

# Continuation Applications in Prosecution Strategy

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One inventive concept, product, or feature, may be able to support multiple patents. In such case, a portfolio of patents may be optimal for obtaining the desired scope of protection. One way to obtain such a portfolio is with a family of two or more legally related patents or applications. These patents and applications are legally related through continuation practice, whereby a later filed application claims priority to an earlier filed application.

A continuing application has three basic requirements 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.

There are two general kinds of continuing applications. A *continuation application* presents new claims that are fully supported by the specification of the parent application. A *continuation-in-part application* amends the specification of the parent application to include additional disclosure and introduces new claims. A third kind of application, a divisional application is a special case of a continuation application. A divisional application is filed after a Restriction Requirement requires an election be-

tween patentably distinct inventions in the same application. The divisional application allows for prosecution of the claims not elected in the parent application.

Implementing a prosecution strategy that includes continuing applications can provide the advantages of educating the Examiner, faster patent protection enabling earlier patent marking, preserving the protection of equivalents, and protecting against competitor design-arounds. Each of these advantages will be briefly explored in further detail.

## Educating the Examiner

Patent Examiners operate under time constraints that do not always allow for them to learn the details or minutiae 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 can often be based upon art that is unrelated to the patentable subject matter. However, through the course of prosecution the applicant is 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 continuing

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application is examined by the same Examiner, then that Examiner begins the examination with the knowledge of the previous prosecution, thus enabling the Examiner to more efficiently examine the application. This can result in a higher quality first ac-

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tion and shorter overall prosecution of subsequent continuation applications.

### **Earlier Patent Issuance**

Often during the course of the prosecution of the application, the Examiner will identify some claims as allowable or as claiming allowable subject matter. These allowable claims can be accepted to be issued as a patent. The remaining broader claims can be further argued in a continuing application. Similarly, an original application may be filed with narrow claims with the purpose of quickly obtaining an allowed patent, while the longer process of obtaining broader patent coverage is handled with a continuing application. An early patent issuance maximizes the enforceable term of the granted patent and enables earlier enforcement of patent claims against infringers or marking of commercial embodiments with a patent number to deter potential infringers.

### **Preserving Protection of Equivalents**

Prosecution history estoppel prevents a patentee from using an expansive theory of claim interpretation to recapture subject matter that was given up during prosecution by amendment or argument. When claims are rejected during prosecution, amendments are often made in order to add additional patentable features. These added features are not granted any equivalence under the Doctrine of Equivalents. On the other hand, narrowly crafted claims have a higher likelihood of quick issuance with minimal or no amendments. These can be presented in the original parent application, while the broader claims that may require extensive amendments or arguments are saved for prosecution in a separate continuing application.

### **Protecting Against Competitor Design-Arounds**

When faced with the threat of potential patent infringement, a competitor will often attempt to change a design in order to fall outside of the claims of a patent. By keeping a continuation application pending throughout the life of a family of patents, new claims can be drafted in the continuation application that seek to cover the newly de-

signed competitor features, so long as the new or replaced features are disclosed in the original patent application.

### **Considerations in Developing a Continuation Strategy**

The advantages of continuation application practice come with some disadvantages that must also be considered when developing a patenting strategy. As mentioned above, patent terms are measured as twenty years from the earliest filing date. Therefore, the term of a continuing application is measured from the filing date of the original parent application. Therefore, continuing applications generally have less remaining patent term once the patents issue as compared to patents granted from original applications. Continuing applications also lead to increased USPTO fees as each application and patent in the family requires separate filing, issuance, and maintenance fees.

Continuation-In-Part (CIP) applications offer the distinct advantage of enabling the addition of subject matter into a utility patent application. However, the new subject matter will only have the priority date of the filing of the CIP application, therefore, additional new prior art is available against the new subject matter. The Federal Circuit has also held that the patent owner bears the burden of proof that the claims in a CIP application are supported by the original application and therefore entitled to the earlier filing date. Additionally, a published patent application becomes a bar to patentability under Section 102 (b) (AIA Section 102(a)(2)) one year after the publication date. Therefore, once a parent patent application has been published for more than a year, that parent application will be prior art against any new subject matter in a CIP application. In this instance it may be preferable to file a new original application rather than a CIP application as the parent application must be distinguished for patentability, and a new original application will necessarily have a longer effective patent term.

Continuing patent application practice is one tool available to achieve goals of a patent strategy. Continuing patent application practice enables applications in a patent family to serve different purposes to achieve the desired scope of protection around an invention.