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U.S. PTO RULE CHANGES SOON TO BE PUBLISHED[1]

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The U.S. Patent and Trademark Office (U.S. PTO) has announced that two new groups of rule changes are expected to be published soon. It has been reported that the rule changes will probably become effective at least 60 days after publication, and probably no earlier than October 1, 2007.

CLAIMS:

One of the two new groups of rule changes pertains to claims. The rule changes on claims relate to proposed rules on claims which were originally listed in 2006, and included several changes desired by the U.S. PTO, such as the following. If an application contains more than 10 independent claims, the applicant should be required to provide a patentability report and other additional documents. When an application contains less than 10 independent claims, only the independent claims, and the dependent claims expressly elected by the applicant, should be initially examined. The U.S. PTO indicated that this rule should be retroactive. However, the complete details of the rule changes relating to claims have not yet been disclosed.

CONTINUATION APPLICATION PRACTICE:

The other group of rule changes relates to proposed rules on continuation application practice, which were also originally listed in 2006, and which were discussed in detail in our July 2007 Newsletter authored by Mr. Mel R. Quintos. However, as with the claims, the complete details of the rule changes on continuation application practice have not yet been disclosed.

NEW STRATEGIES - WHAT APPLICANTS MAY DO NOW:

(1) Evaluate pending patent applications prior to the effective date of the rule changes, if possible. Identify pending applications which disclose important subject matter that has not yet been set forth in claims. Consider filing a continuation application or divisional application with claims directed to that important subject matter prior to the effective date of the rule changes, if possible.

(2) For applications to be filed after the effective date of the rule changes: Consider that it may be beneficial to disclose only one invention in a single application filed.

(3) For applications to be filed after the effective date of the rule changes: If an application has more than 10 important claims, consider combining claims to reduce the total number to 10 claims.

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[1] This article is not intended to convey legal opinion or advice. We disclaim any liability for any errors or omissions.