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October 10, 2007 “Clarification” of USPTO Rules Effective November 1, 2007

On October 10, 2007, the United States Patent and Trademark Office (USPTO) published on its Web site a “Clarification of the Transitional Provisions Relating to Continuing Applications and Applications Containing Patentably Indistinct Claims” (Clarification). The Clarification addresses four topics:

The Transitional “One More” Continuing Application Provision

The USPTO has modified the transitional “one more” continuing application provision so that an applicant can file “one more” continuing application and any continuing applications that satisfy 37 CFR § 1.78(d)(1)(ii), (d)(1)(iii) or (d)(1)(iv) (i.e., divisional applications, continuations of divisional applications, and continuations/continuations-in-part (CIPs) filed with a petition and showing). That is, any continuing applications that satisfy 37 CFR § 1.78(d)(1)(ii), (d)(1)(iii) or (d)(1)(iv) will not be taken into account when applying the “one more” provisions.

- The USPTO states that an applicant can file “one more” continuing application even if a divisional application was filed on or after August 21, 2007
- The USPTO states that an applicant can file a divisional application that claims the benefit of a “one more” continuation application

CIPs Filed by November 1, 2007

The USPTO has made two modifications to the requirement to identify CIP claims that are supported by the parent application(s) (37 CFR § 1.78(d)(3)):

- The USPTO has waived the requirement for CIPs in which a First Office Action on the merits (FOAM) has been mailed by November 1, 2007. In appropriate situations, the USPTO may still require an applicant to identify support for a CIP claim under 37 CFR § 1.105(a)(1)(ix).
- The USPTO has set a February 1, 2008 deadline for satisfying the requirement for CIPs filed prior to November 1, 2007 in which no FOAM has been mailed by November 1, 2007.

Disclosure of Commonly Owned Applications

The USPTO has modified the disclosure requirements for commonly owned applications and patents by waiving the “within two months” aspect of 37 CFR 1.78(f)(1)(i)(A) in some circumstances.

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Applications Filed by November 1, 2007

The USPTO has waived the "two months" portion of 37 CFR 1.78(f)(1)(i)(A) for applications with an actual filing date prior to November 1, 2007. For such applications, only non-provisional applications and patents with any common filing date or priority date need to be disclosed.

- The USPTO states that Application A filed August 1, 2007, with a priority claim to August 1, 2006, does not have to be disclosed in Application B filed August 15, 2007, with a priority claim to August 15, 2006 (or vice versa).

Applications Filed on or After November 1, 2007

The USPTO also has waived the "two months" portion of 37 CFR 1.78(f)(1)(i)(A) for certain applications with an actual filing date on or after November 1, 2007. The waiver applies unless the application has an actual filing date or priority date after November 1, 2007, that is within two months of any actual filing date or priority date of a commonly owned application or patent with at least one common inventor.

In other words, for applications filed on or after November 1, 2007, disclosure of a commonly owned application or patent with at least one common inventor is required if:

- The subject application has any actual filing date or priority date that is the same as any actual filing date or priority date of the commonly owned application or patent

OR

- The subject application has any actual filing date or priority date that falls on or after November 1, 2007, and is within two months of any actual filing date or priority date of the commonly owned application or patent.

This means that, looking backwards from October 31, 2007, we need only identify and disclose applications and patents with common filing dates/priority dates. However, beginning November 1, 2007, we need to identify and disclose applications and patents with filing dates/priority dates within two months of a post-November 1, 2007 filing date/priority date.

- The USPTO states that Application A filed December 1, 2007, with a priority claim to August 1, 2007, does not have to disclose Application B filed August 15, 2007 (or vice versa), because there are no common dates and no post-November 1, 2007, dates that are within two months of each other.
- The USPTO states that Application A filed December 1, 2007, with a priority claim to August 1, 2007, does have to disclose Application C filed December 15, 2007, with a priority claim to August 15, 2007 (and vice versa), because there are post-November 1, 2007 dates within two months of each other.

The Meaning of "Examined" Under 37 CFR 1.78(d)(1)(ii)(B) (Divisionals)

The USPTO has clarified its interpretation of the term "examined" as used in 37 CFR 1.78(d)(1)(ii)(B), which relates to divisional applications. The USPTO states that "examined" is limited to examination in a United States national application or U.S. national phase application, and does not include examination under PCT Article 31. Thus, examination pursuant to a Chapter II Demand will not preclude the filing of a divisional application if the other requirements of 37 CFR 1.78(d)(1)(ii) are met.