The Benefits and Drawbacks of Smaller Patent Applications In View of the New Rules Published August 21, 2007

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The cornerstone of inventive activity is conception. "Invention is not the work of the hands, but of the brain. The man that first conceived the complete idea ... is the first inventor...." Edison v. Foote, 1871 C.D. 80, 81 (Comm'r Pat. 1871); "Conception means the complete and definite mental formulation by an inventor of an invention that is sufficient to enable one of ordinary skill in the pertinent art to reduce the invention to practice." Mergenthaler v. Scudder, 11 App. D.C. 264, 276, 1897 CD 724, 731 (D.C. Cir. 1897). However, inventive activity is usually not directed to a single unitary concept; it ranges over a continuum from unitary concepts to related concepts and embodiments, to concepts having little in common, other than solving a certain problem. Patent applications have in the past corresponded to this range of inventive activity. Until August 21,2007, an inventor could file a U.S. application disclosing and claiming virtually any range of inventive activity, with little adverse consequence. This allowed patent applicants to logically tailor their applications to their inventive activity.

However, the new patent rules published August 21, 2007 (at 72 FR 46716) substantially change that playing field by limiting the rights of inventors to obtain patent protection. As a result, for the reasons explained below, it is now much more beneficial than in the past to file smaller applications disclosing and claiming a smaller scope of invention. Note that the explanations below cover the general concepts, ignoring details of the rules relating to exceptions and alternatives that are largely inapplicable and generally inadvisable. For a more detailed explanation of the rules, see "THE NEW PATENT RULES PUBLISHED AUGUST 21, 2007" Neifeld, Richard, August 28, 2007, published at \\srv01\f$\websites\236\THE NEW PATENT RULES PUBLISHED AUGUST 21, 2007.pdf.

The crux of the new rules are limitations on the number of clams an applicant can present to cover inventions disclosed in any family of applications containing common disclosure. More specifically, the new rules limit the number of claims in any application to no more than 5 independent claims and no more than 25 total claims (5/25 claims limitation rule). 37 CFR 1.75(b). In addition, the new rules prevent end runs around the claim limitation rule by effectively precluding the filing of other applications containing claims to similar inventions. The rules accomplish this by counting as part of the 5/25 claims: all claims in all applications having (1) a common inventor; (2) common assignee; (3) any common priority date (whether based upon a foreign, provisional, US national or PCT application, and including actual filing date); and (4) disclosure supporting in one application claims in the other application, unless the applicant can show that the claims in such applications are all directed to patentably distinct inventions. 37 CFR 1.75(b)(4) and 1.78(f)(2)(i). As a result, large application disclosures that disclose a variety of concepts (which may be claimed in some other application), leave the applicant open to a charge that they have violated the rules and a requirement to correct the violation or forfeit rights. Related rules allow the application to consecutively file (consecutively, such that only one application is being prosecuted at a time) only 3 applications (other than divisional applications) to pursue protection for the disclosed inventions. What this

means in effect is that applications disclosing concepts requiring protection from more than 5 independent claims will have prosecution of some of those claims deferring to continuations applications. However, continuations applications are usually require terminal disclaimers in order to issue. Therefore, the claims for which prosecution is delayed into continuation applications will have a shortened term and be issued and therefore enforceable starting at a much later time than the claims prosecuted in the original application.

So how does one minimize these draconian results? One way is to draft relatively small application disclosures. Assume you have two inventive concepts. Draft one application to disclosure the first inventive concept and not disclose the second inventive concept. Draft all claims in the first application that require support from the disclosed first inventive concept. Draft a second application so that it does not disclose the first inventive concept and does disclose the second inventive concept. Draft all claims in the second application that require support from the disclosed second inventive concept. As a result, neither applications meets the criteria " (4) disclosure supporting in one application claims in the other application." Therefore, the draconian 5/25 claims limitation should not apply.

One benefit of such an approach are that it likely avoids the application of the 5/25 claims limitations for cumulation of claims from multiple applications. Another benefit is that it is more likely that the invention in such an application may be protected by 5/25 claims, substantially avoiding the detrimental limitations on rights imposed by the new rules.

One drawback of such an approach is that, if the applicant later discovers that they have a right to broader protection, issues related to support of the broader protection, and the possible violation of the 5/25 rule as it applies to claims cumulated from related applications arise.

Another drawback of such an approach is that it raises costs in the near term; drafting and filing two applications instead of one is in most cases more expensive.

In summary, the playing field has shifted, favoring drafting of smaller patent applications to avoid the burdens imposed by the new patent rules.

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Date/time code: August 29, 2007 (12:50pm)
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