



THINK FORWARD

Federal Circuit Upholds Same-Day Continuations

By [Joshua Ney](#)

June 27, 2016

On June 21, 2016, the Federal Circuit, in *Immersion Corp. v. HTC Corp.*, held that a patent application filed as a continuation of an earlier application on the issue date of the earlier application has been “filed before the patenting” of the earlier application, and therefore is entitled to the earlier application’s filing date under 35 U.S.C. § 120.

Immersion Corporation (“Immersion”) sued HTC Corporation (“HTC”) for infringing three patents related to a mechanism for providing haptic feedback to users of electronic devices. HTC moved for summary judgment, contending that the patents-in-suit were anticipated by International Publication No. WO 01/54109 (the ’109 publication), which was published on July 26, 2001. HTC’s motion turned on whether the patents-in-suit were entitled to the filing date of a predecessor application filed before the publication date of the ’109 publication.

The predecessor application was filed on January 19, 2000 and issued on August 6, 2002 as U.S. Patent No. 6,429,846. On the same day that the ’846 patent issued, Immersion filed a continuation application, which later issued as U.S. Patent No. 7,148,875. A chain of subsequent continuation applications ultimately led to the patents-in-suit. HTC argued that the patents-in-suit were not entitled to the filing date of the ’846 patent application because the ’875 patent application was not “filed *before* the patenting” of the ’846 patent application, as required by Section 120, creating a break in the “chain” between the patents-in-suit and the ’846 patent application. The district court granted HTC’s motion, holding that the ’875 application did not meet the timing requirement of Section 120 because it was filed on the same day that the ’846 patent issued.

The Federal Circuit reversed, holding that “same-day continuations” meet the timing requirement of Section 120. The Federal Circuit initially noted that the statutory language, by its terms, does not answer the question of whether the times of “filing” and “patenting” must be measured in days, or whether “filing” can precede “patenting” on the same day. However, the court reasoned that the history of Section 120 mandated an interpretation of the statute that would permit same-day continuations to receive their parent’s priority date. The court found that the enactment of Section 120 in the 1952 Patent Act was intended to codify existing law that approved of same-day continuations.

The court also reasoned that the Patent Office’s longstanding interpretation of the statute, and the public’s reliance on that interpretation, supported the acceptance of same-day continuations. The Manual of Patent Examining Procedure had long included a statement explaining that copendency exists if a continuation is filed “on the same day or before” the patenting of an earlier application. The court found that the agency’s interpretation of the statute was persuasive because it had engendered substantial reliance among the public. By some estimates, a reversal of the agency’s position would

have affected the priority dates of over ten thousand patents.

Contact Us

If you have any questions or wish to discuss how this decision impacts your business, please contact one of our [Brinks Attorneys](#).