD OF A PRIORITY FILING	
Priority Application Filed Is:	U.S. Application Claiming Priority Must Be Filed Within:
i. Provisional application	12 months of filing provisional application
ii. Foreign application (depending on country of origin)	12 months of filing foreign application
iii. Patent Cooperation Treaty (PCT) application	30 months of PCT filing date (as national stage application)
	30 months of PCT filing date (as bypass continuation application)
iv. Initial Application followed by PCT application (within 12 months of initial)	30 months of filing Initial application
PRIORITY BASED ON PENDENCY OF A PRIORITY FILING	
New Application Is:	Basis:
v. Continuation application	No addition to priority application disclosure
vi. Divisional application	No addition to priority application disclosure; claims were restricted during prosecution of priority application
vii. Continuation-in-part application	Addition to priority application does not benefit from priority filing date

claim can be filed. The choice of which type of priority application to file should be based in consideration of the tradeoffs represented by each.

Provisional Application

The filing date of a provisional application can be claimed as the effective filing date of a new non-provisional application filed within one year from the date of filing of the provisional.⁷ A provisional application is unlike any other application in some significant ways that make it a perfect anchor for subsequent priority claims. A provisional application is never examined and can never become an enforceable patent, so its primary purpose is to establish a priority date. As such, claiming priority to a provisional application does not affect the pendency of a patent resulting from the non-provisional application. The format of a provisional application need not follow the structure of a non-provisional application, although a specification and a drawing are required, and no claims are required in the provisional application.⁸ This relative informality, along with a substantially lower filing fee than for a non-provisional application, can make a provisional application an expedient and cheap shield against a potential loss of rights.

For example, significant milestones reached during the development of a patentable product or method may be protected prior to completion of the full project. In this case, multiple provisional applications may be filed, and a subsequent non-provisional application may claim the benefit of priority stemming from any or all of those provisional applications based on the purpose of the particular non-provisional application. The effective filing date for the non-provisional application will be the earliest priority date (i.e., the filing date of the earliest provisional application that is claimed). However, as discussed below with reference to some recent cases, a given claim of the non-provisional application may not benefit from that effective filing date. If challenged, the given claim may only benefit from the filing date of whichever of the provisional applications provides support for the subject matter of the claim.

As another example, if a disclosure of patentable subject matter is planned (e.g., in a publication, presentation, pitch, marketing material), the material can first be filed as a provisional application to protect against loss of rights based on public

disclosure. This approach is especially important if a patent will ultimately be pursued in a country, unlike the United States, where disclosure can bar subsequent patentability without any grace period. The provisional application establishes a priority date for the submitted material. A caveat being that only subject matter that was sufficiently described in the material may benefit from the filing date of the provisional application. Thus, it may be advisable to augment the material that is being submitted to include all the details known at the time of filing of the provisional application. It may be helpful to add one or more claims, as well, even if a full application is prohibited by time constraints imposed by the upcoming disclosure.

Foreign Application

The filing date of a foreign-filed application can be claimed as the effective filing date of a new U.S. application that is filed within one year of that filing date. This is possible if the foreign-filed application was filed in a country that is party to the Paris Convention or is a member of the World Trade Organization (WTO).⁹ Like claiming priority to a provisional application, claiming priority to a foreign application does not affect pendency of a subsequent patent. Unlike claiming priority to a provisional application, which is never examined, claiming priority to a foreign application comes with additional duties. For example, references cited against the foreign application are subject to a duty of disclosure to the United States Patent and Trademark Office (USPTO) during examination of the application claiming priority to the foreign application and must be cited in an information disclosure statement (IDS).

A patent application may be filed in a foreign country first, based on the business needs or preference of an applicant (e.g., country projected to have the largest number of sales of the claimed invention). In some instances, the country of first filing may be less a matter of choice than a necessity based on the country of residence of one or more inventors. Many countries, including the United States, require first filing in the country of residence of an inventor. For residents of those countries, to first file in a country other than the country of residence, a foreign filing license (FFL) must be obtained.¹⁰ While some countries, such as the United States, are known to issue an FFL

to a resident inventor who will file a first patent application in a different country fairly quickly (e.g., within a week), others can take months. In those countries, filing a provisional or non-provisional patent application to fulfill the first-filing requirement can expedite a subsequent filing in another country, such as the United States. The subsequent filing can claim priority to the first filing.

Patent Cooperation Treaty (PCT) Application

An application filed under the PCT can provide a window of up to 30 months for filing of a subsequent application that claims priority to the PCT filing date. The same PCT filing can be used to pursue patent protection in over 150 countries. Thus, a PCT application can be an efficient and valuable pathway for an applicant who foresees having a multinational sales or manufacturing network.

As Table 1 indicates, a PCT application can enter national phase examination in the United States in two different ways. According to one way, the PCT application can enter national stage in the United States (and many other countries) through designation of the USPTO as a receiving office.¹¹ In this case, amendments to the claims may be filed prior to examination in the USPTO.¹² An important potential hazard created by a national stage application is that a Request for Continued Examination (RCE) cannot be filed during prosecution if a Declaration has not been filed.¹³ Thus, entering national phase examination as a national stage application without a signed Declaration can result in abandonment of the application after a final rejection in the USPTO if a Declaration cannot be submitted before the statutory bar date for filing a needed RCE.

In the United States, national phase examination of a PCT application can alternately commence as a bypass continuation application.¹⁴ This as a special case, because, as a continuation, the priority claim is based on pendency of the priority application. However, the pendency and the priority window are both 30 months from the filing date of the PCT application. Unlike a national stage application, a bypass continuation can have subject matter modified or added to have the application treated as a continuation-in-part (CIP). In this case, only the subject matter that was also in the PCT application will benefit from the earlier filing date of the PCT

application and, like any CIP, the new matter is susceptible to the parent (PCT) application being used as prior art. Unlike in a national stage application, an RCE may be filed prior to filing the Declaration, and expedited Track One Prioritized Examination, not available to a national stage application, may also be pursued.

Initial Application Followed by PCT Application

A PCT application may, itself, claim priority to an earlier-filed (specifically, first-filed) U.S. or foreign application.¹⁵ In this case, the PCT application must be filed within a year of the earlier-filed provisional or non-provisional application. A subsequent national stage or bypass continuation application must be filed within 30 months of the earlier-filed U.S. or foreign application from which the PCT application claims priority. This approach allows an applicant to first file and begin the patenting process in the most important jurisdiction for their purposes (e.g., where most sales are expected, where manufacturing will take place) before undertaking the longer PCT pathway for patent protection in additional countries.

Eligibility Based on Pendency of Priority Application

As Table 1 indicates, there are several types of applications that can claim priority to a previously filed application based on its pendency. While the previously discussed provisional, foreign-filed, and PCT applications are the first (or second, in the case of a PCT application claiming priority to an earlier-filed application) link in a chain of priority, applications that claim priority based on pendency of earlier-filed applications can be further (second, third, or more) links in a chain of priority.

Continuation Application

A continuation application can be filed before a previously filed application (the parent application of the continuation) issues as a patent or is abandoned.¹⁶ The parent to the continuation application may, itself, have been a continuation application. The grandparent of the current continuation application may have been a continuation application, as well. In this way, a long chain may be created of applications with effective filing dates that are the filing date of the first-filed application in the chain (e.g., a provisional or non-provisional application, a foreign

application, a PCT application). The substantive subject matter in the specification and drawings of the parent application may not be altered in a continuation application.

For any technology deemed important to a patent owner, it can be a good idea to maintain pendency of a patent family by filing continuation applications as prior applications in the family are allowed and issue as patents. Continuation applications facilitate pursuing claims of different focus and scope, including broader scope, from those in parent applications. Maintaining pendency of a patent family can also facilitate flexibility and allow claims directed to competitor activity in the future or additional claims if one or more parent patents are targeted for invalidation. In some cases, multiple (sibling) applications may be filed as continuation applications claiming priority to the same pending priority application to allow different claims to be pursued, simultaneously, in each.

Divisional Application

A divisional application is very much like a continuation application, except that it is specifically triggered by a restriction requirement, issued by the USPTO examiner, identifying some of the claims of the parent application as belonging to a different invention.¹⁷ Those claims may be filed, with the specification and drawings of the parent application, as a divisional application. Like a continuation application, a divisional application must leave the substantive disclosure of the parent application unchanged.

Continuation-in-Part Application

Whether filed as a continuation application or a divisional application claiming priority to a priority application, the addition of new matter results in a CIP.¹⁸ Filing a CIP instead of a new application for the new matter has the downside of tying patent term of the CIP to the effective filing date. On the other hand, a CIP allows the patent owner to manage a single priority chain.

Making the Claim

Even when one or more of the conditions set out in Table 1 apply, a priority claim to an earlier effective filing date must be made expressly. To claim priority, a complete listing with a “specific reference” to the priority application and any intervening

applications that establish the chain of priority must be included in the application data sheet.¹⁹

Applications claiming priority to a provisional application or foreign application, or based on pendency of the priority application, may also include the “specific reference” to earlier filed applications in the specification, along with a statement expressly incorporating each prior application.²⁰ The specific reference and incorporation statements are typically included in a cross-reference to related applications paragraph in the specification.²¹

An express incorporation by reference of the priority application and all intervening applications in a priority chain may be included in the specification, in the cross-reference to related applications, and can be advantageous, especially when translations are involved.²² The addition of the cross-reference paragraph or additions to a cross-reference paragraph are permissible modifications to an original application, as they do not substantively change the disclosed subject matter.

If a priority claim is not made at the time of filing of the new application, it must be made within 4 months of filing the application or within 16 months from the filing date of the priority application, whichever is later.²³ Based on a priority claim, any portion of the specification or drawings of the priority application that is inadvertently omitted in the filing of the application claiming priority is deemed incorporated from the priority application by reference.²⁴

HOW IS PRIORITY ESTABLISHED?

While the mechanics of claiming priority can be fairly straightforward, properly establishing priority may be less clear and more challenging. That is, making a priority claim in an application may not necessarily mean that the claims of a resulting patent will benefit from the effective filing date when it matters most. Validity of a priority claim can typically be challenged based on support for the claims at issue in the priority application and on missing or problematic links in a chain of priority.

Written Description Support

The requirement that a disclosure provide written description support and enablement for claims applies to all patent applications.²⁵ During examination of an application, a USPTO examiner is charged with ensuring compliance with this requirement.

Thus, when the substantive disclosure of a given application is the same as that of the priority application (e.g., a national stage application, continuation, divisional), the priority claim is presumed to be verified when the examiner determines that the application disclosure (also the priority disclosure) does support the claims.

However, when the disclosure of a given application is modified from that of the priority application (e.g., non-provisional claiming priority to an incomplete provisional, continuation-in-part), the USPTO examiner will not necessarily address whether the effective filing date applies to each claim by considering whether a claim is supported only by the modified (later-filed) subject matter or also by the priority application. Thus, as noted by the U.S. Court of Appeals for the Federal Circuit, a patent resulting from such an application is not presumed to be entitled to the earliest filing date according to the priority claim.²⁶ The issue of whether an effective filing date properly applies to a claim is generally raised in an invalidity action (e.g., because a reference cited against the claim qualifies as prior art based on the filing date but not the (earlier) effective filing date) or in a non-infringement position (e.g., because the claim (asserted to be infringed) only predates alleged infringing activity if it can benefit from the earlier priority date).

A 2018 Federal Circuit case is an example of an infringement action being thwarted by a finding that the priority date of the alleged infringed claims was not properly established.²⁷ Because the dates of the alleged infringing activity precede the filing dates of the patents at issue, priority claims to a provisional application that pre-dates the alleged infringing activity were necessary for the infringement suit.²⁸ A motion for summary judgment was granted by a lower court to SunModo, the alleged infringer, and affirmed by the Federal Circuit. The Federal Circuit noted the burden on the patent owner, D Three, to establish entitlement to the claimed priority date.²⁹ With regard to the written description requirement, the court stated that boilerplate broadening language in the priority application was insufficient to support the actual combinations claimed in the patents at issue.³⁰

Another Federal Circuit case presents an example of an invalidity action being based on a prior art reference that does not predate the priority

application but is deemed properly cited against the later-filed patent at issue because the priority date was not properly established.³¹ LAB's priority claim to its provisional application failed because the dosage recited in the claims was not clearly disclosed in the provisional application but, instead, would have required "persons of skill to look to the prior art and make assumptions."³²

A recent case illustrates that written description support can pose a danger both when there is a claim to priority, as in the cases discussed above, and when there is not. In the 2023 decision, the Federal Circuit affirmed invalidation of Arbutus' '127 patent claims by the Patent Trial and Appeal Board (PTAB).³³ The '127 patent was filed during pendency of Arbutus' '069 patent but did not claim priority to the '069 patent. The court affirmed invalidation of the '127 patent claims as being anticipated by the '069 patent, subject matter incorporated by reference in the '069 patent, and a claim limitation asserted to be inherently disclosed in the '069 patent.³⁴ This case is a reminder to consider not only whether a priority claim being made is proper but also whether a priority claim that is not planned is actually necessary.

Make the Chain, Don't Break the Chain

Chains of priority involve multiple patents forming links in the chain and claiming priority to the same first link in the chain. The links in the chain may be continuations or may be divisionals or CIPS, which form another branch from the chain, and a chain may begin with a provisional or non-provisional U.S. filing, a foreign-filed application, or a PCT. For example, the first-filed application (the first link in the chain) may be a provisional application that is followed by a non-provisional (second link). A continuation (third link) may be filed during pendency of the second link, the non-provisional parent, and a CIP (fourth link) claiming benefit of the provisional (first link) filing date through the continuation (third link) and the non-provisional (second link) may be filed. Priority chains allow pendency of a patent family and provide advantages, like the flexibility to address new infringing activity through a new link in the chain with an effective filing date that goes back to the first link. However, issues with one link in a priority chain can expose multiple links to loss of priority.

Making a priority claim without the requisite specific reference to every intervening application linking the current application to the priority application is an avoidable yet not-uncommon mistake. In a 2014 case, the Federal Circuit affirmed invalidation of some of Medtronic's '281 patent claims based on a limitation on Medtronic's priority claim.³⁵ The Federal Circuit agreed with the lower court's ruling that deficiencies in the reference to earlier filed applications (i.e., deficiencies in making the priority claim) in two intermediate applications (but not in the '281 patent itself) were sufficient to cut the chain of priority recited and relied on by the '281 patent and limited the date to which the '281 patent could claim priority.³⁶

In a 2018 case, the Federal Circuit affirmed the PTAB's invalidation of claims of Droplets' '115 patent as obvious in view of an earlier-filed reference based on an improper priority claim by Droplets.³⁷ The '115 patent expressly claimed priority to an immediately preceding application (an intermediate application) but not the provisional application filed before the intermediate application. As a result, an international publication with the same specification as the provisional application could be used to invalidate the claims of the '115 patent. The Federal Circuit made clear the requirement to recite an unbroken chain of priority and rejected Droplets' contention that it could rely on incorporation of the intermediate application, which did properly claim priority to the provisional application, to fulfill that requirement.³⁸

As important as it is to properly establish the chain of priority, through clear and complete reference to each link in the chain, it is just as important not to subsequently break the chain, once established. The priority date of NAI's eighth application in a chain was limited by the USPTO, as affirmed by the Federal Circuit, based on actions taken in the fifth application in the chain.³⁹ The fifth application, a CIP that initially claimed priority to the fourth through first applications in the chain and also to a provisional application outside the chain, deleted its priority claim to the fourth through first applications. This extended the patent term of the fifth application. However, an apparent unintended consequence to the sixth through eighth applications was that they, too, could only benefit from priority to the provisional application, because it was the

only prior application to which there was still an unbroken chain via the fifth application.⁴⁰

A chain of priority can be broken even without an explicit deletion of a priority claim in one of the links. The PTAB found, and the Federal Circuit affirmed, that Arthrex's '907 patent lost the benefit of priority via a chain that included the '707 application.⁴¹ The chain of priority was deemed to be severed by the '707 application's criticism of an embodiment in a prior application in the priority chain that provided written description support for claims in the '907 patent.⁴²

CONCLUSION

Patent practitioners should understand when and how to claim priority. During the drafting and prosecution of any case involved in a chain of priority, the effect of actions taken in that case on other applications in the chain should be considered. When used correctly, priority claims can be a flexible and powerful tool for assertion and protection of a patent owner's rights.

Notes

1. 35 U.S.C. §§ 119, 120.
2. 35 U.S.C. §§ 102(a), 102(b).
3. 35 U.S.C. § 154(a)(2).
4. 35 U.S.C. § 154(a)(2).
5. 35 U.S.C. § 112.
6. 35 U.S.C. §§ 119, 120.
7. 35 U.S.C. § 119(e).
8. 35 U.S.C. § 111(b).
9. 35 U.S.C. § 119.
10. 35 U.S.C. § 184.
11. 35 U.S.C. § 371.
12. 35 U.S.C. § 371.
13. 37 C.F.R. § 1.114(e)(3).
14. 35 U.S.C. § 111.
15. MPEP 1842.
16. 35 U.S.C. § 120.
17. 35 U.S.C. § 121.
18. MPEP 201.08.
19. 37 C.F.R. § 1.78.
20. 35 U.S.C. §§ 119, 120.
21. 37 C.F.R. § 1.77.
22. 37 C.F.R. §§ 1.57, 1.77.
23. *Id.*
24. 37 C.F.R. § 1.57.
25. 35 U.S.C. § 112(a).
26. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299; 86 U.S.P.Q.2D 1385 (Fed. Cir. 2008).

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27. D Three Enterprises, LLC v. SunModo Corporation, 890 F.3d 1042 (Fed. Cir. 2018).
28. Id. at 1045.
29. Id. at 1049, citing In re magnum Oil Tools Int'l, Ltd., 829 F.3d 1364, 1376 (Fed. Cir. 2016).
30. Id. at 1051.
31. L. A. Biomedical Research Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co., 849 F.3d 1049 (Fed. Cir. 2017).
32. Id. at 1058.
33. Arbutus Biopharma Corporation v. ModernaTx, Inc., No. 2020-1183 (Fed. Cir. 2023).
34. Id.
35. Medtronic Corevalve, LLC v. Edwards Lifesciences Corporation, No. 2013-1117 (Fed. Cir. 2014).
36. Id.
37. Droplets, Inc. v. E*Trade Bank, 887 F.3d 1309 (Fed. Cir. 2018).
38. Id. at 1318.
39. Nat. Alts. Int'l, Inc. v. Iancu, 904 F.3d 1375 (Fed. Cir. 2018).
40. Id. at 1381.
41. Arthrex, Inc. v. Smith & Nephew, Inc., 35 F.4th 1328 (Fed. Cir. 2022).
42. Id. at 1342.

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