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AN INTERNATIONAL INTELLECTUAL PROPERTY LAW FIRM

INFORMATIONAL BULLETIN

USPTO Publishes Final Rules Package Changing Continuing

Application Practice and the Examination of Claims

On August 21, 2007, the U.S. Patent and Trademark Office (USPTO) published the long awaited rules package announcing changes to a number of areas of patent practice outlined below. The rules take effect **November 1, 2007** and impact patent applications filed thereafter, as well as patent applications filed prior to November 1.

A summary of some of the major changes is provided below. The formal announcement of the rule changes along with summaries prepared by the USPTO can be found at: <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>.

We would be glad to answer any questions you may have about the rule changes.

Changes to claims examination

An examination support document (ESD) must be submitted in any application that contains more than five (5) independent claims or more than twenty-five (25) total claims, i.e., 5/25 threshold. This change applies to all applications in which a first office action on the merits has not been mailed by November 1. If an application violates the 5/25 threshold, the following options are available: 1) file an ESD; 2) cancel claims to get under the 5/25 threshold; or 3) file a suggested restriction requirement if more than one invention is claimed. For applications filed before November 1, the USPTO is supposed to issue a notice giving applicant time to take appropriate action.

An ESD must include the following: 1) a statement that a sufficient preexamination search was conducted; 2) a listing of references deemed most closely related to each claim; 3) identification of claim limitations disclosed by each reference, i.e., map the limitations of each claim to each reference; 4) a detailed explanation of how each independent claim is patentable over the references; and 5) a showing explaining where each claim limitation finds support in the written description.

Changes to Continuing Application Practice

An application or application family is entitled to two (2) continuing applications (i.e., continuation or continuation-in-part applications) and one (1) request for continued examination (RCE) in either the initial application or the two continuing applications. This 2+1 practice impacts all applications including those filed before November 1. Additional continuations or RCE's may be permitted if a petition and an adequate showing are provided explaining why additional filings are necessary. However, for an application filed before August 21, 2007 in which 2 continuations and 1 RCE have been filed, the applicant is permitted one more continuation or continuation-in-part application after November 1. Continuing applications filed between August 21 and October 31 will count toward the 2+1 limit.

Effective November 1, a divisional application can only be filed in response to a requirement for restriction and claims a non-elected invention that has not been examined. Please note that a "voluntary divisional" application to pursue a disclosed invention can still be filed as a continuation application. A divisional application is entitled to the 2 continuation application and 1 RCE limitation. In addition, divisional applications can be filed in parallel or serially.

Identification of related applications

Applicant must identify other commonly owned patents or patent applications that have: 1) at least one inventor in common with the application; and 2) a claimed filing or priority date within two months of the claimed filing or priority date of the application. This obligation exists even if the claims in the application and the other patent/application are distinct or directed to unrelated subject matters.