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Federal Circuit Patent Bulletin: *Immersion Corp. v. HTC Corp.*

June 21, 2016

"[Under 35 U.S.C. § 120,] an application may be 'filed before the patenting' of the earlier application when both legal acts, filing and patenting, occur on the same day."

On June 21, 2016, in *Immersion Corp. v. HTC Corp.*, the U.S. Court of Appeals for the Federal Circuit (Prost, Linn, Taranto*) reversed and remanded the district court's summary judgment that U.S. Patents No. 7,982,720, No. 8,031,181, and No. 8,059,105, which related to a mechanism for providing haptic feedback to users of electronic devices, were invalid as anticipated under 35 U.S.C. § 102(b). The Federal Circuit stated:

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. Section 120 was included in the Patent Act of 1952, and the language relevant here has remained materially unaltered since then. 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.

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'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.'" 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. 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.

We must therefore widen the lens to look beyond the specific phrase at issue. That widening immediately reveals how pervasively the Patent Act elsewhere, including in other phrases within section 120, specifies time by express reference to days, months, or years. But even apart from other considerations, the significance of that fact for the present issue is not unidirectional. The prevalence of date-based usage elsewhere in the statute does not by itself determine the meaning of a statutory phrase (like the one at issue here) that does not refer to a unit of time: differences in text often furnish a reason for differences in meaning.

To be sure, the usage elsewhere in the Act means that the particular language of section 120 that is at issue here can bear a day-as-unit meaning. That meaning might even be the most natural one to adopt—the one that would fit best with the statute as a whole—if the statute were new and without history, whether pre-enactment or post-enactment. But that is not the posture in which the question is presented. We cannot properly disregard the history bearing on the interpretive question, and that history, we think, is so weighty as to be determinative. . . .

Here, HTC's position would disturb over 50 years of public and agency reliance on the permissibility of same-day continuations. Several patents claiming effective filing dates in reliance on the PTO's articulated position have been the subject of litigation in the recent past. As far as we are aware, until this case, the only square rulings on the issue upheld the same-day-continuation position (rulings issued in two cases by the same judge). Even as to patents currently in force, according to the government's calculations and studies commissioned by amicus Intellectual Property Owners Association, overturning the PTO's position would affect the priority dates of more than ten thousand patents. For those and decades of earlier patents, it is plausible that applicants relied on the policy approving same-day continuations in at least two ways. First, in the PTO, applicants have likely relied on the policy in deciding when to file their continuations; the PTO provides notice of the expected issuance date of the (soon-to-be) parent application, and we are informed that such notice is pretty reliable as to an earliest date of issuance. Applicants' reliance on the PTO position in timing their filing of continuations need not reflect the safest of lawyerly practices to be given weight. Second, after such same-day continuations issued as patents, the patentees plausibly made investments based on assessments of validity using the earlier priority dates. We see no basis for denying the existence of a facially large disruptive effect were we now to repudiate the same-day-continuation policy.