

USPTO Softens Blow of New Patent Prosecution Rules

On October 10, 2007, the U.S. Patent & Trademark Office (USPTO) issued a statement clarifying the planned implementation of the final rules that govern patent applications. The rules, which are scheduled to take effect on November 1, would bring about sweeping changes, such as restricting the number of claims that may be filed in a patent application, limiting the number of continuing applications that may be filed from an original patent application, and constraining how and when the priority of earlier applications can be claimed. The October 10 statement relaxes some of the most severe provisions of the final rules.

To mitigate their effect on existing cases, the final rules include a transitional provision that permits the filing of a single additional continuation or continuation-in-part application without justification, even if that application would not otherwise be permitted under the new rules. The October 10 statement clarifies that divisional applications filed after August 21, 2007 do not affect the availability of this additional application, giving applicants greater flexibility in prosecuting their existing patent portfolios. Under the final rules, however, a divisional application may claim only subject matter that has not previously been examined in a US utility application. Importantly, this interpretation now excludes examination of international (PCT) applications.

Under the final rules, applicants also will be required to identify the priority date for each claim in a continuation-in-part application. Penalties will be imposed for a failure to do so. Under the October 10 clarification, applications that receive substantive examination before November 1 are exempt from this requirement; other cases pending on November 1 may defer compliance until February 1, 2008. As a result, applicants will have fewer applications that are subject to this rule and more time to comply with this requirement in those applications.

The final rules also will require applicants to identify to the USPTO all commonly assigned patents and applications that have at least one common inventor and that have a filing or priority date within two months of one another. The October 10 clarification substantially reduces the burden of this requirement by limiting the rule's retroactive effect. Under the USPTO's planned implementation, the two-month window would not apply to pre-November 1 filing or priority dates.

Even in view of the October 10 statement, the USPTO's new rules may require very different strategies and information management systems than those previously employed in U.S. patent prosecution dockets. The Intellectual Property attorneys at Ropes & Gray LLP regularly counsel clients on such issues.

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