

such a statement in the body of the specification, if appropriate.

Sometimes applicants intentionally omit material from a prior-filed application when filing an application claiming priority to, or benefit of, a prior-filed application. As discussed, the incorporation by reference would only permit material that was inadvertently omitted from the application to be added to the application if the omitted material is completely contained in the prior-filed application. Therefore, if the proposed rule were adopted, applicants would still be able to intentionally omit material contained in the prior-filed application from the application containing the priority or benefit claim without the material coming back in by virtue of the incorporation by reference. Applicants would be able to maintain their intent by simply not amending the application to include the intentionally omitted material. Thus, there should be no impact from the proposed rule in continuing applications where material from the prior application has been intentionally omitted. Therefore, the proposed rule has been drafted such that the application claiming benefit of a prior U.S. application could be a continuation-in-part application (as well as a continuation or divisional).

The proposed rule would not apply to any applications filed before the effective date of the rule. The proposed rule would be prospective only since to apply the rule retroactively would result in changing the expectations regarding incorporation by reference by applicants when the applications were filed.

The Office is interested in comments from the public regarding proposed § 1.57(a), whether there is support or opposition for the proposed rule, and whether there is any desire to limit the proposed rule to continuation or divisional applications and not have it apply to continuation-in-part applications.

Section 1.57(b) clarifies what is acceptable language that identifies an incorporation by reference for essential and non-essential matter as opposed to incorporation by reference of material in a prior application as is proposed in § 1.57(a). Applicants sometimes refer to other applications, patents, and publications, including patent application publications using language which does not clearly indicate whether what is being referred to is incorporated by reference or is just an informational reference. The Office is proposing to limit incorporation by reference (except as provided in § 1.57(a)) to instances only where the words "incorporated by reference" appear. The Office is

attempting to bring greater clarity to the record and provide a bright line test as to where something being referred to is an incorporation by reference. The Office considered the alternative of making any mention of a document an automatic incorporation by reference of the document. Patent applications frequently contain a discussion of prior art documents when discussing the background of the invention, which prior art documents are not intended to be incorporated by reference. The necessity for § 1.57(b) is that applicants who fail to clearly link certain disclosures to means-plus-function language risk having their claims interpreted too narrowly or held unenforceable. Clarifying when material is incorporated by reference during examination by use of specific trigger language is considered an aid to applicants when they invoke 35 U.S.C. 112, ¶ 6. Applicants would be aided by avoiding narrowed claim construction as a result of a number of court decisions which would not look for equivalents outside of the application. See *Atmel Corp. v. Info. Storage Devices Inc.*, 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999), and *B. Braun Medical Inc. v. Abbott Lab*, 124 F.2d 1419, 43 USPQ2d 1896 (Fed. Cir. 1997). Treating these documents as automatically incorporated might result in unintended consequences such as when a means-plus-function claim is presented under 35 U.S.C. 112, ¶ 6.

Similarly, applicants would be aided by not having their claims found unpatentable by a mere reference to outside material unintentionally incorporating material that contained equivalents that would broaden their claims to encompass the prior art. Automatic incorporation by reference would create a trap for applicants and practitioners by creating unintentional equivalents for 35 U.S.C. 112, ¶ 6, language broadening claims to be unpatentable. Additionally, as claims are generally read in light of the specification, what is actually incorporated into the specification can affect the scope of the claims independent of 35 U.S.C. 112, ¶ 6.

Accordingly, comments are desired identifying alternative language to that proposed in paragraph (b) or why requiring this specific language would be a problem.

A patent application incorporating by reference other material must, as described in paragraph (b), include an identification of the referenced patent, application, or publication pursuant to § 1.98(b)(1) through (b)(5). The Office recommends that particular attention be directed to specific portions of

referenced documents where the subject matter incorporated may be found if large amounts of material are incorporated. Guidelines for situations where applicant is permitted to fill in a number for Application No. ____ left blank in the application as filed can be found in *In re Fouché*, 439 F.2d 1237, 169 USPQ 429 (CCPA 1971). Commonly assigned abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications; both types are open to the public upon the referencing application issuing as a patent. See MPEP § 103.

Section 1.57(c) codifies current practice in MPEP § 608.01(p) (Incorporation by Reference), except that § 1.57(c) as proposed is limited to U.S. patent or U.S. patent application publications (*i.e.*, the Office proposes to eliminate the practice of incorporating by reference essential material in unpublished patents in which the issue fee for an application has been paid but the application has not yet issued as a patent). Delays in issuance or the withdrawal from issue of an allowed application put in doubt that an application incorporated by reference will be available to the public when a patent incorporating the other application issues. Similarly, this provision permitting only the incorporation of the publication document of an application is intended to preclude incorporation by reference of material found only in the redacted portion of a published patent application.

Section 1.57(c) updates current practice to reflect publication of applications in two areas. Current practice permits holding in abeyance correction of material incorporated by reference from unpublished U.S. applications that have not issued as patents until allowance of the application making the incorporation by reference. Publication of the applications which contain an incorporation by reference means that the public will need access to the material incorporated by reference prior to an application being issued as a patent. Where the incorporation is to an unpublished application that has not issued as a patent, such application is not readily available. Therefore, holding the correction of an incorporation by reference in abeyance in this situation will materially impair the public's access to the invention that is disclosed by the published application that incorporates an unpublished application.

The Office considered but rejected including unpublished abandoned