

Keywords: 35 U.S.C. § 120; Continuation Application

General: Federal Circuit finds an application may be “filed before the patenting” of the earlier application when both legal acts, filing and patenting, occur on the same day.

Immersion Corporation v. HTC Corporation, HTC America, Inc.

No. 2015-1574 (Fed. Cir. June 21, 2016)

I. Facts

Immersion filed a U.S. patent application on January 19, 2000 and an international application on July 26, 2001, which later published as WO 01/54109 (the WO '109 publication). The U.S. patent application issued as U.S. Patent No. 6,429,846 (the '846 patent) on August 6, 2002. The WO '109 publication is materially identical to that of the '846 patent.

Immersion filed a series of patent applications in August of 2002 that shared a written description with the '846 patent. Immersion asserted an entitlement to the effective filing date of the '846 patent, January 19, 2000. One of these patent applications was filed on the same day that the '846 patent issued and was issued as U.S. Patent No. 7,148,875 (the '875 patent).

Immersion filed additional continuation applications from '875 patent. This process led to U.S. Patent Nos. 7,982,720, 8,031,181, and 8,059,105, (the '720, the '181, and the '105 patents), all of which shared a written description with the WO '109 publication.

District Court Proceedings

In early 2012, Immersion sued HTC for infringing the '720, '181, and '105 patents. HTC sought summary judgement and asserted that the patent claims were invalid under pre-AIA 35 U.S.C. § 102(b) in view of the WO '109 publication. The issue was whether the '720, '181, and '105 patents were entitled to the filing date of the '846 patent (i.e., whether the '875 patent met the timing requirements of 35 U.S.C. § 120 to be entitled to the filing date of the '846 patent as a priority date). 35 U.S.C. § 120 provides, in relevant part:

[a]n application for patent for an invention disclosed...in an application previously filed in the United States...shall have the same effect, as to such invention, as though filed on the date of the prior application, *if filed before the patenting* or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application.

(Emphasis added.)

The district court held that the '875 patent was not “filed before the patenting” of the '846 patent because they were filed on the same day. Accordingly, the patents at issue were not entitled to the filing date of the '846 patent, but rather the filing date '875 patent (August 6, 2002) as a priority date. As such, the '720, '181, and '105 patents were determined to be invalid as being anticipated by the WO '109 publication.

II. Issue

Did the district court err in finding that the '875 patent application was not filed before the patenting of the '846 patent application within the meaning of 35 U.S.C. § 120?

III. Discussion

Yes. The Federal circuit held that the district court erred in finding that the '875 patent was not filed before the '846 patent when they were filed on the same day. The Court first noted that, in a § 120 analysis, the language requires that the later application be “filed before the patenting” of the earlier application. However, that language does not say that unit of time is a day, as opposed to a smaller time unit. The central premise of HTC’s position was that ‘before’ a statutory deadline means ‘before’ that date, not ‘on or before’ that date. However, the Federal circuit noted because the statutory language does not actually speak in terms of days or dates, the language alone does not resolve the crucial unit of time issue.

The Court reasoned that the lens must be widened to look beyond the specific phrase at issue. The Court looked to other sections of the Patent Act, including other phrases within section 120, which specified time by express reference to days, months, or years. The Court reasoned, even with the presence of specific time references used throughout the Patent Act, the significance of that fact for the present issue is not unidirectional.

The Court further noted the presence of specific time references elsewhere in the Patent Act could mean that the particular language at issue here can bear a day-as-unit meaning, if that meaning would fit best with the statute as a whole and if the statute were new and without history. However, the history bearing on the question here could not be properly disregarded.

The Court reasoned that long before Congress enacted section 120 in the Patent Act of 1952, 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. In that case, Mr. Godfrey withdrew a previously filed patent application, and on the same day, refiled his application with an amended specification. The Court held that “if a party chose to withdraw his application for patent ... intending at the time of withdrawal to file a new petition, and he accordingly does so, the two petitions are considered as parts of the same transaction and both constitute one continuous application, within the meaning of the law.” The Court noted that in the decades following *Godfrey*, the Supreme Court, other federal courts, and the Patent Office consistently followed *Godfrey*’s rule.

The Court also noted after the enactment of the Patent Act of 1952, the PTO promulgated 37 C.F.R. § 1.78(a) (1960), stating that “the benefit of the filing date of [a] prior application” can be obtained when “an applicant files an application claiming an invention disclosed in a prior filed *copending* application.” (Emphasis added.) That word on its face would naturally include, not exclude, the same-day situation, and in any event, the word’s prior usage makes that understanding clear. “Copending” had regularly been used in the field to describe the relationship between an earlier-filed application and its later-filed continuation, often with reference to *Godfrey*, which involved the same day situation. The following year, the Patent Office revised the MPEP § 201.11 to state “If the first application issues as a patent, it is sufficient for the second application to be *copending* with it if the second application is filed *on the same day or before* the patenting of the first application.” The Court reasoned that the MPEP has been revised over the decades and the agency has consistently maintained its clearly stated position for half a century.

The Federal circuit further noted the Supreme Court has long recognized that a “longstanding administrative construction,” at least one on which reliance has been placed, provides powerful reasoning for interpreting a statute to support the construction. The Supreme Court has emphasized the weight of this consideration in patent law in particular. In the instant case, the Federal circuit reasoned that HTC’s position would disturb over 50 years of public and agency reliance of permitting same-day continuations.

The Federal circuit noted, according government calculations and studies commissioned by the Intellectual Property Owners Association, overturning the PTO’s position would affect the priority dates of more than ten thousand patents. Moreover, patent applicants have likely relied on the policy in deciding

when to file their continuations. The Court reasoned there is no basis for denying the existence of a large disruptive effect if the same-day-continuation policy were now repudiated.

The Federal circuit also noted that HTC made no meaningful argument for overturning the same-day continuation practice independent of its argument that the section 120 phrase at issue must be read using a “day” as the unit of time for determining beforeness. The Federal circuit further noted that there was no occasion to address the questions that would arise if the PTO now changed its longstanding policy on same-day continuations.

IV. Conclusion

The Federal circuit reversed and remanded the judgment of the district court as to the ’720, ’181, and ’105 patents.

V. Practice Tips

When filing continuation applications, seek input from clients early and plan to file the continuation application one or more days before the parent application issues. However, while not preferred practice, there is now explicit case law supporting a claim for the timeliness of filing a continuation on the date a parent application issues.