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U.S. PTO PROPOSED RULE CHANGES IN CONTINUATION APPLICATION PRACTICE¹ by Mel R. Quintos

The U.S. Patent and Trademark Office (USPTO) has proposed changing the rules Pertaining to the filing of continuation applications, divisional applications, continuation-in-part (CIP) applications, and requests for continued examination (RCEs). The USPTO's objectives for the proposed rule changes include: (1) allowing for the examination of applications directed to "new" inventions, instead of the "reworking" of continued examination filings; (2) reducing the number of patents that have overlapping disclosures and claims; and (3) focusing on the examination of important patentability issues during the first examination of the invention.

Therefore, the USPTO is of the opinion that its above objectives can be attained by adopting the following proposed rule changes: (1) only one continued application (continuation application, divisional application, CIP application or RCE) will be permitted; and (2) the first-action final practice is to be eliminated. As to divisional applications: (a) the filing of a divisional application is permitted only if the USPTO issues a restriction (or lack of unity) requirement on the parent application, (b) the divisional application can only claim the benefit of a single parent application which had the restriction requirement, and (c) only a single continuation application or an RCE will be permitted for each divisional application.

In addition to the above, the USPTO's proposed rule changes include a requirement that the applicant identifies "related" applications or patents. Related applications or patents are defined as those that have: (1) close effective filing dates (within 2 months), (2) a common inventor, (3) a common assignee, and (4) substantially overlapping disclosures. The identification of related applications or patents must: (a) include the application number (and the patent number, if applicable), and (b) be located in the paragraph of the specification containing cross-reference to applications for which benefit is not claimed (normally, in the first paragraph after the title of the invention portion of the specification) or in a separate paper. The identification is to be submitted within 4 months from the actual filing date or the date on which the U.S. national stage commenced.

If the disclosure of a related application or patent substantially overlaps the applicant's disclosure, the USPTO will avoid the examination of the application on the merits, and will rebuttably presume double patenting between the claimed inventions of the related applications or patents. When faced with such a rebuttable presumption of double patenting, the applicant must: (1) cancel indistinct claims: (2) rebut the presumption by explaining how the pending applicaitons contain only patentably distinct claims: or (3) submit a Terminal Disclaimer.

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