

## New USPTO Rule Package on Claims and Continuations

The USPTO has announced some sweeping rule changes that go into effect on **November 1, 2007**. These changes limit the number of Continuation applications and Requests for Continued Examination (RCEs) that may be filed by patent applicants. Additionally, strict limitations on the number of claims that can be included in an application or application family are imposed. All applicants and patent practitioners filing US patent applications should familiarize themselves with the new rules where possible. Furthermore, applicants and practitioners alike should be aware that in some cases, some action may be required to bring existing applications into compliance with the new rules. Details of the new rules can be found at:

<http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>

This document is intended as an overview of the new rules and not as legal advice regarding any specific application pending before the USPTO. However, if you have questions regarding pending applications, please feel free to contact us for more details. Furthermore, although we will make every effort to ensure that all pending applications comply with the new rules, please contact us if you are aware of any other co-pending applications that might impact a pending application being handled by Akerman Senterfitt.

### The rule changes affect four major areas of patent practice before the USPTO:

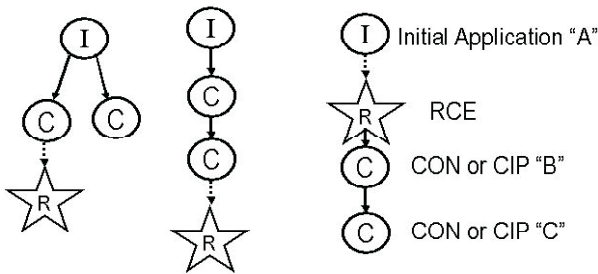
New limits on the total number of claims	-	The "5/25" rule
New limits on the total number of Continuations	-	1 RCE, 2 Continuation Applications
New limits on filing Divisional Applications	-	No voluntary Divisional Applications
New limits on Copending Applications	-	Identify "patentably indistinct" claims

### **THE 5/25 RULE: Applications should be limited to a total of 25 claims and/or 5 independent claims**

- If more claims are necessary than the 5/25 rule allows, a "Suggested Restriction Requirement" (SRR) may be filed. The SRR details which claims relate to separate inventions, in order that a Restriction Requirement may be issued so that one or more Divisional applications can be filed, although patent examiners need not follow the applicant's SRR.
- Alternatively, an Examination Support Document (ESD) may be filed setting out details of a search that has been conducted to USPTO requirements, a listing of references deemed to most closely relate to the subject matter of each claim, identification of the claim limitations disclosed by the references, a detailed explanation of patentability for each independent claim and a statement of support for each claim limitation in the specification.
- Multiple dependent claims are counted as the number of claims to which they refer back. For example, a claim 4 that is dependent on claims 1, 2 or 3 would be counted as 3 claims, and so the use of multiple dependent claims cannot be used to overcome the restrictions on claim numbers.
- Excess claims fees for total claims above 20 and independent claims above 3 still apply.
- The limitations on claims apply to all applications on which a first Office Action on the merits (that is, an examination report) has not issued by November 1, 2007. Applicants will have up to February 1, 2008 to comply with the rules for applications filed before November 1, 2007.
- The limitations on claims apply to patent families having the same owner where the filing or priority date are within 2 months of one another, where there is overlapping inventorship and where there is at least one claim in one application that is "patentably indistinct" over another application. There is a rebuttable presumption of a patentably indistinct claim where the filing date is the same and the specification has substantial overlap.

**1 RCE, 2 CONTINUATIONS:** Only two Continuation applications and one Request for Continued Examination (RCE) may be filed per patent family without a showing of reasons why further RCEs or Continuations include an amendment, argument, or evidence that could not have been previously submitted.

These applications may be filed in any order as follows:



- If more Continuations or RCEs are required, a petition and a fee of \$400 must be filed setting out why further Continuations or RCEs include an amendment, argument or evidence sought to be entered could not have been previously submitted.
- The filing of Appeals to continue prosecution of applications will likely be more frequent than in the past, in order to continue prosecution of patent applications, which is likely to further slow down the Appeal procedures, although the USPTO plans to hire more petitions examiners.
- The rule on Continuations and RCEs applies to all applications filed on or after November 1, 2007. For applications filed before August 21, 2007, an applicant will be entitled to “one more” Continuation or RCE even if the application is over the new limits for Continuations and RCEs.

- PCT Bypass Continuation applications do not count as one of the allowed Continuation applications, provided that no Demand was filed in the PCT application and the National Phase was not separately entered.
- The use of Continuation applications to correct errors in inventorship should be reduced.
- New rules on presenting additional references in Information Disclosure Statements (IDSs) are proposed to allow the filing of an IDS after close of prosecution without the need for filing a Continuation application if accompanied by a certification stating that the references were not known previously, with a detailed explanation of the relevance of the cited references and a patentability justification explaining why the claims are allowable over the cited references or an amendment to overcome the cited references.
- When filing Continuation-in-Part applications, applicants must identify the claims that have support in the original application. Only the claims identified as having support in the original application will receive the benefit of the earlier filing date.

**NO VOLUNTARY DIVISIONALS:** Divisional applications may no longer be filed on a voluntary basis, but only after a Restriction Requirement has been issued and only in respect of Non-Elected inventions.

- If the Restriction Requirement is responded to with traverse, or if the Restriction is provisional (for example, is a Species Restriction where there are one or more generic claims), applicants must wait until final disposition of the earlier application before filing the Divisional.
- Claims must be cancelled, not merely withdrawn, before they can be included in a Divisional application.
- Applicants can file a Suggested Restriction Requirement before the first Office Action in order to generate a Restriction Requirement and be allowed to file a Divisional application in an application where it is necessary to present more than 5/25 claims.
- The filing of a divisional application to a non-elected invention counts as a new patent family and will be entitled to two Continuations and one RCE.

**NEXT STEPS: Bringing Pending Applications into Compliance**

**Identify all co-pending applications (i) owned by the same party and having common inventors and a filing date or priority date that is within two months of the filing or priority date of the application being filed, or (ii) owned by the same party, having common inventors, the same filing dates and substantially overlapping disclosure.**

- If a co-pending application has a claim which is patentably indistinct to a claim in a co-pending application, **both** (or all) of the applications combined will be subject to the new limits on numbers of claims (thus, the applications may only contain 25 claims or 5 independent claims between them).
- If the applications are owned by the same party, have substantially overlapping disclosures, and the same filing dates, there will be a rebuttable presumption of a patentably indistinct claim that will have to be overcome within a specified time limit. A “substantially overlapping disclosure” is disclosure in one application that would support a claim in the other application.

All applications which may fall under these provisions should be identified to the USPTO. This requirement must be complied with for **all currently pending applications by February 1, 2008.**

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