IP Alert: Patent Office's Continuation Filing Deadline Rule Upheld by the Federal Circuit



PATENT OFFICE'S CONTINUATION FILING DEADLINE RULE UPHELD BY THE FEDERAL CIRCUIT

By Ernest V. Linek

Yesterday, the Court of Appeals for the Federal Circuit reversed and remanded the decision of the Delaware district court in *Immersion Corp. v. HTC Corp.*, No. 1:12-cv-00259, 2015 WL 627425 (D. Del. Feb. 11, 2015). That case held that to have continuity with an earlier filed application that was being issued as a patent, the continuing application must have been filed the day before the patent was issued by the U.S. Patent and Trademark Office. This ruling was contrary to more than 50 years of USPTO practice and procedures.

The question presented to the Federal Circuit was simply this—does 35 U.S.C. § 120, for treating a patent application, filed as a continuation of an earlier application, require that the continuing

application be filed at least on the day before the patent issues—or can the continuation be filed on the same date that the patent issues?

The statute states that the continuing application must be “filed before the patenting” of the earlier application.

The Federal Circuit held that filing can occur on the same day as the issuance of the patent.

According to the court, the statutory language does not compel, though it certainly could support, adoption of a day as the unit of time for deciding if filing is “before” patenting. More importantly, the court noted that history is decisive in permitting the same-day-continuation result, under which, using units of time of less than a day, a “filing” is deemed to occur before “patenting.”

Long before Congress enacted Section 120 in the 1952 Patent Act, the Supreme Court in *Godfrey v. Eames*, 68 U.S. (1 Wall.) 317 (1864), established the basis for same-day continuations for priority-date purposes. There, Mr. Godfrey had withdrawn a previously filed patent application and, on the same day, refiled his application with an amended specification. *Id.* at 324. The Court held that “if a party choose(s) to withdraw his application for a patent . . . intending at the time of such withdrawal to file a new petition, and he accordingly do(es) so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law.” *Id.* at 325–36. It adopted that position for purposes of giving the earlier application’s priority date to the successor application (where the two were sufficiently related). And in the decades following *Godfrey*, the Supreme Court, other federal courts, and the USPTO consistently followed *Godfrey*’s rule.

The 1952 Patent Act, which introduced Section 120, was broadly a codification of existing continuation practices. And same-day continuations have been approved by a consistent, clearly articulated agency practice going back at least half a century, which has plausibly engendered large-scale reliance and reflects the agency’s procedural authority to define when the legal acts of “filing” and “patenting” will be deemed to occur, relative to each other, during a day.

COPENDING APPLICATIONS

When a later-filed application is claiming the benefit of a prior-filed nonprovisional application under 35 U.S.C. 120, 121, 365(c), or 386(c), the later-filed application must be copending with the prior application or with an intermediate nonprovisional application similarly entitled to the benefit of the filing date of the prior application.

Copendency is defined in the clause which requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application.

Prior to the Delaware decision, when a prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. *See MOAEC, Inc. v. MusicIP Corp*., 568 F. Supp. 2d 978, 982 (W.D. Wis. 2008). In that case, the district court interpreted "before" to mean "not later than" and allowed a continuation application filed the same day that the parent patent issued to have the benefit of the filing date of the parent application.

BACKGROUND OF THE CASE

On January 19, 2000, Immersion Corp. filed with the USPTO a patent application disclosing a mechanism for providing haptic feedback to users of electronic devices. On August 6, 2002, that application issued as U.S. Patent No. 6,429,846.

Meanwhile, Immersion had filed International Application No. PCT/US01/01486, and that application was published as WO 01/54109 on July 26, 2001. The written description of the PCT publication is materially identical to that of the '846 patent. Under 35 U.S.C. § 102(b), the PCT publication became invalidating as to claims to subject matter disclosed in that publication unless those claims were entitled to an effective filing date before July 26, 2002.

Beginning in August 2002, i.e., after the July 2002 date, Immersion filed in the United States a series of applications that similarly shared the written description of the '846 patent and for which Immersion asserted an entitlement to an effective filing date of January 19, 2000, the filing date of the '846 patent's application, relying upon Section 120.

It is not disputed here that Section 120 allows multiple links of such "continuation" applications in a chain leading back to an earlier application as long as each link meets the section's requirements. Here, one link is contested. Immersion filed an application—
which eventually matured into U.S. Patent No. 7,148,875—on August 6, 2002, the same day that the '846 patent issued. The present dispute is whether the '875 patent's application was "filed before the patenting" of the '846 patent's application and hence is entitled to the 2000 filing date of the '846 patent.

In early 2012, Immersion sued HTC Corp. and HTC America, Inc. (collectively, HTC) for infringing the '720, '181, and '105 patents. HTC sought summary judgment that the asserted patent claims are invalid under 35 U.S.C. § 102(b) because the WO '109 publication of July 26, 2001, disclosed the subject matter of those claims.

The decisive issue was the priority date to which the patents at issue are entitled based on the chain of applications tracing back to the '846 patent—specifically, whether the link between the '875 patent's application and the '846 patent's application met Section 120's timing requirement.

The district court held that the ’875 patent’s application was not “filed before the patenting” of the ’846 patent’s application within the meaning of Section 120, because they were filed on the same day.

CONCLUSION

According to the appellate court, this is not a case where the language of the statute actually contradicts the longstanding judicial and agency interpretation. Nor is it a case in which the longstanding agency position is plainly outside the agency’s granted authority. Here, the position is essentially a procedural one—establishing when the agency will consider an input into its process (the legal act of “filing”) and an output of its process (the legal act of “patenting”) to occur relative to each other—neither one being a precisely identifiable self-defining physical act, but a legally defined event. The USPTO has been granted authority to establish procedures that organize its processing of requests to issue (or cancel) patents, from entry to exit. *See* 35 U.S.C. § 2.

Once the appellate court determined that Section 120 permits consideration of whether filing was before patenting *within* a single day, any argument against same-day continuations runs into insuperable difficulties, given *Godfrey* and the USPTO’s authority, supported by obvious practical considerations, to declare when the events of “filing” and “patenting” are deemed to occur within the same day.

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Posted: June 22, 2016