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# Client Alert

## New Rules for Claims and Continuation Practice Before the USPTO

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**On August 21, 2007, the United States Patent and Trademark Office (“the Office”) published a long-anticipated final rule setting forth amendments to 37 CFR that will have significant effects on claims and continuation practices for patent applications.<sup>1</sup> According to the Office, these changes should provide “more effective and efficient examination for the typical applicant without additional work” and require the applications that “place an extensive burden on the Office” to “help focus examination by providing additional information to the Office.”<sup>2</sup>**

Under the new rules effective November 1, 2007, an applicant may:

- present up to five (5) independent claims and a total of twenty-five (25) claims for examination in each patent application, and
- file two continuation and/or continuation-in-part (CIP) applications and one request for continued examination (RCE) from an initial patent application.

These rules permit an applicant to present up to fifteen (15) independent claims and up to a total of seventy-five (75) claims to an invention in an initial application and two continuation and/or CIP applications. Divisional applications, with continuation and/or CIP applications, permit an applicant to present up to 15 independent claims and 75 total claims to each distinct invention disclosed in the specification. An applicant may exceed these limits, but will be required to provide additional information and/or justification to the Office.

<sup>1</sup> Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Distinct Claims, and Examination of Claims in Patent Application; Final Rule, 72 Fed. Reg. 46716-46843 (August 21, 2007).

<sup>2</sup> 72 Fed. Reg. 46716.

Amendments to 37 CFR §1.75 set forth new rules for claim practice:

- An applicant wishing to present more than 5 independent claims or 25 total claims for examination in a single application must provide an examination support document in compliance with new section 37 CFR §1.265, covering all the claims in the application. (37 CFR §§1.75(b)(1)). An applicant will be notified of excess claims and will have a non-extendable two-month time period to cancel excess claims or submit an examination support document (37 CFR §1.75(b)(3)).
- The examination support document includes a preexamination search statement describing how a search was carried out, a listing of references deemed most closely related to the subject matter of each of the claims, an identification of all of the claim limitations that are disclosed in the references, a detailed explanation particularly pointing out how each of the independent claims is patentable over the cited references, and a showing of where each claim limitation finds support under 35 USC §112 in the application specification and in any prior-filed application (37 CFR §1.265(a)).
- If an application has a claim deemed patentably indistinct over a claim in a commonly owned application, then **all** the claims of the other commonly owned application will be taken into account in determining claim number in an application (37 CFR §1.75(b)(4)).
- Claims withdrawn from consideration and claims being prosecuted in divisional applications are not taken into account in determining claim number in an application, unless the claims are reinstated or rejoined (37 CFR §1.75(b)(5)).

According to the Office, this final rule avoids placing a limit on the number of claims that may be presented for examination in an application, since an applicant willing to provide an examination support document in compliance with 37 CFR §1.265 may present as many independent and total claims as they desire. However, such an applicant must “help focus examination by providing additional information to the Office in an examination support document.”<sup>3</sup>

Amendments to 37 CFR §§1.78 and 1.114 set forth new rules for continuation and RCE practice:

- An applicant wishing to file more than two continuation and/or CIP applications claiming benefit of priority to a prior-filed application, must file any additional application under 37 CFR §1.78(d)(1)(vi) with a petition, fee, and a showing that the amendment, argument, or evidence sought to be entered could not have been submitted during the prosecution of the prior-filed application. Certain applications filed on or before August 21, 2007 (i.e., the publication date of the final rule), will be eligible for “one more” continuation or CIP application (37 CFR §1.78(d)(1)(iv) and (v)).
- An applicant wishing to file more than one RCE must submit a petition under 37 CFR §1.114(g) with a fee and a showing that the amendments, argument, or evidence sought to be entered could not have been submitted prior to the close of prosecution in the application. The “one RCE” rule counts RCE filings in the application as well as in related applications (37 CFR §114(f)), and counts RCE filings made prior to the effective date of November 1, 2007.<sup>4</sup>

<sup>3</sup> 72 Fed. Reg. 46721.

<sup>4</sup> 72 Fed. Reg. 46717.

Divisional applications can be filed with claims to a non-elected invention as long as the prior-filed application was subject to a restriction requirement (37 CFR §1.78(a)(2)) and co-pendency under 35 USC §120 is satisfied. Under 37 CFR §1.142(c), an applicant may file a suggested requirement for restriction (SRR), accompanied by an election without traverse of an invention to which there are no more than 5 independent claims and 25 total claims.

Applicants filing multiple applications that may contain conflicting or patentably indistinct claims are subject to new disclosure rules set forth in amendments to 37 CFR §1.78:

- An applicant must identify each other pending application or patent that has a filing or priority date within two months of the filing or priority date of the application, names at least one inventor in common, and is commonly owned (37 CFR §1.78(f)(1)). This requirement does not supplant other duties of disclosure, and the Office cautions against “intentionally filing related applications outside of the two-month window in an attempt to avoid the requirement to identify other applications that are material to the patentability of the application.”<sup>5</sup>
- A rebuttable presumption of at least one patentably indistinct claim exists if two applications have the same filing date, name at least one inventor in common, are co-owned, and contain “substantial overlapping disclosure,” and this presumption must be rebutted or overcome by submitting a terminal disclaimer (37 CFR §1.78(f)(2)). Absent good and sufficient reason for two or more co-owned, pending, non-provisional applications containing patentably indistinct claims, the Office may require elimination of patentably indistinct claims from all but one of the applications (37 CFR §1.78(f)(3)).

### Conclusion: Strategic Considerations

In response to rule changes instituted by the amendments to 37 CFR published on August 21, 2007, applicants should consult with their patent attorneys to develop strategies to work with these new rules to obtain optimal patent protection for their inventions. In some cases, there may be advantages to taking certain actions before November 1, 2007. We therefore recommend immediate attention to determining the best course of action for your applications. A preliminary list of some recommended strategies might include:

- Identify applications filed on or before August 21, 2007, that will be eligible under 37 CFR §1.78(d) for “one more” continuation or CIP application without a petition and showing.
- Draft applications with multiple claim sets written so as to trigger the Office to issue restriction requirements that allow divisional applications to be filed. For example, each claim set directed to a distinct invention should be easy to identify by the use of consistent language that clearly points out the patentably distinct features of the invention being claimed. Each claim set should include no more than 5 independent claims and 25 claims total.
- File a suggested requirement for restriction (SRR) of claims when filing an application.
- Appeal final rejections instead of continuing prosecution with RCEs and continuation applications.



<sup>5</sup> 72 Ref. Reg. 46721-46722

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