

HARARI INCORPORATION-BY-REFERENCE: A SENSIBLE STANDARD*

Harold C. Wegner**

I. SUMMARY

In *Harari v. Hollmer*, ___ F.3d ___ (Fed. Cir. 2010)(Prost, J.), the Federal Circuit made a positive contribution to the law of incorporation-by-reference of essential materials from a related patent application necessary to provide an enabling disclosure under 35 USC § 112, ¶ 1, where the referenced application is not identified by serial number. *Harari* represents a positive endorsement of the incorporation-by-reference practice that permits minimizing the actual text in individual patent applications. This not only saves on paper and helps mitigate electronic clutter but, from an applicant's standpoint, minimizes the amount of text that otherwise can be an unnecessary expense when parallel foreign filings require expensive translations charged at cost per word.

The *Harari* case follows the pattern of incorporation-by-reference for contemporaneously filed information in a related case approved in *In re Fouche*, 439 F.2d 1237, 1239 (CCPA 1971), where the Office has not yet provided the serial number for that case. See § II, *Fouche Incorporation-by-Reference*. The

* This paper represents the personal views of the writer and does not necessarily reflect the views of any colleague, organization or client thereof.

** Former Director of the Intellectual Property Law Program and Professor of Law, George Washington University Law School. Partner, Foley & Lardner LLP. hwegner@foleycom.

Court in *Harari* restates the law of new matter as to an incorporation-by-reference to a “reasonable examiner” standard. *III. Restatement of the Law in Harari.* The restated standard is whether the identity of the document incorporated by reference be clear to a reasonable examiner based upon the documentary evidence in the case? *See § III-A, Following the Fouche Standard.* In reaching its conclusion keyed to a “reasonable examiner”, the suggestion is made that if the same question is presented in the context of a validity determination for a granted patent, the standard may be keyed not to a “reasonable examiner” but instead to a person skilled in the art. *See § III-B, Different Incorporation Standards Pre- and Post-Grant.*

The Court also integrates the law of incorporation-by-reference of *patent* documents in a patent law context with the law of incorporation-by-reference of documents outside the patent law context. *See § IV, Non-Patent Law Incorporation-by-Reference.* *Fouche* and *Harari* make an excellent foundation for an international standard, while at the present time open questions remain. *See § V, Conclusion.*

II. FOUCHE INCORPORATION-BY-REFERENCE

The *Harari* case follows the pattern of incorporation-by-reference approved in *In re Fouche*, 439 F.2d 1237, 1239 (CCPA 1971), for contemporaneously filed information in a related case where the Office has not yet provided the serial number for that case.

In essence, under the *Fouche* practice it is quite common for related patent applications to be filed at about the same time where a critical information common to the inventions in both applications is set forth in detail in only one of the applications, but there is an express incorporation-by-reference of the common

subject matter in the original application. But, since the serial number of the referenced application may not be known at the time of filing, the referenced application is identified by *other* information such as the inventors' names and title of the application, with the serial number being identified in blank. For example: "This application incorporates-by-reference the method for making the starting material of this invention which is disclosed in the concurrently filed application of Robert A. Smith and Sarah P. Jones, *Method for making Such'n'So Compounds*, serial no._____."

The cross reference is specific to one and only one application that lacks only the serial number identification, so it is not new matter to add the serial number by amendment.

A. The Factual Setting of *Fouche*

In the original *Fouche* application documents critical disclosure as to how to make the claimed compound was referenced to a copending application that was not identified by serial number: "The specification ... state[s] that the compound can be 'prepared as described in Example I of our application No._____ ". No other identification of the referenced application was given at the time the instant application was filed. Appellant later attempted, by amendment, to change the referring language from 'our application No._____' to 'my Application Serial No. 459,921 filed May 17, 1965.' The Patent Office did not assign this serial number to the earlier application until after the instant application was filed." *Fouche*, 439 F.2d at 1238. Thus, "[t]he question to be decided ... is... whether the language 'our application No. ,' together with [a] reference to Example I [which identifies the subject matter of the incorporation-by-reference], distinguished the application which later received serial No. 459,921 from all others. If it did, there can of

course be no ‘new matter’ problems, since the amendment entering the serial number and filing date would amount to a mere change in wording.” *Fouche*, 439 F.2d at 1239.

The incorporation-by-reference of the copending application was permitted without introduction of new matter under 35 USC § 132 based upon considerations including several factors:

“[I]t is undisputed that, at the time of filing the present application, appellant in fact had on file in the Patent Office an application containing enough information to complete his disclosure as to the appealed claims. It is therefore clear that he had solved, as of his present filing date, any technical problems involved in making and using the claimed compositions. This is a major consideration in judging compliance with the first paragraph of § 112. See *In re Argoudelis*, 434 F.2d 1390 (CCPA 1971), and especially Judge Baldwin's concurring opinion therein.

“[A]pplication serial No. 459,921 does in fact contain an ‘Example I’ disclosing a method for preparing [the starting material]. We note that in *Ex parte Harvey*, [163 USPQ 572 (P.O. Bd. App. 1968)], the board looked to the nature of the subject matter disclosed in the earlier application as one means of linking that application to the referring language.

“[And], there has been no showing by the Patent Office that there existed any other application to which the referring language could have pertained.” *Fouche*, 439 F.2d at 1240.

B. The Differing Facts in *Harari*

Whereas the incorporation-by-reference in *Fouche* was in an *original* application without parentage that referenced a contemporaneously filed application without serial number identification at the time of filing, in *Harari* the incorporation-by-reference was in a *continuing* application identical to the parent application: Thus, by the time of the *continuing* application all information about the serial numbers of the application was known.

Thus, in the parent application the referenced application was not identified by serial number because it was filed on the same day as the parent application. The referenced application was identified by “the title of the application, named inventors, and the fact that the application was filed on the same day as the [parent] application.” In the continuing application, the same text was used including citation of the referenced application as having a filing date which is the “same day as the present application”.

Of course, the latter information incorrect because the filing date is the same date as the *parent* case and not the continuing case. This ambiguity was excused and the amendment adding the correct serial number was found not to constitute new matter. In reaching this conclusion, the Court restated the *Fouche* standard for incorporation-by-reference without new matter.

III. RESTATEMENT OF THE LAW IN *HARARI*

A. Following the *Fouche* Standard

In reversing the Board’s finding of “new matter”, the Court restated the law on incorporation-by-reference to a standard of whether “the identity of the incorporated reference is clear to a reasonable examiner in light of the documents presented”. *Harari*, __ F.3d at ____. More completely, the Court stated:

“[T]he Board appears to have applied the wrong standard in determining that the incorporation language was confusing. The disputed continuation application is at the initial filing stage, where the examiner is first presented with an original disclosure and a preliminary amendment. The proper standard by which to evaluate the sufficiency of incorporation by reference language, at this stage of the proceedings, is whether the identity of the incorporated reference is clear to a reasonable examiner in light of the documents presented.” *Harari*, __ F.3d at __ (footnote omitted)

Relying upon the leading *Fouche* case, the Board further explained that “the relevant inquiry is whether a reasonable examiner would be so befuddled by the language of the original disclosure, despite the explanation provided in the transmittal and preliminary amendment, that he could not determine what document was intended to be incorporated by reference.” *Id.* (citing *Fouche*, 439 F.2d at 1239).

The Court in *Harari* expressly endorsed the policy of incorporation-by-reference of copending applications without serial number identification:

“It is not inappropriate for an application to identify for the purposes of incorporation by reference a co-pending application by title, inventors, and a context-specific filing date, where such information is sufficient to identify the application at the time the information is presented. 37 C.F.R. § 1.57(g)(2). It is not new matter, and indeed it is strongly encouraged, to later amend the identifying language to recite a serial number and filing date, when that information becomes available. *Id.*; see also *Schering Corp. v. Amgen Inc.*, 222 F.3d 1347, 1352-53 (Fed. Cir. 2000) (holding that renaming or re-identifying items in the disclosure to comport with later-developed and more precise nomenclature is not new matter). There is no specific deadline by which such a clarifying amendment must be made.”

B. Different Incorporation Standards Pre- and Post-Grant

In *dictum*, the court suggested that the standard for whether incorporation is proper *after* grant focuses upon the understanding of a person skilled in the art, as opposed to a pre-grant standard of the understanding of a reasonable examiner:

“[I]f we were determining the validity of an issued patent containing the disputed incorporation by reference statement, ‘filed on the same day as the present application,’ where that language actually refers to an application other than the one issued, then we would be concerned with whether one of ordinary skill in the art could identify the information incorporated.” *Harari*, ___ F.3d at ___ n.2.

Of course, whenever there is an incorporation-by-reference to a copending application that is not identified by serial number, it is incumbent upon the applicant to amend the specification during the application procedure to add the missing serial number, and if the applicant fails to do so, the Examiner must reject the claims based upon such an incorporation-by-reference until the necessary amendment adding the serial number is made. Therefore, this should not in practice be a problem. This is implicitly recognized by the Court in *Harari* itself: “The present case... does not involve ... language that is intended to appear in an issued patent. Thus the proper lens through which to view the disputed language is that which is ascertainable to a reasonable examiner.” *Id.*, ___ F.3d at ___ n.2.

IV. NON-PATENT LAW INCORPORATION-BY-REFERENCE

Citing *Northrop Grumman Info. Tech., Inc. v. United States*, 535 F.3d 1339 (Fed. Cir. 2008), the Court also integrated the law of incorporation-by-reference of key disclosure in a *patent* document with the law established in this area for incorporation-by-reference in a *non-patent law* context. The court first noted several *patent* cases involving incorporation-by-reference, citing *Zenon Env'tl., Inc.*

v. U.S. Filter Corp., 506 F.3d 1370, 1378-81 (Fed. Cir. 2007); *Cook Biotech, Inc. v. Acell, Inc.*, 460 F.3d 1365, 1376-78 (Fed. Cir. 2006); *Advanced Display Sys. v. Kent State Univ.*, 212 F.3d 1272, 1283-84 (Fed. Cir. 2000), and noted that the Federal Circuit “ha[s] not often heard a government contract appeal that turns on a question of incorporation by reference, and our case law in this area somewhat sparse.” *Northrop Grumman*, 535 F.3d at 1343-44.

The Court then restated the *patent* standard for incorporation-by-reference:

“[T]o incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents [identified].” *Northrop Grumman*, 535 F.3d at 1344 (quoting *Cook Biotech*, 460 F.3d at 1376, *Advanced Display Systems*, 212 F.3d at 1282).

Thus, “[i]n other words, the incorporating contract must use language that is *express and clear*, so as to leave *no ambiguity about the identity of the document being referenced, nor any reasonable doubt about the fact that the referenced document is being incorporated into the contract.*” *Id.* (emphasis added).

V. CONCLUSION

Incorporation-by-reference continues to be a valuable tool to simplify patent drafting by eliminating redundant disclosures in multiple applications. As the electronic filing era proceeds and with the ease of internet hyperlinks, it may be anticipated in the future that a regime of hyperlinked incorporation-by-reference of essential documents may be established on a global basis. Not only would individual documents be made simpler, but translation costs for global filing programs could be significantly impacted.

At the same time, it must be recognized that each national patent regime may have differing standards on incorporation-by-reference. Therefore, while this paper provides an analysis of *domestic* considerations keyed to *Fouche* and *Harari*, it would be useful as a matter of future global patent simplification to have the standards set forth here codified for international patent procedures in the major countries of the world.