

IMMERSION CORP. v. HTC CORP., Appeal No. 2015-1574 (Fed. Cir. June 22, 2016). Before Prost, Linn, and Taranto. Appealed from D. Del. (Judge Andrews).

## Background:

Immersion owns a number of U.S. patents, each of which issued from a string of continuation applications that claim priority benefit of the filing date of a common parent application under 35 U.S.C §120. The first continuation application in that string was filed on the same day that the parent application issued as a patent. All of the subsequent continuation applications were filed at least one day prior to its predecessor application's issuance as a patent or abandonment.

Immersion also filed a PCT application claiming priority to the same parent application. That PCT application, which has a disclosure materially identical to that of the parent application and each of the continuation applications, was published more than one year prior to the filing date of the first U.S. continuation application.

Immersion sued HTC for infringing claims of three of the patents that issued from the string of continuation applications. HTC contended that because the first continuation application was filed on the same day that the parent application issued as a patent, it was not "filed before the patenting" of the parent application as required by §120, and thus the asserted claims were not entitled to the filing date of the parent application, but instead were only entitled to the filing date of the first continuation application. HTC asserted that the publication of Immersion's PCT application thus qualified as prior art to the asserted claims under pre-AIA 35 U.S.C. §102(b), and anticipated the asserted claims, rendering the claims invalid. The district court agreed with HTC's arguments and granted summary judgment of invalidity. Immersion appealed.

## Issue/Holding:

Does the filing of a continuation application on the same day its parent application issues as a patent meet the requirement of 35 U.S.C. §120 that the continuation application be "filed before the patenting" of the parent application? Yes, reversed and remanded.

## Discussion:

HTC's central premise was that the §120 language "filed before the patenting" means "before a statutory deadline" which means "'before' that date, not 'on or before.'" The Federal Circuit stated that the statutory language does not compel, though it certainly could support, such an interpretation, and found that the statutory language, considered alone, does not resolve the issue. Analyzing a number of factors, the Federal Circuit found that history is decisive in permitting the same-day-continuation result. In 1863, the Supreme Court approved same-day continuations, and the 1952 Patent Act, which introduced §120, was broadly a codification of existing continuation practices. Also, same-day continuations have been approved by a consistent, clearly articulated USPTO practice going back at least 50 years, which engendered large-scale public reliance and which is within the USPTO's procedural authority to define when the legal acts of "filing" and "patenting" will be deemed to occur. Moreover, Congress has done nothing to disapprove of this clearly articulated position despite having amended §120 several times since its first enactment in 1952.