Continuation Practice

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Peter Cortless, Member
Continuing Application Practice

- Continuing Applications (CON)
- Divisional Applications (DIV)
- Continuation-in-Part Applications (CIP)
Relevant Statutes

• 35 U.S.C § 120 – “Benefit of earlier filing in the United States”
• 35 U.S.C. § 121 – “Divisional applications”
Terminology

• A “divisional” application is a special continuing application used in cases where there is a restriction/election of species requirement

• A “continuation-in-part” application is a special continuing application that introduces new matter
Continuations vs. Claims to Provisionals

• The claim to the benefit of the filing date of an earlier filed provisional application in a US non-provisional application is under 35 USC § 119(e)

• Thus, it is not proper to refer to the subsequently filed US non-provisional as a continuing application or a continuation-in-part application of the earlier filed US provisional application
Requirements

• Common Disclosure
  – Judged under 35 USC § 112
  – Requirement relaxed for CIP applications

• At Least Partial Common Inventorship
  – ABC → A is OK
  – ABC → CDE is OK
  – ABC → DEF is not OK

• Copendency
  – Must be filed before parent application:
    • issues or
    • becomes abandoned
  – Copendency exists if filed on the issue date of the parent application
Why Do Applicants File Continuations?

- Examiner may be willing to allow narrower claim set right now
- Pursue narrower claims in CON while appealing broader claims
- Utilize Patent Prosecution Highway programs based on allowance of subset of claims
- Preserve the right to pursue additional claims without the limitations of reissue practice
- Can provide a more flexible way to enter the US from a PCT application
Choosing Between 371 and “Bypass CON” Filings

• § 371 national phase entry is more familiar to foreign applicants, but “bypass continuation” filings can be advantageous in at least some situations

<table>
<thead>
<tr>
<th>§ 371 National Phase Entry Filing</th>
<th>“Bypass Continuation” Filing</th>
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<tbody>
<tr>
<td>PCT applications having international filing date up to September 15, 2012 subject to pre-AIA rules</td>
<td>Any “bypass continuation” application filed today or later is subject to post-AIA rules</td>
</tr>
<tr>
<td>Unity of invention practice</td>
<td>US restriction practice</td>
</tr>
<tr>
<td>Literal translation of PCT application, plus any preliminary amendments</td>
<td>More flexibility in amending and/or reformatting specification and claims (can file as CIP in case of new matter)</td>
</tr>
<tr>
<td>Stricter procedure for correcting inventors (pre-AIA and post-AIA)</td>
<td>Simply list correct inventive entity (must have one inventor in common with PCT application)</td>
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<tr>
<td>Preliminary amendment likely not published</td>
<td>Changes incorporated into specification and claims should be published (can establish provisional rights to damages)</td>
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One Notable Downside of Bypass CONs

• Priority documents will not be automatically provided to the USPTO by WIPO
Divisional Application

• The term “divisional” application has little to no significance with the USPTO

• Best practice to avoid confusion is to only use the term “divisional” in connection with an application that only presents subject matter that was not elected in response to restriction requirement

• Claims that were previously subject to a restriction requirement in a parent application are protected from double patenting rejections over the elected claims under 35 USC § 121
  – Are all pending claims properly subject to the double patenting rejection?
  – If not, consider whether to cancel the claims properly subject to the double patenting rejection
Continuation-in-Part Applications

- Can be filed during the lifetime of an earlier nonprovisional application
- Repeat some substantial portion or all of the earlier nonprovisional application and adding matter not disclosed in the earlier nonprovisional application
- The mere filing of a continuation-in-part does not itself create a presumption that the applicant acquiesces in any rejections which may be outstanding in the copending national nonprovisional application or applications upon which the continuation-in-part application relies for benefit
Continuation-in-Part Applications

• Unless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, the USPTO does not determine whether the earlier nonprovisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 USC § 112.
Continuation-in-Part Applications

• Continuation-in-Part applications are often misunderstood, even by U.S. practitioners

• New matter can be introduced relative to the parent application

• CIP practice can be problematic because:
  – Patent term is calculated from the earliest claimed priority date, whether or not the claims are entitled to priority
  – The parent application may be available as obvious-type prior art against the claims
  – Other jurisdictions do not recognize CIP practice

• CIPs are useful in some circumstances:
  – Correcting errors
  – Adding data
Patent term is calculated from the earliest claimed priority date

- Parent application filed January 1, 2000
- Application is published on July 1, 2001
- Your client develops an improvement in 2005
- If you file a CIP application, any forthcoming patent will expire in 2020
- If you file a new application without a priority claim, any forthcoming patent will expire in 2025
The parent application may be available as obvious-type prior art against the claims

- Santarus v. Par Pharma (Fed. Cir. 2012)
  - Some claims lack priority to parent application
  - Majority holds that parent patent was prior art against claims lacking priority

- See also In re Chu, 66 F.3d 292 (Fed. Cir. 1995)
Other jurisdictions do not recognize CIP practice

• Parent application filed January 1, 2000
• First PCT application filed January 1, 2001
• Application is published on July 1, 2001
• CIP application directed to an improvement filed on January 1, 2002
• Second PCT application directed to improvement filed and enters the national/regional phase
• Published application may not be prior art to second application in the United States
• Published application will be prior art to second application in jurisdictions as Europe and Japan
So, When Do We File CIP Applications?

• When Correcting Errors:
  – Errors in the specification of a non-provisional or PCT application
  – Errors in inventorship

• When Adding New Data:
  – Can be particularly useful when entering the US from a PCT application
Common Issues for CON/DIV/CIPs

• Deadline for Presenting Priority Claim
• Special Issue under the AIA
• Inventorship and Declarations
• Deleting a Priority Claim
Deadline for Presenting Priority Claim

• Should be done when initially filing the CON/DIV/CIP application

• Deadline is:
  – 4 months of the filing date of application or
  – 16 months of prior application

• Petition to accept an unintentionally delayed priority claim requires:
  – Submission of reference to priority application
  – The surcharge under Rule 1.17(t) ($1,410)
  – A statement that the entire delay between the date the claim was due under Rule 1.78(a)(2)(ii) and the date the claim was filed was unintentional
Special Issues Under the AIA

• Is this a “transitional” application having:
  – a pre-March 16, 2013 priority claim and
  – one or more claim (at any time and including parent applications) lacking pre-March 16, 2013 support?

• If so, we must check the appropriate box on the ADS

• This duty continues after filing

• It appears difficult (if not impossible) to uncheck this box, so think carefully before presenting claims

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.
Inventorship and Declarations

• Inventorship should be corrected to correspond inventorship to subject matter of the DIV/CON claims

• New Oath/Declaration is always required for CIP

• New Oath/Declaration is required if the parent and CIP application straddle September 16, 2012 AIA transition date

• Application Data Sheet must be filed in order to claim priority
Deleting a Priority Claim

• An Applicant can delete the benefit claim by amending the application

• The Examiner will check to see if there is any new prior art available because of such amendment

• PTO will likely will refuse any subsequent request to amend application to re-introduce the deleted benefit claim if applicant files a request to add under the deleted benefit claim using the unintentionally delayed provisions of the rules

• Deleting a priority claim is rarely done, but sometimes warranted when dealing with a chain of CIP applications
Summary

• In sum, the rules and statutes that govern CON/DIV/CIP applications require:
  • That for CON/DIV applications there be continuity as to the disclosure that satisfies the statutory requirements of 35 USC § 112, first paragraph
  • That the prior application to which the CON/DIV/CIP claims benefit to must be co-pending when the CON/DIV/CIP is filed
  • The CON/DIV/CIP application contain a specific reference to the prior application(s) in the Application Data Sheet
Thank you!