McDermott Will & Emery

Sweeping USPTO Patent Rule Changes for Continuations and Claims

Strategies to Meet the New Obligations under the Complex Rules

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Overview of Major Changes

I) Number of claims permitted in an application

II) the painful Examination Support Document (ESD)

III) Reporting requirements and applications containing patentably indistinct claims

IV) Continuing applications and RCEs

Number of Claims

37 CFR 1.75

Number of Claims
37 CFR 1.75(b)

- **The rule changes affecting the number of claims under § 1.75 are applicable to:**
  - **Applications* filed on or after November 1, 2007;**
  - **Applications entering the national stage on or after November 1, 2007; and**
  - **Applications* in which a First Action On the Merits (FAOM) was <u>not</u> mailed before November 1, 2007.**
    - **For example, applicant is required to file an Examination Support Document (ESD) in an application that contains more than 5/25 claims if a FAOM was <u>not</u> mailed before November 1, 2007.**

***Including reissue applications, but not reexamination proceedings.**

Number of Claims
37 CFR 1.75(b)

- **Applicants may present, without an ESD, up to:**
  - **Five (5) independent claims or**
  - **Twenty-five (25) total claims in an application.**
    - **➔ the "5/25" rule**
- **Applicant may present more than 5/25 claims, if applicant files an ESD before the FAOM.**

Number of Claims
37 CFR 1.75(b)

- **The 5/25 claim threshold does <u>not</u> count withdrawn claims.**
  - **Applicant may provide a suggested restriction requirement (SRR) before FAOM or a restriction requirement.**
- **The 5/25 claim threshold includes all of the claims present in other copending application(s) deemed to have a patentably indistinct claim, but <u>not</u> the claims in issued patents.**
  - **Applicant may present up to 15/75 claims via an initial application and 2 continuation or CIP applications prosecuted serially.**

Number of Claims
37 CFR 1.75(b)

- **If an application contains claims to more than one invention, applicants may file a suggested requirement for restriction (SRR) under § 1.142(c).**
- **Any SRR must be:**
  - **Accompanied by an election of an invention to no more than 5/25 claims, identifying the elected claims; and**
  - **Filed before the earlier of a FAOM or an Office issued restriction requirement.**
    - **Once the Office issues a restriction requirement, applicant may not simply submit an alternative SRR.**
- **An examiner's decision <u>not</u> to impose a restriction requirement cannot be petitioned**

Number of Claims
37 CFR 1.75(b)

- **If an ESD in compliance with § 1.265 is <u>not</u> filed before FAOM, the application must remain at 5/25 or fewer claims.**
- **In determining whether an application exceeds the 5/25 claim threshold:**
  - **Withdrawn claims are <u>not</u> taken into account, unless they are reinstated or rejoined (§ 1.75(b)(5));**
  - **Claims of other commonly owned applications having a patentably indistinct claim will be taken into account (not just the patentably indistinct claims) (§ 1.75(b)(4)).**

Number of Claims
37 CFR 1.75(b)

- **If the SRR is accepted,**
  - **The claims to the non-elected invention(s) will be withdrawn;**
  - **The claims to the elected invention will be examined; and**
  - **The FAOM will set out the restriction requirement,**
    - **In a manner similar to a restriction requirement previously made by telephone (*see* MPEP 810).**

Note: Excess claims fees cannot be refunded for withdrawn claims that are <u>not</u> canceled prior to FAOM. *See* 35 USC 41(a)(2).

Number of Claims
37 CFR 1.75(b)

- **If a SRR is <u>not</u> accepted in an application containing more than 5/25 claims, the applicant will be notified.**
  - **The examiner may make either no restriction requirement or a different restriction requirement.**
- **If the examiner does <u>not</u> make a restriction requirement,**
  - **The notice will provide a two-month time period that is not extendable under § 1.136(a).**
  - **To avoid abandonment, the applicant must:**
    - **File an ESD in compliance with § 1.265; or**
    - **Amend the application to contain no more than 5/25 claims.**

Number of Claims
37 CFR 1.75(b)

- **If the examiner makes a *different* restriction requirement,**
  - **The notice will provide a two-month time period that is not extendable under § 1.136(a).**
  - **Applicant must make an election to avoid abandonment.**
  - **If the elected invention is drawn to more than 5/25 claims, applicant must also:**
    - **File an ESD in compliance with § 1.265 that covers each elected claim; or**
    - **Amend the application to contain no more than 5/25 claims to the elected invention.**

Number of Claims
37 CFR 1.75(b)(3)

- **Applicant will be notified if:**
  - **The application contains more than 5/25 claims;**
  - **An ESD has been inadvertently omitted;**
  - **A SRR is not filed; and**
  - **It is before FAOM.**

Number of Claims
37 CFR 1.75(b)(3) (cont.)

- **For applications filed (or that entered the national stage) on or after November 1, 2007:**
  - **The notice will set a two-month time period that is <u>not</u> extendable under § 1.136(a).**
  - **To avoid abandonment, applicant must:**
    - **File an ESD in compliance with § 1.265; or**
    - **Amend the application to contain no more than 5/25 claims.**

Number of Claims
37 CFR 1.75(b)(3) (cont.)

- **For applications in which a FAOM was *not* mailed before November 1, 2007:**
  - **The notice will set a two-month time period that is extendable under § 1.136(a), up to maximum of six months.**
  - **To avoid abandonment, applicant must:**
    - **File a SRR;**
    - **File an ESD in compliance with § 1.265; or**
    - **Amend the application to contain no more than 5/25 claims.**

Number of Claims
37 CFR 1.75(b)(3) (cont.)

- For applications in which a FAOM was not mailed before November 1, 2007 (continued):
  - The notice may be combined with a restriction requirement.
  - To avoid abandonment, applicant must make an election.
  - If the elected invention is drawn to more than 5/25 claims, applicant must also:
    - File an ESD in compliance with § 1.265 that covers each elected claim; or
    - Amend the application to contain no more than 5/25 claims to the elected invention.

Number of Claims
37 CFR 1.75(b)

- **If an ESD in compliance with § 1.265 was <u>not</u> filed before FAOM, an amendment that results in the application containing more than 5/25 claims will be treated as non-responsive.**
  - **The notice will set a two-month time period that is not extendable under § 1.136(a).**
  - **To avoid abandonment, applicant must file an amendment that does <u>not</u> result in the application containing more than 5/25 claims.**

Number of Claims
37 CFR 1.75(b)(4)

- **The Office will treat an application as no longer pending for purposes of § 1.75(b)(4) if:**
  - **A notice of allowance is issued;**
  - **The application is recognized as abandoned;**
  - **A notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 USC 141 is filed; or**
  - **A civil action under 35 USC 145 or 146 is commenced.**

Number of Claims
37 CFR 1.75(b)(1)

- **A dependent claim must:**
  - **Be in dependent form;**
  - **Refer back to another claim(s) in the same application;**
  - **Incorporate by reference all the limitations of the previous claim to which it refers; and**
  - **Specify a further limitation of the subject matter of the previous claim.**

Number of Claims
37 CFR 1.75(b)(4)

- **For determining whether an application exceeds the 5/25 rule and for claim fees calculation,**
  - **A claim that does <u>not</u> incorporate by reference all the limitations of the claim to which it refers will be treated as an independent claim.**
  - **A claim that refers to a claim of a different statutory class of invention will also be treated as an independent claim.**
    - **For example, a method of using the composition of claim 1 comprising….**

Number of Claims
37 CFR 1.75(b)(4)

- For determining whether an application exceeds the 5/25 claim threshold and for claims fees calculation (continued),
  - A multiple dependent claim will be considered to be that number of claims to which direct reference is made therein.
  - A claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim.
  - In the following example, each claim will be considered to be 3 claims:

    Claim 4. A device according to claim 1, 2, or 3, further comprising…

    Claim 5. A device according to claim 4, further comprising…

Number of Claims
37 CFR 1.181

If applicant disagrees with the Office's determination of the number of claims, the applicant can file a petition under 37 C.F.R. § 1.181 to overcome the determination. However:

- **Filing a petition does not stay the 2 month non-extendable period for complying with the 5/25 rule.**
- **The Office frequently takes more than 2 months to decide a petition under 37 C.F.R. § 1.181.**

➔ Thus, there appears to be no practical way to overcome an incorrect claim number determination

Proposed Changes to Claims Containing Alternative Language

The Office has proposed amending 37 C.F.R § 1.75 to require that no alternative within a claim is defined as a set of further alternatives within the claim, and each alternative within a list of alternatives must be substitutable one for another.

New section 1.140 would require that two or more independent inventions may not be claimed in a single claim, and further requires that all the species encompassed by a single claim meet at least one of the following two conditions: (1) The species share a substantial feature essential for a common utility, or (2) The species are prima facie obvious over each other.

72 Fed. Reg. 154 (2007) at 44992-45001 (open to comments until October 9, 2007).

Examination Support Documents (ESD)

37 CFR 1.265

Examination Support Document 37 CFR 1.265

- **An ESD must include:**
  - **A pre-examination search statement;**
  - **Listing of references deemed most closely related to the subject matter of each claim;**
  - **Identification of claim limitations disclosed by each reference;**
  - **Detailed explanation of patentability; and**
  - **Showing of support for <u>each</u> claim limitation under 35 USC 112, ¶ 1.**

Examination Support Document 37 CFR 1.265(a)(1) and (b)

- **A pre-examination search statement must include:**
  - **A statement that a pre-examination search in compliance with § 1.265(b) was conducted.**
  - **An identification of:**
    - **The field of search by US class and subclass, the date of the search; and**
    - **For database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search (in the manner set forth in MPEP 719.05.)**

Examination Support Document 37 CFR 1.265(a)(1) and (b)

- **A pre-examination search under § 1.265(b) must:**
  - **Be directed to the claimed invention; and**
  - **Encompass all of the limitations of each of the claims, giving the claims the broadest reasonable interpretation.**

Examination Support Document 37 CFR 1.265(a)(1) and (b)

- The pre-examination search must involve:
  - U.S. patents and patent application publications;
  - Foreign patent documents; and
  - Non-patent literature.
- These sources cannot be eliminated,
  - Unless the applicant justifies with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source.
    - The justification must be included in the pre-examination search statement.

Examination Support Document 37 CFR 1.265(a)(2) and (c)

- **The listing of references must include:**
  - **A list identifying each cited reference in compliance with §§ 1.265(c)(1) and (c)(2);**
  - **A legible copy of each cited reference, except for U.S. patents and patent application publications; and**
  - **Any existing English language translation of each cited non-English language reference.**

Examination Support Document 37 CFR 1.265(a)(2)

- **The references that would be most closely related to the subject matter of each claim include any reference that discloses:**
  - **The greatest number of limitations in an independent claim;**
  - **A limitation of an independent claim that is not shown in any other reference; or**
  - **A limitation of a dependent claim that is not shown in any other reference.**
- **Applicant must consider all of the references that applicant has knowledge of, regardless of the source.**

Examination Support Document
37 CFR 1.265(a)(3)

- **Applicant must identify at least one appearance in the reference of a specific feature, showing, or teaching for which the reference is being cited.**
  - **Applicant would <u>not</u> need to specifically point out more than one occurrence.**
  - **However, applicant should do so where the additional appearance may not be apparent and may have some additional significance.**

Examination Support Document 37 CFR 1.265(a)(3)

- **If applicant recognizes that a reference is relevant for more than one feature, showing, or teaching, the applicant would need to specifically identify:**
  - **Each additional feature, showing, or teaching; and**
  - **The portion where the feature, showing, or teaching appears in the document.**
- **A mere statement indicating that the entire reference, or substantially the entire reference, is relevant would not be sufficient.**

Examination Support Document 37 CFR 1.265(a)(4)

- **The ESD must include a detailed explanation that particularly points out how each of the independent claims is patentable over the references cited in the listing of references.**
  - **Applicant must set out with particularity, by reference to one or more specific claim limitations, why the claimed subject matter is not described in the references, taken as a whole.**
  - **A general statement that all of the claim limitations are not described in a single reference will <u>not</u> be sufficient.**

Examination Support Document 37 CFR 1.265(a)(4)

- **In light of the *KSR* decision, applicant must explain why a person of ordinary skill in the art would not have combined the references to arrive at the claimed subject matter.**
- **The applicant must also explain why the claim limitations referenced render the claimed subject matter novel and non-obvious over the cited prior art.**

Examination Support Document 37 CFR 1.265(a)(5)

- An ESD must include a showing of where each limitation of the claims finds support under 35 USC 112, ¶ 1, in the written description of the specification.
- If the application claims the benefit of a prior-filed application(s), the showing must also include where each claim limitation finds support in each such application.
  - Applicant must identify each means- (or step-) plus-function limitation and the corresponding structure, material, or acts.

Examination Support Document 37 CFR 1.265(d)

- **A *supplemental* ESD is required:**
  - **When applicant presents an amendment to the claims that is not encompassed by the previous ESD; and**
  - **When applicant files an IDS that includes a reference that is deemed as closely, or more closely, related to the subject matter of at least one claim than the references provided in the previous ESD.**

Examination Support Document 37 CFR 1.265(e)

- **Applicant will be notified if:**
  - **The ESD or pre-examination search is deemed to be insufficient; or**
  - **The claims have been amended such that the ESD no longer covers each claim.**

Examination Support Document 37 CFR 1.265(e)

- The notice will provide a two-month time period that is not extendable under § 1.136(a).
- To avoid abandonment, the applicant must within the time period either:
  - File a corrected or supplemental ESD; or
  - Amend the application such that it contains no more than 5/25 claims.

Examination Support Document 37 CFR 1.265(f)

- **If an ESD is accompanied by a certification under § 1.265(f), the ESD is not required to include an identification of claim limitations disclosed by each reference under § 1.265(a)(3).**
  - **This exemption applies only to applications filed by a small entity as defined by the Regulatory Flexibility Act (5 USC 601 *et seq*.).**
    - **Questions related to whether an entity meets this definition may be directed to the Small Business Administration.**
    - **An entity that meets the definition of a small entity set forth in § 1.27 for paying reduced fees may or may not meet this definition.**

RECOMMENDATIONS

I) For pending applications that have not received a FAOM by November 1, 2007, identify those applications that exceed the 5/25 rule and consider the appropriate course of action (e.g. SRR or cancel claims) under the new rules.

II) For applications filed on or after November 1, 2007, either the number of claims should be limited to no more than 5/25, or an SRR should be submitted with an election that does not exceed the 5/25 rule.

III) Draft claims in a straight-forward, reader-friendly format that will facilitate examiner comprehension and minimize the imposition of the 5/25 rule.

Reporting Requirements & Applications with Patentably Indistinct Claims

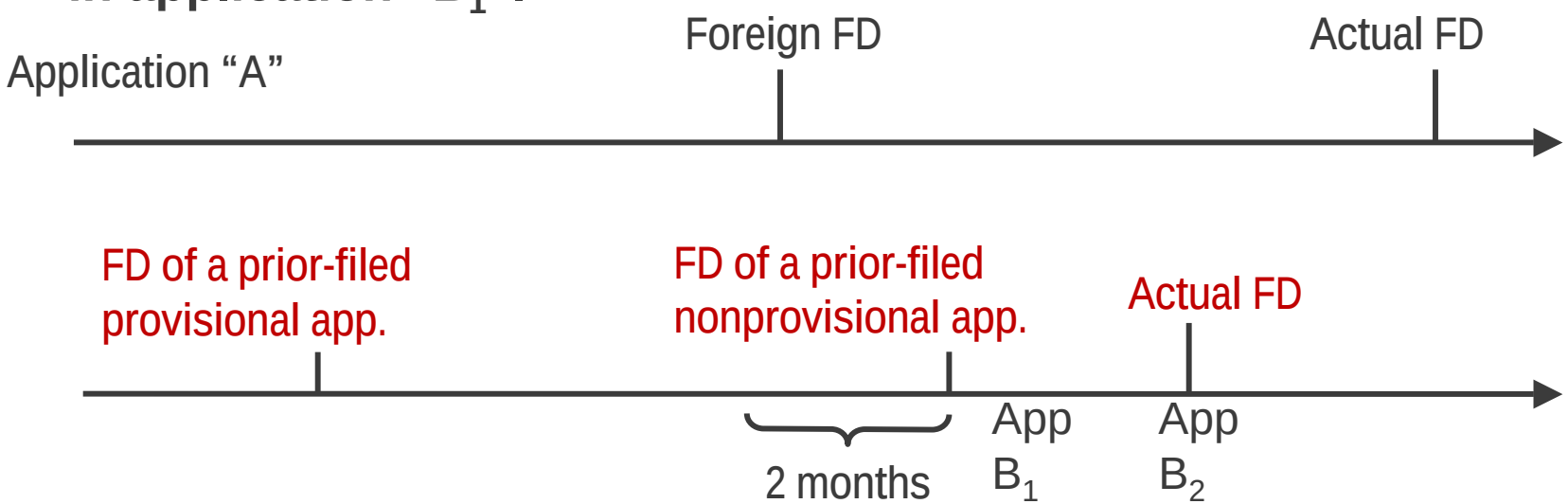
37 CFR 1.78

Reporting Requirements 37 CFR 1.78(f)(1)

- **Applicant must for all applications filed on or after 11/1/07 identify other commonly owned application(s) or patent(s) that has:**
  - **An inventor in common with the application; and**
  - **A claimed filing or priority date within two months of the claimed filing or priority date of the application.**
- **Taking into account the actual filing date, any foreign priority date, and any filing date of a prior-filed provisional or nonprovisional application for which a benefit is claimed.**

Reporting Requirements 37 CFR 1.78(f)(1)

- **For the example below, applicant for application "A" is required to identify application "B_1" and applicant for application "B_1" is required to identify applicant "A" because the foreign priority date of application "A" is within two months from the filing date of a prior-filed nonprovisional application for which benefit is claimed in application "B_1".**



Reporting Requirements
37 CFR 1.78(f)(1)

- **Applicant must submit the identification of other commonly owned applications or patents within the later of:**
  - **Four months from the actual filing date of the application or from the date on which the national stage commenced; or**
  - **Two months from the mailing date of the initial filing receipt in the other application.**

Applications with Patentably Indistinct Claims 37 CFR 1.78(f)(2)

- **A rebuttable presumption will exist that the application and the other commonly owned application(s) or patent(s) contain at least one patentably indistinct claim,**
  - **If the other application or patent has:**
    - **An inventor in common with the application;**
    - **A claimed filing or priority date that is the same as the claimed filing or priority date of the application; and**
    - **Substantial overlapping disclosure with the application.**
      - » **Substantial overlapping disclosure exists if the other application or patent has support for at least one claim in the application.**

Applications with Patentably Indistinct Claims 37 CFR 1.78(f)(2)

- **If the rebuttable presumption under § 1.78(f)(2) exists, applicant must either:**
  - **Rebut the presumption by explaining how the application contains only patentably distinct claims; or**
  - **Submit a terminal disclaimer.**
    - **If the other application is pending, applicant must also explain why there are two or more pending applications which contain patentably indistinct claims.**

Applications with Patentably Indistinct Claims 37 CFR 1.78(f)(2)

- **If the rebuttable presumption under § 1.78(f)(2) exists, applicant must submit a rebuttal or a terminal disclaimer within the later of:**
  - **Four months from the actual filing date of the application or from the date on which the national stage commenced;**
  - **The date on which a patentably indistinct claim is presented; or**
  - **Two months from the mailing date of the initial filing receipt in the other application.**

Applications with Patentably Indistinct Claims 37 CFR 1.78(f)(3)

- **For commonly owned pending applications that contain at least one patentably indistinct claim,**
  - **The Office will treat each application as having the total number of claims present in all of the applications for the purposes of determining whether each application exceeds the 5/25 claim threshold. *See* § 1.75(b)(4).**
  - **In the absence of good and sufficient reason, the Office may require elimination of the patentably indistinct claims from all but one of the applications. *See* § 1.78(f)(3).**

Applications with Patentably Indistinct Claims 37 CFR 1.78(f)

- The rule changes to § 1.78(f) are applicable to:
  - Applications pending on or after November 1, 2007 (f)(1) and (f)(2)
  - For applications filed before November 1, 2007, (f)(2) only
  - Applicant must comply with the requirements under § 1.78(f)(2):
    - Within the time periods set forth in § 1.78(f)(2); or
    - By February 1, 2008, whichever is later.

RECOMMENDATIONS

I) **Applicants should monitor copending applications and foreign applications that share a common inventor to determine whether any copending applications or foreign applications meet the reporting requirements.**

II) **Applicants should begin identifying pending applications that meet the reporting requirements and prepare the necessary disclosure forms in advance of the February 1, 2008 deadline.**

Continuing Applications & Requests for Continued Examination

37 CFR 1.78 and 1.114

Continued Examination Filings 37 CFR 1.78(d) and 1.114

- Applicants may file, without a petition and showing:
  - Two continuation or continuation-in-part (CIP) applications; and
  - A single request for continued examination (RCE) in an application family.
    - An application family includes the initial application and its continuation or CIP applications.
- Applicant may file any additional continuing application or RCE with a petition and showing.

Continuing Applications 37 CFR 1.78(d)

- Applicants may file a divisional application if:
  - The prior-filed application is subject to a requirement for restriction; and
  - The divisional application claims only a non-elected invention(s) that has not been examined.
  - So called "voluntary divisionals" (not filed as a result of a restriction) will be considered as a continuation by the Office.
- Applicants may file divisional applications in parallel or series.
  - A divisional application is <u>not</u> required to be filed during the pendency of the initial application, as long as the copendency requirement of 35 USC 120 is met.

Continuing Applications
37 CFR 1.78(d)

- **A divisional application can be filed for unpaid for, unexamined inventions which lack unity of invention in an International Application via the Bypass Application route.**

Continued Examination Filings 37 CFR 1.78(d) and 1.114

- **Applicants may file, without a petition and showing:**
  - **Two continuation applications of a divisional application; and**
  - **A single RCE in the divisional application family.**
    - **A divisional application family includes the divisional application and its continuation applications.**
- **Applicant may also file any additional continuing application or RCE in the divisional family with a petition and showing.**

Continuing Applications
37 CFR 1.78(a)(3) and (a)(4)

- **A continuation application is a continuing application that discloses and claims only an invention(s) that was disclosed in the prior-filed application.**
- **A CIP application is a continuing application that discloses subject matter that was <u>not</u> disclosed in the prior-filed application.**

Continuing Applications
37 CFR 1.78(d)

- **Any benefit claim to a prior-filed nonprovisional application must satisfy at least one of the paragraphs in § 1.78(d)(1) :**

§ 1.78(d)(1)(i)	–	Conditions for 2 CONs or CIPs of an initial application.
§ 1.78(d)(1)(ii)	–	Conditions for divisional applications.
§ 1.78(d)(1)(iii)	–	Conditions for 2 CONs of a divisional application.
§ 1.78(d)(1)(iv)	–	Conditions for "one more" CON or CIP of an international application in which a Demand and the basic national fee have not been filed.
§ 1.78(d)(1)(v)	–	Conditions for "one more" CON or CIP for a nonprovisional application abandoned in pre-examination.
§ 1.78(d)(1)(vi)	–	Conditions for a third or subsequent CON or CIP filed with a petition and showing.

Continuing Applications – Bypass Application 37 CFR 1.78(d)(1)(iv)

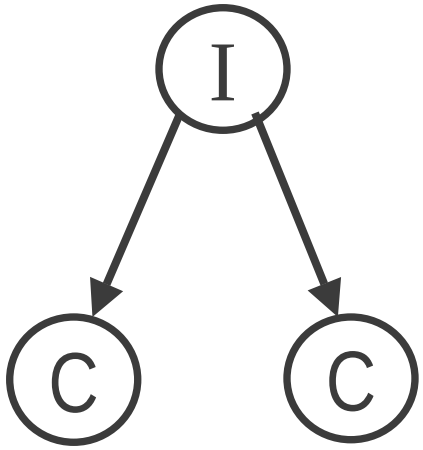
- **Applicant may file "one more" continuation or CIP application without a petition and showing, if the following conditions are satisfied:**
  - **The prior-filed application is an international application designating the US;**
  - **A Demand has not been filed and the basic national fee has not been paid in the prior-filed application; and**
  - **The prior-filed application does not claim any benefit of any other nonprovisional application or international application designating the US.**

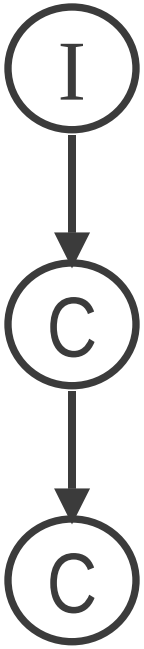
Continuing Applications 37 CFR 1.78(d)(1)(v)

- **Applicant may file "one more" continuation or CIP application without a petition and showing, if the following conditions are satisfied:**
  - **The prior-filed application is an application under 35 USC 111(a) (non-provisional application);**
  - **The prior-filed application became abandoned due to the failure to timely reply to an Office notice issued under §1.53(f) *(e.g.*, a notice to file missing parts);**
  - **The prior-filed application does <u>not</u> claim any benefit of any other nonprovisional application or international application designating the US.**

Continuing Applications
37 CFR 1.78(d)(1)(i)

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





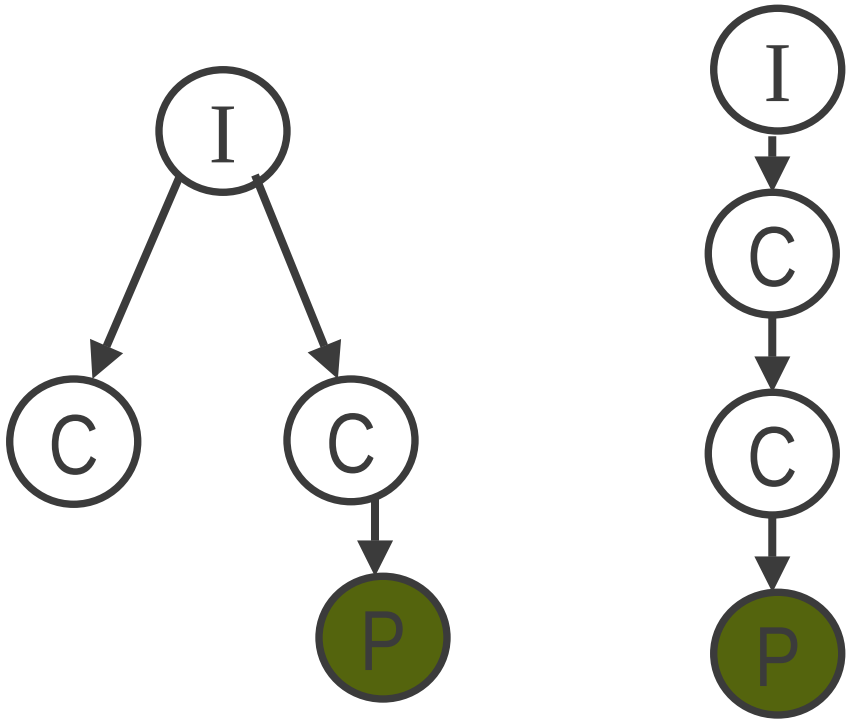
Initial Application “A”

Continuation or CIP “B”

Continuation or CIP “C”

Continuing Applications
37 CFR 1.78(d)(1)(vi)

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



Initial Application “A”

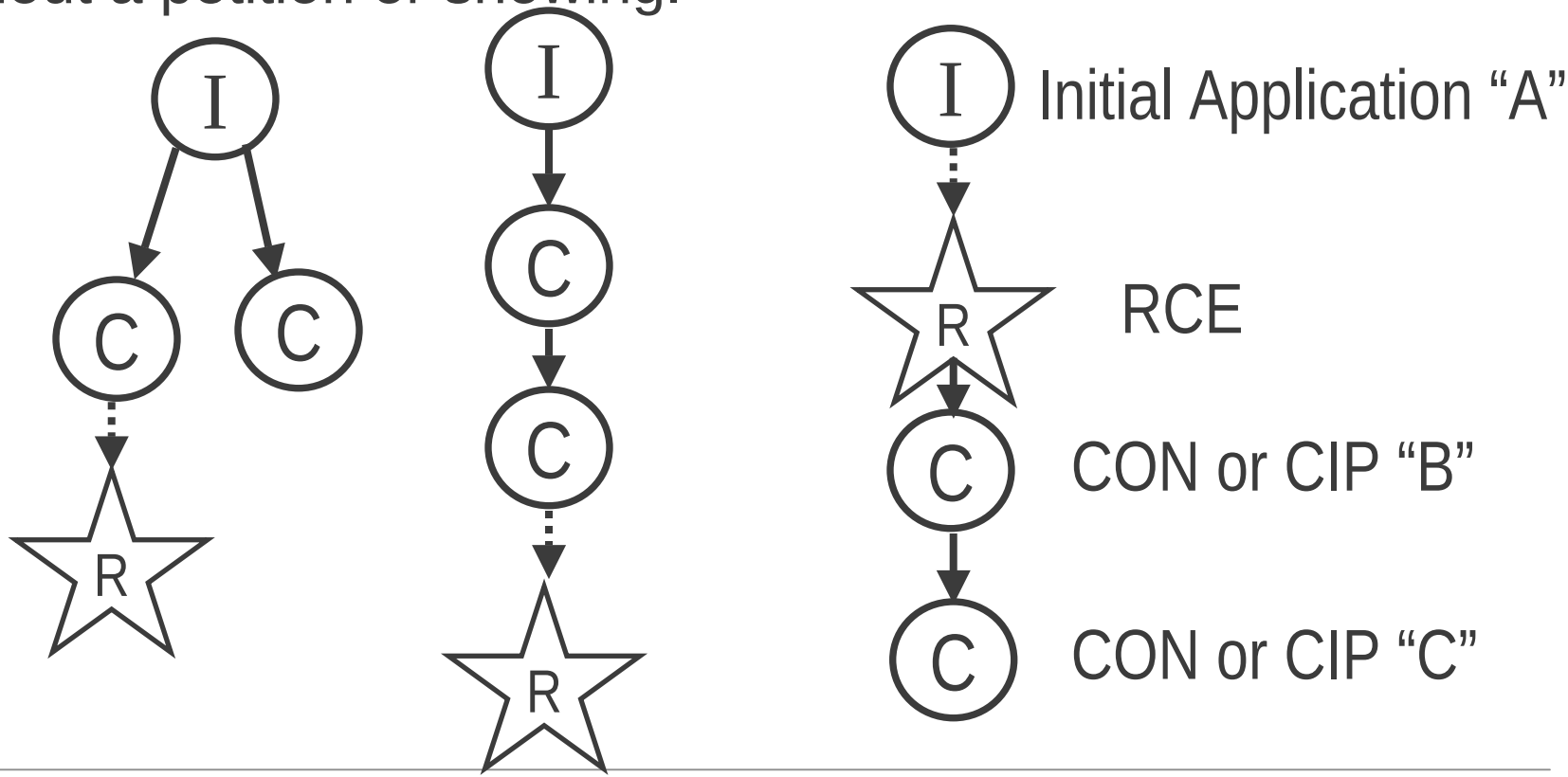
CON or CIP “B”

CON or CIP “C”

Continuation or CIP with a petition and showing

Request for Continued Examination 37 CFR 1.114(f)

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



Request for Continued Examination 37 CFR 1.114(f)

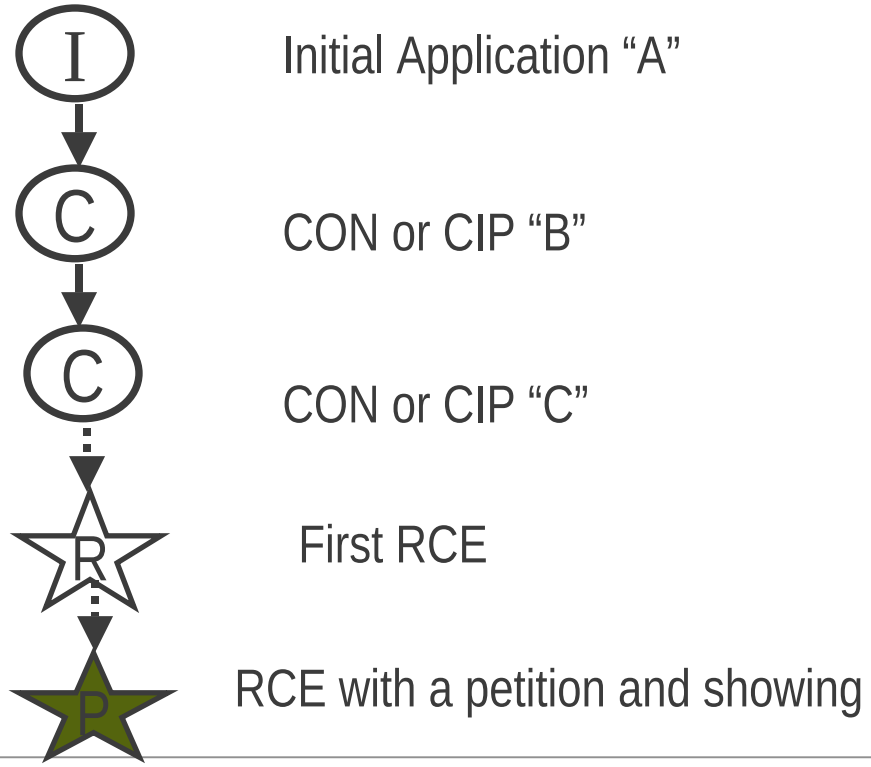
- It is possible to file more than 1 RCE in a family if the RCE is not filed in an application claiming priority on another family member with a previously filed RCE, for example: if RCEs are filed in parallel continuation applications. Parallel continuations do not claim priority on each other.

- PTO has not officially recognized this possibility, but the PTO removed the slide showing the example where this would not be permitted in later versions of the new rule slideshow.

- It is expected that the USPTO will change this rule.

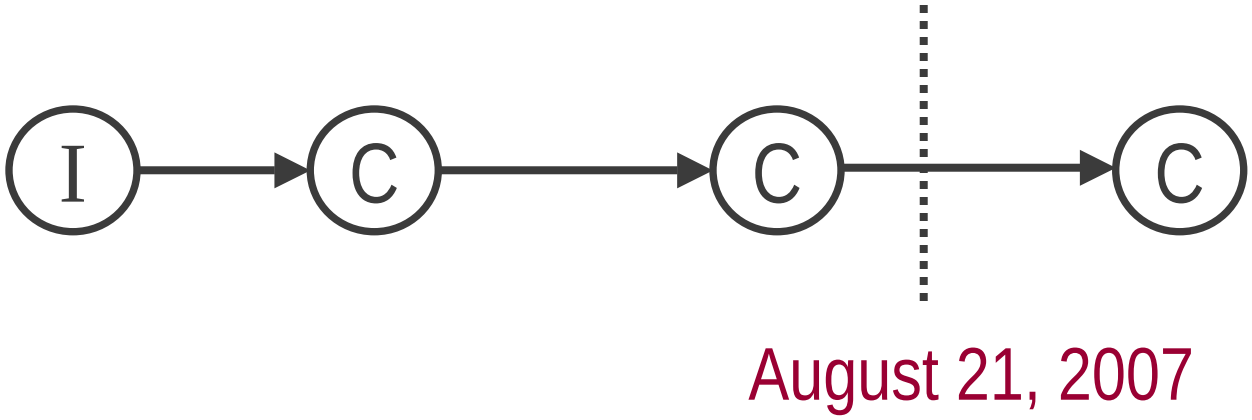
Request for Continued Examination 37 CFR 1.114(g)

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



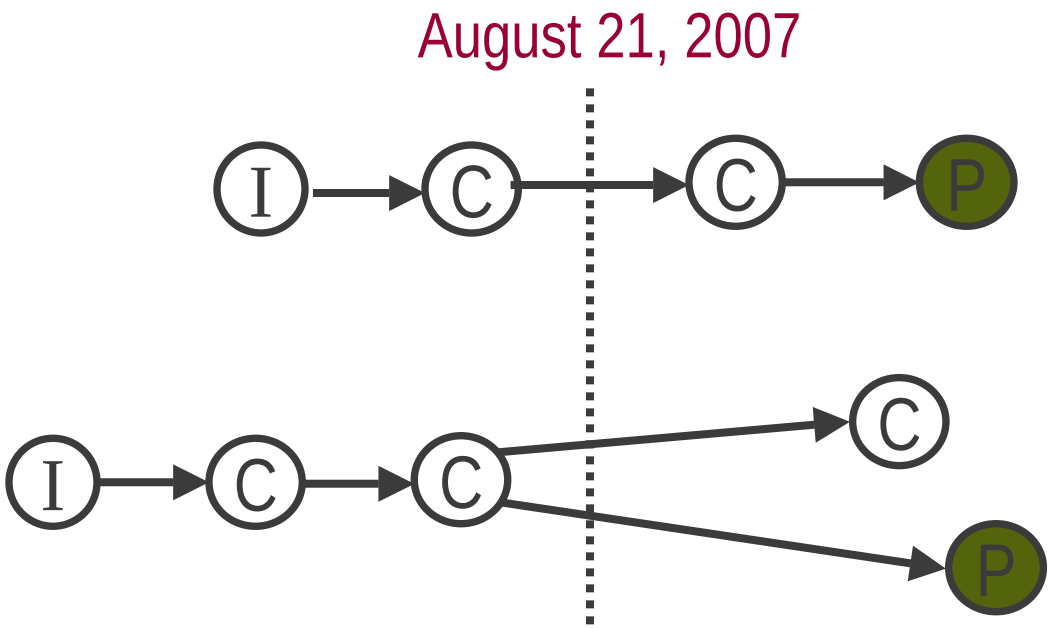
Continuing Applications
37 CFR 1.78(d)

Applicant may file “one more” continuing application for applications filed before August 21, 2007, without a petition and showing.



Continuing Applications
37 CFR 1.78(d)

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



Continuing Applications
One More Provision

- The "one more" provision is not codified in the Rules, but, rather is explained in the Office's Summary of the Rules and in the Response to Comments.

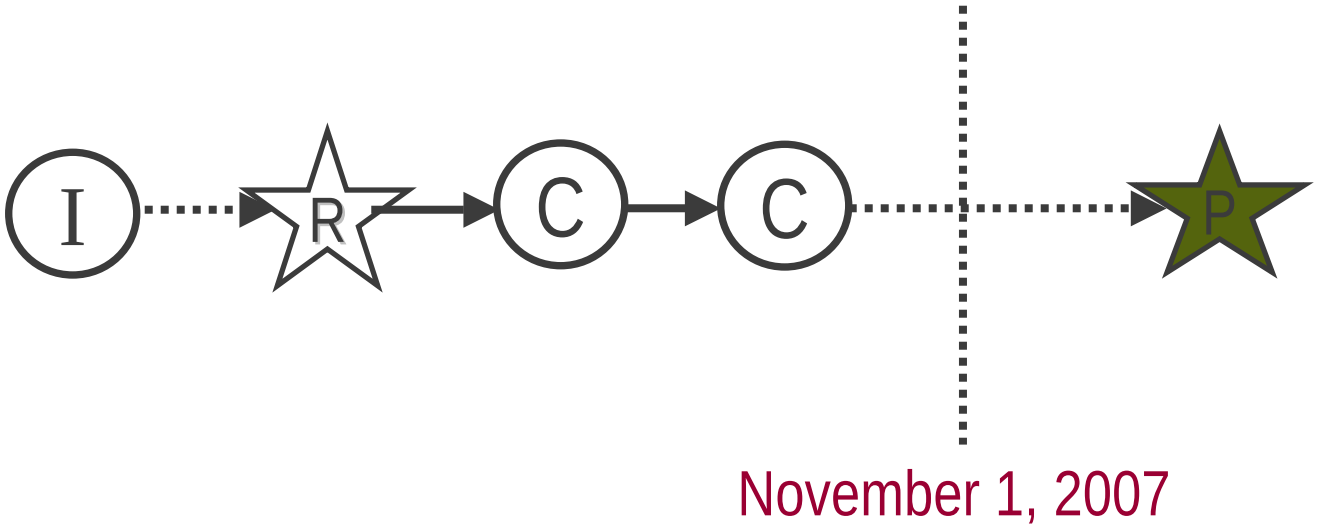
- There is no limit on filing continuation applications before November 1, 2007.

- If a continuation is filed after August 21, 2007 that equals or exceeds the two continuation per application family, no additional continuations will be allowed after November 1, 2007 without a petition and showing.

- The "one more" continuation can be CIP even if it claims priority on a divisional.

Request for Continued Examination 37 CFR 1.114

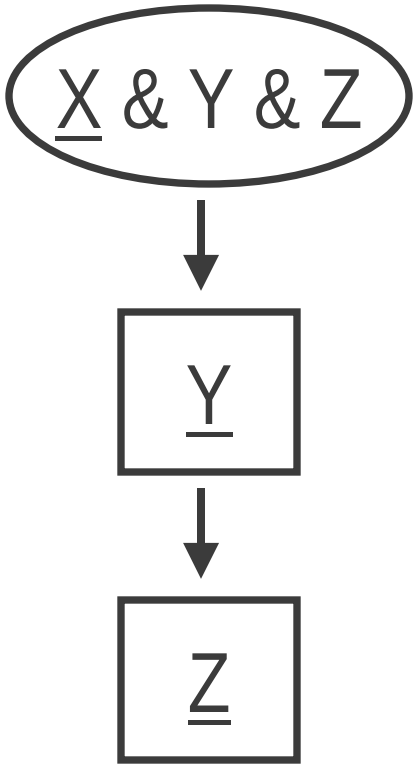
Applicant may file a second or subsequent RCE in an application family on or after November 1, 2007, with a petition and showing.



Continuing Applications
37 CFR 1.78(a)(2)

- **A divisional application is a continuing application that**
  - **Discloses and claims only an invention(s) that was disclosed and claimed in a prior-filed application, but**
  - **Was subject to a requirement for restriction in the prior-filed application, and**
  - **Was <u>not</u> elected for examination and was <u>not</u> examined in any prior-filed US application. *See* also § 1.78(d)(1)(ii).**

Divisional Applications
37 CFR 1.78(d)(1)(ii)



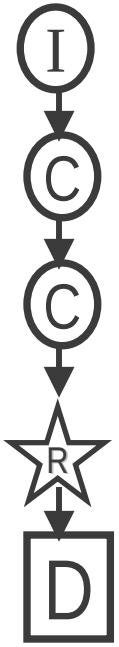
The prior-filed application discloses and claims inventions “X”, “Y”, and “Z”.
- The application is subject to a restriction requirement.
- Applicant elected invention “X” for examination.

Divisional Application #1 claims only invention “Y”, a non-elected invention that was not examined.

Divisional Application #2 claims only invention “Z”, a non-elected invention that was not examined.

Divisional Applications
37 CFR 1.78(d) and 1.114(f)

A divisional application is <u>not</u> required to be filed during the pendency of the initial application, as long as the copendency requirement of 35 USC 120 is met.



Initial application “A” w/ restriction requirement

CON or CIP “B”

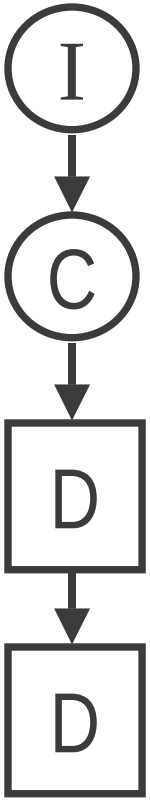
CON or CIP “C”

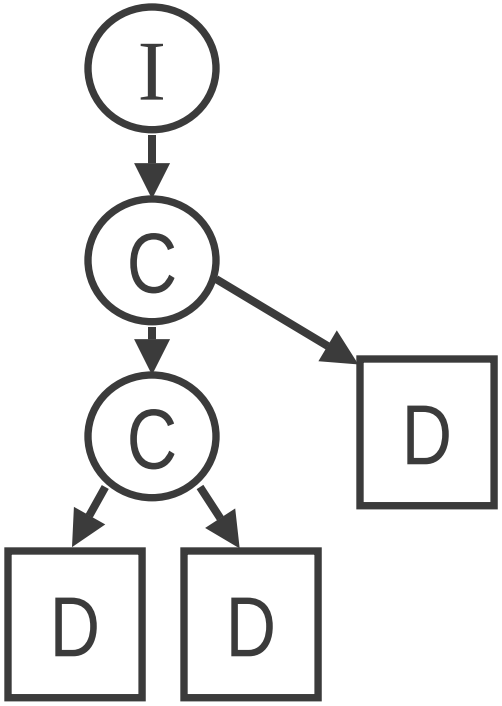
RCE

Divisional application “D”

Divisional Applications
37 CFR 1.78(d)(1)(ii)

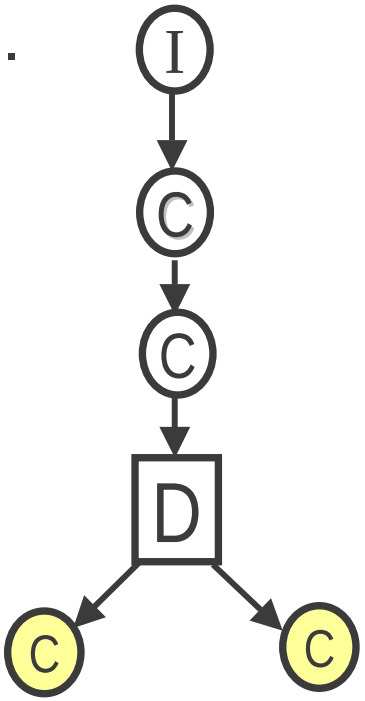
Applicant may file the divisional applications in parallel or series.





Divisional Applications
37 CFR 1.78(d)(1)(ii) and (iii)

Applicant may file two continuation applications (but not CIPs) of a divisional application, without a petition and showing.



Initial application "A"

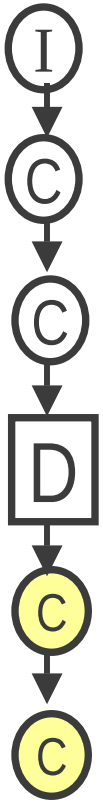
Continuation or CIP "B"

Continuation or CIP "C"

Divisional "D"

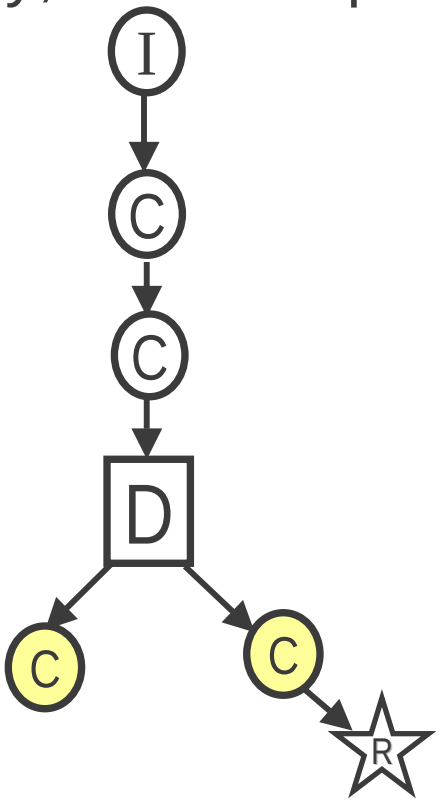
Continuation "E"

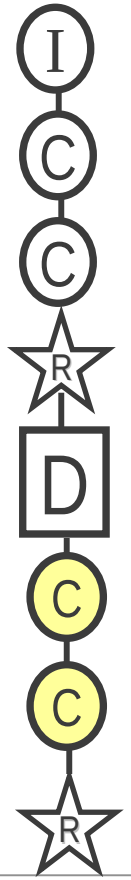
Continuation "F"



Request for Continued Examination 37 CFR 1.114(f)

Applicant may file a single RCE in a divisional application family, without a petition and showing.





Continuing Applications 37 CFR 1.78(d)

- **If applicant presents a benefit claim that is not permitted by § 1.78(d)(1):**
  - **The Office will refuse to enter the improper benefit claim and refuse the benefit of the filing date of the prior-filed application.**
    - **The application will be treated as entitled only to the actual filing date and will be subject to prior art based on the actual filing date of the application.**
    - **For example, if the prior-filed application is published more than 1 year prior to the actual filing date of the application, the publication can be used as prior art under 35 USC 102(b).**

Continuing Applications 37 CFR 1.78(d)(3)

- **Applicant must identify the claims in a CIP application that are supported by the prior-filed application.**
  - **Any claims that are <u>not</u> identified will be subject to prior art based on the actual filing date of the CIP application.**
  - **A new ground of rejection necessitated by a late submission of such an identification will not preclude a second or subsequent action from being made final.**
- **The examiner may require applicant to identify where (by page and line or paragraph number) the specification of the application or the prior-filed application provides support and enablement for a claim. *See* § 1.105(a)(1)(ix).**

Continuing Applications 37 CFR 1.78(d)

- Applicant may request to have a continuation application placed on an examiner's amended (Regular Amended) docket under the optional streamlined continuation application procedure, if:
  - The continuation application is complete including a specification, at least one claim, and drawings (if required), and is filed on or after November 1, 2007;
  - The application discloses and claims only an invention(s) that was disclosed and claimed in the prior-filed application;
  - The applicant agrees that any election in response to a restriction requirement carries over to the continuation application;
  - The prior-filed application is under final or appeal; and
  - The prior-filed application is expressly abandoned upon filing of the continuation application.

Continuing Applications 37 CFR 1.78(d)

- **Applicant cannot rely upon a restriction requirement to file a divisional application in the following situations:**
  - **Applicant traverses the restriction requirement;**
  - **The restriction requirement is provisional, such as a requirement for election of species in an application that contains a claim that is generic to all of the claimed species (*see* MPEP 809); and**
  - **The claims to the non-elected invention may be rejoined at the request of the applicant (*see* MPEP 821.04 *et seq*.).**

Continuing Applications
37 CFR 1.78(d)

- **When a restriction requirement is withdrawn in these situations, any divisional application that has been filed as a result of the restriction requirement will <u>not</u> be proper under §§ 1.78(a)(2) and 1.78(d)(1)(ii).**
  - **Applicant may delete the benefit claim or change the benefit claim, if appropriate (*e.g.*, to a continuation or CIP application if conditions under § 1.78(d)(1)(i) are satisfied).**

Continuing Applications 37 CFR 1.78(d)

- For an application that contains a generic claim,
  - Applicant should conclude prosecution of the generic claim in the initial application and its continuation or CIP applications, including exhaustion of any available appeals, before filing a divisional application to a non-elected species.
- For an application that contains withdrawn claims that could be rejoined under the rejoinder practice,
  - Applicant should cancel the withdrawn claims before filing a divisional application to the non-elected invention.

Petition and Showing 37 CFR 1.78(d)(1)(vi) and 1.114(g)

- **Applicant may file a third or subsequent continuation or CIP application or a second or subsequent RCE if applicant files:**
  - **A petition in compliance with § 1.78(d)(1)(vi) or 1.114(g);**
  - **The petition fee set forth in § 1.17(f);**
  - **An amendment, argument, or evidence; and**
  - **A showing that the amendment, argument, or evidence sought to be entered could not have been submitted during the prosecution of the prior-filed application, or prior to the close of prosecution in the application.**

Note: "An amendment, argument, or evidence" includes any new claims in a continuing application, but not an IDS.

Proposed IDS Rules

The Office has proposed new rules for filing an IDS after first action, after close of prosecution, and after payment of the issue fee.

The proposed rules would allow the filing of an IDS after close of prosecution if accompanied with a certification under 37 C.F.R. § 1.97(e)(1) or (2) and with a detailed explanation of the cited non-cumulative references, and a patentability justification explaining why the claims are allowable over the cited references or an amendment to overcome the cited reference and a detailed explanation of how the amended claim is allowable over the cited references.

After payment of the issue fee, a petition to withdraw from issue is further required to have an IDS considered.

71 Fed. Reg. 131 (2006) at 38808-23.

Petition and Showing 37 CFR 1.78(d)(1)(vi) and 1.114(g)

- The petitions will be decided on a case-by-case basis as to whether applicant's showing is sufficient.
- The Office may review the prosecution history of the prior-filed application(s) or require additional information.
- The Office may also consider the following factors:
  - Whether applicant should file an appeal or a petition under §1.181 rather than a continuing application or an RCE.
  - The number of applications filed in parallel or series with substantially identical disclosures; and
  - Whether the amendment, argument, or evidence was submitted with reasonable diligence.

Examples of petitions for an additional continuation or RCE that may be granted

I) A new ground of rejection in a final rejection that could not have been anticipated by applicant.

II) Time is needed to obtain evidence (such as test data) to overcome a lack of utility rejection under 35 U.S.C. § 101 or lack of enablement under first paragraph of 35 U.S.C. § 112.

III) Office can consider prosecution history to determine whether applicant has been diligent and can require that all possible continuations and RCE have been exhausted.

Continuing Applications 37 CFR 1.78(a) and (d)

- The rule changes to continuing application practice under § 1.78(a) and § 1.78(d) are applicable to:
  - Applications* filed on or after November 1, 2007; and
  - Applications entering the national stage on or after November 1, 2007.
- Applicant may file "one more" continuing application, without a petition and showing, for:
  - Applications* filed before August 21, 2007; and
  - Applications entering the national stage before August 21, 2007.

*Including reissue applications, but not reexamination proceedings.

Request for Continued Examination 37 CFR 1.114

- **The rule changes to RCE practice under § 1.114 are applicable to:**
  - **Any RCE filed on or after November 1, 2007.**
- **Any RCE filed on or after November 1, 2007 that is a second or subsequent RCE in an application family will require a petition and showing.**

Appeals and Petitions

The Office encourages greater use of the petition and appeal processes.

Appeals

The Office noted that the Board of Appeals has successfully eliminated its backlog and can now handle a greater number of appeals. However, the Office has recently proposed new rules for Appeal Briefs that include additional requirements (statement of facts, claim analysis section, drawing analysis section, means or step plus function analysis section when necessary) which will increase the cost of preparing appeal briefs. 72 Fed. Reg. 145 (2007) at 41472-90 (open to comments until 9/28/07).

Petitions

The Office noted that most petitions under 37 C.F.R. § 1.181 are decided within four months, however, applicants are only given two months to comply with the 5/25 rule.

RECOMMENDATIONS

I) **If it is anticipated that an RCE will be filed in a pending application family in which an RCE has previously been filed, file the RCE on or before October 31, 2007.**

II) **Upon filing a divisional application, cancel the withdrawn claims in the parent application to prevent rejoinder.**

III) **In a situation which requires multiple applications with a common specification, file multiple applications but make sure that all claims are patentably distinct to avoid violating the 5/25 rule and filing an ESD. Alternatively, file patentably distinct inventions in one application to provoke restriction requirement, or file SRR to generate divisional applications.**

IV) **For currently pending applications in which multiple additional continuations are desired, file the continuations before November 1, 2007, to avoid the implications of the "one more" provision.**

Refund of Excess Claims Fees

37 CFR 1.117

Refund of Excess Claims Fees 37 CFR 1.117

- **Applicants may request a refund of any excess claims fees paid on or after December 8, 2004 for a claim:**
  - **If the amendment canceling the claim is filed before an examination on the merits has been made of the application.**
    - **The amendment must be filed at least one day before a FAOM, notice of allowability or allowance, or action under *Ex parte Quayle* is shown in the PALM system as having been counted.**
    - **Certificate of mailing or transmission under § 1.8 will <u>not</u> be taken into account.**

Refund of Excess Claims Fees 37 CFR 1.117

- The request for refund must be filed within two months from the filing of the amendment canceling the claim.
  - This time period is not extendable.
- The Office will not refund any excess claims fee paid for a withdrawn claim that is not canceled before FAOM.
  - The Consolidated Appropriations Act authorizes a refund only for a claim that has been canceled before an examination on the merits has been made of the application under 35 USC 131.

Patent Term Adjustment (PTA)

37 CFR 1.704

Patent Term Adjustment (PTA) 37 CFR 1.704

- **A failure to comply with § 1.75(b) in an application will cause a reduction of any PTA.**
  - **<u>Example #1</u>: In an application that contains more than 5/25 claims and no ESD (and no SRR), applicant did not file an ESD until after four months from the filing date of the application.**
  - **<u>Example #2</u>: In an application in which an ESD was not filed before FAOM, applicant filed an amendment resulting in the application containing more than 5/25 claims.**

Patent Term Adjustment 37 CFR 1.704

- **Any PTA will be reduced by the number of days beginning on the day after the date that is the later of:**
  - **The filing date of the amendment resulting in the noncompliance with § 1.75(b);**
  - **Four months from the filing date of the application; or**
  - **Four months from the date on which the national stage commenced.**

Patent Term Adjustment 37 CFR 1.704

- Any PTA will be reduced by the number of days ending on the filing date of:
- An ESD in compliance with § 1.265;
  - An election of an invention in response to a restriction requirement that is drawn to no more than 5/25 claims;
  - An amendment resulting in the application containing no more than 5/25 claims; or
  - A SRR accompanied by an election of an invention that is drawn to no more than 5/25 claims.

More Information

- For more information,
  - USPTO web site at www.USPTO.gov; or
  - Contact the Office of Patent Legal Administration at (571) 272-7704 or e-mail to PatentPractice@uspto.gov.