

Notes from Robert Bahr's 8-23-2007 Presentation Explaining the New USPTO Rules Limiting Patent Continuation Applications and Claims in a Patent Application

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INTRODUCTION

Due to the importance of this topic, I am publishing my notes on the 8-23-2007 Webinar for general distribution. These are my notes taken concurrently with the presentation explaining the limitations on continuation practice and claims. Generally speaking, the USPTO has now limited applicants to an original application, 2 continuations of that original application, and 1 RCE for one of those three applications, and to only 5 independent and 25 total claims (5/25) per application. The USPTO has imposed substantial hurdles on the applicant who exceeds those limits including filing of an ESD (Examination Support Document), an SRR (Suggested Restriction Requirement), or canceling claims to limit the application to 5/25.

For applications not having a first office action on the merits by 11/1/2007, those limitations apply. For such applications, applicants will have to take comply, preferably affirmatively instead of awaiting a USPTO requirement. My notes on the presentation follow.

Presentation by Robert Bahr, Deputy Commissioner for Patent Examination Policy, USPTO.

I. GENERAL LIMITATIONS

FR published 8/21/2007 "Changes to practice for continuation..." 72 FR 42716

2 cons and 1 RCE per application.

5 ind and 25 total claims per application, without an application support document.

Effective date is 11/1/2007

May file 2 continuations or CIPs and 1 RCE in an "application family"/

Additional RCE with pet. and showing.

Division may be filed in parallel or series so long as co-pending. Divisions not subject to the 2/1 limitations on parent application's patent family.

For divisional, applicant may file 2 continuations and 1 RCE in the divisional application family.

Division and its continuations (greater than 2/1) - Additional application or RCE with petition and showing.

In each application 5/25 without exam support document. More, if file support document filed before first action. Does count all application having patentable indistinct application.

Must identify common inventor and priority dates within 2 months. Rebut table presumption that applications contain at least 1 patentably indistinct claim, if filed within 2 months and same inventor?

Office may require applicant eliminate patentably indistinct from more than one application.

Retaining 1st action final rejection practice. Applicant may guard against by seeking entry of a 1.116 amendment, which is not entered.

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Second OA may be final, except new ground necessitated by claim amendments or IDS. 2/1/2008 compliance date.

Continuation practice, 78(a)(9)(d), applicable to applications filed on or after 11/1/2007, including reissues but not reexaminations, and entering the national stage on or after 11/1/2007.

II. **37 CFR 1.114**

Applies to applications filed 8/21/2007 or before. Until 11/1/2007 one may file as many cons as desired without limit.

1.78(f)(1) and (2) must file support documents for non-complying applications pending 11/1/2007.

May file suggested for restriction.

Benefit requirements - 1.78(d)(1) defines conditions for.

Improper benefit claims are refused.

Claims in a CIP supported by parent must be identified to be entitled to benefit of parent.

Applicant traverses RR or provisional such as election of species, cannot rely upon RR to file

III. **DIVISIONAL ISSUES**

If a RR is withdrawn then purported divisional will not be a divisional; may change benefit claim to continuation claim if other conditions satisfied.

Advice - Conclude prosecution of generic claim in base case first. Cancel withdrawn claims to avoid improper benefit claim in purported division.

If non elected claims rejoined and exceed the 5/25 limit, examination support document before first

OA required to avoid claim limitation. 1.78(d)(1)(iii)?

3rd application allowed, if one of the prior filed application had no benefit claims to regular/PCT and was abandoned in response to notice to file missing parts.

Petition showing; amendment, argument or evidence could not have been entered in the prior application. Examples: filing of appeal, # of parallel filings.

IV. **1.75(B) - EXAMINATION OF CLAIMS**

5/25 allowed without ESD

5/25, ESD 1.265 document prior to 1st OA on merits.

No ESD for >5/25 (5/25 includes claims in application with patentably indistinct and does not include withdrawn claims),

1.142(c) - Suggestion of restriction requirement (SRR), before FOAM. Must elect if examiner accepts. elected examined, non elected withdrawn.

1.141(a)(2). - Excess claims fees not refunded.

IF SRR not accepted, applicant will be given notice with 2 month to file ESD or amend to 5/25 or a different RR not extendable 2 month time limit to file ESD or amend to 5/25.

Inadvertently omitted ESD, examiner will get a notice; for applications filed on or after 11/1/2007.

2 month time period to file ESD or amend to limit to 5/25.

Applications with no FOAM before 11/1/2007, ***extendable*** 2 month time period, to avoid

abandonment, file ESD, or SRR, or amend to limit claims to 5/25.

V. **37 CFR 1.265 - ESD**

Commonly owned applications rule containing at least one patentably indistinct claims.

1.75(b)(4), all claims in all such applications count.

Copendency treatment for 1.74(b)(4) if a NOA issued, abandoned, NOA under 135 or 146 commenced.

Dependency must incorporate by reference referenced claim limitations and specify a further limitation. ??? incorporate by reference ???

*** Claims to different statutory classes treated as independent claims. ***

ESD required before FOAM

Statements in examination search report ESD

references list

claim limitations disclosed by each reference

112, 1st showing of support for each claims in each priority application.

preexamination search statements

1.265(b) search conducted.

Field of Search referencing - USPCS

search logic (keywords and fields)

file and database service

PER MPEP 719.05.

encompass all limitations and all dependent claim limitations.

US patents

Foreign patents

Non patent literature

List references

Copy of non US patent docs

Closely related reference - shows greatest number of limitations in an independent claim

Limitation of any dependent claim not shown elsewhere

Map limitations to references for each feature, showing, or teaching, identify each.

Explain why claim is non obvious, novel, over cited prior art.

112 showing must show support in application and all parent applications, and each means embodiment of MPF recitation.

1.265(e); IDS with more pertinent reference requires new ESD!

1.265(f) small entity exemption. 5 USC 601. Certification requirements unclear.

VI. **1.78(F)(1) - REQUIREMENTS FOR PRIORITY**

Common inventor.

All applications with priority date or filing date within 2 months of filing date.

Notification of closely related cases required within 4 months/2 months.

common inventor

same filing date

overlapping disclosure

Rebuttable presumption that applications claims the same invention.

Rebut presumption or submit terminal disclaimer and explain why 2 applications.

4 months/2 months time limit. (filing date of application or other application)

VII. 37 CFR 1.117

Refunds, amendment canceling claims for applications filed after 12/8/2004, file request for refund with amendment canceling claims. The office will refund the excess claims fees.

VIII. 37 CFR 1.704 - IMPACT ON PATENT TERM EXTENSION

Limitations

Failure to comply with prosecution limitations relating to continuations and 5/25 limits.

Failure to comply with 1.75(b); delaying prosecution.

From date of PTO action until date of complying response.

IX. Q & A'S FROM BOB SPARR'S PRESENTATION - LIVE QUESTIONS AND ANSWERS BY BOB SPARR

Do canceled claims count to 5/25 rule. No.

How does 5/25 become 15/75 in a single application. 15/75 refers to initial application and 2 continuing applications without petition or justification.

Can applicant add new claims to get back up to the 5/25 cap after restriction/election? Yes, but reinstated or rejoined claims would count, so use care in presenting additional new claims.

ESD's questions. If a group of application filed the same date with overlapping disclosures, in different stages, how is 5/25 determined. - Based upon non allowed applications.

If application has not FOAM by 11/1/2007, must limit to 5/25 or file ESD, or file SRR and ESD. ESD in reissue - Can search be prior art of record; the patent examiner in the patent? - No. Does not automatically satisfy the search for ESD.

Patentably indistinct claims means what? - Test for 1-way obviousness double patenting.

Presumption: same f/d including effective filing date, common inventor, common assignee, and substantially overlapping disclosure.

Prior to submitting ESD, can you wait to see if examiner will issue a RR? No, must submit either SRR or ESD before 1st action.

What about RR that is made final, can divisional application be filed? - Yes, but if RR withdrawn, or if claims rejoined, division would no longer be proper.

Petitions showings - 1.78(f) must application be disclose that are to completely unrelated subject matter. Yes.

Con/CIPs, can one file 3 RCE and no continuation applications? No. No, can file a continuation and request streamlined docketing, which has the effect of an RCE time-wise for prosecution.

A provisional application does not count as initial application (one of 3).

A RR is not considered a FOAM.

Can Google be used to satisfy requirements for non patent literature search? - Answer unclear.

1.78(d)(3) - Does this apply to CIPs? Files to applications pending after 11/1/2007???

Bypass application; does that count as 1 of the 2 applications? See 1.78(d)(1)(iv); under some situations the bypass does not count as one of the 2 continuations.

Can claims fees payment be limited to elected claims in SRR? No, all claims paid for must be paid for when filing the application.

Should all pending applications address the 5/25 requirement? - USPTO will send notice in cases that exceed 5/25 and have no FOAM by 11/1/2007. However, applicants can pro-actively act - file

Consequence for failing to identify commonly owned applications and patents? See answer J15.

Do new rules apply to reissue application with FOAM prior to 11/1/2007. - No.

Can one traverse a patentably indistinct presumption? - Yes.

Until 11/1/2007 applicants can file continuations. However, cases filed from now till then, those cases will be taken into account in determining whether another continuation may be filed after 11/1/2007.

In a continuing application 5/25 limit applies even if parent application did not have an ESD.

Application with > 5/25 and an SRR is filed, can examiner refused to accept the SRR? - Yes.

If an applicant is a small entity, what are the ESD requirements and 5/25 requirements? - Small entities are not exempt generally. However, they are exempt from the ESD claims support requirements.

For family of applications filed prior to 8/21/2007 and no FOAM, how does the USPTO treat them? - If they have at least one patentably indistinct claim, the USPTO would send a notice requiring compliance with new rules; ESD, 5/25 limitation, and SRR.

What is sufficiency of showing required for additional application. New argument or ground by examiner is not per se sufficient to authorize filing continuation; if reasonably anticipated, then insufficient.

Is addition of new matter in a CIP sufficient to justify 3rd continuation? - No.

Can one wait after filing a SRR if over 5/25? Yes. One can wait until after examiner evaluates the SRR before limiting to 5/25 or filing ESD.

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September 9, 2007 (7:48pm)

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