



# USPTO Final Rule Changes for Continuations and Claims

John B. Pegram  
Ronald C. Lundquist  
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## Our Backgrounds

### Ron:

- Patent prosecution, opinions, due diligence and client counseling
- Emphasis on Biotechnology

### John:

- Mixed practice:
  - Electrical & Mechanical prosecution
  - Patent litigation & opinions in all technical fields



# Disclaimer

- FR This presentation provides only general suggestions for your consideration
- FR The rules are complex
- FR The USPTO comments are extensive
- FR The PTO interpretations and our advice will evolve
- FR You should obtain specific advice for each situation



# Discussion Topics

## Claim and Continuation Final Rules

- Limits on Continuations/RCEs
  - Transitional Period
  - Future Applications
- Limits on the Number of Claims

## Strategy and Tactics



## The “Bottom Line”

- ❖ PTO Rules Will Generally Encourage:
  - Filing one CON at a time (in series) and avoiding parallel prosecution
  - Limiting the number of claims per application
  - Going to appeal process more frequently
  
- ❖ Pending Applications Must Be Reviewed Carefully
  - For disclosed but unclaimed subject matter
  - Strategies will vary depending on the posture of the application(s)



# Effective Date

- ❖ Claim and Continuation Final Rules
  - Published August 21, 2007
  - Effective November 1, 2007 (mostly)
  - Some Rules will impact pending applications



## Basics of the New Rules

- ❖ Limits on continuing applications and requests for continued examination (“2+1”)
- ❖ Changes in divisional application practice:
  - Restriction required to qualify as a divisional
  - Serial divisionals are allowed
- ❖ Claim limits (“5/25” and “15/75”) in certain related cases will apply unless an Examination Support Document (“ESD”) is filed
- ❖ Patentably Indistinct Applications
  - Requirement to identify certain applications
  - The PTO Presumption



# CONTINUING APPLICATIONS and RCEs





# The New Vocabulary (1)

## “Initial application”

- No priority claims to a non-provisional
- Can claim priority to a provisional or foreign applications

## “Continuing application”

- Any application that claims priority to earlier U.S. non-provisional or PCT national stage application

## “Continuation application”

- A “continuing” application claiming ONLY invention(s) disclosed in the prior application



## The New Vocabulary (2)

- ❖ “Continuation-In-Part application” (CIP)
  - A “continuing” application that discloses subject matter not disclosed in the prior application
  
- ❖ “Divisional application” (DIV)
  - A “continuing” application, in which
  - Claims are defined by a restriction requirement made final in a prior-filed application, and
  - The divisional application claims only a non-elected invention that was not examined



## The New Vocabulary (3)

- ❖ “Application family”
  - An application and its permitted continuations
- ❖ “Initial Application Family”
  - The first non-provisional application’s family
- ❖ “Divisional Application Family”
  - A divisional application and its permitted continuations
- ❖ “Request for Continued Examination” (RCE)
  - Same as the old rules (not redefined)

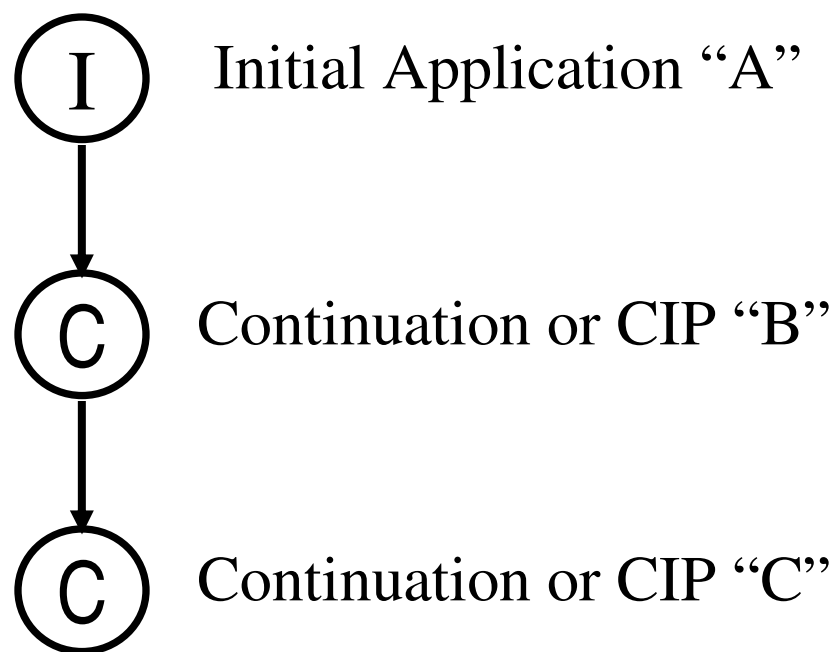
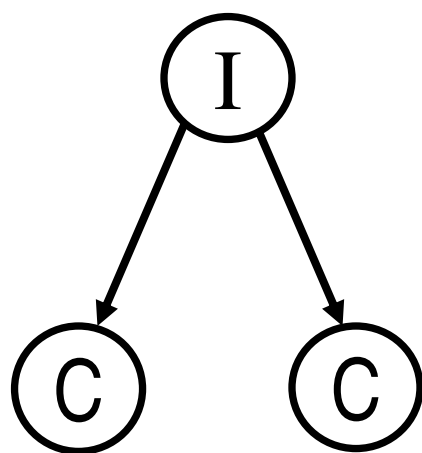


## The CON and RCE Limits

- ❖ “2+1” Limit on continuing applications and RCEs
  - 2 Continuations (including CIPs) and 1 RCE are automatically permitted for each “application family”
  - The 2 CONs and 1 RCE can be filed in any order
  - Can’t have 2 RCE’s and 1 CON
  - A Petition is required to exceed either the 2 CON or 1 RCE limit

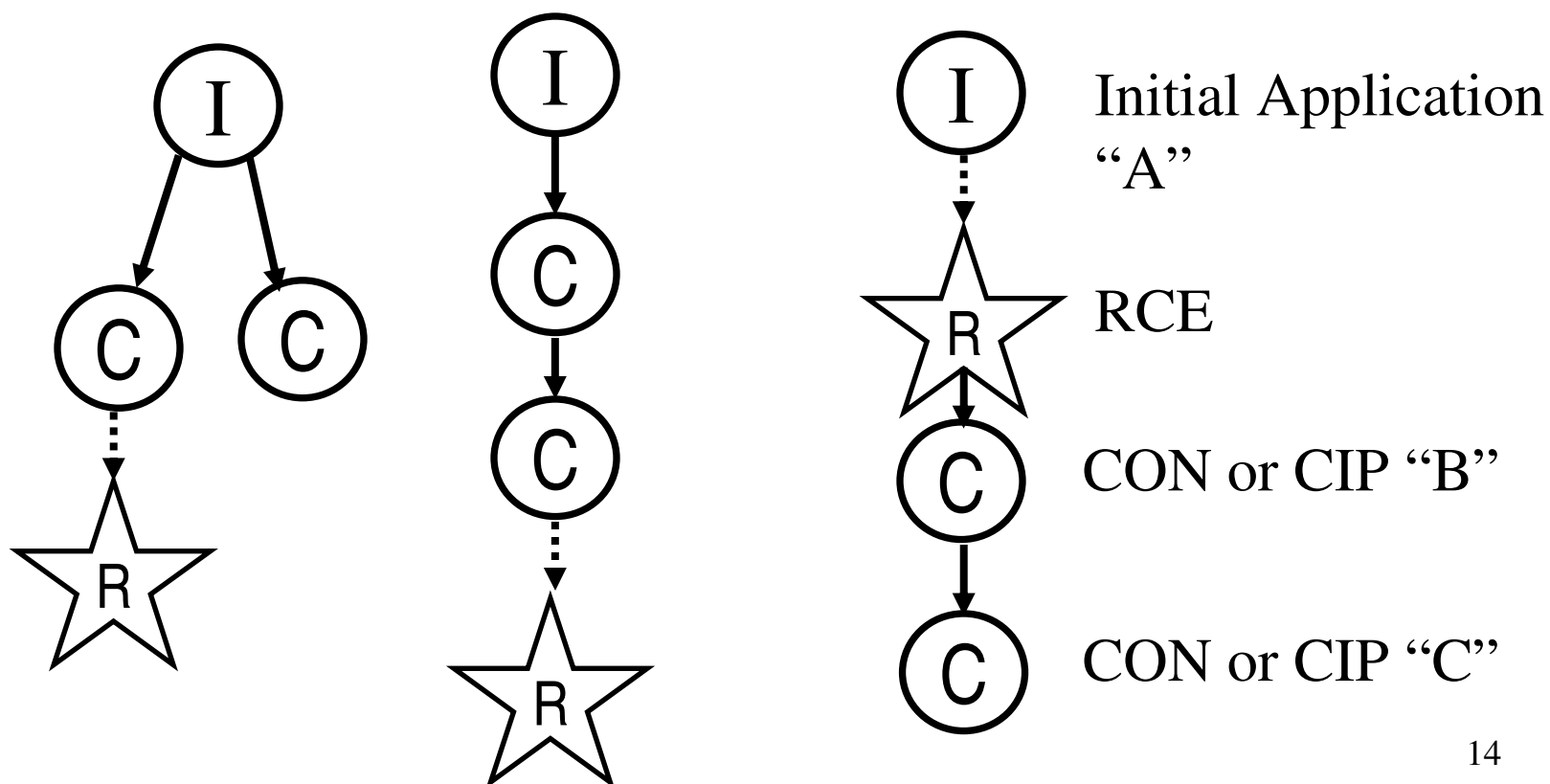
# Continuing Applications

Applicant may file two continuation or CIP applications (parallel or serial) without a petition and showing.



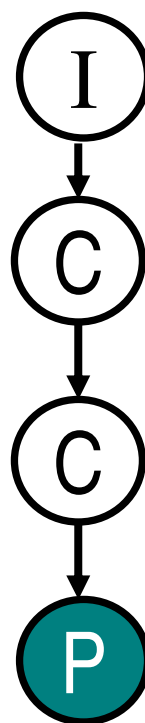
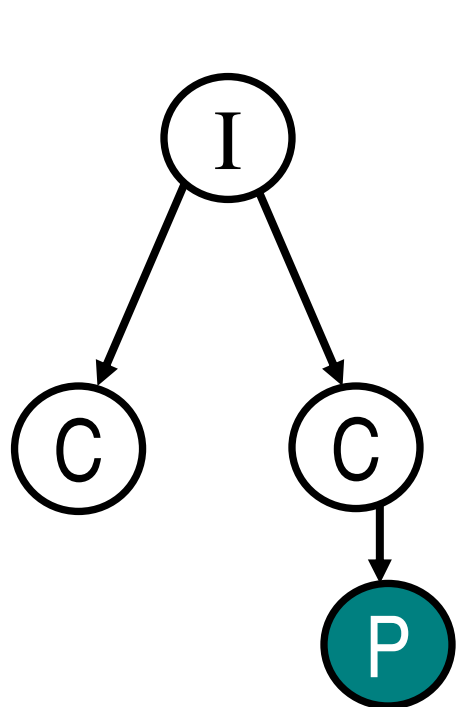
# Request for Continued Examination

Applicant may file a single RCE in an application family, without a petition or showing.



# Continuing Applications

Applicant may file a third or subsequent continuation or CIP application with a petition and showing.



Initial Application “A”

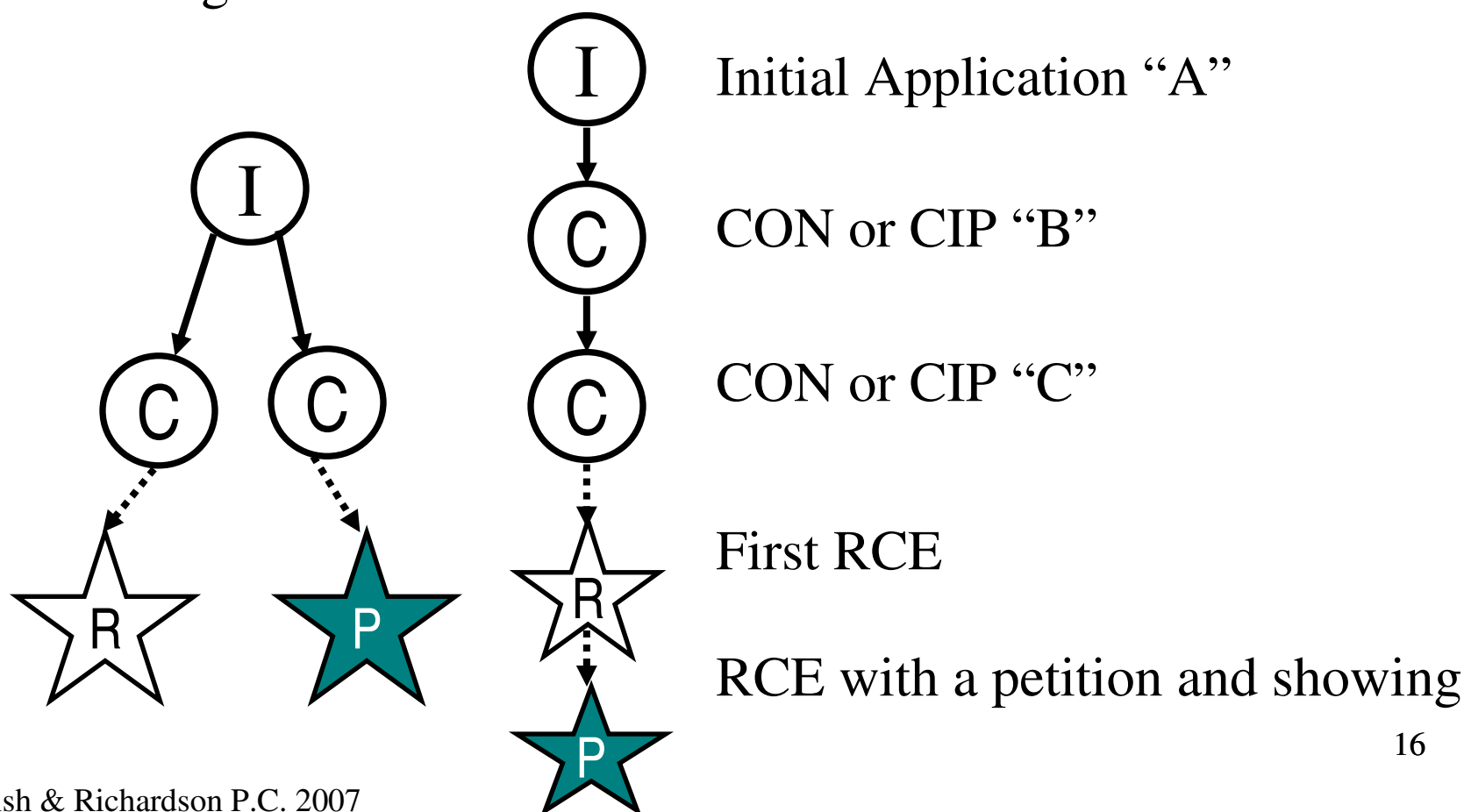
CON or CIP “B”

CON or CIP “C”

Continuation or CIP with a petition and showing

# Request for Continued Examination

Applicant may file a second or subsequent RCE with a petition and showing.







## Petitions for Additional CON or RCE

- ❖ A Petition with a “showing” is required to exceed the 2+1 limit on CONs/RCEs
- ❖ Petition for 3d CON or 2d RCE:
  - Must show amendment, argument or evidence could not have been submitted earlier
  - No *per se* rule about specific situations, BUT
  - Showings that are unlikely to succeed:
    - Newly discovered art
    - New ground of rejection in a final Office Action
    - Submission of evidence from clinical trials



# NEW RESTRICTION-DIVISION PRACTICE

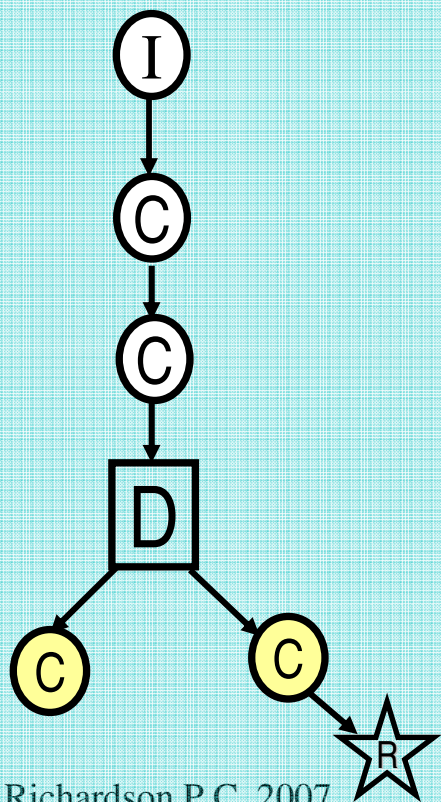


## New Restriction-Division Practice (1)

- ❖ Applicants may file divisional applications in parallel or series.
  - A divisional application is not required to be filed during the initial application, as long as the priority requirements of 35 USC 120 are satisfied
  - *I.e.*, DIV2 can be filed from an application in the DIV1 family
- ❖ CIPs cannot be filed from a divisional application
- ❖ Each Divisional Application gets its own set of 2 CONs and 1 RCE (“2+1”)
- ❖ CONs and RCE can be filed in any order

# Divisional Application Families

Applicant may file 2 continuing applications and 1 RCE in a divisional application family, without a petition and showing.





## New Restriction-Division Practice (2)

- ❖ Since a “divisional application” must claim a non-elected invention:
  - Cannot file an application for non-restricted subject matter, i.e., unclaimed subject matter
- ❖ So, no more “voluntary divisionals,” i.e., continuations with claims that were not previously examined or restricted
  - An attempted voluntary divisional is an ordinary Con or CIP if filed in the initial application family
  - An attempted voluntary divisional has an invalid priority claim if filed in the divisional family



## New Restriction-Division Practice (3)

- ❖ It may be to your advantage not to traverse a restriction requirement:
  - More restriction groups provide more prosecution opportunities, since each restriction group can be the basis for a “divisional application family”
  - Traversing a restriction makes the status of any divisional that you file uncertain until the restriction made final.
  - Traversing a restriction reduces your flexibility to choose claims that satisfy your 5/25 count
  - In election of species situations, the PTO strongly advises against filing of divisionals before a generic claim has been fully considered



# CLAIM LIMITS



## Claim Limits

- ❖ The basic 5/25 Limit:
  - Up to 5 independent claims
  - 25 total claims
  - No ESD required if the 5/25 limit is met
- ❖ Cancelled claims are NOT counted
- ❖ Claims withdrawn from consideration because of a restriction requirement are NOT counted
- ❖ BUT, the claims in some commonly owned applications will be counted
  - Discussed further below





## Claim Limits

- ❖ 5/25 claims can be filed in each of
  - an initial or divisional application
  - two continuations in that family
- ❖ Up to 15/75 total claims possible in an application family, without filing an ESD or petition for an extra CON
  - Using serial prosecution
- ❖ More than 5/25 claims can be filed
  - With a “Suggested Restriction Requirement” (SRR) by the applicant
  - Potential problem without an SRR or ESD



# PATENTABLY INDISTINCT APPLICATIONS



## Related Case Identification Requirement

- ❖ Applicants will be required to identify other applications and patents that:
  - Are commonly owned,
  - Have an inventor in common with the application, and
  - Have a filing or priority date within two months of any filing or priority date of the application



## The “patentably indistinct” presumption

- ❖ PTO will presume that applications and patents are “patentably indistinct” if:
  - They have a common inventor
  - They are commonly owned,
  - They have substantial overlapping disclosure, and
  - They have the same filing date or priority date(s)
- ❖ Applicant will be permitted to rebut the presumption



## Linking of “patentably indistinct” applications for counting claims

- ❖ The PTO will count all claims in copending applications having at least one patentably indistinct claim for 5/25 claim counting
  - Up to Notice of Allowance
  - Allowed claims will not be included in the count
- ❖ In the absence of good and sufficient reason, the PTO may require elimination of “patentably indistinct” claims from all but one application
  - Not limited to applications with same filing date
  - PTO currently has this option; now being emphasized



## But, What Does “Patentably Indistinct” Mean?

- ❖ Apparently, it is the present standard for obviousness-type double patenting:
  - Would any claim of either application be anticipated by or have been obvious over a claim in another commonly owned application having a common inventor. MPEP ¶ 804(II)(B)(1).



# THE EXAMINATION SUPPORT DOCUMENT ("ESD")



## Conditional Requirement of an ESD

- ❖ Required if more than 5/25 pending claims:
  - In one restriction group in one application
  - In two (or more) applications if there is a single patentably indistinct claim in each, and total claim count is more than 5/25
  
- ❖ Time for filing:
  - In response to a notice from the PTO, e.g., Examiner disagrees with applicant's SRR, or
  - Before the First Action On the Merits ("FAOM")





# Examination Support Document (“ESD”)



## Three Principal Tasks

- Preexamination Search & Statement
- Detailed Identifications
  - Tying Prior Art to Claim Limitations
  - Tying Disclosure to Claim Limitations
- Detailed Statement of Patentability



## Short Deadlines



# STRATEGY & TACTICS



## Strategy & Tactics (1)

### Plan Ahead

- Search before filing
  - Consider proposed new IDS rules
- Focus claims before filing
  - Don't plan to redraft claims after first office action



## Strategy & Tactics (2)

### Consider:

- Filing provisional applications more frequently
  - Not included in the CON-RCE limits
  - May allow more time
    - to search, and
    - to perfect claiming strategy and tactics
- Filing a Rule 1.103(d) request to defer examination up to 3 years from priority date



## Strategy & Tactics (3)

- ❖ Avoid Examination Support Documents (ESDs)
  - Potentially more work than preparing the application
    - More difficult, legal work
  - Non-extendable 2 month deadline
  - May create potential points of attack on the patent in litigation
    - Consider consulting a patent litigator when preparing an ESD



## Strategy & Tactics (4)

- ❖ Consider filing a Suggested Restriction Requirement (“SRR”) at the outset in every case where there is more than 5/25 claims
- ❖ Consider whether patentably distinct inventions should be filed in separate, initial applications
  - May need to notify the PTO of such separate applications
  - If the inventions in two applications are truly patentably distinct, there is less risk that they will be examined together



## Strategy & Tactics (5)

- ◆ Requests for Continued Examination (RCEs) are more valuable now
  - consider a petition or appeal before using the one permitted RCE—you may not have a good justification for another RCE when you need it



# THE TRANSITION





## Transition (1)

- ❖ Basic Effective Date: November 1, 2007
- ❖ Most changes will apply to nonprovisional applications pending on that date
- ❖ Continuing application rules
  - The changed definitions of continuing applications and the priority claim requirements of rules 1.78(a) & (d)(1) apply to applications filed on or after Nov. 1
- ❖ Claim limits
  - The “5/25” rules apply to any application filed on or after Nov. 1 (CFR 1.75)
  - Also apply to pending applications that have NOT had a FAOM



## Transition (2)

- ❖ “One more” CON or CIP is permitted in application families
  - Filed before August 21, 2007
  - Even if 2 CONs/CIPs were already filed before August 21
  - The “One more” can be filed now or after Nov. 1
- ❖ Multiple CONs/CIPs can be filed until October 31<sup>st</sup>
  - BUT after Nov. 1 all of these will need to meet the 5/25 rule, the requirement to identify rule and the patentably indistinct presumption rule in most cases
  - These applications will be counted in the “2+1” rule
  - And will be counted as your “one more”



## Transition (3)

- ❖ Applicant may present more than 5/25 claims, without filing an ESD, in an application in which the first office action on the merits was mailed before November 1, 2007



## Transition (4)

- ❖ Deadline to identify closely filed, commonly-owned applications with a common inventor for pending applications is the later of:
  - February 1, 2008
  - Four months from actual filing date or 371 date
  - Two months from filing receipt date for the other application



## Transition (5)

- ❖ Deadlines to identify commonly-owned applications with a common inventor, overlapping disclosure, and same filing or priority date for pending applications (and rebut the presumption) is the later of:
- February 1, 2008
  - Four months from actual filing date or 371 date
  - Two months from filing receipt date for the other application
  - The date on which a patentably indistinct claim is presented in the other application



## For More Information:

- ❖ The new Rules, PTO Comments, a PTO slide show and PTO FAQs can be accessed at

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

- ❖ Today's presentation and a link to the PTO rules page will be posted at [www.fr.com/rules](http://www.fr.com/rules)

- ❖ Direct Questions to your usual F&R contact



## Credits

Thanks to many attorneys at Fish & Richardson.

Especially:

- Ramon Tabtiang (Boston office)
- Richard Bone (Silicon Valley office)
- Kevin Greene (DC office)



# THE END

John B. Pegram  
[pegram@fr.com](mailto:pegram@fr.com)

Ronald C. Lundquist  
[lundquist@fr.com](mailto:lundquist@fr.com)