

THE IMPACT OF THE NEW PATENT RULES PUBLISHED 8/21/2007 ON PATENT PRACTICE

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RICHARD NEIFELD, Ph.D., PATENT ATTY.

- NEIFELD IP LAW, PC - www.Neifeld.com
- EMAIL: rneifeld@neifeld.com
- 4813-B EISENHOWER AVE., ALEXANDRIA, VA 22304

OUTLINE

I. INTRODUCTION

II. DETAILS OF RULES

III. IMPACT, AND WHERE DO
WE GO FROM HERE?

I. INTRODUCTION

A. CITATION

B. GOAL OF RULES

C. EFFECT OF RULES

E. MECHANICS OF RULES

A. CITATION

- “Changes To Practice ... in Patent Applications; Final Rule.”
72 FR 46,716-46,843, August 21, 2007
- CODIFIED IN 37 CFR
- OVER 150,000 WORDS

B. USPTO'S GOAL

- TO “reduce ... [the] backlog”
- TO “improv[e] ... quality of issued patents”
- 72 FR 46717

C. EFFECT OF RULES

SMALLER APPLICATIONS AND LESS PROTECTION

- LIMITS ON SIZE OF DISCLOSURE, NUMBER OF CLAIMS
- LIMITS ON THE NUMBER OF CONTINUATIONS, DIVISIONS⁶

D. MECHANICS OF NEW RULES

THE NEW RULES ALLOW
“LARGE” APPS, *BUT ONLY*
IF THE APPLICANT FILES A
BURDENSOME AND RISKY
“ESD”

II. DETAILS OF RULES

A. ACRONYMS AND DEFS.

B. ESD

C. “5/25” CLAIMS LIMIT

D. 3 APPS. LIMIT

E. REPORTING REQMTS.

F. SRRs

II.A. - ACRONYMS AND DEFS.

ACRONYMS

- ESD – EXAMINATION
SUPPORT DOCUMENT
- SRR- SUGGESTED
REQUIREMENT FOR
RESTRICTION

DEFINITIONS

- 5/25 – 5 INDEPENDENT AND 25 TOTAL CLAIMS
- 3 APPS. LIMIT– LIMIT ON PRIORITY CLAIMS TO 2 APPLICATIONS CLAIMING PRIORITY TO AN ORIGINAL APPLICATION

DEF. DIVISIONAL

- AN APPLICATION HAVING CLAIMS DEFINING ONLY AN INVENTION THAT WAS DISCLOSED, CLAIMED, RESTRICTED, NOT ELECTED, AND NOT EXAMINED, IN A PRIOR APPLICATION. 1.78(a)(2)

DEF. CONTINUATION

- AN APPLICATION THAT CLAIMS INVENTIONS *DISCLOSED* IN A PRIOR APPLICATION. 1.78(A)(3)
- NOTE: “DIVISIONAL” IS NOW A *SPECIES OF* “CONTINUATION”

II.B. - ESD

37 CFR 1.265

ESD REQD. IN LARGE APPLICATIONS

- PRIOR TO EXAMINATION
- AN IDS IS FILED
- A CLAIM IS AMENDED

IF ESD “DEEMED INSUFFICIENT”

- LIMIT CLAIMS TO 5/25; OR
- FILE “CORRECTED” ESD
- OTHERWISE APPLICATION ABANDONED

ESD REQMTS.

- Comprehensive Search
- Detailed Search Report
- Showing of non-obviousness
- Showing of support
- For each claim limitation

ESD RISK

**SUBSTANTIAL RISK THAT THE
USPTO WILL FIND AN ESD, A
'CORRECTED' ESD,
INSUFFICIENT, RESULTING
IN ABANDONMENT OF THE
APPLICATION**

ESD – 1.265(f)

(CERTAIN SMALL ENTITIES
ARE NOT REQUIRED TO
IDENTIFY LIMITATIONS IN
EACH CLAIM DISCLOSED
BY EACH REFERENCE.)

ESD ADVICE

- BURDENSOME, AND AN UNACCEPTABLE RISK
- **DO NOT USE, IF AT ALL POSSIBLE**

II.C. 5/25 CLAIMS LIMIT

(AKA THE SMALL
APPLICATIONS RULE)

5/25 CLAIMS

- 37 CFR 1.75(b) (1)
- 37 CFR 1.75(b)(4)

1.75(b) (1)

“An applicant must file an ... [ESD] before [examination of the claims] ... if the application contains or is amended to contain more than **five independent** claims or more than **twenty-five total** claims.”

1.75(b) (1)

TRANSLATION – APPS. ARE
GENERALLY LIMITED TO NO
MORE THAN 5/25 CLAIMS

1.75(b) (4)

1.75(b) (4) “If [an] application contains ...[a] claim that is ***patentably indistinct*** from ...[a] claim in one or more other [commonly owned] ***pending*** non- provisional applications, ... the Office will ***treat the claims ... as present ... for purposes ... of this section.***”

“... *patentably indistinct*” ?

- 1.75(b) (4) “... *patentably indistinct*” ?
- USPTO Response to Comment 141
“The standard for “**patentably indistinct**” as the term appears in § 1.78 is **one-way distinctness in an obviousness-type double patenting analysis.**”

“... *pending*” ?

- 1.75(b) (4) “... *pending*” ?
- 72 FR 46726 (COMMENTS TO RULES) - “The Office, however, will treat the application as no longer pending for purposes of § 1.75(b)(4) if: (1) A notice of allowance is issued...” .

“treat the claims ... as present”

- 1.75(b)(4) “ ... for ... this section.”?
- **TRANSLATION – 5/25 LIMIT APPLIES TO THE SUM OF ALL CLAIMS IN ALL PENDING NON ALLOWED APPS. HAVING A CLAIM THAT IS OBVIOUS IN VIEW OF A CLAIM IN ANOTHER ONE OF THE APPS.**

5/25 CLAIMS LIMIT SUMMARY

- THE SUM OF ALL CLAIMS IN ALL PENDING NON ALLOWED APPLICATIONS THAT CLAIM PATENTABLE INDISTINCT INVENTIONS IS LIMITED TO 5/25

1.75(b)(4) EXCLUSION OF ALLOWED APPS.

1.75(b)(4) EXCLUSION
DESIGNED TO MINIMIZE
APPEALS ON BROAD CLAIMS
IN AN ORIGINAL CASE,
FAVORING INSTEAD CONTS.

1.75(b)(4) EXCLUSION OF ALLOWED APPS.

1.75(b)(4) EXCLUSION OF
CLAIMS IN ALLOWED APPS.
FROM 5/25, ENABLES FILING
A CONTINUATION, ONCE THE
FIRST APP. IS ALLOWED

II.D. 3 APPS. LIMIT

THE RIGHT TO CLAIM
PRIORITY IS GENERALLY
LIMITED SO THAT ONLY 2
(NON DIVISIONAL) CONTS.
MAY BE FILED FROM ANY
ORIGINAL APP.

AUTHORITIES

- RULE 1.78(d)(1)(i)-(vi)
(LIMITATIONS ON PRIORITY)

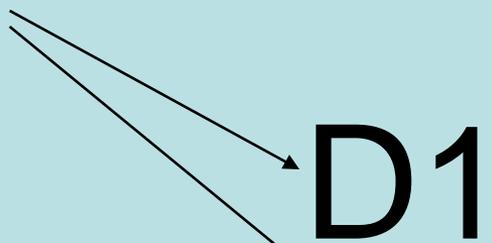
CONTINUATIONS

NO MORE THAN 2 (NON
DIVISIONAL) CONTS. CAN
CLAIM PRIORITY TO AN
ORIGINAL APP. 1.78(d)(1)(i).

2 CONTS. LIMIT TIME



• ~~OA RR~~ → C1 → C2



D2

UNEXAMINED PCT

- PCT APP. IN WHICH NO DEMAND (FOR EXAM.) IS FILED AND FOR WHICH THE FEE FOR ENTERING THE US NATIONAL STAGE IS NOT PAID DOES NOT COUNT AS ONE OF THE 3 APPS. 1.78(d)(1)(iv).

INCOMPLETE US

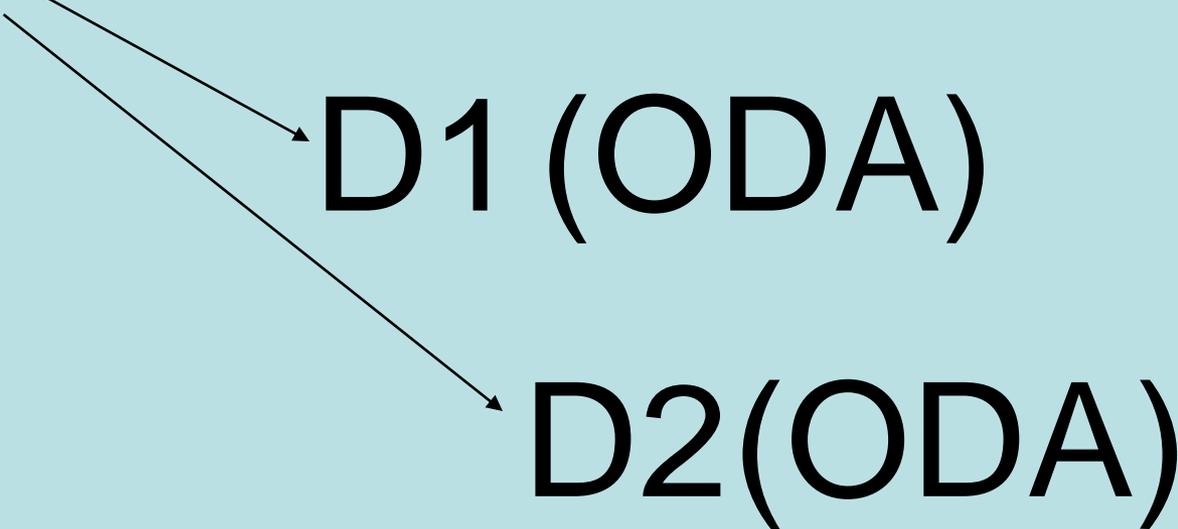
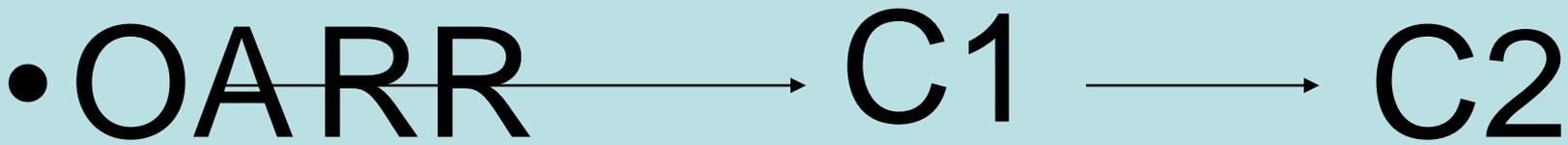
AN ORIGINAL US APP. THAT
BECAME ABANDONED FOR
FAILURE TO PAY THE APP.
FEE OR FILE THE INVENTOR
DEC. DOES NOT COUNT AS
ONE OF THE 3 APPS.

1.78(d)(1)(v)(A)-(C); 1.53(f).

1.78(d)(1) (ii) – DIVISIONAL

DEF – ORIGINAL DIVISIONAL
APPLICATION (ODA) – First
application claiming invention
withdrawn in the OA

2 CONTS. LIMIT TIME



CONT. OF AN ORIGINAL DIVISIONAL

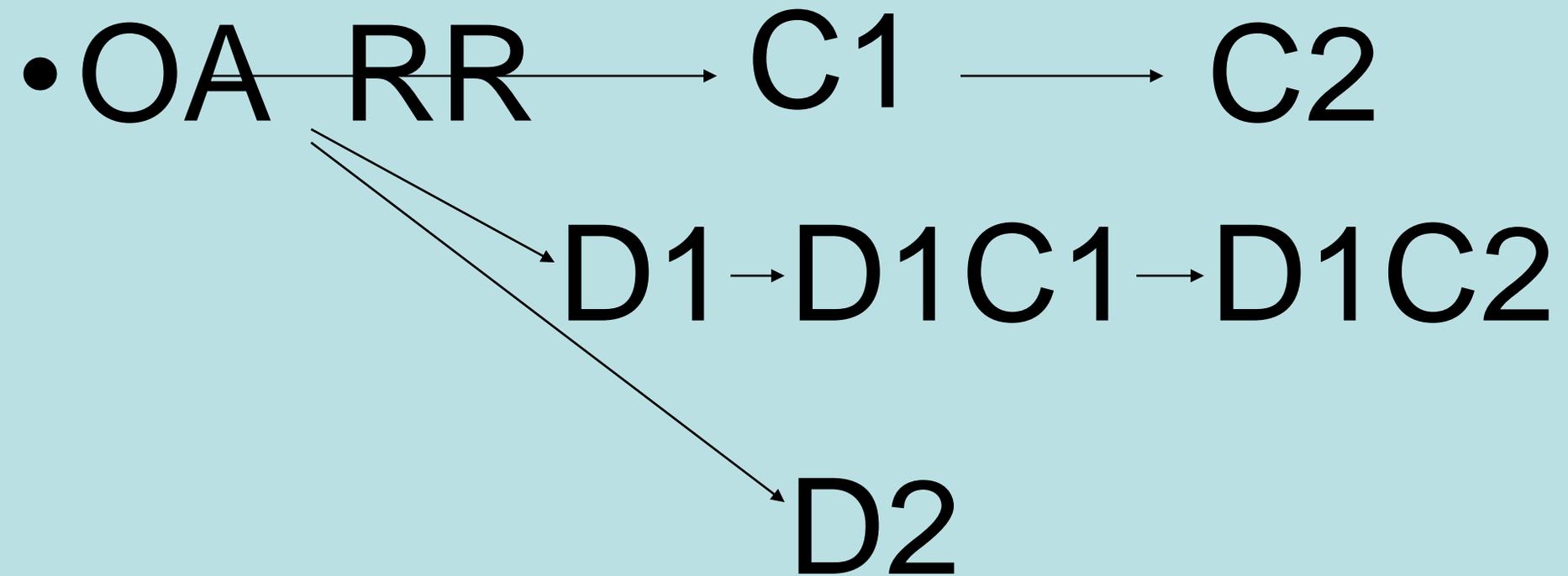
NO MORE THAN 2 (NON
DIVISIONAL) CONTS. CAN
CLAIM PRIORITY TO AN
ORIGINAL DIVISIONAL
APP.1.78(d)(1)(ii) AND
(d)(1)(iii)(D)

CONT. OF AN ORIGINAL DIVISIONAL

- THE 2 (NON DIVISIONAL) CONTS. OF ORIGINAL DIVISIONAL CAN CLAIM ONLY THE INVENTIONS CLAIMED IN THE ORIGINAL DIVISIONAL.
1.78(d)(1)(iii)(B).

2 Continuations

—————→ TIME



THIRD CONT.

- APP., PETITION, SHOWING, AND FEE
- “[something] ... that could not have been submitted ... [in the prior] application....”
1.78(d)(1)(vi)

3 APPS. LIMIT - SUMMARY

FOR ANY ORIGINAL APP. OR
ORIGINAL DIVISIONAL
APPLICATION, CAN FILE
ONLY 2 CONTINUATIONS

II.E. REPORTING REQUIREMENTS

REQUIRE APPLICANTS TO
IDENTIFY AND “CORRECT”
APPS. IN WHICH THEY MAY
BE CLAIMING PATENTABLY
INDISTINCT INVENTIONS

1.78(f)(1) – REQMT.

- IN ALL NON ALLOWED APPS., FILE A PAPER IDENTIFYING BY APP. NUMBER AND PATENT NUMBER, EACH OTHER PENDING OR PATENTED NONPROVISIONAL APPS. MEETING THE FOLLOWING CRITERIA:

1.78(f)(1) - CRITERIA

- ANY PRIORITY DATE WITHIN 2 MONTHS OF ONE ANOTHER;
- COMMON INVENTOR; AND
- OWNED BY THE SAME ENTITY

1.78(f)(2) - CRITERIA

- 1.78(f)(1) CRITERIA +
- PRIORITY DATE IS COMMON TO BOTH
- A CLAIM IN THE SUBJECT APP. IS *SUPPORTED* BY THE OTHER APP. OR PATENT.

1.78(f)(2) - PRESUMPTION

- PRESUMPTION EXISTS IF (F)(2) CRITERIA MET
- PRESUMPTION - THE APP. CONTAINS CLAIMS THAT ARE **PATENTABLY INDISTINCT** FROM CLAIMS IN THE OTHER PENDING APP. OR PATENT

REQD. RESPONSE TO PRESUMPTION

- REBUT THE PRESUMPTION WITH ANALYSIS AND ARGUMENT; OR
- FILE A TERMINAL DISCLAIMER, EXPLANATION, LIMIT CLAIMS TO 5/25

1.78(f)(2) - CRITERIA

- AVOID (f)(2) BY *NOT DESCRIBING* DIFFERENT INVENTIONS IN DIFFERENT APPLICATIONS.
- LIMIT DESCRIPTION IN AN APP. TO ONE INVENTION

II.F SRR

- APPLICANT MAY SUGGEST A RR AND AGREE NOT TO CONTEST IT. SRR FILING AVOIDS LOSS OF *PATENT TERM ADJUSTMENT* FOR LARGE APPLICATIONS, REGARDLESS WHETHER EXAMINER IMPOSES SRR.
- USEFUL IN LARGE APPS.; RISKY.

IV. IMPACT, AND WHERE DO WE GO FROM HERE?

- EFFECT OF THE NEW RULES
- ANTICIPATED LEGISLATION
- ANTICIPATED ADDL. RULES

EFFECT OF NEW RULES

- SMALLER DISCLOSURES
- GREATER NUMBER OF APPS.
- MORE APPEALS TO THE BPAI

EFFECT OF NEW RULES

- SRR IN PENDING CASES
- INCREASE IN RATE OF EXAMINATION OF APPLICATIONS
- MANY VOLUNTARY TDs AND CLAIM AMENDMENTS

HR 1908; S. 1145

- USPTO MAY REQUIRE SEARCH AND ANALYSIS (HR 1908)
- SEARCH MUST BE BY U.S. CITIZEN, OR U.S. CORPORATION, OR THE APPLICANT (HR 1908)

HR 1908; S. 1145

- FIRST INVENTOR TO FILE
- POST GRANT OPPOSITIONS
- UNIVERSAL 18 MONTH PUBLICATION
- EXTENDS TIME AFTER PUBLICATION FOR THIRD PARTY PRIOR ART SUBMISSIONS

PROPOSED RULES

- IDS LIMITATIONS (LIMIT TO 20 REFS.)
- LIMITS ON ALTERNATIVE CLAIMING (MARKUSH AND THE LIKE);
RESTRICTION WITHIN A CLAIM
- LIMIT RIGHTS ON APPEAL

CONCLUSION

- MAJOR CHANGES IN US PATENT SYSTEM CONTINUE AT AN UNPRECEDENTED PACE
- SOME CHANGES REFLECT A GENERAL ANTI PATENT SENTIMENT

THE END THANK YOU!

RICHARD NEIFELD, PRESIDENT

NEIFELD IP LAW, PC - www.Neifeld.com

StockPricePredictor.com, LLC -
www.PatentValuePredictor.com

EMAIL: rneifeld@Neifeld.com

TEL: 703-415-0012 EXT. 21