Continuation Patent Applications: 10 Reasons You Should Consider Filing

IP Law Bulletin
on 05.01.2017 | Posted in Litigation, Patents

If you’ve filed for patents in any industry – be it biotech, high tech, manufacturing, or another sector altogether – you’ve likely been faced with a decision on whether to file a “continuation” application at the US Patent and Trademark Office (USPTO). In simple terms, a “continuation” application is a new patent application allowing one to pursue additional claims based upon the same description and priority date(s) as a pending “parent” application. Continuation applications are a flexible tool, useful for furthering numerous business objectives.

Here are ten reasons you should consider filing a US continuation patent application as part of your intellectual property strategy:

1. **Multiple Inventions.** The USPTO only allows a patent to claim one invention. However, patent applications are often drafted, or determined by the USPTO, to cover multiple inventions. In such cases, the USPTO may issue a “restriction requirement,” dividing up the inventions and asking the applicant to select one for examination. The other inventions can be pursued in a continuation application called a “divisional.”

2. **Broader Claims.** Sometimes, patent applications are allowed with claims providing only “narrow” coverage. For example, an applicant may choose to establish an immediate defense by expediting claims to a specific embodiment of an invention, or accepting an Examiner’s offer to allow a subset of the pending claims. In such circumstances, a continuation application is useful follow-up for pursuing “broader” protection. Continuations might also be filed to cover alternative embodiments of the invention or block design-arounds.

3. **Go On the Offensive.** Continuation applications can also be used offensively. For example, one can file a continuation with claims covering a competitor’s product as long as it is described in the original parent application.

4. **Creating Uncertainty.** In addition to building clear defensive and offensive positions, continuation applications (usually with broad claims) can be used to create uncertainty around the final scope of patent protection and provide a deterrent to competitors.

5. **Evolving Technology.** Technology is constantly evolving. A pending continuation application can provide a vehicle for drafting claims covering future advances, as long as they are supported in the original parent application.

6. **Law in Flux.** Similar to technology, the law is in a constant state of flux. Legal developments, such as the Supreme Court’s decisions in *Myriad* and *Alice* limiting what is eligible for patent protection, have fundamentally altered the patent landscape. Continuation applications provide a tool for addressing legal developments, for example through new claims that work around, or exploit, the changes.
7. **Litigation.** Continuation applications are standard tools for patentees engaged in, contemplating, or expecting litigation. For example, a pending continuation application allows you to react to the lawsuit’s outcome – like drafting new claims to avoid newly discovered prior art.

8. **Maximize Value.** When a patent might be sold or licensed in the future, maintaining a continuation application can maximize value by allowing the purchaser or licensee to use the continuation to pursue their objectives.

9. **Defer (Decisions, Costs).** Sometimes, it is necessary to defer a decision or cost. Continuation application can be used to delay prosecution, for example, by “restarting” the examination timeline by abandoning a patent application in favor of a continuation application with the same or similar claims.

10. **Keep Your Options Open.** A continuation application must be filed before the parent application issues as a patent. Therefore, filing a continuation application can be viewed like purchasing an “options contract” to pursue new, additional claims for any reason in the future.

Savvy applicants will consider continuation applications as a valuable tool throughout patent prosecution, and will draft their applications to include multiple defensive, offensive, fallback, and alternative positions.

**Final Tip:** You don’t have to wait until your patent application is allowed – use continuations to react to business, scientific, or legal developments at any time.

**Tags:** Litigation, Patent Prosecution, Patents, USPTO