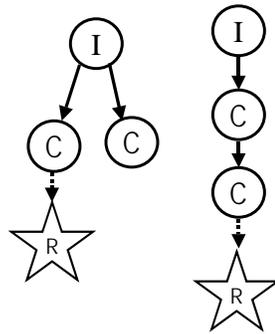


USPTO Issues New Continuation and Claiming Rules

The USPTO on August 21, 2007 issued a package of revisions to the rules, 37 C.F.R., affecting continuation practice and limiting permissible claim count with additional and substantial burdens. These changes affect all patent applicants. This notice briefly summarizes only the most significant changes.

Limits On Continuations

An applicant is limited to an initial application and two continuing applications, including Continuations-In-Part. An applicant may claim priority to only two prior copending applications (parent-child-grandchild), or to only one prior copending application if another application also claims priority to the same prior application (parent and 2 children). This limits applicants to only three related applications, whether filed concurrently or consecutively. Additionally, applicants may file only one Request for Continued Examination (RCE) among any of the three related applications.



For each 3d or subsequent continuation, or 2d or subsequent RCE, an applicant must file a petition with a showing why the amendment, argument or evidence presented could not have been filed earlier.

If an application is subject to a restriction or election requirement, the divisional applications may each have two children or a child and grandchild, and only one RCE among these, directed to claims of each patentably distinct invention identified by the restriction requirement.

Limits on Claim Count

Applicants are effectively limited to five independent claims and twenty-five total claims (the 5/25 threshold) pending at any time for each patentably distinct invention. If there is any patentably indistinct claim in two separate applications, all claims of both applications are counted for the 5/25 threshold. The PTO may also require that the patentably indistinct claim be cancelled from all but one pending application.

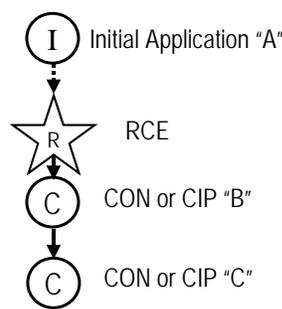
The PTO presumes that there is at least one patentably indistinct claim in two commonly owned applications if they have at least one common inventor, have significant overlapping disclosure, and claim the same priority date. Applicants may rebut the presumption.

Can Applicants Exceed the Claim Limits?

Only by meeting significant additional burdens. For any application that maintains more than the 5/25 claim threshold, an applicant must provide an Examination Support Document (ESD) before a First Action On the Merits (FAOM).

An ESD must include a pre-examination search statement that a search for prior art was conducted for every claimed feature, separately or in combination with other claimed features. The search field must be documented, and should include US and foreign patents, and non-patent literature.

The most closely related prior art results of the search must be listed and analyzed for applicability to each claim, with specific reference to the location of each claimed feature in the prior art search results. A detailed explanation of patentability must be set forth, pointing out the patentable differences between the claims and the closest prior art. An ESD must also show 35 U.S.C. 112, ¶ 1 support for each claim feature.



How Does This Affect Pending Applications?

The new rules are immediately applicable to pending applications. In any application pending on August 21, 2007 that already includes more than three related continuations in the family of related applications, an Applicant may file “one more” continuation at any time after August 21, 2007 without a petition and showing.

Any application pending on November 1, 2007 that has not received a FAOM is subject to the 5/25 claim threshold. Applicants will be notified, and have two months to either cancel claims to below the 5/25 threshold, or else provide an ESD prior to issuance of a FAOM.

Applicants with pending applications have until February 1, 2008 to identify any commonly owned applications having at least one common inventor and filed within two months of each other, to comply with the 5/25 threshold applied to patentably indistinct claims in multiple applications.

Conclusion

OSTROLENK is committed to helping our clients navigate these challenging times for patent applicants. We would like to discuss your applications.

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