

Title: **Special Considerations for Assigning a Continuation-In-Part Patent Application**

Full Article: In Causam Enterprises, Inc. v. International Trade Commission, No. 2023-1769, decided October 15, 2025, the United States Court of Appeals for the Federal Circuit held that the phrase “all divisions, reissues, continuations and extensions thereof” in an assignment for a patent application does NOT encompass continuation-in-part applications.

The issue was whether the language of the assignment conveyed rights to a subsequently filed continuation-in-part application. The assignment document assigned U.S. patent application 11/895,909 to America Connect, Inc. The specific language of the assignment transferred ownership of the “[i]nvention” of the ‘909 application and “all patents which may be granted therefor” and “all divisions, reissues, continuations and extensions thereof” (emphasis added). The assignment did not mention continuations-in part.

The Court concluded that continuations and continuations-in-part are widely understood to be different, partly in view of the fact that the Manual of Patent Examining Procedures treats them separately. Merely referring to assignment of “the invention” was insufficient to allow the Court to read “continuation” as “continuation or continuation-in-part.” As a result, the Court concluded that the 2007 assignment document did not convey rights in a subsequently filed continuation-in-part application.

The history of the assignment and resulting patents is complicated. The inventor, Joseph Forbes, filed U.S. patent application 11/895,909 on August 28, 2007.

A divisional application, U.S. patent application 13/172,195, was filed on March 1, 2010 from the ‘909 application.

A continuation-in-part application, U.S. patent application 13/463,761, was filed on March 3, 2012, from the ‘195 application.

From the continuation-in-part application, a series of continuation applications were filed: SN 14/456,306 (filed 8/11/2014) claimed priority of the ‘761 application, and 15/618,981 (filed 6/9/2017) claimed priority of the ‘306 application. The ‘981 application was granted as U.S. Patent No. 10,394,268, which was the subject of the Court decision discussed above.

After the 2007 assignment document to America Connect, Inc., in 2009 Consert, Inc. acquired America Connect’s interest in the original ‘909 application. In a 2013 settlement, inventor Forbes assigned to Consert, Inc. some patents, including the original ‘909 application, but U.S. patent application 13/463,761 was specifically excluded from settlement.

The Court determined that the issue of ownership of the ‘268 patent “boils down to the effect of the 2007 assignment.” As stated above, the specific language of the 2007 assignment transferred ownership of the “[i]nvention” of the ‘909 application and “all patents which may be granted therefor” and “all divisions, reissues, continuations and extensions thereof.” The document did not mention continuations-in part.

The Court then determined that, “under the operative language of the 2007 assignment, the crux of the matter is whether to interpret the assignment of the “[i]nvention” of the ’909 application and “all patents which may be granted therefor” and “all divisions, reissues, continuations and extensions thereof” to include the ’761 continuation-in-part application. The Court held that the answer is no, i.e., that the language “all divisions, reissues, continuations and extensions thereof” does NOT cover continuation-in-part applications.

Practice Tips:

Despite what might appear to be a reasonable grammatical interpretation, in the context of an assignment document, the term “continuation” does not include a continuation-in-part.

Also, the assignment in a parent application that covers continuations-in-part may arguably cover a subsequently filed continuation-in-part. However, a continuation-in-part application by definition includes subject matter not included in the parent application. Accordingly, there may be an issue as to whether the assignment of the parent application will cover the new subject matter that was not present in the parent. This is particularly an issue when the new subject matter was contributed by a new inventor not listed in the parent application.

Accordingly, even if the assignment of the parent application covers continuations-in-part, one should always obtain a new assignment for the continuation-in-part application.

More importantly, there are almost no reasons to file a continuation-in-part application. If a claim in a continuation-in-part application is not completely supported by the parent application, that claim will not be entitled to the effective filing date of the parent application. And, depending on the timing of the filings, the parent application may be prior art with respect to the continuation-in-part.

If the parent application supports the claim of subsequently filed application, the patentee would be much better off filing the subsequent application as a direct continuation or divisional. In that case, there would be no doubt that the subsequently filed application is entitled to the effective filing date of the parent application and the parent application would not be prior art to the subsequently filed application. On the other hand, if the parent application does not support a claim in a subsequently filed application, there is no benefit in labelling the subsequently filed application as a continuation-in-part.

Filing the subsequent application as a continuation-in-part application could potentially create confusion as to whether the parent application supports a claim in the subsequent application, which would create a complex (and likely expensive) factual issue to resolve in a proceeding as to whether a claim is supported by the parent.

Patentees should review any continuation-in-part applications in their portfolio to ensure proper assignment. Parties acquiring intellectual property should conduct careful diligence to ensure that continuation-in-part applications are subject to separately recorded assignments. Before commencing litigation for a patent family including a continuation-in-part, a potential plaintiff should ensure that chain of title may be definitively established for all of the applications in the family to avoid a later challenge to ownership and standing. Similarly,

parties facing an infringement complaint involving a continuation-in-part patent should confirm that the patent was properly assigned.

Accordingly, be careful of the wording in an assignment document, and think carefully before deciding to file a continuation-in-part application.

Author(s)' Name(s), Title(s), and Email(s):

William C. Rowland

703 838 6510

william.rowland@bipc.com

Duane A. Stewart, III

412 562 1622

duane.stewart@bipc.com