



# Patent Nation: A Web Conference

## Jon Dudas and Practitioners on the New Claims & Continuations Rules

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Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office



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# Principle Rule Changes



## 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

# Principle Rule Changes



## II. Claim Limits/ESDs

- 5 independent and 25 total claims permitted per application (after any restriction) without an Examination Support Document (ESD)
- Applicants can submit Suggested Restriction Requirement grouping inventions into sets of 5/25 claims
- ESD requires search and analysis of most relevant prior art and explanation of written description for each claim

# Principle Rule Changes



## III. Related Applications

- 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

# Live Meeting Poll

## Audience Poll

**Which category of rule changes are most likely to impact your business?**

- **Continuations/RCEs**
- **Claim Limits/ESDs**
- **Related Applications**

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# Panel Members:



**Steve Maebius**  
*Moderator*

Co-Chair, Life Sciences Industry Team



**Bob Bahr**  
Senior Patent Counsel, Office of the Deputy Commissioner for Patent Examination Policy



**Courtenay Brinckerhoff**  
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**Steve Fox**  
Of Counsel and Former VP and Deputy General Counsel for IP, Hewlett-Packard Company



# Biotech Perspective: Pinched By Continuation/RCE Limits



## **Continuations/RCEs are often needed**

- To negotiate with Examiner over allowable subject matter
- To submit evidence of enablement/utility
- To permit grant of allowed (often narrow) claims and continued pursuit of broader claims
- To pursue protection of originally unclaimed embodiments

# High-Tech Perspective: Benefits/Burdens



## Limited continuations/RCEs:

- Encourages bone fide advancement of prosecution.
- Limits delay and uncertainty associated with unlimited continuations.
- Discourages abusive hindsight prosecution some have used to capture new products that are not supported by the original specification.

## Related Applications rules:

- New record keeping/disclosure requirements.
- Requires more careful and selective filing strategies, especially for non-U.S. multi-nationals working with multiple law firms
  - Difficulty in assessing what is related

# Three Key Areas for Discussion

- I. Continuations/RCEs
- II. Claim Limits/ESDs
- III. Related Applications

# What Do I Need To Do Now?



1. Review after-final applications for RCEs that must be filed before Nov. 1, 2007
  - Where an RCE already was filed in the patent family
2. Review families with multiple co-pending applications for continuations that must be filed before Nov. 1, 2007
  - Where more than one continuation is needed in the same patent family

# What Do I Need To Do Now?



3. Review pending, un-examined applications for 5/25 claims limit
  - Cancel claims to satisfy 5/25 claims limit
  - Amend claims to support Restriction Requirement with groups of no more than 5/25 claims
  - File a Suggested Restriction Requirement with groups of no more than 5/25 claims
4. Review pending Restriction Requirements
  - Respond without traverse to preserve right to file Divisionals
  - Cancel non-elected claims to prevent withdrawal of restriction and/or rejoinder of non-elected claims

# What Do I Need To Do Now?



## **By November 1, 2007:**

Review CIP applications and identify which claims are supported by the priority application(s)

## **By February 1, 2008:**

Review patent portfolios for related applications (common owner, common inventor)

Disclose applications with any priority date within 2 months

Address presumption of patentably indistinct claims for applications with overlapping disclosures and any common priority date

# Is There Anything I **Shouldn't** Do?



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## 1. **Don't file continuations indiscriminately**

The rules permit at least “one more” continuation application per patent family that can be filed now or after Nov. 1, 2007

## 2. **Don't wait until Nov. 1, 2007 to implement new strategies**

Many of the rules will apply to applications that already are pending, and even to applications already undergoing examination or allowed

## 3. **Don't forget the Feb. 1, 2008 deadlines for related applications rules**

# Questions/Comments Contact:



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