



# Patently Strategic Musings

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# Continuation Practices- Overview

- **What is Continuation Practice?**
- **Types of Continuation Applications**
- **Benefits of Continuations**
- **Terminal Disclaimers**
- **Prosecution Latches**

# What is Continuation Practice?

- Filing additional patent applications based on a previously filed parent application
- Enables modification of claims
- Extends patent protection
- Allows a strategic response to new prior art or market developments **without losing the benefit of the original filing date**
- Can be filed at any point while at least one patent application in a patent family is pending
- Can be filed in sequence (i.e., parent-child), in parallel (i.e., sibling), or some combination thereof.
- **Increases the portfolio's value!**

# When should a Continuation be filed?

- Filed before the patenting or abandonment of or termination of proceedings on the parent application
- Has the same effect as though it was filed on the date of the prior or parent application

# Types of Continuations

- **Continuation Application**

- No new matter
- Pursuing matter unclaimed in previous application

- **Divisional**

- No new matter
- Filed after a restriction requirement issued by the USPTO – indicates separate and distinct inventions

- **Continuation-in-part**

- Adds new matter
- Pursuing matter, including new matter, unclaimed in previous application

# Benefits of Continuations

- Extended prosecution time
  - **Flexibility.** Keeping prosecution process alive, allowing more time to refine claims and respond to USPTO rejections.
  - **Adaptability.** Extending timeframes help for adaption to changes in technology and market conditions.

# Benefits of Continuations (Continued)

- Broadening claim scope
  - **Claim refinement.** Allows adjustment and broadening of claims based on new insights, prior art references, or developments during prosecution.
  - **Extended Claims set.** Different aspects of an invention can be pursued in separate continuation applications, providing comprehensive protection.

# Benefits of Continuations (Continued)

- Strategic Claim Drafting
  - **Targeting competitors.** Claims can be crafted to cover competitor products or emerging technologies more effectively.
  - **Benefit of hindsight.** Potential infringing products may be mapped such that newly drafted claims read directly upon them.
  - **Market changes.** Enables claims to be adjusted based on shifts in the market or new applications of the invention.
  - **Changing case law.** Claims may be modified to better align with new prevailing case law.



# Benefits of Continuations (Continued)

- Preserving Priority Date
  - **Original filing date.** Continuation applications retain the priority date of the original (parent) application, which is crucial for maintaining an early filing date against competitors.

# Benefits of Continuations (Continued)

- Prior Art-proofing
  - **Unconsidered prior art.** A continuation application may be issued in light of prior art unconsidered by the parent's prosecution, thus the prior art may be removed as a reference in, for example, a Inter Partes Review.

# Benefits of Continuations (Continued)

- Defensive Patenting
  - **Blocking Competitors.** Continuation applications can be used to create a robust patent portfolio that deters competitors from entering the market.
  - **Litigation Leverage.** A family of continuation applications can provide multiple patents, increasing leverage in potential litigation or licensing negotiations.

# Benefits of Continuations (Continued)

- Multiple Inventions from One Parent
  - **Divisional Applications.** When a parent application discloses multiple inventions, divisional applications can be used to pursue each invention separately, ensuring all disclosed inventions are protected.

# Benefits of Continuations (Continued)

- Evolving Inventions
  - **Continuation-in-Part.** Allows for the addition of new matter to reflect ongoing research and development, while still benefiting from the original filing date for the disclosed subject matter.

# Terminal Disclaimers

- **Double Patenting.** When a continuation application is filed, the claims may overlap or be similar to the claims in the parent application, prompting a double patenting rejection from the USPTO.
- **Terminal Disclaimer.** The most common way to overcome a non-statutory double patenting (obviousness-type) rejection is by filing a terminal disclaimer.
  - Disclaims the term of the second patent that extends beyond the term of the first patent, linking their expiration dates

# Terminal Disclaimers (Continued)

- **Requirements to File**
  - Filed during pendency of the application
  - Common ownership of the involved patent/application

# Terminal Disclaimers – Proposed Changes

- **Each patent must be challenged separately.** Infringer or any third party who wishes to challenge the validity of claims subject to a terminal disclaimer must challenge each patent separately
- **Proposed Rule Change.** Patent with the terminal disclaimer will be enforceable only if the patent is not tied to a patent in which any claim has been finally held unpatentable or invalid over prior art
  - **Fate and enforceability** of a patent would be tied to any reference patent to which a terminal disclaimer was filed



# Prosecution Latches

- **Unreasonable and Inexcusable Delay.** Results in valid patent being deemed unenforceable if the patentee is found to have delayed prosecution of the patent application, **causing prejudice to the defendant**
- Introduced to address pre-1995 “submarine” patents
  - **Pre-1995:** patent term started at issuance with a 17 year patent term
    - Patentees would delay prosecution for years until an industry blossomed only to “surface” with a 17 year patent term from issuance
  - **Post-1995:** patent term is 20 years from the earliest priority date

# Sonos Inc v. Google LLC

- **The original case.** Sonos sued Google for infringement of its patents directed to smart speaker technology.
- **Sonos wins, for now.** A jury found that Google infringed two of Sonos's patents, and awarded a verdict of \$32 million.
- **Google asserts prosecution laches.** Google alleged that Sonos's patents were unenforceable under the doctrine of prosecution laches.
- **Sonos patent unenforceable under prosecution laches.** District Court ruled that Sonos's patents "issued after an unreasonable, inexcusable, and prejudicial delay of over thirteen years by the patent holder."
  - **Delay.** There was a 13-year delay from the time of the filing of Sonos's original provisional application to the time of filing of the targeted continuation claims, including five years after Sonos first learned of Google's technology

# Effects of Sonos Inc v. Google LLC

- **Parallel filings.** File parallel continuation applications
- **File within 6 years.** Prioritize continuation filings in the first 6 years (from earliest priority date)
- **Be quick.** File continuations quickly after learning of competing product(s)
- **Take notes.** Document considerations in continuation strategy

# Limiting Continuations Illegal?

- The USPTO proposed rules pertaining to a limitation on continuation applications in 2007, which were challenged in two separate but combined litigations that the USPTO lost (*Tafas v. Dudas*).
- The USPTO currently remains under a permanent injunction forbidding it from promulgating regulations that overlap with the “Final Rules” announced by the USPTO in August 2007. The sanction is contempt of court.
- Congress has not granted the USPTO the authority to restrict the number of continuing applications, requests for continued examination, or claims that may be filed.

# Questions/Discussion

