



United States Patent and Trademark Office Announces Extensive Rule Changes

The United States Patent Office (USPTO) has announced the most extensive overhaul of USPTO procedure in more than 30 years. The new rules go into effect on November 1, 2007 and will affect the basic procedures for obtaining patents. The changes to the patent laws are described in more detail below:

1. Implementation of the "5/25 Claim Rule", limiting the number of claims per application to 25 total claims and 5 independent claims. Exceeding these numbers will require the filing of a complex petition.
2. Continuation and Continuation-in-Part (CIP) applications will be limited to two (2), and Requests for Continued Examination (RCE) applications will be limited to one (1).
3. Applicants must disclose all applications having patentably indistinct claims that are filed within two months of each other by the same owner and/or include at least one common inventor. The USPTO may consider these applications as a single application for the purpose of calculating the 5/25 Claim Rule (see #1 above).

THE 5/25 CLAIM RULE

Under prior patent rules, a patent application could include an unlimited number of claims. Under the limits imposed by the new 5/25 Claim Rule, to expand the number of claims an applicant must file an Examination Support Document (ESD) and include the following:

1. A listing of the prior patents or references that are most relevant to each claim.
2. Identification of the application claim elements which are disclosed in each reference.
3. A statement demonstrating how the application claims are patentable over the prior patents or references.
4. Detailed identification of where in the application support for each claim is found.

It is unlikely that an ESD will be widely recommended in practice. Preparation and filing of an ESD will carry high costs, and the requirement that otherwise unnecessary statements be made on the record before examination also restricts an attorney's ability to later argue for broad patent protection in response to an examiner's rejection of claims.



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ADMISSIONS INFORMATION

by state, follows respective attorney name
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LIMITATION ON NUMBER OF CONTINUATION, CIP AND RCE PATENT APPLICATIONS

"Continuation" applications are often filed to pursue a set of claims not allowed in an initial application.

"Continuation-in-Part" or "CIP" applications are filed when it is necessary to add "new matter" to an application, i.e., invention details that were not previously disclosed in the initial application. This type of application is utilized when the ongoing development of an invention presents additional improvements for which patent protection is desired.

"RCE" applications are often filed when a final rejection has been issued for an existing application and allow an attorney to present further claim amendments and arguments in pursuit of an allowance of the application.

As stated above, the new rules impose a limit of two (2) Continuation and/or CIP applications and one (1) RCE application per application. Additional Continuation, CIP and/or RCE applications beyond these limits require a Petition that includes the following:

- Presentation of any additional amendment, argument or evidence.
- Payment of a petition fee of \$400.00 (in addition to application fee).
- A showing that the additional amendment, argument or evidence could not have been presented previously.

Rather than filing a Petition, an applicant may appeal the examiner's final rejection to the Board of Patent Appeals and Interferences. In either case, the applicant will incur additional expenses. While the USPTO has stated that the new rules are directed at reducing costs by restricting the number of claims and continuation applications, it is likely that an applicant's costs may increase should a patent attorney need to perform additional work, such as preparation and filing of Petitions, ESDs, examiner interviews and appeals, in order to obtain the desired scope of patent coverage.

Applicants may wish to contact their patent attorney to discuss the implication of the new rules on their current patent strategy and determine what action might be taken between now and November 1, 2007 to mitigate the effect of the new rules. For more information regarding the new rules, please contact Katie H. McGuire at 585. 899.2936 or kmcguire@jaeckle.com or Paul T. Lavoie at 585.899.2963 or plavoie@jaeckle.com.