

On August 21, 2007, the U.S. Patent Office published new rules in the Federal Register that profoundly affect the prosecution of patent applications. The new rules are intended to reduce the backlog of applications in the U.S. Patent and Trademark Office by placing limits on the number of continuing applications and claims that an applicant may file that are directed to one invention and on the number of times that an application may be examined as a matter of right. The new rules, along with advisory materials published by the USPTO, are available at [USPTO Rules](#).

Continued Examination Practice

Prior to the publication of the new rules, applicants could continue examination of their inventions indefinitely by filing an unlimited number of continuation or continuation-in-part (CIP) applications or an unlimited number of requests for continued examination (RCE). However, under the new rules an applicant is only entitled to file two continuation or CIP applications, plus one request for continued examination (RCE) in a single family of applications as a matter of right. Any additional continuation applications, CIPs, or RCEs must be accompanied by a petition and showing that the amendments, arguments, or evidence presented in the additional application or RCE could not have been presented previously. The Office will determine the sufficiency of applicants' showing on a case-by case-basis. Guidelines have not been provided, and there are no specific situations in which a petition will automatically be granted.

Under the new rules, applicants may file divisional applications of a prior-filed application only for claims that were subject to a restriction requirement, but were not elected for examination and were not examined in any other non-provisional application. For each divisional application, applicants may file two continuations plus one RCE, as a matter of right. Any further continuations or RCEs in the divisional application family will require a petition and showing that the presented amendments, arguments or evidence could not have been presented previously.

Applicants having applications filed before August 21, 2007 who have already filed one or more continuation applications or CIPs in an application family are permitted only "one more" continuation or CIP to be filed after August 21, 2007 without a petition and showing. Applicants, however, will not be entitled to "one more" RCE in an application family already having one RCE, unless the RCE is filed before November 1, 2007.

Number of Claims

The new rules place a limit on the number of claims in an application to 5 independent claims and 25 total claims (the "5/25" threshold). Applicants submitting additional claims must provide an examination support document (ESD) before the first office action on the merits. Alternatively, prior to the first office action on the merits, applicants can file a suggested requirement for restriction (SRR) to restrict the claims to groups of separately patentable inventions, each group having an acceptable number at or under the 5/25 threshold. However, the Examiner is not bound to accept the SRR and may issue a different restriction requirement or none at all.

The new rules limiting continuation practice, discussed above, in combination with the new rules limiting the number of claims directed to an invention, effectively allows an applicant a maximum of 15 independent and 75 total claims in an application family, not including any divisional application, as a matter of right, without the need for an ESD.

The 5/25 threshold on the number of claims applies to all pending applications that have not received a first action on the merits by November 1, 2007, and all applications filed thereafter.

Related Applications

For pending applications that have not been allowed by November 1, 2007, the new rules require an applicant to identify all commonly owned applications or patents that (1) have at least one inventor in common, and (2) have an effective filing or priority date within two months of the application in question. For purposes of the effective filing or priority date, the rules require

consideration of any effective priority or filing date on which an application can rely, not just the earliest priority date available.

Under the new rules, a rebuttable presumption that the applications have "conflicting" or patentably indistinct claims arises if the co-owned applications have substantially overlapping disclosure and the same effective filing or priority date. In this case, the examiner will treat each application as having an effective number of claims that is the sum of all of the applications' claims for purposes of the 5/25 threshold. The applicant may rebut the presumption by showing that the application's claims are patentably distinct from the co-owned application or patent, or the applicant may file a terminal disclaimer. If the patentably indistinct claims appear in two pending applications, the applicant must also provide sufficient reasons why there are two or more pending applications with patentably indistinct claims. If such an explanation is insufficient, the examiner may require elimination of the patentably indistinct claims from all but one of the applications.

Looking Ahead

One likely consequence of the new rules is that applicants will be required to more distinctly claim their inventions at the outset of examination. Given the shortened examination cycle under the new rules, applicants should exercise diligence and prudence in reviewing their pending applications to ensure that all their inventions are being adequately claimed and be prepared to take appropriate action where necessary to conform to the new limits on numbers of claims.

Due to the general nature of this news update on the new rules published by the USPTO, the information provided herein may not be applicable to all situations and should not be acted upon without specific legal advice based on the particular situation.