

4 KEY TAKEAWAYS

Prosecution Laches: A Potential Threat to Continuation Application Practice

Kilpatrick's [Darin Gibby](#) and [David Hsu](#) presented a session during the firm's annual "SKI-LE" in Vail, Colorado, exploring prosecution laches and continuation application strategies in light of the recent decision in *Sonos v. Google*. Firm clients and attorneys heard how this case may have major implications in the patent law landscape as in-house counsel often seek to file continuation applications over several years to cover scope not explicitly claimed in the first application.

Key Takeaways from their presentation, include:

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Continuation Application Practice: Keeping an application family pending through continuation applications may be important to a client for different reasons. Continuation applications may keep competitors guessing as to what claims may be allowed after prosecution and may force competitors to spend money watching applications. Patent holders can catch design arounds if a competitor practices a disclosed embodiment. Continuation applications can cover additional claims if the patent holder decides to change a product and that product was disclosed in an earlier application. Continuation applications also provides a patent holder options if a patent is in an ex parte reexamination proceeding, other post-grant proceeding, or litigation.

Prosecution Laches: A patent can be deemed unenforceable under the doctrine of prosecution laches if (1) the patentee's delay in prosecution was unreasonable and inexcusable under the totality of the circumstances, and (2) the alleged infringer suffered prejudice resulting from the delay.

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Recent Case Raises Questions about Continuation Application Practice: In *Sonos v. Google*, the District Court for the Northern District of California held that Sonos's patents were unenforceable for prosecution laches. Sonos had filed two continuation applications 13 years after the provisional application but diligently prosecuted applications in the patent family. The Court reasoned that complying with statutory requirements and USPTO regulations was not sufficient to avoid prosecution laches.

Continuation Application Considerations: When filing a continuation application, practitioners should be aware of the risk of prosecution laches, particularly if the application is being filed eight years or more after the priority date. Practitioners should also be more concerned if the claims have questionable support or enablement in the specification. Weak support or enablement may be used as evidence of prejudice against an alleged infringer.

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