



West & Associates, A PC
www.westpatentlaw.com

CONTINUING APPLICATIONS

BASIC INFORMATION

ABOUT

CONTINUING APPLICATIONS:

CONTINUATIONS, DIVISIONALS & CIPs



What is a Continuing Application?

- A continuing patent application is a new patent application that continues the examination process. It enables the applicant to continue to argue with the USPTO for broader (or different) patent protections while also allowing the original patent application to issue.
- The original application is often called the parent, and successive application(s), children.
- The claims in a continuing application usually have the priority date of the parent application.



Do I have to file a Continuing Application?

- No. It is never mandatory to file.
- A continuing patent application may serve many business purposes, but is not required for the parent application to issue.
- If you want to continue arguing some of the rejected claims, or seek broader protection, but you don't want to delay issue of your patent, a continuing application is a way to do this.
- Continuing Applications can add value to a business, especially if you are seeking to divest.



Are There Different Types of Continuing Applications?

- Yes!
- **Continuations**—These applications seek protection on the same invention as the underlying application, possibly claimed in a different way. **MOST COMMON.**
- **Divisionals**—These applications seek protection on an invention that was somehow deemed distinct from your underlying patent claims—perhaps your original application disclosure contained two, or more, different inventions.
- **Continuations-In-Part**—These applications allow for the addition of new material to the body of the application. However, this **CAN IMPACT YOUR INVENTION DATE**, so the benefits/drawbacks should be fully discussed before using this form.



Should I file a Continuing Application?

- Maybe, it depends on your business.
- If some of your original claims were rejected, you can file a continuation with those claims, hoping to get a different examiner or just continue arguing.
- If the product has modifications, you can file a continuation-in-part on those modifications not disclosed in the parent application.
- If you simply want broader protection, for example, if a competitor has a similar item with features that are not protected by your patent or a potential licensee is trying to design around your patent claims, a continuation may be a deterrent.
- Keeping prosecution open may interest potential investors or increase interest in acquisition.



What's the Deadline for Filing?

When do I need to let you know I want to file?

- All types of continuing applications must be filed before the issuance or abandonment of the parent application—once the parent issues, the window for filing closes.
- A Continuation or Divisional application can usually be filed fairly quickly, since the same body of the application is used and only new claims need to be added.
- A Continuation-in-Part, however, includes new material in the body of the application. It can be as time consuming as drafting a new application and, generally, cannot be done quickly.



WE ARE WATCHING



PATENTS TRADEMARKS COPYRIGHTS

**WEST & ASSOCIATES, A PC
3050 CITRUS CIRCLE, SUITE 207
WALNUT CREEK, CA 94598
TEL: 925.262.2220
WWW.WESTPATENTLAW.COM**

