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Effect Of New USPTO Rules On Patent Applicants

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I. Continuations/RCEs

- 2 continuation applications and 1 RCE per patent family as a matter of right.
 - Divisional applications are counted separately and can be the basis for 2 continuations and 1 RCE (in addition to those based on the original application)
 - Additional continuations/RCEs permitted by petition showing that new amendment, argument or evidence to be submitted could not have been presented earlier.

II. Claim Limits

- 5 independent and 25 total claims permitted per application (after any restriction) without an Examination Support Document (ESD).
- Applicants can submit Suggested Restriction Requirement (SRR) grouping inventions into sets of 5/25 claims.

III. Related Application Disclosure

- All commonly-owned applications and patents with a common inventor and any priority date within 2 months must be identified.
- For applications and patents with any common priority date and overlapping disclosures, applicants must:
 - rebut the presumption that the claims are not patentably distinct or
 - submit a Terminal Disclaimer and justification for multiple applications.

RCE Actions Due by November 1, 2007

- Review all after-final cases for possible RCE
- If an RCE already has been filed in the subject application, or in any parent application, or in any child application, an RCE should be filed by October 31, 2007, because a further RCE will not be permitted after November 1, 2007.

CIP Actions Due By November 1, 2007

- Review all pending continuation-in-part applications and identify all claims that are supported by the parent application
- If this requirement is not met, the Examiner may assume in next office action that all claims are entitled only to the benefit of the actual filing date of the continuation-in-part application

Continuations

- Any continuations filed by October 31, 2007 will count towards the continuation limits that will apply to further continuations filed after October 31, 2007
- Thus, filing multiple continuations by October 31, 2007 will preclude the filing of further continuations after October 31, 2007
- Rules 78(f)(2) and (3) may be invoked against new continuations

5/25 Claim Rule

- After November 1, 2007, the USPTO will issue notices in affected applications that do not satisfy the 5/25 claims rule
- Applicants will be given two months (not extendable) to bring the application into compliance
 - Cancel excess claims;
 - file SRR; or
 - file Examination Support Document (ESD)
- For applications filed after 8/21/07, file SRR together with application

Related Applications – Filing Date Within Two Months Of Each Other

- Identify all commonly owned co-pending applications with at least one common inventor and with priority dates within two months of each
- All such co-pending applications must be identified in each co-pending application “in a separate paper” filed by **February 1, 2008** in applications that have not been allowed
- Notify all affect law firms prosecuting your applications

Related Applications – Overlapping Disclosure & Same Filing/Priority Date

- Presumption that at least some claims are patentably indistinct
- Prepare a rebuttal to the presumption that the claims are patentably indistinct **by February 1, 2008**
- Or...

Related Applications – Overlapping Disclosure & Same Filing/Priority Date

- If two or more co-pending applications are retained with patentably indistinct claims, then by **February 1, 2008**, prepare
 - (i) an explanation of the “good and sufficient reason” for the existence of the co-pending applications;
 - (ii) Terminal disclaimers; and
 - (iii) 5/25 claims total in both applications

Longer Term Best Practices

- Combine two or more related applications together into a single application with SRR to obtain a restriction which will then allow two continuations and one RCE for each divisional
- Given the limits on CIPs, there may be little reason to file an application to an improvement as a CIP; instead just file as a fresh application which incorporates by reference but does not claim priority to earlier applications