

Zenon Env'tl., Inc. v. United States Filter Corp.

Nos. 06-1266, -1267, Federal Circuit (Newman, Lourie,* Linn)

“To 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.”

On November 7, 2007, the Federal Circuit reversed the district court’s judgment that U.S. Patent No. 6,620,319, which related to large scale water treatment involving microfiltration, was not invalid as anticipated under 35 U.S.C. § 102. The Federal Circuit stated:

“In order to gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” Thus, in order for the ‘319 patent to be entitled to priority from the ‘373 patent, continuity of disclosure must have been maintained throughout a chain of patents from the ‘373 patent leading up to the ‘319 patent.

Incorporation by reference “provides a method for integrating material from various documents into a host document . . . by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were explicitly contained therein.” “To 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.” Whether material has been incorporated by reference into a host document, and the extent to which it has been incorporated, is a question of law. In making that determination, “the standard of one reasonably skilled in the art should be used to determine whether the host document describes the material to be incorporated by reference with sufficient particularity.”

We have previously described incorporation by reference and anticipation as separate inquiries. “[I]f incorporation by reference comes into play in an anticipation determination, the court’s role is to determine what material in addition to the host document constitutes the single reference. The factfinder’s role, in turn, is to determine whether that single reference describes the claimed invention.”

In the present case, US Filter asserted that the ‘319 patent was invalid by reason of anticipation, and thus was required to prove by clear and convincing evidence that each and every element of the claimed invention was described in [U.S. Patent No. 5,639,373]. [W]e disagree with the court’s conclusion that the intervening patents incorporated by reference, with sufficient particularity to one reasonably skilled in the art, the gas distribution system disclosed in the ‘373 patent. . . . We are not persuaded by Zenon’s assertion, which the trial court accepted, that that language incorporates by reference the entire disclosures of

the '373 and '083 patents. Such an interpretation is inconsistent with the plain language of the statement. The plain language expressly limits the incorporation to only relevant disclosures of the patents, indicating that the disclosures are not being incorporated in their entirety. Moreover, the plain language indicates that the subject matter that is being incorporated by reference pertains to the details relating to the construction and deployment of a vertical skein. Thus, we must look, as one reasonably skilled in the art would, to the grandparent patents to determine what the patentees meant by details relating to the construction and deployment of a vertical skein.

Turning to the written description, the '373 patent expressly states that the vertical skein consists of three distinct elements, viz., fibers, a pair of headers, and a permeate collection means. Thus, by definition, a skein does not include a gas distribution system. In addition, throughout the '373 patent, the inventors used a specific term to describe the combination of a skein and a gas distribution means. . . . As such, a reasonable person of ordinary skill in the art would understand that the gas distribution system covered by the '373 patent is not a detail relating to the construction and deployment of a vertical skein, but rather is a separate and distinct element of the invention, and thus was not incorporated by reference in the '250 patent.

[B]ecause the '250 patent fails to incorporate by reference, with sufficient particularity to one reasonably skilled in the art, the gas distribution system disclosed in the '373 patent, and thus a lack of continuity of disclosure exists in the family chain, the '319 patent is not entitled to the filing date of the '373 patent. Because it is undisputed that the '373 patent discloses each and every limitation of the claims of the '319 patent, and the '373 patent was filed more than one year prior to the filing of the '319 patent, we thus conclude that the '319 patent is anticipated by the '373 patent and hence invalid.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.862.1025 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

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