Is it a Continuation If You File it on the Parent Application's Issue Date? - Round 2!

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Back in 2008, I published "Is it a Continuation If You File it on the Parent Application's Issue Date?"[2] The thesis of that article was to question the long standing policy of the USPTO of according benefit to an application filed on and claiming benefit of an application issued the same day. There, I stated that "[n]o court appears to have decided whether a later filed application filed on the date an earlier filed application issues is 'filed before the patenting' of the earlier filed application within the meaning of 35 USC 120."

There has been a fair amount of water under the bridge, since then. Two years later, the CAFC decided Encyclopaedia Britannica v. Alpine, which, in dicta, stated:

> *We also leave for another day* whether the '955 application is entitled to the filing date of August 31, 1993. The district court concluded that because of infirmities in the '955 application, it "was not entitled to any filing date." Therefore the district court concluded the patents in suit are only entitled to the February 28, 1994 filing date. The patents in suit are anticipated by the May 16, 1991 publication regardless of whether they are entitled to the August 31, 1993 filing date or the February 28, 1994 filing date. Therefore, we need not decide whether the '955 application is entitled to a filing date of August 31, 1993 pursuant to 35 U.S.C. § 111. [Italics added for emphasis.]

The day is drawing near when the CAFC will have to decide whether filing on the same day as issuance of the putative parent application satisfies the copendency requirement of 35 USC 120. Since Encyclopaedia Britannica, two district courts have opined on whether an application is copending when filed on the same day as issuance of the putative parent application. While the procedural posture and burdens of proof and arguments before these two courts may have influenced their outcomes, they reached diametrically opposite results!

In August of 2014, in Ultratec, Inc. v. Sorenson Communications, Inc., (W.D. Wis), one Court stated that:

> Under 35 U.S.C. § 120, a continuation application may be entitled to the priority date of a parent application "if filed before the patenting" of the parent application. This provision is known as the "copendency" requirement. In re Doyle, 293 F.3d 1355, 1363 (Fed. Cir. 2002). The `835 patent issued on August 5, 2003, the same day that the application for the `082 patent was filed. Defendants argue that because the `082 patent application was filed on the same day that the `835 patent was issued, the `082 application was not filed before the patenting of its parent application. As plaintiffs point out, this court rejected a similar argument in MOAEC, Inc. v. MusicIP Corp., 568 F. Supp. 2d 978, 981-82 (W.D. Wis. 2008), finding that the United States Patent and Trademark Office's Manual of Patent Examining Procedure interpreted "before" to mean "not later than." See also Molins PLC v. Textron, Inc., 48 F.3d 1172, 1180 n.10 (Fed. Cir. 1995) (MPEP "is entitled to judicial notice as an official interpretation of statutes or regulations as long as it is not in conflict therewith."). The Court of Appeals ...

> has not yet weighed in on this issue. Encyclopaedia Britannica, Inc. v. Alpine Electronics of America, Inc., 609 F.3d 1345, 1352 (Fed. Cir. 2010) ("We therefore leave for another day whether filing a continuation on the day the parent issues results in applications that are co-pending as required by the statute.") Although defendants encourage me to overrule my holding in MOAEC, they have not presented any good reason for doing so that was not addressed and rejected [in] that decision. Accordingly, I find that the `082 and `835 patent applications were copending, making the `082 patent a continuation of the `835 patent.

In February of 2015, in Immersion Corporation v. HTC Corporation, (D. Del), another Court stated that:

> Plaintiff has the burden of going forward to prove entitlement to an earlier priority date. Tech. Licensing Corp. v. Videotek, Inc., 545 F.3d 1316, 1329 (Fed. Cir. 2008); PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d 1299, 1305-06 (Fed. Cir. 2008). In this case, that means that Plaintiff has the burden of producing some evidence that it filed the continuation applications before the parent patent issued on August 6, 2002. The Court is not convinced of the correctness of Defendants' contention that a patent automatically issues at 12:00:01 a.m. on the issue day. Nevertheless, Plaintiff has presented no evidence of when on August 6, 2002 the applications were filed. Thus, no matter when the parent patent issued on August 6, 2002, Plaintiff has presented no evidence showing that the applications were filed before the parent patent issued. It is Plaintiff's burden to come forward with some evidence. It has not. Plaintiff has therefore not shown that the '720, '181, and '105 patent applications have a priority date earlier than August 6, 2002.

While an appeal is not certain in any particular case, the split in the district court decisions make an appeal on the issue of copendency very high. Accordingly, expect to see this issue squarely before the CAFC in the not too distant future.

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2. See http://www.neifeld.com/advidx.html