

APPELLATE COURT RESURRECTS 10,000 PATENTS

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Many patent owners breathed a collective sigh of relief when on June 21 the U.S. Court of Appeals for the Federal Circuit overturned a 2015 district court decision that if left in place would have invalidated over 10,000 U.S. patents.

Patent owners often file what is called a “continuation” application shortly before a patent issues. One reason for this filing is to obtain broader claims than the patent office allowed in the original or “parent” patent. Traditionally the patent office has allowed these continuations to be filed any time **on or before** the day the original patent issued. Last year the U.S. District Court for the District of Delaware held in *Immersion Corporation v. HTC Corporation, HTC America, Inc.* that continuation applications be filed no later than the day **before** the original application issues as a patent; if filed later than that date the continuation application would be invalid. The Delaware district court ruling would have had the effect of invalidating thousands of patents that were filed on the day the original patent issued; one day late under the *Immersion* doctrine.

The Federal Circuit disagreed with the district court’s ruling, concluding that the deadline to file a continuation application based on an issuing original patent is at the end of the day the original patent issues.

In anticipation of this ruling by the Federal Circuit, Tucker Ellis recently released a [Client Alert](#) explaining that due dates for continuation applications should be docketed the day before the issue date of the parent. With this Federal Circuit ruling, continuation application due dates that claim priority to a parent case that is issuing can be placed on the same day of the issue date of said parent.

Although the Federal Circuit ruling in *Immersion* grants an extra day for filing, Tucker Ellis will continue docketing the filing date for continuation applications the day before the issue date of an original application as a precaution.

ADDITIONAL INFORMATION

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