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Practical Strategies and Best Practices for Addressing the New USPTO Claims, Continuations, and RCEs Rules

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On August 21, 2007, the United States Patent and Trademark Office (USPTO) issued a set of new rules limiting the number of (1) claims, (2) continuing applications, and (3) requests for continued examination (RCEs). While the rules are quite complex, there are effective strategic considerations in addressing the new rules. Set forth below is a brief summary of the principal rule changes, a map to the key regulations, some suggested immediate action items, and longer-term best practices.

Principal Rule Changes

I. Continuations/RCEs

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

II. Claims Limits/ESDs

- Five independent and 25 total claims permitted per family of patentably indistinct applications (after any restriction) without an examination support document (ESD)
- Applicants can submit a Suggested Restriction Requirement, grouping inventions into sets of 5/25 claims
- ESD requires search and analysis of the most relevant prior art and explanation of support for each claim

III. Related Applications

- All commonly owned applications and patents with a common inventor and any filing/priority date within two months must be identified
- For applications and patents with any common filing/priority date and substantial overlapping disclosures, applicants must:
 - Rebut a presumption that the claims are not patentably distinct OR
 - Submit a Terminal Disclaimer and justification for multiple applications



Key Regulations

The locations of the key regulations and effective dates are set forth below.

- 1.75(b)(c) 5/25 claim limitations (new applications after November 1, 2007 and pending applications with first office action after November 1, 2007)
- 1.78(a) Definitions of continuing, divisional, continuation, and CIP
- 1.78(d)(1) Limitations on continuing applications (new applications filed after November 1, 2007, and an application family pending before August 21, 2007 is allowed one more continuation)
- 1.78(d)(3) Requirement to identify in a CIP any claim that is supported by the parent (any application pending on or after November 1, 2007)
- 1.78(f) Requirements to identify related applications, and presumption of patentably indistinct claims (new applications after November 1, 2007; for applications filed before November 1, 2007, by February 1, 2008 or, in some cases, later)
- 1.114(a)(d)(f)(g) Limitations on RCEs (any RCE after November 1, 2007)
- 1.136 List of deadlines which cannot be extended
- 1.265 Requirements for an ESD

Immediate Action Items

- Factor in new rules when considering how to respond to an office action.
- If prosecution of an application is closed (e.g., after final rejection) and an RCE already has been filed in any application in the application family, consider filing an RCE before November 1, 2007; an RCE as a matter of right cannot be filed after November 1, 2007.
- For applications with a pending restriction requirement, consider the new claim limitation rules (e.g., consider not traversing so that future divisional applications will be permitted, consider cancelling non-elected claims to prevent rejoinder that would implicate claim limits).
- In general, there should be no rush to file continuations before November 1, 2007 because for applications pending before August 21, 2007, the rules permit the filing of “one more” continuation in an application family after November 1, 2007 as a matter of right. The latest application in the family must have been filed before August 21, 2007. See effective dates in the *Federal Register*.
- For branched/parallel application families, where two or more co-pending applications claim priority to the same nonprovisional U.S. application, consider whether any continuations need to be filed before November 1, 2007. Assuming the latest application in the family was filed before August 21, 2007, after November 1, 2007, only “one more” continuation can be filed across the whole family. If any continuations are filed after August 21, 2007, no further continuations beyond two will be permitted as a matter of right after November 1, 2007.
- For applications where the first office action is not issued before November 1, 2007, voluntarily comply with 1.75(b) claim limitations by canceling claims and/or amending claims to support a restriction requirement that will group claims into 5/25 and suggest a restriction (this also may avoid loss of patent term adjustment). Consider the USPTO manual of classification when formulating a suggested restriction.
- Review application families for CIPs. The 1.78(d)(3) requirement to identify in a CIP any claim that is supported by the parent goes into effect for any application pending on or after November 1, 2007. Any such CIPs should be identified (and appropriate action taken) to avoid the presumption that no claims are entitled to the parent application filing date.



- For applications that have unclaimed embodiments, add claims to unclaimed embodiments (with a suggested restriction) to trigger a restriction requirement that will permit the filing of a divisional application (and continuations and RCE thereof) and not use up a continuation.
- Consider appealing unsound rejections now before the USPTO Board of Appeals becomes overwhelmed and before any new appeals rules take effect.
- Develop a system to identify related applications as defined by 1.78(f).
- If a CIP of a divisional is desired, file the CIP before November 1, 2007.

Longer-Term Best Practices

- Combine two or more related applications into a single application with the goal of obtaining a restriction, which will then permit the filing of divisional application(s) (and two continuations and one RCE for each divisional). If the claims are not patentably distinct, cancel claims to comply with the 5/25 claim limit.
- Interview examiners early and often to resolve as many issues as soon as possible.
- Draft applications to include all evidence (e.g., test data) to establish patentability. If more time is needed during prosecution, consider suspension or deferral of examination under 37 CFR 1.103.
- Review and revise claims (e.g., claims based on a non-U.S. application) before the first office action to minimize claim objections and § 101 and § 112 issues, comply with the 5/25 claim limit, and/or add claims directed to patentably distinct subject matter with the goal of obtaining a restriction, which will then permit the filing of divisional application(s) (and two continuations and one RCE for each divisional).
- Draft claims in new applications in view of the new rules (e.g., include multiple independent claims that may be subject to restriction).
- Suggest a restriction requirement with the goal of obtaining a restriction, which will then permit the filing of divisional application(s) (and two continuations and one RCE for each divisional). This must be done before the examiner issues a restriction or before the first office action on the merits. Consider the USPTO manual of classification when formulating a suggested restriction.
- Identify prior art (and other pertinent information) from related applications early. The USPTO may not routinely permit additional RCEs to submit a "late" information disclosure statement (IDS).
- The new rules and commentary disfavor CIPs. For improvements, consider filing a CIP as a new application that incorporates by reference but does not claim priority to earlier applications.
- Use the optional streamlined continuation application procedure to have a continuation examined quickly. This streamlined procedure approximates RCE practice.
- Be careful about filing a divisional before the parent application is allowed and/or cancel non-elected claims to avoid rejoinder that would (1) make the divisional application improper and (2) implicate the 5/25 claim limit.
- Review commonly owned copending applications with at least one common inventor, overlapping disclosures and any same filing/priority date (if any U.S., Patent Cooperation Treaty (PCT), or foreign filing date of one application is the same as any U.S., PCT, or foreign filing date of another application) and prepare rebuttal of presumption of patentably indistinct claims or explanation justifying parallel applications to be submitted with a terminal disclaimer.
- Consider increased use of provisional applications (e.g., when additional experiments are anticipated) because the limits on filing applications do not apply to provisional applications. A subsequently filed non-provisional application can include new matter but count as the initial application under the continuation limits. Regular applications can be converted to provisionals.
- To ensure compliance with the requirements to disclose related applications and prevent allegations of inequitable conduct, it is essential to coordinate prosecution of related applications closely.