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4 Times To File A Continuation Patent Application

By **Erin Coe**

Law360, San Diego (March 17, 2016, 2:00 PM ET) -- When inventors are looking to protect an innovation, a standard patent application may not be enough, and a continuation application may be the answer to fortify their claims and prevent competitors from designing around their invention.

While their patent application is pending, inventors also can file a continuation application that has the same specification but modified or additional claims, giving them the benefit of the earlier filing date of the original or "parent" application.

The number of continuation applications filed with the U.S. Patent and Trademark Office has steadily grown over the years, from 31,271 in fiscal year 2009, to 47,447 in fiscal year 2011, to 64,372 in fiscal year 2013, to 76,898 in fiscal year 2015.

"It's less expensive than filing a new application," said Jennifer Hayes, a Nixon Peabody LLP partner. "And the advantages are you can cover different aspects of your invention and may be able to cover features of an invention that was described in the specification but was not claimed in the parent application."

Here, attorneys highlight four times when patent applicants may want to consider obtaining a continuation patent.

When Planning to File a Patent Application

As inventors prepare to move forward with a patent application, they also should consider whether there are any continuation patents they may want to pursue.

"I think companies and clients should be thinking about continuation applications as part of their long-term strategy for developing their patent portfolio," Hayes said. "When I meet with clients to talk about the original patent application, we develop multiple patent claims we could claim in the parent patent application, and also oftentimes pick one or two that could be important and could be filed in a later set of continuation applications."

By considering this option at the outset, inventors can identify the key features they want to have in a parent application that might be approved by the patent office quickly, while filing broader claims in continuation applications that could take longer to get through the prosecution process, she said.

"This can be a really important strategy for startups," she said. "Oftentimes, investors want to make sure a company has one or more patents. When a company puts narrow claims in an original application and files for a prioritized examination, it might be able to get a patent issued in less than a year, and that way, it can focus on continuation applications for broader claims."

When drafting the initial application, prosecutors should focus on writing a robust specification with many alternative embodiments, according to Bradley Van Pelt, a shareholder at Banner & Witcoff Ltd.

"You should brainstorm with the inventors and try to predict where the technology is heading and capture that at the time of filing," he said. "This can give you flexibility to craft valuable claims in continuations."

Starting with narrower claims in a parent application makes sense because once the examiner allows the parent case, he or she will be more favorable to the child application, where the applicant can present broader claims, according to Van Pelt.

One disadvantage of continuation practice is that examiners are still searching for and may find prior art in a continuation proceeding that was not discovered during the prosecution of the parent application, according to Linda Thayer, a partner at Finnegan Henderson Farabow Garrett & Dunner LLP.

"If the record reflects that this piece of art is potentially relevant, and the continuation contains claims that are closely related to those of the parent, it may cast a cloud over the parent," she said. "[But] it is still preferable to know about the prior art than not knowing and finding out during litigation that the parent patent is invalid. Finding out during prosecution of a continuation means that the claims of the parent could be amended and strengthened in the continuation."

Instead of making minor changes to a continuation application, prosecutors may want to draft claims using different language from a parent application so that it would not be as obvious whether art cited in a continuation proceeding brings into question the validity of the parent patent, she said.

While there is some risk involved in pursuing a continuation application, not filing one may be the biggest of all, according to Les Bookoff, a co-founder of patent counseling and prosecution services boutique Bookoff McAndrews PLLC.

"Once the parent case issues, you won't have the co-pendency requirement for filing a continuation application," he said. "Years later, when the technology has developed and you could have mined the claims to get something really good, there is not going to be much recourse at that point."

When the Technical Field Is Evolving

Having a continuation application in the works also can be beneficial for inventors that are still developing their products to determine which features may be the most important and where the market may be trending, according to Hayes.

"Filing a continuation application gives inventors time to see where the industry is headed and what competitors might be working on so that they make sure that they are covering the key features of products as well as features that competitors and other industry players

are potentially interested in," she said.

Oftentimes, when startups are still in the prototype stage with their products, the filing of continuation applications assists them in aligning the patent claims with the products actually on the market, she said.

"When they are doing an original patent application fairly early in the design stage, companies often through the design process come up with a product that is slightly different or more than slightly different than what they originally started with," she said. "A continuation application gives them an opportunity to develop a product and file claims that more closely match the product that makes it to market."

Another advantage of going through the continuation process is it gives inventors extra time to digest the prior art in the field, according to Hayes.

"After going through the patent office with a parent application, inventors can get a better understanding of the prior art and what others are working on," she said. "In a continuation application, they can tailor their claim set faster and more quickly identify the innovative features that are disclosed in the original patent specification."

Continuation patents can build on inventors' efforts to prevent competitors from simply designing around an invention, according to Bradley Hulbert, a co-founder of IP firm McDonnell Boehnen Hulbert & Berghoff LLP.

"By claiming an invention in different ways, it's harder for a competitor to take the basic idea and design around it," he said. "It adds another stake in the picket fence around your invention."

When the Law Is in Flux

Another instance in which inventors may want to look at continuation applications is when core patent laws and how they are interpreted by authorities are in a state of limbo.

For instance, in *Alice Corp. v. CLS Bank International*, the U.S. Supreme Court in 2014 held that abstract ideas implemented with a computer cannot be patented under Section 101 of the Patent Act, and the decision has been responsible for a wave of software patents being invalidated at the courts and the patent office.

Patent applicants with software claims may want to file continuation applications as the courts and the patent office continue to flesh out what is patent eligible subject matter, according to Hulbert.

"Inventors may want to file continuation applications while they wait to get guidance on how courts want software claims to be constructed," he said. "Inventors can draft claims in different ways, such as by claiming the hardware, input processes or output processes of a software invention. That gives them flexibility once the Federal Circuit gives more guidance. By having different variations of claims, at least some claim subsets may hit the mark in terms of what the Federal Circuit later advises it is looking for."

The option of a continuation application can be helpful in keeping a patent family alive in the face of changing patent laws, according to Thayer.

"With the passage of *Alice*, more patent claims have been found invalid as patent ineligible,"

she said. "If the patent is a member of an open patent family, and there is sufficient supporting material in the specification, the claims — amended to comply with the most recent guidance — may be able to be refiled in a continuation."

When Involved in Patent Litigation

If a patent owner is currently bringing an infringement suit or its patents are being challenged in a post-grant proceeding at the patent office, it can be advantageous to have a pending continuation application so that related claims can be modified based on what arises in those contentious proceedings.

"It's useful to have a continuation application to be able to come up with claims of different scope and to either capture what the accused product is or avoid prior art references that are discovered in the course of litigation," said Jeffrey Snow, a partner in Pryor Cashman's IP group. "If related claims of similar scope are further examined by the patent office and equally found to be patentable, that's further indication of the strength of the patent [in litigation]."

Having a continuation application increases the value of the patent application or the patent family as a whole and makes the patent or family more attractive to those seeking to litigate, according to Thayer.

"If additional prior art becomes known during litigation or post-grant review, the claims may be amended and the art cited in the continuation application," she said. "The flexibility — and the unknown of what claims may issue in the future from any continuations — is one factor that may weigh in favor of settling when a defendant is faced with an 'open' family."

During prosecution, attorneys must be mindful that claim amendments and arguments made to overcome rejections of a continuation application can be used in litigation of the parent patent as a way to limit the scope of the invention or to argue that the construction of the claims should be relatively narrow, according to Hayes.

"Prosecutors should be cognizant of the potential risks of arguments and claim amendments made throughout the patent portfolio, and they should be consistent in their arguments and responses," she said.

--Editing by Jeremy Barker and Kelly Duncan.
