

The USPTO's Notice Published 10-11-2007, Relaxing Some of the Requirements of the New Rules Published 8-21-2007

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I. INTRODUCTION

On 10/11/2007, the USPTO published on its web site, and also e-mailed to members of the patent bar, a notice entitled "Clarification of the Transitional Provisions Relating to Continuing Applications and Applications Containing Patentably Indistinct Claims" (herein after "Notice"). A copy of the Notice is posted at <http://www.neifeld.com/clmcontclarification.pdf>.

In fact, that Notice relaxes some of the oppressive requirements of the new patent rules published 8/21/2007. The changes to the requirements specified in the Notice are described below.

II. CHANGES TO PROVISIONS SO THEY DO NOT AFFECT LEGACY APPLICATIONS

The Notice relaxes certain provisions so that they do not impose burdens on applications in existence prior to the new rules. Those relaxations are described below.

A. THE REQUIREMENT TO IDENTIFY EFFECTIVE FILING DATES IN CIP APPLICATIONS IS WAIVED FOR APPLICATIONS EXAMINED PRIOR TO 11/1/2007, AND DELAYED TO 2/1/2008 FOR ALL OTHER APPLICATIONS

"[F]or any continuation-in-part application in which a first Office action on the merits has been mailed before November 1, 2007, the requirement in 37 CFR 1.78(d)(3) that an applicant must identify the claim or claims in the continuation-in-part application for which the subject matter is disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application is hereby waived."

TRANSLATION - Applicants do not need to identify the effective filing date for claims in continuation-in-part applications examined prior to 11/1/2007.

"[F]or continuation-in-part applications filed before November 1, 2007 but for which a first Office action on the merits has not been mailed before November 1, 2007, the applicant may delay compliance with the requirement in 37 CFR 1.78(d)(3) that an applicant must identify the claim or claims in the continuation-in-part application for which the subject matter is disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application until February 1, 2008."

TRANSLATION - Applicants do need to file, by 2/1/2008, in all CIP applications, a paper identifying the effective filing date for each claim.

B. THE 1.78(F)(1) REQUIREMENT TO IDENTIFY APPLICATIONS FILED WITHIN 2 MONTHS OF ONE ANOTHER IS WAIVED FOR APPLICATIONS FILED PRIOR TO 11/1/2007

"Specifically, in an application having an actual filing date before November 1, 2007

('subject application'), the applicant in the subject application is not required to identify any other pending or patented application that does not have the same actual filing date or the same benefit or priority filing date as the subject application, even if the other application has an actual filing date or benefit or priority filing date within two months of the subject application."

TRANSLATION - In a subject application filed prior to 11/1/2007, an applicant need only identify other applications and patents having priority dates in common with the subject application. Thus, Notice waives the requirement in 1.78(f)(1) to identify applications having priority dates within 2 months of one another for applications filed prior to 11/1/2007.

C. THE 1.78(F)(1) REQUIREMENT TO IDENTIFY APPLICATIONS THAT ARE FILED WITHIN 2 MONTHS OF ONE ANOTHER IS LIMITED TO APPLICATIONS HAVING PRIORITY DATES ON OR AFTER 11/1/2007 THAT ARE WITHIN 2 MONTHS OF ONE ANOTHER

"Specifically, in an application having an actual filing date on or after November 1, 2007 ("subject application"), the applicant in the subject application is not required to identify any other pending or patented application that has an actual filing date or benefit or priority filing date before November 1, 2007, unless: (1) the subject application has a benefit or priority filing date that is the same as the actual filing date or the benefit or priority filing date of the other application; or (2) the subject application has an actual filing date or benefit or priority filing date on or after November 1, 2007 that is the same as or within two months of the actual filing date or the benefit or priority filing date of the other application."

TRANSLATION - Applicants only need to identify applications having priority dates within 2 months of one another for priority dates that are on or after 11/1/2007.

III. THE RIGHT TO FILE "ONE MORE" IS UNAFFECTED BY DIVISIONS AND THE LIKE

"This notice modifies the transitional 'one more' continuing application provision to permit applicant to file 'one more' continuing application and any continuing applications that satisfy the conditions set forth in 37 CFR 1.78(d)(1)(ii)[divisional], (d)(1)(iii)[continuation of a divisional], or (d)(1)(vi)[still born PCT application] (e.g., a divisional application that claims a non-elected invention that has not been examined) on or after November 1, 2007, without a petition and showing. More specifically, a continuing application that satisfies the conditions set forth in 37 CFR 1.78(d)(1)(ii), (d)(1)(iii), or (d)(1)(vi) will not be taken into account for purposes of determining whether there is an 'other application filed on or after August 21, 2007 that also claims the benefit under 35 U.S.C. 120, 121, or 365(c) of such prior-filed nonprovisional applications or international applications' under the transitional 'one more' continuing application provision." [Interpolation added.]

TRANSLATION - Applications that are divisionals, PCTs that do not enter the U.S. national phase, or U.S. national applications that are not completed (failure to pay fees or file necessary parts) do not count against the right to file "one more" application.

IV. EXAMINATION DURING A PCT INTERNATIONAL PHASE DOES NOT LIMIT THE RIGHT TO FILE A DIVISIONAL DURING U.S. NATIONAL

PHASE PROSECUTION

"The term 'examined' in 37 CFR 1.78(d)(1)(ii)(B) is limited to examination within the meaning of 35 U.S.C. 131 and 37 CFR 1.104 in a national application under 35 U.S.C. 111(a) or a national stage application resulting from an international application entering the national stage in the United States under 35 U.S.C. 371. The term 'examined' in 37 CFR 1.78(d)(1)(ii)(B) does not include the international phase examination under PCT Article 31 that occurs as a result of the filing of a Demand for international preliminary examination."

TRANSLATION - Prosecution during the international phase of a PCT application does not limit the right to file division applications for inventions restricted in U.S. national phase prosecution of the PCT application.

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