

New USPTO Rules—
How Will They Affect Your
Business

NIXON PEABODY
ATTORNEYS AT LAW



Stephen Rudisill

Continuing Applications

- Without a petition and showing:
 - **Two** continuation or continuation-in-part (CIP) applications;
and
 - **One** request for continued examination (RCE)
in an application family
- With a petition and showing:
 - Any additional continuation, CIP or RCE filed
on or after **November 1, 2007**

Continuing Applications

- A **continuation** application discloses and claims only an invention(s) that was disclosed in the prior-filed application.
- A **CIP** discloses subject matter that was not disclosed in the prior-filed application.

NPA

C

RCE

C

Petition

Divisional Applications

- A divisional application discloses and claims only an invention that:
 - Was subject to a **restriction requirement** in the prior-filed application, and
 - Was **not elected** for examination and was **not examined** in any prior-filed application

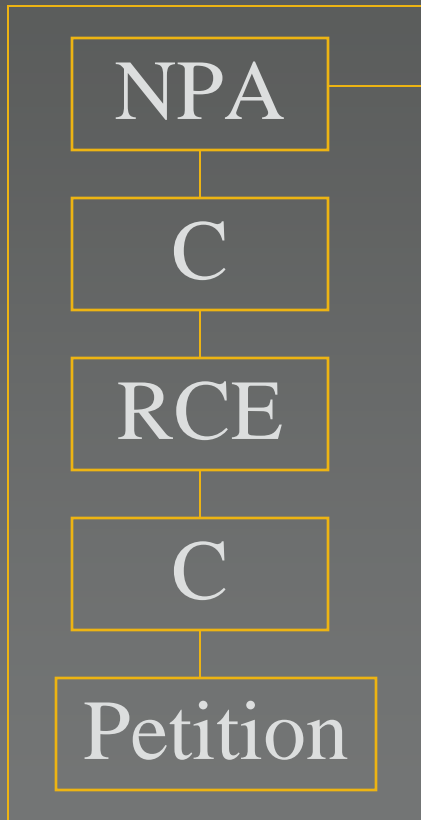
Divisional Applications

- May be filed in **parallel** or in **series**
 - A divisional application is not required to be filed during the pendency of the initial application, as long as the copendency requirement of 35 USC 120 is met

Divisional Applications

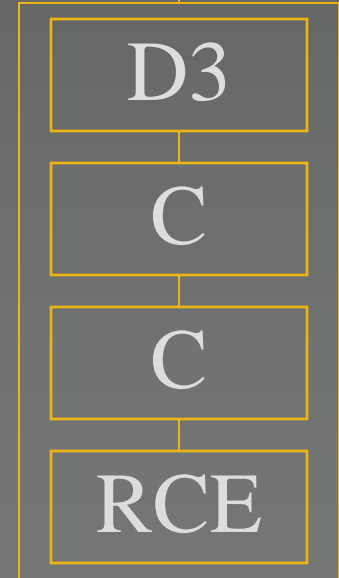
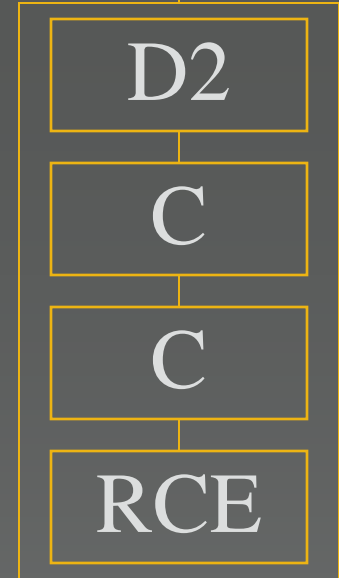
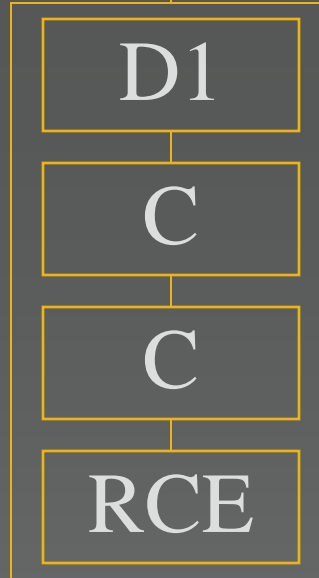
- **Each** divisional family may include:
 - Two **continuation** applications – **no CIP's**
 - A single **RCE**
 - Additional continuing application or RCE with a petition and showing

Application Family



Restriction

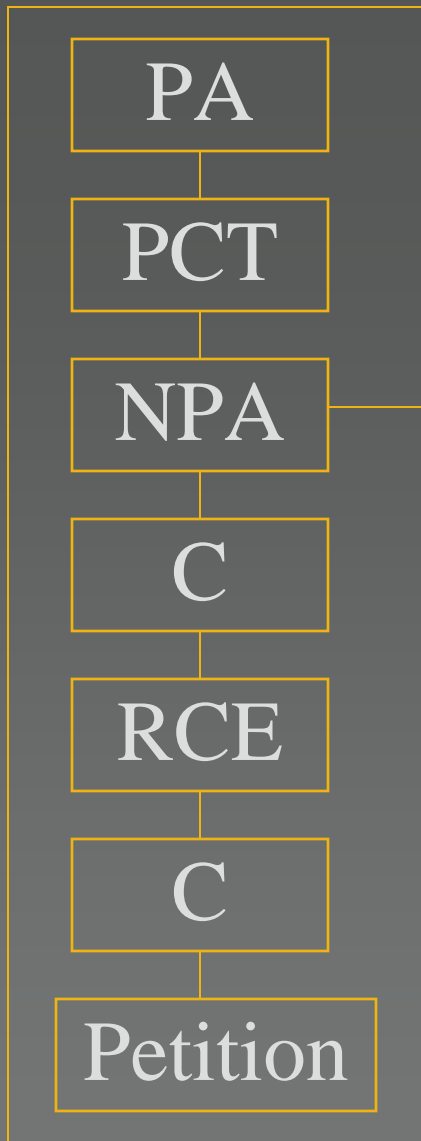
Divisional Application Families



Use of PCT Application

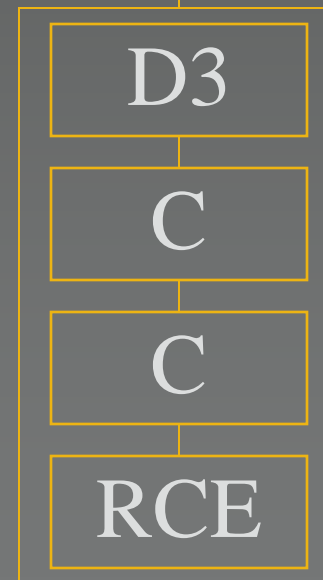
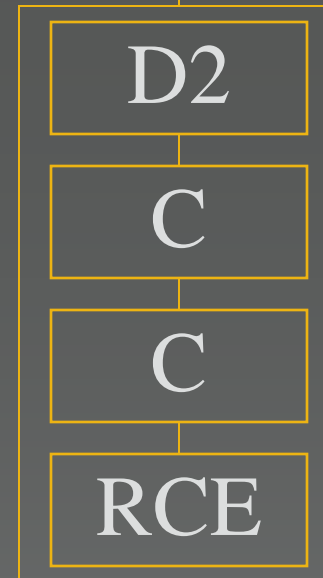
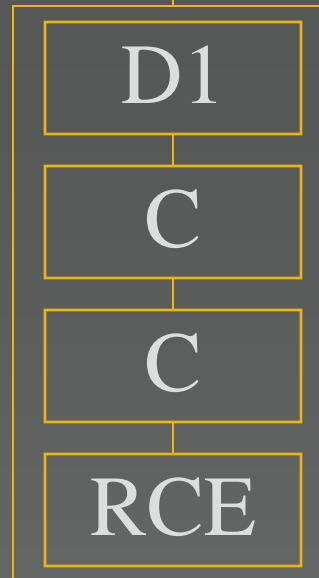
- In PCT, do not claim priority to any **non-provisional** U.S. application
- May provoke **unity of invention** objection
- Utilize **search and preliminary examination**
- National phase gets 2 CONs/CIPs, 1 RCE

Application Family



Restriction

**Divisional
Application Families**





Janet Garetto

Limits of Number of Claims

- Applicants can present – as of right – **5 independent** claims and **25 total** claims
 - Aka **5/25 Rule**
- Permits **15 independent** and **75 total** claims per invention
 - Aka **15/75 Rule**
 - Initial + 2 CON or CIP applications + 1 RCE = 15/75

What is An Independent Claim?

- An **independent** claim
 - Refers to another claim (but does not incorporate by reference all limitations of claim to which it refers)
 - Refers to a claim of a different statutory class
 - » ex. “A method of using the composition of claim X”
 - » ex. “A product produced by the process of claim Y”

What Counts for the 5/25 Claim Threshold?

- **Counts** all claims in copending, commonly owned application(s) having patentably indistinct claim(s)
 - PTO will treat each application as having total number of claims present in **all copending, commonly owned applications** to determine whether each application exceeds 5/25 Rule

What Does Not Count for the 5/25 Claim Threshold?

- Does **not count**
 - Withdrawn claims
 - Claims in issued patents

What Justification is Required If You Exceed the 5/25 Threshold?

- Applicants can exceed 5/25 Rule only **IF** provide **justification** before PTO issues 1st Office Action on merits (FAOM)
- Justification document is called an **“Examination Support Document”** or **“ESD”**

Examination Support Document Requirements

- **Due before FAOM** if **exceed 5/25** Rule
- **ESD** requires
 - Showing where each claim limitation is supported in written description
 - Statement that pre-examination search in compliance with rules was conducted
 - Identification of field of search by U.S. class and subclass, date of search, search logic and files searched

Examination Support Document Requirements

- **ESD** further requires
 - Searching of each limitation of each claim
 - Searching of U.S. patents and patent publications, foreign patents and non-patent literature
 - Applicant's consideration of all references applicant knows of, regardless of source

Examination Support Document Requirements

- **ESD** further requires
 - Identification of claim limitations disclosed in each reference
 - Listing of references most closely related to subject matter of each claim
 - Detailed explanation that particularly points out how each independent claim is patentable over references

Adequacy of Examination Support Document

- Subject to **PTO discretion**
- Applicant will be notified if:
 - ESD or preexamination search is inadequate; or
 - Claims have been amended so ESD no longer covers each claim
- Applicant will be given two (2) months to cure by
 - Filing corrected or supplemental ESD or
 - Amending application to comply with 5/25 Rule

Suggested Restriction Requirement (SRR)

- If application contains claims to more than one invention, applicants may file a **“suggested requirement for restriction” (SRR)**
- SRR must
 - Elect invention involving no more than 5/25 claims;
 - Identify elected claims; and
 - Be filed before **earlier of FAOM** or PTO issued **restriction requirement**

What Happens with SRR?

- Examiner can **accept** proposed restriction requirement
 - Claims to non-elected invention will be withdrawn and claims to elected invention will be examined
- Examiner can **issue a different** restriction requirement
 - PTO notice will give period to elect claims
- Examiner can **issue no** restriction requirement
 - PTO notice will give period to file ESD or comply with 5/25 Rule

Will PTO Notify You If You Fail to Properly Comply with Rules?

- PTO will notify Applicant if:
 - Application violates 5/25 Rule;
 - ESD has been omitted;
 - SRR is not filed; and
 - It is before FAOM

How PTO Will Handle Response Time for Failure to Comply with These Rules?

- For applications filed (or entered national stage) **on or after 11/1/07**:
 - 2 month nonextendible period to file ESD or comply with 5/25 Rule
- For applications without FAOM **before 11/1/07**:
 - 2 month extendible period (up to 6 months) to file SRR, ESD or comply with 5/25 Rule
 - PTO notice may be accompanied by a restriction requirement
 - To avoid abandonment, applicant must make proper election

Effective Dates

- **5/25 Rule applies** to applications:
 - filed on or after 11/1/07 (including reissue)
 - entering national stage (PCT) on or after 11/1/07
 - in which a FAOM was not mailed before 11/1/07 (including reissue)

Refund of Excess Claims Fees

- Can request a **refund** of excess claims fees paid on or after 12/8/04 for a claim
 - If claim cancellation is filed before examination on merits
 - » Claim must be cancelled at least 1 day before FAOM, notice of allowability or allowance, or Ex parte Quayle action is shown in PTO's PALM system
 - Refund request must be filed within 2 months from filing of claim cancellation
 - PTO will not refund excess claims fee for withdrawn claims that are not canceled before FAOM



Daniel Burnham

Identification of Commonly Owned Patents and Applications

- Applicants must identify any commonly owned application or patent that has:
 - A common inventor; and
 - A filing date or “priority date” within two months of the filing date OR “priority date”
- PTO will provide “listing of commonly owned applications and patents” form in October

Identification of Commonly Owned Patents and Applications

- “Priority Date” is broadly interpreted
 - Provisional filing date
 - Foreign priority date
 - PCT filing date
 - PCT national stage filing date
 - Previous continuation(s) filing date(s)

Identification of Commonly Owned Patents and Applications

- Applies to all currently pending applications
 - Exception: Does not apply to pending applications with Notice of Allowance dated before February 1, 2008
 - Must file statement of identification form in pending applications by February 1, 2008
- For future applications, must provide statement within 4 months of the filing date

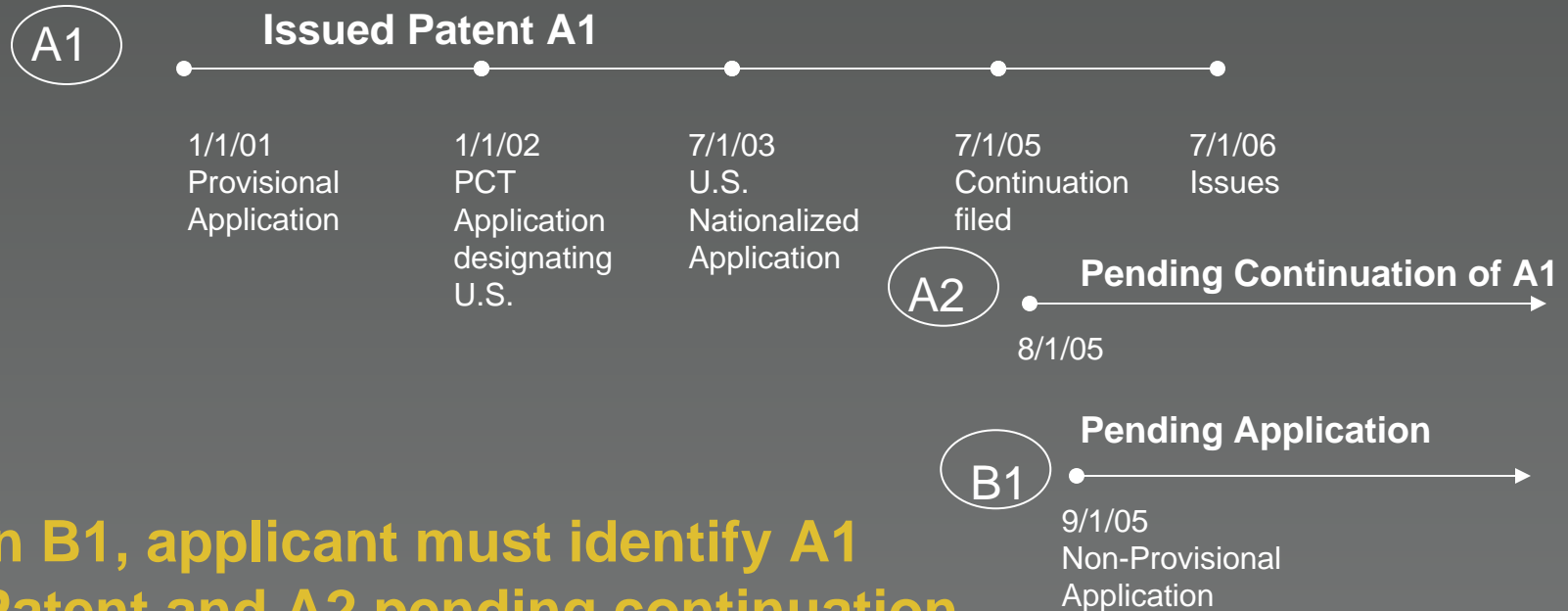
Identification of Applications and Patents Containing Patentably Indistinct Claims

- Presumption of patentably indistinct claim for commonly owned patents and applications if:
 - Substantial overlapping disclosure;
 - One common inventor; and
 - Claimed filing or priority date that is the **same** as the claimed filing or priority date of the other application

Identification of Applications and Patents Containing Patentably Indistinct Claims

- For commonly owned pending applications that have at least one patentably indistinct claim, the PTO:
 - Will treat them as one application for the 5/25 rule;
 - May require elimination of the patentably indistinct claims from all but one of the applications
- Applicant must also file within 4 months:
 - Terminal Disclaimer; or
 - Statement explaining why all of the claims are patentably distinct from claims of other application

Example of Identification of Commonly Owned Patent Family A and Patent Family B



- In B1, applicant must identify A1 Patent and A2 pending continuation
- In A2, applicant must identify A1 Patent and B1 Application

Example of Identification of Commonly Owned Patent Family A and Patent Family B

- In A2, there is a “presumption of patentably indistinct claims” relative to A1 Patent
 - Why? (i) same priority date and (ii) substantially overlapping disclosure
- In A2, the applicant must also file:
 - Terminal Disclaimer; OR
 - Statement explaining why all claims are patentably distinct from claims of patent A1

Identification of Commonly Owned Patents and Applications - 37 CFR 1.78(f)

- Potential issues with rule
 - Multiple law firms handling cases for same client without knowledge of other applications
 - PTO discourages using a “conservative approach” with statement of identification
 - » Applicants should not use form to list applications that do not meet the “common inventor” or “date” requirements
 - » Rule 56 requires disclosure of other pending applications that do not meet the “common inventor” or “date” requirements

Identification of Commonly Owned Patents and Applications - 37 CFR 1.78(f)

- Potential issues with rule
 - Exercise caution with applications with one common inventor and filed just outside the 2-month window
 - » List in an IDS to avoid inequitable conduct charge
 - File statement within 4-month time limit -- there is no extension period
 - Consider a second statement rebutting presumption of patentably indistinct claims after future claim amendments are made



Peter Prommer

Prosecution Tips: pre-November 1

- Pending applications with **more than 5/25** claims
 - Try to get FAOM
 - » Status inquiry
 - » Call Examiner
 - Try to get allowance
 - » May work for continuations

Prosecution Tips: pre-November 1 (cont.)

- Pending **final actions**
 - Review patent family for previous RCE
 - Determine if a claim amendment will overcome rejection
 - Respond to final action and file additional RCE
- **Divisional** applications
 - No CIPs for divisionals under new rules
 - Need to review patent family and file any necessary CIP application
 - BUT, consider loss of continuation application

Prosecution Tips: pre-November 1 (cont.)

- If unclaimed subject matter requires more than 5/25 claims **AND** one continuation already filed
 - Consider filing **multiple continuation** applications with patentably distinct claims
 - » Provides maximum flexibility
 - » BUT, (i) increased filing costs and future maintenance fees, (ii) multiple examiners and (iii) need to explain why claims are distinct
 - **Alternative:** file “one more” continuation application at any time and file an SRR
 - » Reduced upfront filing costs
 - » BUT, less flexibility if SRR not accepted

Prosecution Tips: pre-November 1 (cont.)

- Some suggestion of entering national stage for pending PCT that exceeds 5/25 claims
 - Rules may appear to provide support
 - BUT, other parts of rules and PTO interpretation suggest otherwise
 - » FR46828 (see comment 337) and question F3 in FAQ (see <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>)

Prosecution Tips: pre-November 1 (cont.)

- Review pending applications now
- Develop systems for coordinating all of your patent counsel
- Start reviewing pending applications for compliance with 5/25 rule



William Pegg

Preparation of Application

- Perform a prior art search prior to filing
 - Consider proposed IDS rules (71 FR 38808)
 - Searches should be narrowly targeted
- Craft claims to promote restriction, regardless of number of claims, and submit SRR + election
- Include Means/Step Plus function claims
- Include Markush claims/alternative claiming formats
 - Consider proposed Markush rules (72 FR 44992)

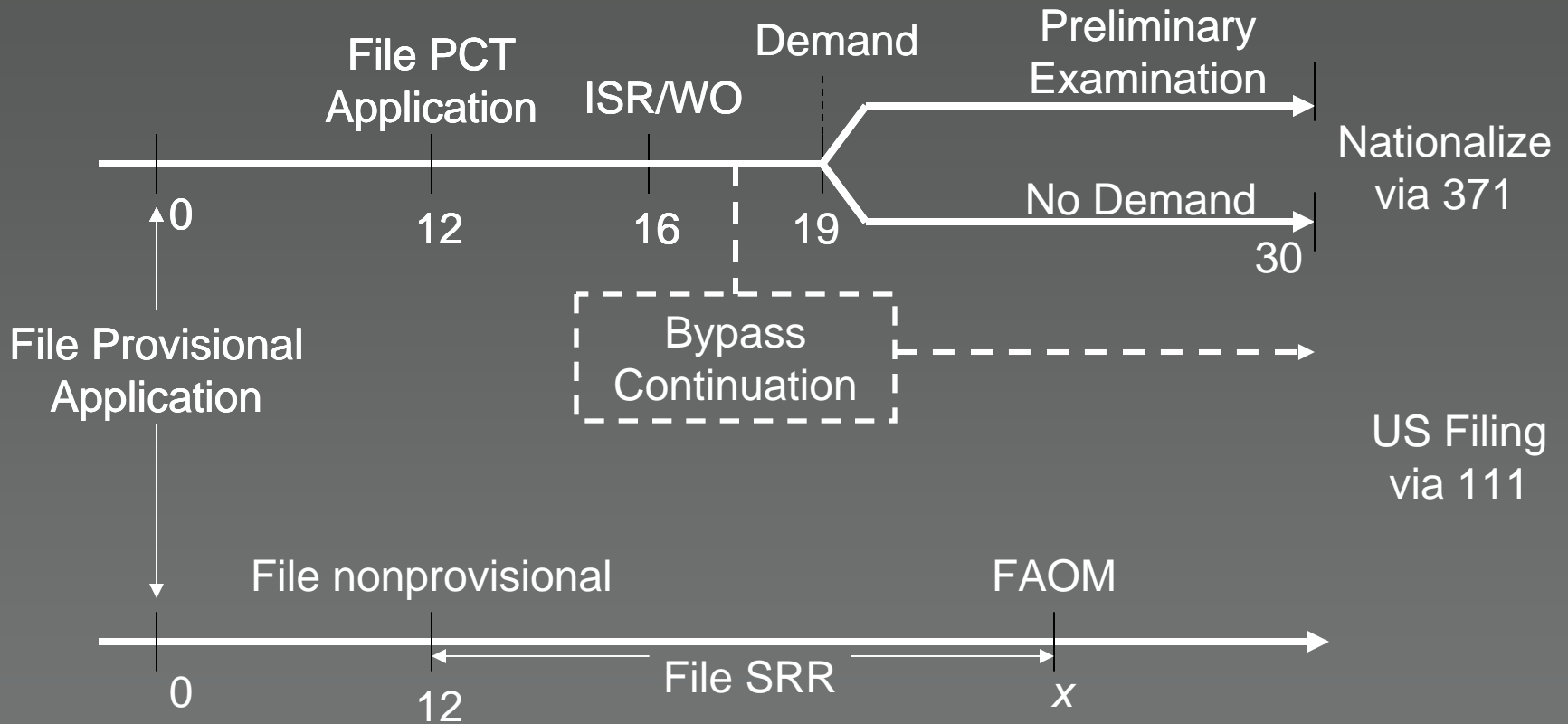
Do you file multiple application or single application?

- Single non-provisional application
 - Strongly favored by PTO
 - GOAL: Prompt a multi-pronged restriction requirement
- Multiple non-provisional applications
 - Strongly discouraged by PTO
 - GOAL: Try to convince one or more Examiners why the claims in all of the applications are patentably distinct (or file terminal disclaimers)

PCT vs. Domestic?

- Case-by-Case Determination
- PCT maximizes available options
 - National Stage in Designated States

PCT vs. Domestic?



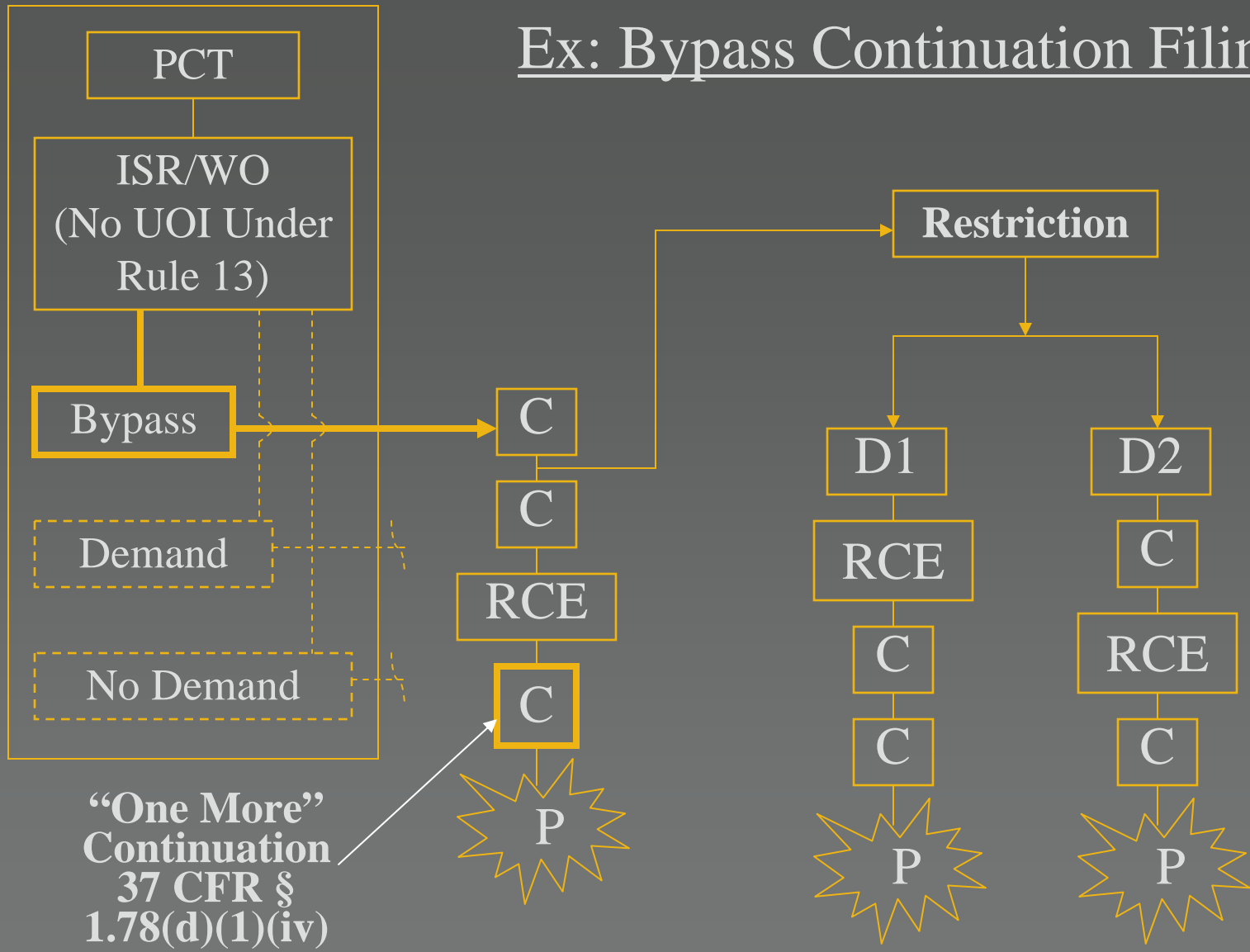
PCT vs. Domestic?

- 37 CFR § 1.475 (b) is a **roadmap** for **unity of invention**
Unity of invention will be found if the claims are only in one of the following combinations of categories:
 - (1) A product and a process specially adapted for the manufacture of said product; **or**
 - (2) A product and process of use of said product; **or**
 - (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; **or**
 - (4) A process and an apparatus or means specifically designed for carrying out the said process; **or**
 - (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process

Domestic vs. PCT? (cont.)

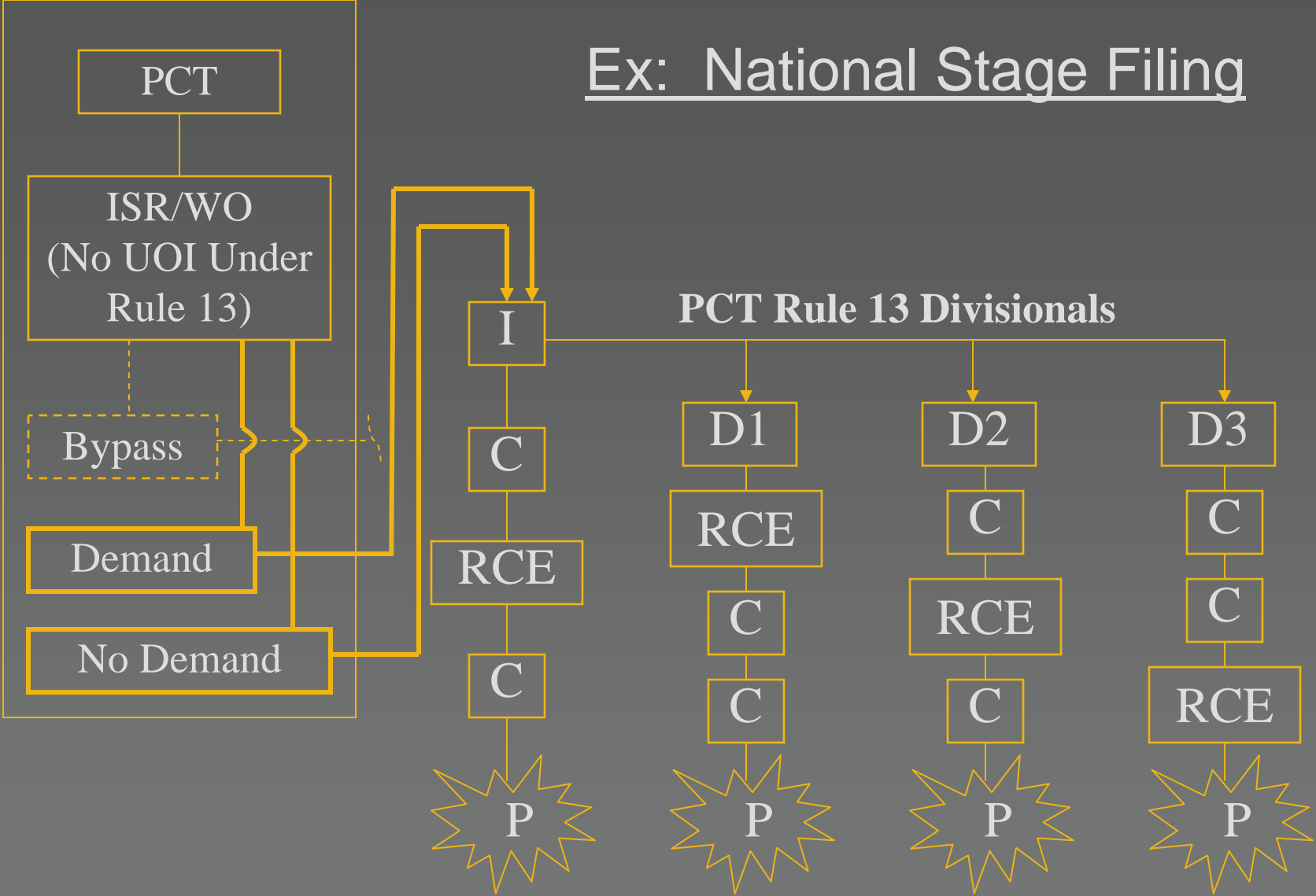
- A “divisional application” may be premised upon a lack of unity of invention under PCT Rule 13 (see 37 CFR § 1.78(a)(2))
- Once the national stage application (via 35 USC § 371) has been taken up by the Examiner, prosecution proceeds as for a domestic application (via 35 USC § 111), with the exception that unity of invention proceeds as under 37 CFR § 1.475 (MPEP § 1893.03)

Ex: Bypass Continuation Filing



**“One More”
Continuation
37 CFR §
1.78(d)(1)(iv)**

Ex: National Stage Filing





John Gatz

Prosecution Tips

- Avoid Filing Examination Support Documents (ESD) When Drafting More Than 5/25 Claims
 - ESD Requirements
 - » A preexamination search statement
 - » Listing of references most closely related to all of the claimed subject matter
 - » Identification of claim limitations in each reference
 - » Detailed explanation of patentability
 - » Support showing under 35 U.S.C. § 112, ¶ 1

Prosecution Tips Cont.

- Timely File Information Disclosure Statements (IDS)
 - May avoid an unnecessary RCE
- Carefully Review First Office Action
 - Mistakes may be made by Examiner that would prevent a Final Second Office Action

Prosecution Tips Cont.

- Interview Cases After First Office Action
- Consider Getting All Evidence Submitted Early in Prosecution
 - Declarations, testing Results
 - Perfect evidence if appeal becomes necessary
- Avoiding Another Final Office Action when Filing RCE
 - Effective response to final office action

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