

# THE NEW USPTO RULES: SUGGESTIONS FOR SURVIVAL IN A NEW ENVIRONMENT

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## Key Changes Under the New Rules

- How the USPTO intends to improve quality and enhance efficiency:
  - Limit applicants to filing two continuation or CIP applications and a single RCE for each application family unless a petition and showing is filed. 37 CFR §§ 1.78(d) and 1.114
  - Limit each application to five (5) independent claims and twenty-five (25) dependent claims (counting claims from related applications) unless an Examination Support Document (ESD) is filed prior to first action on merits (FAOM). 37 CFR § 1.75(b)
  - Applicants must identify commonly owned patents and patent applications having at least one common inventor if certain filing date criteria are met. 37 CFR § 1.78(f)

## New Tools for Compliance

- Examination support document (ESD)
  - Requires a thorough search for each independent and dependent claim; a showing of support for each claim; and a showing of patentability for each independent claim. § 1.265
- Suggested requirement for restriction (SRR)
  - Applicant may propose a restriction to the examiner and elect one group that satisfies the 5/25 claim limitation requirement.
- Optional streamlined continuation procedure
  - Permits applicant to request that a continuation under 35 USC § 111(a) and 37 CFR § 1.53(b) be placed on the examiner's amended docket if claims are limited to the invention claimed in the parent and other requirements are met. This will expedite processing.

## Key Dates

08/21/07

- *The Final Rule publication date. It is used to determine whether the transitional “one more” continuing application is available.*

11/01/07

- *The effective date of the new rules.*
  - Continuation provisions of § 1.78(d)(1) apply to continuing applications filed on or after this date while § 1.78(d)(3) applies to pending CIPs.
  - 5/25 claim limitation provisions of § 1.75(a) apply to all applications which have not received a first office action on the merits (FAOM) as of this date.
  - All newly filed applications must comply with the identification requirements of § 1.78(f)(1) and (f)(2).

02/01/08

- *The date by which applicants must comply with § 1.78(f) for cases filed prior to 11/01/07 which have not yet been allowed (or four months from filing if longer).*
- *The date by which claims supported in a parent application must be identified for CIPs filed prior to 11/01/07 but without the mailing of a FAOM before 11/01/07.*

## Definitions Under the New Rules

**Continuing Applications** – encompasses continuations, CIPs and divisionals. § 1.78(a)(1).

Notes: Includes CPAs but not RCEs.

Must also consider international applications designating the U.S.

**Divisional Applications** – an application which only discloses and claims subject matter that was the subject of a requirement for restriction in a prior-filed application. § 1.78(a)(2).

**Continuation Application** – an application which only discloses and claims invention(s) disclosed in the prior-filed application. § 1.78(a)(3).

– This definition will now encompass “voluntary” divisionals.

Note: Continuations of divisionals and streamlined continuations must claim same invention as parent.

**Continuation-in-part** – an application which discloses subject matter not disclosed in the prior-filed application. § 1.78(a)(4).

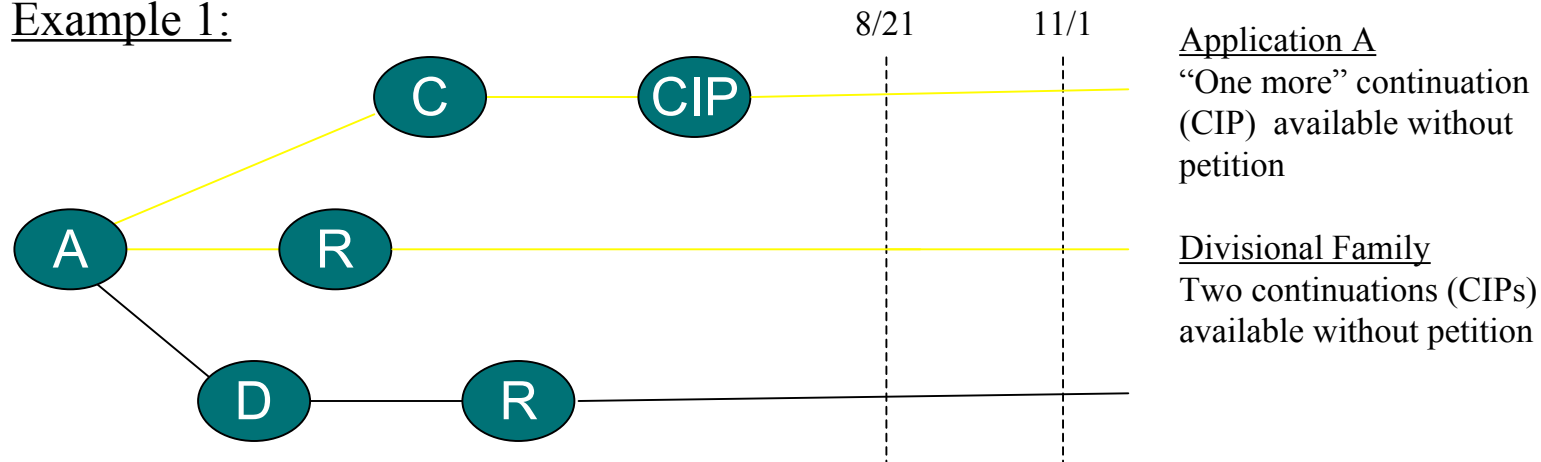
## Definitions Under the New Rules (cont.)

**Dependent Claim** – refers to a previous claim, incorporates all limitations of that claim and specifies a further limitation.

**Application Family** – the original application and all continuations, CIPs and RCEs thereof.

**Divisional Family** – a divisional (as newly defined) and each continuation or RCE filed thereon.

Example 1:



## The Continuing Examination Limitations Under §§ 1.78(d) and 1.114

- 37 C.F.R. § 1.78(d)(1) *severely* curtails the filing of continuing applications on or after 11/01/07. And 37 C.F.R. § 1.114 *severely* curtails RCE practice.
- Applicants may file, without a petition and showing:
  - Only two continuations (or continuations-in-part) and one RCE
  - Limit applies to each application family
- Before 11/01/07, all pending continuations are automatically entitled to benefit of all prior filing dates. But the usefulness of such filings will be limited by other changes to the rules (§§ 1.75(a) and 1.78(f)).
- Since an RCE is not a new application, filing an RCE either before or after 11/1/07 will have no impact on benefit in an application filed before 11/01/07.

## Continuing Application Practice

- In most cases, continuations, CIPs and RCEs should be presented in series since these applications are subject to the identification requirements of § 1.78(f) and the claim limitations of § 1.75(b)

*But won't filing these applications in series shorten my patent term?*

- Yes. But the USPTO's view is that these continuing applications are intended to obtain one or more patents on a single patentable invention. Applicants should expedite prosecution to maximize patent term.

*Practice Tip: Where possible, file a new application to a separately patentable improvement instead of a CIP.*

- From now on, “voluntary” divisions should be avoided since they are treated as continuations.

*Practice Tip: Try to present claims to all features in the first instance, or wait until a continuation is needed (while retaining priority proofs).*



## The Use of CIPs

- A CIP is only entitled to its actual filing date for subject matter not supported in the parent application.
- The use of CIPs will shorten patent term.
- The new rules require that prior to FAOM, applicant identify which CIP claims are supported in the prior application(s) and where.
- Any claims for which support in a prior application has not been shown will be treated as entitled only to the CIP filing date.

*Practice Tip: Try to limit the use of CIPs. In an ongoing development project, try to file new applications that claim subject matter that is separately patentable over what was previously disclosed and claimed.*

## The Optional Streamlined Continuations Procedure

- The rules do not permit applicant to file a second RCE in place of one of the two continuations (or CIPs).
- Instead, the USPTO will permit applicant to request that a continuation under 35 USC § 111.1(a) and 37 CFR § 1.53(b) be placed on the examiner's amended docket which will result in action more quickly than if on examiner's continuation docket.
  - The continuation application must be complete and filed on or after 11/01/07.
  - The application must only contain claims to the invention claimed in the parent.
  - Applicant must agree that any election made in the parent carries over.
  - The parent must be under final rejection or appeal.

## The Optional Streamlined Continuations Procedure (cont.)

- The parent must be expressly abandoned concurrently with filing the continuation.
- Applicant must submit a written request that the continuation be placed on the examiner's regular docket.

*Can this procedure be used for a CIP?*

- No. This procedure is limited to continuations.
- This procedure does not apply to design applications which can use a continued prosecution application (CPA) under § 1.53(d) to obtain expedited examination.
- See accompanying Request for Streamlined Docketing Procedure Form.

## The Suggested Requirement for Restriction (SRR)

- Prior to the earlier of a FAOM or the examiner issuing his or her own restriction, applicants may submit a SRR under § 1.142(c).
  - Applicant proposes a restriction of the presented claims
  - Elects one group and limits the claims in that group to 5/25
- The examiner may accept or reject applicant's proposed restriction, or may issue a different restriction.

*What is my recourse if the examiner does not accept my suggested restriction?*

- Petition is available only to review the appropriateness of the examiner's restriction, not the appropriateness of the SRR.

## Divisional Application Practice

- Applicant may file a divisional application only if, prior to examination, there was a restriction requirement in the parent application.
- The divisional may only be directed to the non-elected invention.
- Divisionals may be filed in parallel or in series.
- A “voluntary” divisional, whether filed before or after 11/01/07 will be treated as a continuation.
- If a divisional is filed and the restriction/election is later withdrawn, the divisional is improper and must be converted to a continuation, if possible.

## Divisional Application Practice (cont.)

### *Practice Tips:*

- *Unless a restriction requirement is totally unreasonable, you may wish not to traverse the restriction since you will get another set of 5/25 (and possibly 15/75) for each group of restricted claims.*
- *Defer filing the divisional until you are sure the restrictions cannot be withdrawn*
  - *Cancel non-elected claims from parent when filing each divisional. This will insure the restriction will not be withdrawn.*
  - *Resolve election of species and linking claim issues before filing a divisional.*

## Design Application Practice

- Since RCE is not available for a design application, applicant is only entitled to two continuations or CIP applications for a design application.
- A continuation of a design application can be filed either under § 1.53(b) or as a CPA under § 1.53(d).
- The Streamlined Continuation Practice is not available for design applications since CPA is available.

## Petition and Showing

- Applicant may file a third continuation or CIP or second RCE only upon grant of a petition under §§ 1.75(d)(1)(vi) or 1.114(g).
  - An amendment, argument or evidence
  - A petition fee under § 1.17(f)
  - The petition must contain a detailed showing of why the further continuation is needed
- A need to cite additional prior art is insufficient reason for a third continuation.
- Additional time to complete tests needed to rebut a new rejection may be sufficient.
- The need to copy claims from a recently issued patent for interference might be granted if applicant requests a statutory invention registration.

*Would a complicated prosecution or a difficult examiner be sufficient reason?*

- Probably not. Applicants are expected to prosecute diligently, submitting claims and evidence early on and taking appeals as needed to avoid a third continuation. The entire record will be reviewed before grant.



## Exceptions to the Continuing Application Limits

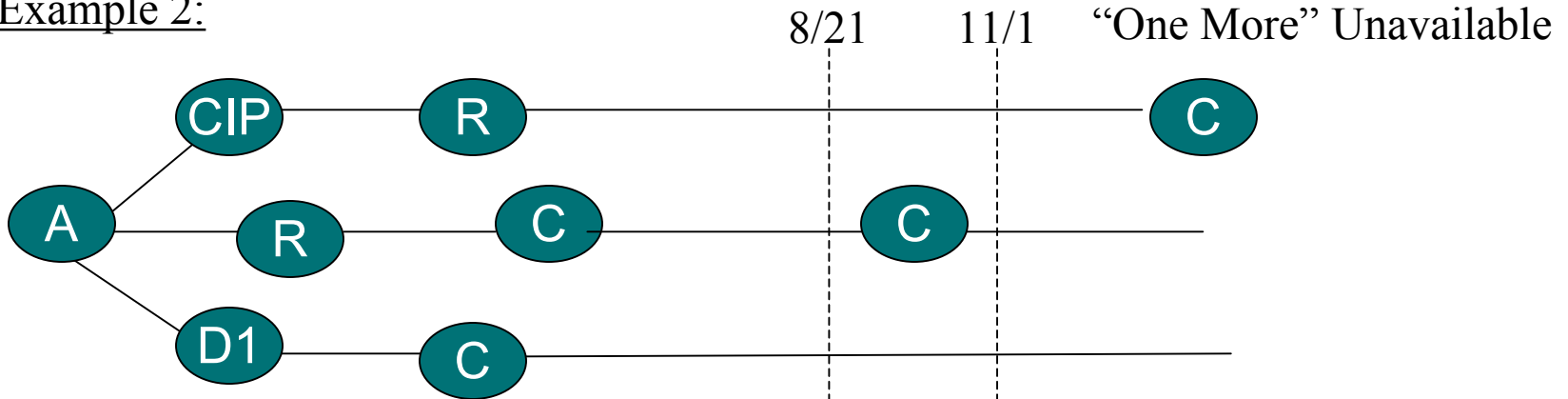
- In determining whether the continuing application limit has been reached, the USPTO will not include the following:
  - Bypass continuations. See § 1.78(d)(1)(iv)
  - Original applications (but not continuations) where applicant refiles rather than responding to a Notice to File Missing Parts but has paid the basic filing fee. See § 1.78(d)(1)(v)
- The commentary also indicates that an applicant can file “one more” continuing application after 11/01/07 without petition if:
  - the application claims benefit only of non-provisional applications filed or entering the national stage prior to 08/21/07, and
  - there is no other application filed on or after 08/21/07 that also claims benefit of such prior applications.
- Second condition could possibly make this “one more” continuing application of limited value.

## “One More” Continuing Application Clarification

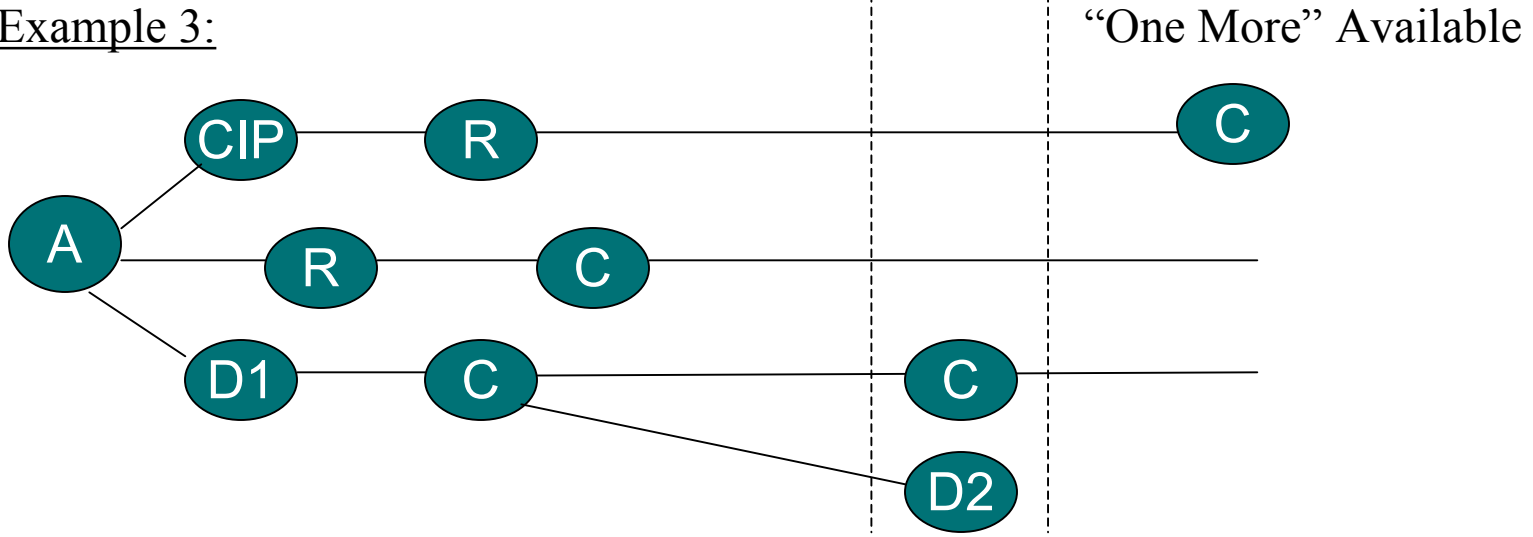
- USPTO officials admitted that destroying the “one more” continuing application due to filing a divisional after 8/21/07 was not intended.
- A Clarification issued on October 10, 2007 indicates that divisionals, continuations of divisionals and continuations with a granted petition will not be counted in determining whether “one more” continuation or CIP is available.

# “One More” Continuing Application Examples

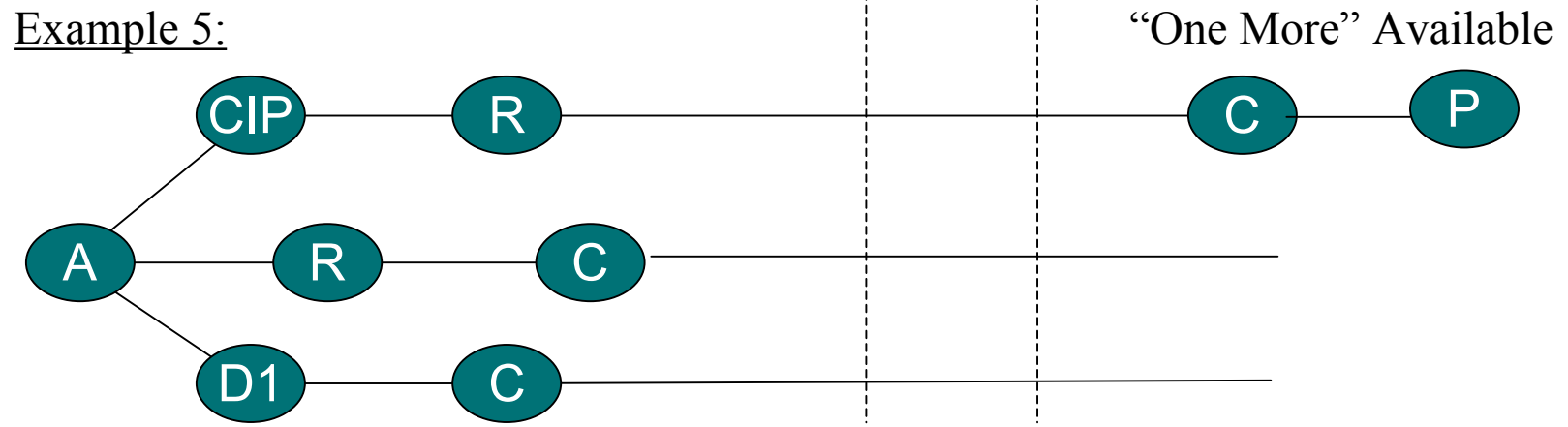
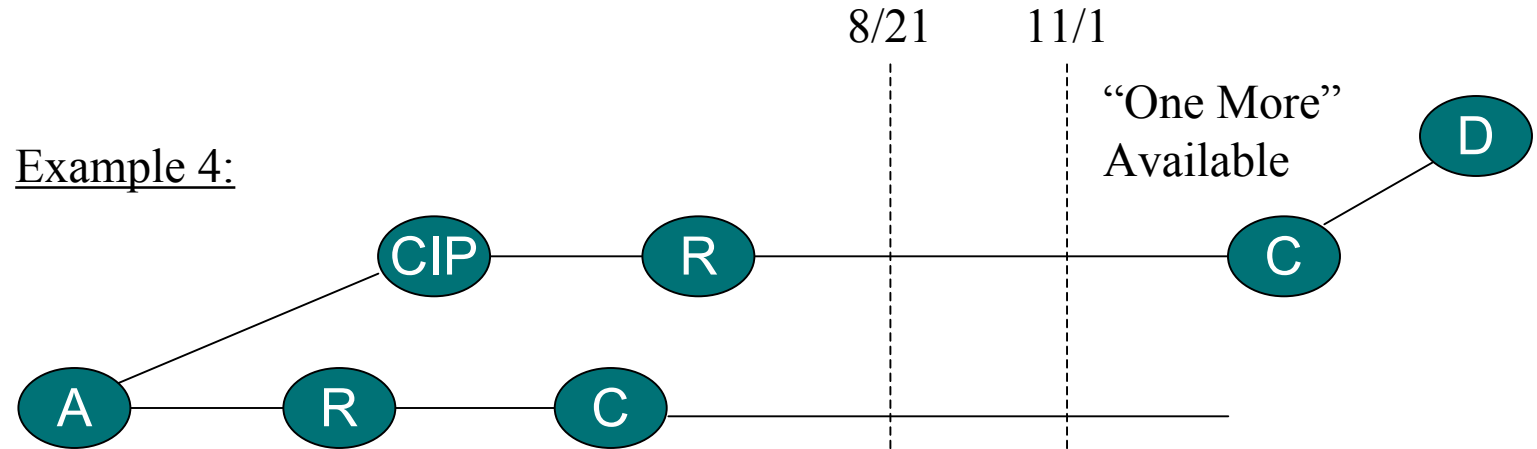
Example 2:



Example 3:



## “One More” Continuing Application Examples (cont.)



## Application Filing Strategies After 11/01/07

- File separate applications each directed to a separately patentable invention.
  - Advantages:
    - Consistent with USPTO's objectives
    - Will focus prosecution
  - Disadvantages:
    - May complicate § 1.78(f) identification requirements
    - Examiner may disagree and require applicants to combine cases in accordance with § 1.78(f)(3)

*Practice Tip: By filing multiple applications with non-overlapping disclosures, even if the examiner tries to combine, applicants can justify plural cases because all claims are not supported in one disclosure.*

## Application Filing Strategies After 11/01/07 (cont.)

- File a single application with claims to several inventions and file an SRR.
  - Advantages:
    - Reduces initial filing costs
    - May simplify § 1.78(f) identification requirements
  - Disadvantage:
    - Examiner may reject SRR and require applicant to reduce claims to 5/25
    - In such a case applicant will need to carefully prosecute its continuations to obtain as many as 15/75 claims in the application family
- Whether separate applications or a single application is filed, have a broad range of claims, including narrow claims, to necessitate a complete search and reduce the need for continuations.

## Prosecution Strategies After 11/01/07

- If more than 5/25 claims are required, try filing an SRR (before FAOM).
- In response to a FAOM, prepare the case for appeal by introducing evidence of non-obviousness.
- Interview the examiner after FAOM to get him to understand the invention and what you are trying to claim.
- File continuations serially. This permits applicant to obtain as many as 15/75 claims if each case is prosecuted diligently.
- File any divisionals in parallel if patent term is important.
- File any divisionals serially if commercial product has yet to be identified and consider selecting least important inventions first.
- If you have exhausted all continuations, you might consider withdrawing benefit claims to file additional continuations.
- Try to bypass claiming benefit of a PCT application for foreign filing.

## Action To Take Before 11/01/07

- Continuing applications and RCEs filed before 11/01/07 will be accorded benefit of prior filing dates. But the usefulness of these refilings may be limited by other changes to the rules. (See 37 C.F.R. §§ 1.75(b) and 1.78(f)(3)).

*Before 11/01/07, should I file one or more continuations for each pending application and sort things out later?*

- While this is the strategy some are advocating and it might be one option particularly if your portfolio is either small or you have an unlimited budget and you defer paying the filing fees, in most cases it would probably be more productive to determine which cases should be refiled before 11/01/07.
- Particularly for large portfolios, one option would be to focus on the “jewels” and on particular categories of cases.



## Action To Take Before 11/01/07 (cont.)

*Practice Tip: If an application is either under final or allowed, and an RCE has already been filed in the application family, consider filing another RCE before 11/01/07 if you need to continue prosecution.*

- This will provide an additional application without affecting the limits of § 1.78(d). In the case of an allowed application, the RCE could be used to cite newly discovered prior art.
- Filing a RCE will not invoke the 5/25 limits.

*Practice Tip: If you have a large application family with many pending cases, you may wish to file one or more continuations before 11/01/07 if you are prepared to file ESDs (if you anticipate claims will be combined for 5/25 limits).*

- These continuations can be used to claim inventions not previously claimed.

## Action To Take Before 11/01/07 (cont.)

*Practice Tip: Get cases allowed insofar as possible before 02/01/08 to reduce § 1.78(f) identifications.*

*Practice Tip: Identify “voluntary continuations” and their impact on filing additional continuations in the application family.*

## The 5/25 Claim Limit

- An application cannot contain (or more precisely, be deemed to contain) more than 5 independent claims or more than 25 total claims (not counting withdrawn claims), unless an Examination Support Document (ESD) is filed before the first office action on the merits (FAOM). § 1.75(b)(1).

*What is considered an independent claim in this rule?*

- A claim referring to another claim, without incorporating all of its limitations. § 1.75(b)(2).
- A claim referring to another claim of a different statutory class of invention. *Id.*

### Example 6:

“The product of the process of claim 1.”

“A protein expressed from the nucleic acid of claim 1.”

The USPTO will treat these claims as independent. See Q&A A8.

## The 5/25 Claim Limit (cont.)

*Can I avoid the 5/25 rule by filing separate cases?*

Not necessarily.

- The USPTO can look beyond the application under consideration to determine whether the 5/25 limit has been met.
- More particularly, if two commonly owned pending non-provisional applications share patentably indistinct claims, then the USPTO will treat each application as containing all the claims of the other application to see if the 5/25 limit has been complied with. § 1.75(b)(4).
- Note that this rule is different in scope than the disclosure obligations of § 1.78(f). E.g., it does not depend on whether the two applications were filed within two months of each other. See Fed. Reg. 46726 (08/21/07)

## The 5/25 Claim Limit (cont.)

### Claim Aggregation Notification Practice

- If USPTO counts the claims of another or other applications to conclude that the 5/25 rule has been exceeded, USPTO says it will do the following:
  - if before FAOM, and omission of ESD was inadvertent, applicant will be given a two month non-extendible time to:
    - cancel the patentably indistinct claims from all but one of the applications, or
    - file an ESD, or
    - amend claims to conform to 5/25 rule.

## The 5/25 Claim Limit (cont.)

### Claim Aggregation Notification Practice (cont'd)

- If after FAOM, applicant will be given a two month non-extendible time to:
  - cancel the patentably indistinct claims from all but one of the applications, or
  - amend the claims to conform to 5/25 limit. See USPTO Q&A F8 (9/27/07).
- There is a separate notification practice for applications which, by themselves, exceed the 5/25 limit. This is discussed below.

## The 5/25 Claim Limit (cont.)

*Can I get more than 5/25 claims by filing continuing applications?*

- Yes.
  - The USPTO has said that you can file a parent and two continuations (or CIPs), each containing up to 5 independent claims and 25 claims in total, if they are “filed and prosecuted serially.” Fed. Reg. 46721, 46725-26 (08/21/07).
  - Continuations containing only patentably distinct claims also are not subject to the § 1.75(b)(4) claim aggregation rule, so they can be prosecuted in parallel or serially.

*Practice Tip: Rather than using up one of the permitted continuations to prosecute patentably distinct inventions, consider presenting all claims in one case and filing a suggested requirement for restriction (SRR) before first action on the merits (FAOM) to avoid surprises.*

## Should You File an ESD?

### Advantages

- Allows freedom to exceed 5/25 claim restriction at any time in prosecution (although may require supplemental ESD).
- Avoids post-FAOM consequences of USPTO claim aggregation from co-pending cases.
- Puts onus back on USPTO to examine case on the merits.

### Disadvantages

- Cost.
- Possible admissions.
- Statistics on Petitions for Accelerated Examination.



## The Basic Parts Of An ESD: The Search

- Generally, search must cover patent documents worldwide and non-patent literature. §§ 1.265(a)(1), (b).

*Can you simply search your own prior art records?*

- The rules and guidelines implicitly seek a fresh search.

*Can you rely on foreign or international search reports, or prior USPTO searches?*

- “Not automatically” – search must encompass all limitations of each claim. See ESD Guidelines (9/6/07).
- The search must encompass all claim limitations (both independent and dependent). § 1.265(b).

## The Basic Parts Of An ESD: The Search (cont.)

### Example 7:

The composition of claim 1, wherein the excipient is selected from the group consisting of mannitose, fructose and sucrose

*Tip: Have all reasonably contemplated claims in hand before the search.*

- Satisfies § 1.265(a)(2), (b).
- Makes easier filing a supplemental ESD following a claim amendment. See § 1.265(e)(1).

## The Basic Parts Of An ESD: The Most Closely Related References

- Applicant must identify the references most closely related to the claims.
- This is required for each of the claims. § 1.265(a)(2).

*What if I'm wrong?*

- If applicant misses a number of references more closely related to the claims than those the examiner finds, USPTO may deem search insufficient. If reference is cited, but misapplied, consequences not set forth in rules.

*What if the best references were not found in the search?*

- Cite it: “Applicant must consider all of the references that have been brought to the applicant’s attention regardless of the source ...” Fed. Reg. 46741-42 (8/21/07); ESD Guidelines (9/6/07).

## The Basic Parts Of An ESD: The Most Closely Related References (cont.)

- Applicant must identify the limitations that are disclosed by the references. § 1.265(a)(3).

*Tip:* Use a claim chart.

- See example claim chart from ESD Guidelines (9/6/07) (next slide).
- See also accompanying Examination Support Document Transmittal and Listing of References forms.

# USPTO Example of an Identification of Limitations Disclosed by a Reference

Claim 1	Purcell et al. (US 20040193487)
A method of delivering a secure promotion to a user comprising:	Abstract; figure 6
a) collecting a plurality of offers;	Implied by offers presented to user in figure 6
b) assigning a unique identifier to each of the offers from the plurality of offers;	Abstract; ¶0018; ¶0049
c) encoding each of the unique	Abstract; ¶0018; ¶0049 identifiers;
d) providing a retailer with the plurality	Figure 4 box 4; ¶0043 (retailer provided of coupons; with coupons)
e) identifying the user;	Figure 6 box 602 (user logs onto retailer site)
f) providing the user with a plurality of coupons for selection;	Figure 6 box 606 (user selects offers)
g) determining which of the provided coupons the user has selected;	Figure 6 boxes 614, 620,626 (that the user prints/receives coupons requires determining which coupons were selected)
h) informing the retailer about the selected coupons by the user;	Figure 6 boxes 616-618 (if the user chooses electronic delivery the selections are sent to the retailer)
i) decoding the identifiers on the selected coupons and validating the selected coupons using the decoded identifiers;	¶0049; ¶0050
j) redeeming the validated coupons; and	Figure 4 boxes 406-408; ¶0043; ¶0050
k) providing a clearinghouse with the redemption information.	¶0043 (the offers are totaled and reported to a service system, the service system can be considered a clearinghouse.)

## The Basic Part of an ESD: The Patentability Argument

- A “detailed” explanation, “particularly” pointing out how each of the independent claims is patentable. § 1.265(a)(4)
- This explanation may be set forth together with the disclosed limitation identification required by § 1.265(a)(3). Fed. Reg. 46742 (8/21/07).

## The Basic Part of an ESD: § 112 Support

- Applicant must show where each claim is supported.
- Claim support must also be shown for each priority or benefit application. § 1.265(a)(5)

*Even for provisional applications?*

- Yes.

*What do you do for means (or step) plus function claims?*

- Identify the structures, materials or acts.
- If multiple embodiments are covered, each should be separately identified. ESD Guidelines (9/6/07).

## When To File An ESD or SRR

- Before FAOM
- Right to file ESD or SRR generally expires upon issuance of FAOM (right to file SRR may expire earlier on issuance of restriction requirement)

### Pre-FAOM Notification Practice

- If application contains more than 5/25 claims and no ESD or SRR is on file, then prior to issuing FAOM USPTO says it will do the following:
  - if application filed before 11/01/07, USPTO will issue a two month extendible notice to:
    - file an ESD, or
    - amend claims to conform to 5/25 limit, or



## When To File An ESD or SRR (cont.)

- file an SRR.
- This notice can be combined with a restriction requirement, requiring applicant to make an election, and conform elected claims to 5/25 rule (file ESD or cancel claims).
- if application filed on or after 11/01/07, and omission of ESD appears inadvertent, USPTO will issue a two month non-extendible notice to:
  - file an ESD, or
  - amend claims to conform to 5/25 rule.
  - No SRR is permitted in response. See USPTO Q&A F3 (9/27/07).

## When To File An ESD or SRR (cont.)

*What if I accidentally amend claims after FAOM in violation of 5/25 limit?*

- *The amendment is considered non-responsive*
  - If the amendment appears inadvertent, a two month non-extendible time will be given to provide an amendment complying with 5/25 rule. See USPTO Q&A F4 (9/27/07).

*Can I exceed the 5/25 rule to secure the allowance of an objected to dependent claim by rewriting it in independent form?*

- *No, per the above rule. See USPTO Q&A F15 (9/27/07).*

## When To File An ESD or SRR (cont.)

### SRR Rejection Practice

- If application contains more than 5/25 claims and an SRR filed before FAOM, and the examiner does not accept the SRR, USPTO says it will do the following:
  - If the examiner does not make another restriction requirement, applicant will be given two month non-extendible time to:
    - file ESD, or
    - cancel claims.

## When To File An ESD or SRR (cont.)

- If the examiner does make another restriction requirement, applicant will be given a two month non-extendible time to:
  - make an election; and
  - file ESD or cancel claims.

*Since the backlog in my applicant's art unit is 18 months to initial examination, can I safely file an ESD or SRR anytime in that period?*

- Yes, but you may cause the patent term adjustment to be reduced.
  - You must file an ESD or SRR within four months of application filing, or else your term adjustment will be reduced by an amount equal to the time delay. See § 1.704(c)(11).
  - There are other acts that can cause reduction in patent term adjustment. See USPTO Q&A § N (9/27/07).

## The ESD Partial Relief Provision

- The ESD need not identify all the limitations disclosed by the most closely related references if the owner of the application:
  - has 500 or fewer employees (including affiliates), § 1.265(f)(1); or
  - is a non-dominant independent not-for-profit, § 1.265(f)(2); or
  - is a small town or the like, § 1.265(f)(3).

## The ESD Partial Relief Provision (cont.)

*Do these patent owners still need to file an ESD?*

- Yes. They still need to perform a search, identify the most closely related references, explain why independent claims are patentable, and show § 112 support.

## Refund Rules

- A refund of excess claims fees is available for excess claims cancelled before “examination on the merits,” if requested within two months of cancellation. § 1.117.
  - An “examination on the merits” is a FAOM, a notice of allowability/allowance, or a Quayle. Note that a restriction requirement is not included.
  - Claims must be canceled, not simply withdrawn due to restriction.
  - The excess claim fees must have been paid on or after 12/08/2004.

## The Identification Requirements Under § 1.78(f)(1)

- Purpose: To insure that applicants do not try to bypass the limitation on continuation applications under § 1.78(d) and the claim limitations under § 1.75(b)
- Under § 1.78(f)(1), applicant must identify all co-pending, commonly assigned applications and patents that have:
  - At least one inventor in common
  - At least one of either the filing or benefit date that falls within two months of the filing date of the application in question
    - Includes any foreign priority date and any provisional and/or non-provisional application for which benefit is sought
  - Identification is required in all pending applications not yet allowed
  - Identification is required regardless of what is being claimed



## The Additional Requirements Under § 1.78(f)(2)

- Under § 1.78(f)(2) a rebuttable presumption is created that at least one claim in each commonly assigned application is directed to the same patentable invention if:
  - At least one of either the filing or any benefit date is the same
  - At least one inventor in common; and
  - Substantially overlapping disclosure exists i.e., at least one of the application's claims is supported by the other application's disclosure.
- In response, applicant may either:
  - Rebut the presumption (USPTO applies a one-way obviousness test); or
  - File a terminal disclaimer with an explanation of why the applications should not be combined under § 1.78(f)(3); or
  - Cancel the patentability indistinct claims from all but one application.
- USPTO will combine the claims in each application for purposes of the 5/25 claim limit

## Identification Deadlines

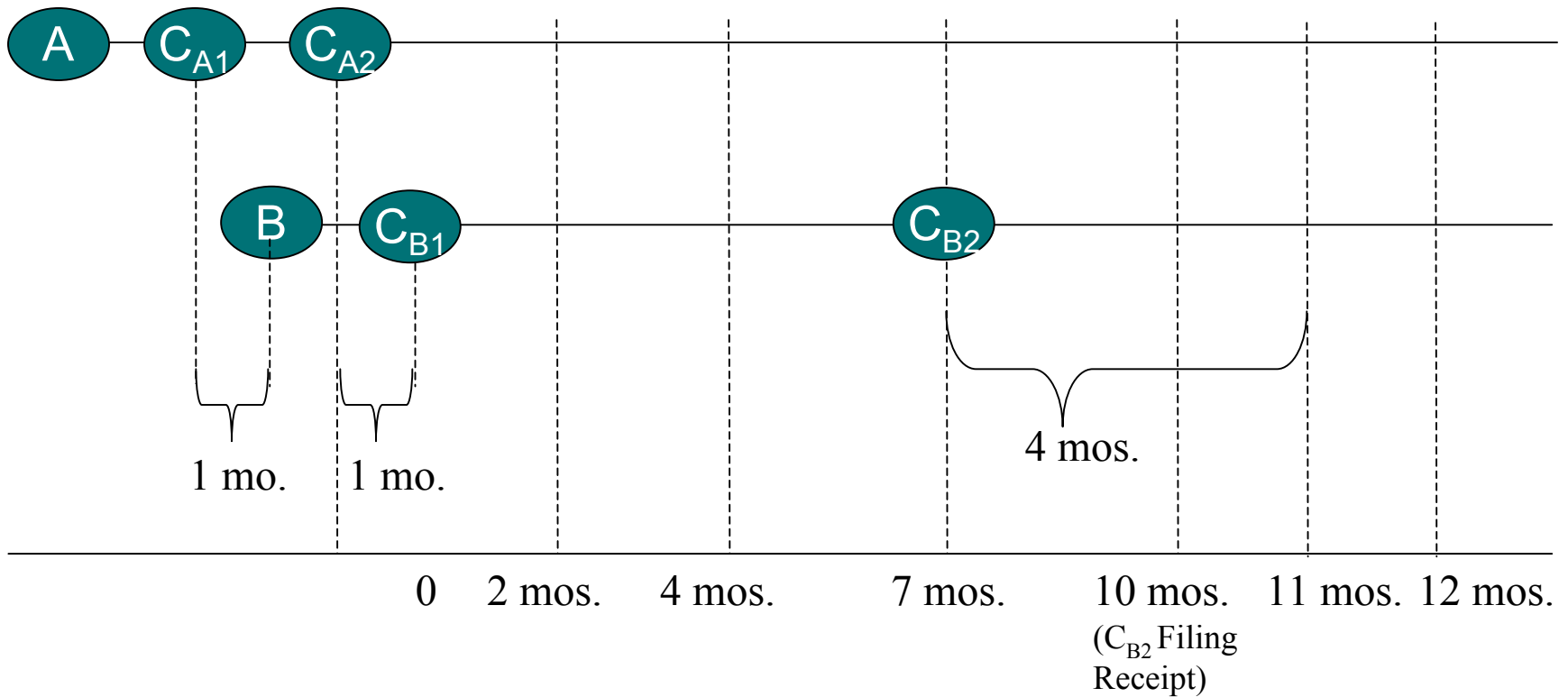
- For all pending, non-provisional applications as of 11/01/07, a § 1.78(f) identification must be filed by the later of 02/01/08 or four months from filing. This deadline is non-extendible.
- For all non-provisional applications filed or entering the national stage on or after November 1, 2007, the identification is due either
  - Four months from the actual filing date
  - Four months from entry into the national stage; or
  - Two months from the mailing of the initial filing receipt in the other application

*Does this mean I only need to submit one identification document for each application?*

- No. You need to supplement the identification until the application is allowed to cite any later filed and/or discovered cases that would meet the § 1.78 requirements.

## Identification Deadlines (cont.)

Example 8:



At 4 months, CA2 must identify A, CA1, B and CB1 (Initial Submission)

At 11 months, CB2 must identify B, CB1 and CA1 and CA2 (Initial Submission)

At 12 months, CA2 must identify CB2 (Supplemental Submission)

## Complying With the § 1.78(f) Requirements

*Can I entrust my outside counsel with complying with these disclosure requirements?*

- No, not unless outside counsel is handling your entire patent portfolio. When several firms are handling the work, they cannot check for cases filed by other firms. The USPTO expects that the searches needed to comply with § 1.78(f) will be made by the assignee.

*Can I avoid the disclosure requirement by making sure related cases are filed outside the two month window?*

- No. The commentary makes clear that § 1.56 requires citation of related cases outside the window.

*How do RCEs and CPAs factor into the identification requirement?*

- While a CPA is a continuation application and the identification requirements apply, an RCE is not. So no identification is required based on filing an RCE.

## Complying With the § 1.78(f) Requirements (cont.)

### *Practice Tips:*

- Wait until after two months from the actual filing date and then do a docketing search for all co-pending cases that must be disclosed.
- Once a disclosure has been made in Application A, a docket entry should be made to file a supplemental identification in Application A for any addition to each application already identified.
- As a minimum, all cases in an application family must be identified in every case in the family since they all stem from a common parent and thus have at least one identical filing date so that the § 1.78(f)(2) presumption will apply.
- Remember to consider provisional filing dates in determining whether a identification of only non-provisional applications and patents is required.

## Additional § 1.78(f)(2) Requirements

*Are there any other requirements if I have a § 1.78(f)(2) situation?*

- Yes. In addition to the identification requirements, the rebuttal of the presumption or submission of a terminal disclaimer are concurrently due.
- Also, if an amendment is filed, applicant will again need to rebut this new presumption or file a terminal disclaimer. See § 1.78(f)(2)(iii).

## Transitional § 1.78(f)(1) Identification Requirements

- The USPTO's Clarification limits the identification requirements for applications and patents filed before 11/01/07.
- If the subject application for which the identification is being prepared was filed before 11/01/07, the applicant is only required to identify commonly assigned applications and patents having a common inventor with either a filing or any benefit date in common with the filing date of the subject application.
- If the subject application was filed on or after 11/01/07, then applicant is only required to identify other applications or patents that (1) have a filing or benefit date the same as any benefit date of the subject application or (2) have a filing or benefit date on or after 11/01/07 that is the same as or within two months of the actual or any benefit date of the subject application.
- See the accompanying Listing of Commonly Owned Applications and Patent forms.

## Requirement To Combine Claims In One Application

- To further limit efforts to present patentably indistinct claims in different applications, in the absence of good and sufficient reasons to maintain plural applications to related subject matter, the USPTO may require applicant to cancel patentably indistinct claims from all but one application. § 1.78(f)(3).

### *Practice Tips:*

- For cases already filed, try to maintain a clear line of demarcation.
- One argument that might be used to overcome the requirement is to point out that particular claims are not supported in the application containing the other related claims.



## Terminal Disclaimers and Continuations

- Under the new rules, because all continuations and CIPs will have a common filing date and will require compliance with § 1.78(f)(2), applicants will be required to file a terminal disclaimer in both pending parents and in continuations or CIPs which contain at least one claim to the same invention unless the parent has been allowed.
- A terminal disclaimer would not be required if applicant can establish that none of the claims in either the continuation or CIP is directed to the same invention claimed in any pending parent.

## Final Action Practice

- While the USPTO had proposed elimination of the first action final practice in the Proposed Rules, since it now has expanded the number of continuing applications in the Final Rules, it has accordingly retained its first action final practice.
- The USPTO has also expanded the situations where the second office action may be made final when a new ground of rejection is necessitated by
  - an amendment to eliminate unpatentable alternatives
  - an IDS filed after FAOM
  - a double patenting rejection
  - applicant identifying support for claims in a CIP in a prior application
  - applicant identifying a claim as means-plus-function

## Final Suggestions

- The USPTO is continually updating its web site with materials relating to this Final Rule Package
- USPTO PowerPoint Slide Show and Q & A have both been updated
- Guidelines for ESD have been published
- USPTO has provided several forms for use with the Final Rules
- Check the USPTO web site regularly for further updates at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>
- Contact the Office of Patent Legal Administration with your questions
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  - E-mail: PatentPractice@uspto.gov.

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