



STRATEGIC USE OF US CONTINUATION APPLICATIONS IN BUILDING PATENT PORTFOLIO

One inventive concept, be it a product or process, may sometimes have the potential to support multiple patents. There are several ways to accomplish a portfolio of patents when you find that having multiple patents gives the best scope of protection for your invention.

In this regard, there are two tools for continuing prosecution before a patent examiner. These two tools are a Request for Continued Examination (RCE) and a continuing application. There are three types of continuing applications, namely, continuation application (CON), divisional application (DIV), and continuation-in-part application (CIP).

Continuation applications are wonderful tools to increase the size and scope of your patent portfolio. With some careful planning, you can use continuation applications to turn your invention into multiple patent applications and patents which will provide a broader, inter-locking patent protection and thoroughly cover a particular market or technology.

If you have filed a patent application in the United States Patent and Trademark Office (USPTO) or you have filed an international application designating the United States, and the application is currently pending, the filing of a continuation application could be the next step in your patent strategy.

What is a continuation application?

A “continuation application” is a new, complete patent application derived from an earlier-filed application (useful reference: [MPEP 201.07](#)). A continuation application is filed by an applicant who wants to pursue additional claims to an invention which was already disclosed in one of their earlier applications. The prior-filed patent application is referred to as the parent or base application and the continuation application is referred to as the child application. The child continuation application will "claim priority" from the parent application and subsequently retains the priority date and the specifications of the disclosed invention of the parent application.

Why is priority important?

Earlier the filing date of a patent application, the less prior art it faces. Filing a patent application on a certain date excludes all references from the prior art that are effective after that certain date.

Generally, this is why you would want to claim the priority of an earlier application, when available. If the continuation application successfully claims priority to an earlier-filed parent application, you get the benefit of the filing i.e. priority date of the parent application in the continuation application. This means that the child application is treated as though it was filed on the filing date of the parent application.

Moreover, chains of priority claims are possible. For example, assume a first or grandparent patent application “Pat.A” is filed, and before it issues, a parent application “Pat.B” is filed properly



claiming the priority of the grandparent application under 35 U.S.C. §120. Further, a third child application “Pat.C” is filed properly under 35 U.S.C. §120 claiming the priority of the parent, Pat.A, and grandparent application, Pat.B, In this case, the child application Pat.C is entitled to the priority of the grandparent application Pat.A.

Long chains of priority applications extending over as much as 20 years can be developed under the current law, and in this case the priority claims can antedate a large body of references and prior art.

Basic requirements to file a continuation application:

A continuing application has three basic requirements (useful reference § [35 U.S.C. 120](#)):

- 1) A pending parent application;
- 2) At least one common inventor with the parent application; and
- 3) A proper claim of priority to the parent application.

Apart from these requirements, the continuation application also needs to contain or must be amended to contain a specific reference to the parent application from which a benefit is claimed under § [35 U.S.C. 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#).

Pendency of applications:

A U.S. patent application is considered “pending” during the time between its date of filing, and the date that it is either abandoned or issued as a U.S. patent.

As stated in § [35 U.S.C. 120](#), a child application is considered to be copending with an earlier application if it is filed before the earliest among these events:

- (a) The granting of the earlier patent;
- (b) The abandonment of the earlier application; or
- (c) The termination of proceedings of the earlier application.

Granting of the earlier application:

The filing of the continuation application must be done before the parent application has been granted. When a patent application has been approved and is about to be issued, there is a three-month time limit to pay the issue fees of the patent grant. It is also possible to file a continuation application in this time period.

Abandonment of the earlier application:

A patent application may be abandoned before a patent is issued. If a parent application is going to be abandoned, then any continuing application claiming its priority needs to be filed before the parent application is abandoned.

The parent application is considered to be abandoned according to the regulations described in [37 CFR 1.135](#). A patent application can be abandoned in two ways. First, it can be abandoned if the owner doesn't respond to the latest USPTO notice or office action letter. This can occur, for example, if the USPTO requests an amendment to the patent application by a certain date and the amendment is never turned in. An application can also be abandoned if the owner makes a formal



request for abandonment. If abandonment happens before the patent application is published, which occurs 18 months after the application is filed, the application will remain private and can't be viewed on the USPTO database.

Termination of the earlier application:

The filing of the continuation application must be done before the parent application has been terminated.

A patent application can be terminated during the proceedings in the following situations:

- The application becomes abandoned if the issue fee is not paid by the original three-month deadline, and any continuing application filed after the three month deadline is not considered co-pending with the abandoned parent.
- The Patent Trial and Appeal Board decides to terminate the proceedings in an application as explained in [MPEP § 1214.06](#), for example, a patent application for which no claims stand allowed.
- A decision of the court orders the termination of the parent application as explained in [MPEP § 1216.01](#).

One common inventor with the parent application

There must be at least one inventor in common between each continuing application and all of its antecedent applications. Every application in a chain of application having their priority claims filed under 35 USC 120, must have filed at least one common inventor. This rule also applies to any provisional patent application(s) present in the priority claim chain.

If there is no common inventor between the parent and the child applications, the child application will be considered as an invention on its own. In this case, the parent application turns up in the prior art search, and the child application may be rejected due to double-patenting of an invention.

Proper claim of priority to the parent application

The continuation application must have a proper chain of priority claims. If there are intermediate patent applications between the parent and the child application, the priority claims between each of the intermediate applications must be properly stated.

The continuation application cannot introduce new matter [[35 USC §132\(a\)](#)] and the disclosure in the application must correspond to that of the parent application(s) which the application claims benefit from. Minor changes to the title, summary or claims are allowed. However, these changes may not include any new matter, but they may take out any references to inventions that do not fall under the scope of the continuation application.

When a continuation application is typically filed?

This type of application is often filed when a patent examiner has allowed some claims but rejected others in a patent application, or when an applicant feels that they have not exhausted all the useful



ways of claiming different embodiments of the invention during patent prosecution; or to establish a right for further examination by the U.S. Patent and Trademark Office.

What are the pros of filing a continuation application?

1) Acquainting the Examiner

Patent Examiners operate under time constraints that do not always allow them to learn the details of a patent application before issuing a rejection. If the claims are worded broadly, the Examiner will only search deep enough into the prior art in order to find the claimed elements. Therefore, early claim rejections of broadly worded claims may often be based upon art that is unrelated to the patentable subject matter. However, through the course of prosecution the applicant may be able to educate the Examiner as to the problem that is addressed by the claimed invention and why prior art solutions are distinguished.

If the continuation application is examined by the same examiner, they may begin the examination with the knowledge of the previous prosecution. This enables the examiner to more efficiently examine the patent application and can result in a higher quality first action and shorter overall prosecution of subsequent continuation applications.

2) Earlier Patent Issuance

Patent applications are typically written as broadly as possible and for this reason are met with resistance in the Patent Office. The Patent Office will often allow the narrow claims of an application while rejecting the broader claims. When an applicant has a particular product with immediate commercial potential, it may be wise to let go of the broad claims during prosecution to obtain a patent on the narrow claims covering the specific product. The broader claims can be filed in a separate continuation application, with the commercial product being protected in the meantime. An early patent issuance advances and maximizes the enforceable term of the granted patent and enables earlier enforcement of patent claims against infringers and leads to the marking of commercial embodiments with a patent number to deter potential infringers.

Separating the claims between the parent and the child application will also prevent the payment of extra claim fees for claims in the parent application that may be dropped during patent prosecution.

3) Preserving Protection of Equivalents

When claims are rejected during patent prosecution, amendments are often made to the claims in order to add additional patentable features. These added claim features may not be granted any equivalence under the [Doctrine of Equivalents](#).

The Doctrine of Equivalents is used by a patentee to argue that a product is infringing on the invention of the patentee, when the accused product does not perfectly read on to any claims of the infringing patent, and there is insubstantial difference between the accused product and the infringed invention.

On the other hand, by using continuation applications, narrowly crafted claims may be presented in



the parent application since they have a higher likelihood of quick issuance with minimal or no amendments. The broader claims that cover the invention may require extensive amendments or arguments, and hence may be saved for prosecution in a separate continuing application. This helps in preserving the doctrine of equivalents to protect the invention from competitors who adopt an identical essence of the invention.

4) Protecting Against Competitor Design-Arounds

A competitor will often attempt to change minor designs in a product based on the patentee's invention in order to fall outside of the claims of the patent. This is usually done to reduce a threat of potential patent infringement.

When a continuation application is kept pending through the life of a family of patents, new claims may be drafted in the continuation application that seek to cover the newly designed competitor features. However, this can only be done if the material covered by new or altered claims in the continuation application was already disclosed in the original patent application.

5) You want to claim minor variations

Maintaining the pendency of the subject matter disclosed in the patent application allows the patent owner to craft new claims for the same disclosure at a later date. This may be done for various reasons such as separating claims by market so that one set of claims may be licensed only into one market and another set of claims may be licensed only into another market; or separating claims into standards essential and not standard essential, or into functional claims and ornamental claims; and so on.

6) Broadening patent protection

Continuation applications allow the inventor greater flexibility in claiming the invention. In a continuing patent application, the focus of the claims can be altered or shifted regardless of whether the claims include the primary invention described in the patent application. A continuation application does not need to disclose a new or an original invention. It can merely contain different claims for an invention which was already disclosed in the parent application.

What are the cons of filing a continuation application?

1) Increased cost

The cost of pursuing multiple continuing patent applications can be very high. Continuation applications also lead to increased USPTO fees as each application and patent in the family requires separate filing, issuance, and maintenance fees in addition to patent agent or attorney fees. Such costs may be restricting for new commercial ventures, small companies, and independent inventors.

2) Increased time

A utility patent application in the United States may take at least 2 years to be granted. When multiple continuation applications are filed, the time taken for the prosecution and granting of those



applications may require several years.

3) Less remaining patent term

Utility patent terms are measured as twenty years from the earliest filing date. The result of filing a utility continuation application instead of a separate independent application is that the term of any utility patent maturing from the continuation application is calculated from the filing date of the parent application and not from the filing date of your child continuation application. Thus, when the parent application expires, any continuation applications claiming its priority date will also expire. If the time taken for the prosecution and granting of the continuation application is considered, the continuation application may have an even lesser active time.

4) No new matter can be added to the disclosure

A continuation application inherits the parent application's priority date and its specification is limited to the parent application's disclosure. Any new developments that occurred since the original patent filing cannot be described in a continuation application because new matter cannot be added to a continuation application.

Conclusion

Continuation-application filings are becoming increasingly common. The advantages of continuation application practice come with some disadvantages that must also be considered while developing a patent strategy. Filing continuation applications offers many advantages, particularly now that patents are frequently enforced. However, blindly filing continuation applications will lead to an explosion in costs.

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