***Immersion Corp. v. HTC Corp.*: "Same Date" § 120 Filings**

In *Immersion Corp. v. HTC Corp*., __ F.3d __ (Fed. Cir. June 21, 2016)(Taranto, J.), the panel concludes that a continuation application filed on the date of patenting is one that has been "***filed before the patenting***", a necessary condition for continuation status.

Attached is a note that explores problematic historical issues that the panel would do well to correct, to the extent that the case might be reviewed by the Supreme Court. This would enhance the chances that the Court would sustain the result in this case.

Regards,

Hal

Immersion Corp. v. HTC Corp.: Problematic Historical Issues

Immersion Corp. v. HTC Corp., __ F.3d __ (Fed. Cir. June 21, 2016)(Taranto, J.), concludes that an application ***filed on the same date*** as the patenting of an earlier application is one that has been "***filed before the patenting***" of that earlier application within the meaning of 35 USC § 120 of the 1952 Patent Act. The Patent Office initially interpreted Section 120 in its *Manual of Patent Examining Procedure* as requiring exactly what the statute says, that priority is granted only if the filing date of the later application is *before* the date of patenting; under the original interpretation of "before the patenting" meant that if the filing date of the later application is the *same* as the filing date of the would-be parent application, the statutory requirement is not met, and there is no priority right.

Attached at page 2-5 is an excerpt from the opinion . Specific points are highlight marked in turquoise, complemented by a red-boxed analysis: The panel sees an ambiguity in the statute, but reaches its conclusion keyed to a lack of context of the historical realities of 1952 patent procedures.

Did the Panel Reach the Right Result?

Is the *result* reached in *Immersion Corporation* correct as a policy matter? Can the result be justified by alternate reasoning outside the scope of this paper?

The writer takes no position on these questions. To the extent that the *result* should be sustained, if the Supreme Court grants *certiorari* review, chances for sustaining the result reached by the panel would be enhanced if the panel were to reissue its opinion to take into account historical realities.

***From the Opinion*:**

This case involves one necessary condition, under 35 U.S.C. § 120, for treating a patent application, filed as a continuation of an earlier application, as having the earlier application's filing date[.] *** The condition at issue *** is that the continuation application be "filed before the patenting" of the earlier application. The question is whether, for that condition to be met, the continuing application has to be filed at least one *day* before the earlier application is patented, or whether an application may be "filed before the patenting" of the earlier application when both legal acts, filing and patenting, occur on the same day.

We adopt the latter position. The statutory language does not compel, though it certainly could support, adoption of a day as the unit of time for deciding if filing is "before" patenting. And history is decisive in permitting the same-day-continuation result, under which, using units of time of less than a day, a "filing" is deemed to occur before "patenting." *** [S]ame-day continuations *** reflect[ ] the agency's procedural authority to define when the legal acts of "filing" and "patenting" will be deemed to occur, relative to each other, during a day.

The "day" versus "date" scenario of the opinion, *arguendo*, makes sense, if the Patent Office determined the *time* of filing an application. It did not measure the time of filing.

In 1952 when Section 120 was enacted into law, the Patent Office only registered the *date* of filing. There was no electronic date/time stamp, but instead patent filings at some time, even the next day after filing, were date stamped with the date of actual receipt of the papers in the Patent Office. The date of filing was stamped with an "'Office Date' stamp". *See* MPEP § 200 (2nd ed. November 1953) MPEP § 505, *"Office Date" Stamp of Receipt.* ("In whatever manner an application *** is received by the Office, the date of its receipt is at once stamped thereon. *** The stamp is referred to the 'Office Date' stamp and *** establishes the 'filing date.'"). By the 1960's when the Patent Office was still at main Commerce Department building, papers could be deposited in a "Midnight Box" that a guard would lock shut at midnight.

* * *

DISCUSSION

Section 120 provides, in relevant part:

> [a]n application for patent for an invention disclosed . . . in an application previously filed in the United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application, *if filed before the patenting* or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application.

35 U.S.C. § 120 (emphasis added). Section 120 was included in the Patent Act of 1952, and the language relevant here has remained materially unaltered since then. [citations omitted]

Section 120's language does not by its terms answer the question whether a later-filed application can claim the same filing date as an earlier-filed application when the later one is filed on the day of the earlier one's patenting. Section 120's language requires that the later application be "filed before the patenting" of the earlier. But that language does not say that the unit of time is a day, as opposed to some smaller unit. As far as that language goes, filing can precede patenting on the same day.

> As noted, *supra*, in 1952 and subsequently, the Patent Office measured filing events only in terms of the *date* and not the *time* of any day, as evidenced by the fact that the "'Office Date' stamp" to indicate the *date* of filing was commonly applied to the contents of a bag of mail received on one day and then stamped on a subsequent day. In 1952 there never was a record kept of the *time* of filing.

The central premise of HTC's position—that neither of two events on the same day can be "before" the other— is that time under the section 120 language at issue must be measured with a "date-level granularity," *i.e.*, in units no smaller than a "day." HTC Br. at 18-19; Oral Arg. at 21:44-23:00. HTC's brief relies on that premise from the very start, embedding the premise in its foundational framing of the issue as whether "'before' a statutory deadline means 'before' that date, not 'on or before.'" HTC Br. at 3; id. at 1 ("'Before' a statutory deadline means before that date, not *on or before* that date."). The formulation presupposes the answer in referring to "date[s]" and even in using the phrase "*on or* before": "on a day" is ordinary usage; "on a minute" or "on a moment" or "on a time" is not. And it is only on that presupposition that the dichotomy between "before" and "on or before" is forceful, as it has been precisely in cases involving *day* (equivalently,

date) language. *See, e.g.*, *United States v. Locke*, 471 U.S. 84, 90, 96 n.11 (1985); *Burton v. Stevedoring Servs. of Am.*, 196 F.3d 1070, 1073 (9th Cir. 1999); *Int'l Union, United Mine Workers of Am. v. Mine Safety & Health Admin.*, 900 F.2d 384, 385 (D.C. Cir. 1990). But that dichotomy is inapplicable, or at best question-begging, where the statutory language, as with the phrase at issue here, does not actually speak in terms of days or dates. Here, quite simply, the language at issue, considered alone, does not resolve the crucial unit-of-time issue.

* * *

Soon after the 1952 Act's enactment, the PTO promulgated 37 C.F.R. § 1.78(a) (1960), stating that "the benefit of the filing date of [a] prior application" can be obtained when "an applicant files an application claiming an invention disclosed in a prior filed *copending* application." (Emphasis added.)

> "Soon after" the 1952 statutory enactment, *here*, was 1960, nearly one full *decade* after enactment.

Not surprisingly, then, the agency soon went beyond the term "copending" (with its *Godfrey*-based meaning[,*Godfrey v. Eames*, 68 U.S. (1 Wall.) 317 (1864)],) to be more explicit about the same-day situation. Although an early edition of the Manual of Patent Examining Procedure defined "copending" by simply echoing section 120's language, MPEP § 201.11 (2d ed. 1953), every later edition of the MPEP, beginning in 1961, specifically notified the public of the agency practice concerning same-day filing and patenting: "If the first application issues as a patent, it is sufficient for the second application to be *copending* with it if the second application is filed *on the same day or before* the patenting of the first application." MPEP § 201.11 (3d ed. 1961) (emphases added).

> Rev. 1 of the First Edition *maintained* the initial Office interpretation. Five years before the 1961 date cited in the opinion, the First Edition in Rev. 2 (June 1956) reflects the current Office position on copendency.

* * *

*** HTC makes no meaningful argument for overturning the same-day-continuation practice independent of its argument that the section 120 phrase at issue must be read as using a "day" as the unit of time for determining beforeness. Indeed, once we conclude that the phrase permits consideration of whether filing was before patenting *within* a single day, any argument against same-day continuations runs into insuperable difficulties, given *Godfrey* and the PTO's authority, supported by obvious practical considerations, to declare when the events of "filing" and "patenting" are deemed to occur within the same day. ***

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