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

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Assume you find out unexpectedly that your application issued, you find out on the date of issuance, and you intended to file a continuation or division of that application. What can you do? Do you have the right to file a continuation or division? That is, can you meet the 37 CFR 1.78(a)(1) "copendency" requirement and the 35 USC 120 "filed before the patenting" requirement in order to be entitled to benefit of the filing date of the parent application, now issued as a patent?

The USPTO seems to think so, based upon my inquiries to USPTO officials, and based upon 37 CFR 1.78 as interpreted by the Director of the USPTO, in the MPEP. However, there appears to be no statutory or judicial authority supporting the USPTO's position.

The USPTO recognizes that a claim in an application to continuation or division status requires "copendency" as defined in 37 CFR 1.78. 37 CFR 1.78(a)(1) contains that requirement, stating:

> 1.78 Claiming benefit of earlier filing date and cross-references to other applications.
>
> (a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed *copending nonprovisional applications or international applications designating the United States of America*. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. [Italics added for emphasis.]

37 CFR 1.78(a)(1)'s "*copending ...applications*" means that the USPTO recognizes a benefit claim requires "copendency". MPEP 201.11clarifies that the USPTO means by copending, stating:

> Examiner Note:
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> 1. This form paragraph must be preceded by heading form paragraph 2.09. If the 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. Thus, the later-filed application may be filed under 37 CFR 1.53(b) while the prior >application< is

> still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues. **>Patents usually< will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the prior application before the continuing application is filed. [MPEP 201.11, Rev. 2, May 2004; italics added for emphasis.]

Thus, MPEP 201.11 specifies that the USPTO will deem a later filed application filed on the date that an earlier filed application issues to be copending with that earlier filed application. Thus, in the eyes of the USPTO, such applications are copending, thereby meeting the 37 CFR 1.78(a)(1) copendency requirement. Thus, assuming compliance with the other requirements for benefit, the USPTO will accord the claims of the later filed application benefit of the filing date of the earlier filed application.

However, courts are not beholden to administrative agencies; vice versa! A court would grant little or no deference to PTO construction of a rule dealing with "copendency" when construing the 35 USC 120 statutory requirement for benefit that the second application be "filed before the patenting" of the earlier filed application. What 35 USC 120 states in relevant part is:

> 35 U.S.C. 120 Benefit of earlier filing date in the United States.
> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application 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.... [35 USC 120, amended Nov. 14, 1975, Public Law 94-131, sec. 9, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 104(b), 98 Stat. 3385; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)).]

No 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. However, normal rules of grammatical construction convey the meaning that an application filed on the same day another application is patented is not "filed before the patenting" of the other application. Normal rules of grammatical construction would convey the meaning that an application filed after the patenting of an earlier application is not "filed before the patenting" of that earlier application. Normal rules of grammatical construction would convey the meaning that, if an applicant files a continuation application in response to seeing their issued patent on their parent application, then the continuation was not "filed before

the patenting" of the earlier application. Normal rules of grammatical construction and an operative definition of "patented" would convey the conclusion that a later filed application is not "filed before the patenting" of an earlier filed application if one can sue on the patent granted on the earlier filed application before the later filed application is on file. Thus, a court applying only the normal rules of grammatical construction is likely to find that the later filed application is not entitled to benefit of the earlier filed application. Of course, a court may apply other factors when construing the statute, such as legislative intent and public policy. Hence, this issue appears to be an open legal question.

Returning to the fact pattern of this article: Assume you find out unexpectedly that your application issued, you find out on the date of issuance, and you intended to file a continuation or division. What can you do?

You can of course file an application and call it a continuation and presumably ultimately get a patent, since the USPTO will respect the benefit claim. However, that patent is subject to an invalidity challenge, if ever enforced, on the basis described herein above. Thus, to protect your interests you may also want to file a reissue application and attempt to obtain overlapping protection of what you intended to claim in the continuation application. Reissue applications are substantially more burdensome, and their claims are subject to the recapture rule. Thus, a reissue application is a limited remedy, but at least provides an additional remedy beyond merely relying upon the continuation application.

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