

Final Rule: Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications

Changes Relative to the Rules Originally Proposed in January of 2006

This final rule revises practice with respect to continued examination filings (continuing applications and requests for continued examination), for the examination of claims in patent applications, and multiple applications that have the same claimed filing or priority date, substantial overlapping disclosure, a common inventor, and common ownership. The changes in this final rule allow the USPTO to conduct a better and more thorough and reliable examination of patent applications.

The USPTO published two notices in January of 2006 proposing changes to the practice for continuing applications, requests for continued examination, multiple applications containing patentably indistinct claims, and the examination of claims in applications. *See Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims*, 71 *Fed. Reg.* 48 (Jan. 3, 2006), 1302 *Off. Gaz. Pat. Office* 1318 (Jan. 24, 2006) (proposed rule) (hereinafter “Continuing Applications Proposed Rule”) and *Changes to Practice for the Examination of Claims in Patent Applications*, 71 *Fed. Reg.* 61 (Jan. 3, 2006), 1302 *Off. Gaz. Pat. Office* 1329 (Jan. 24, 2006) (proposed rule) (hereinafter “Claims Proposed Rule”). The notices provided an extended comment period and the USPTO received over five hundred written comments in response to these notices.

Changes to continuation, continuation-in-part and request for continued examination practice: The USPTO proposed in January of 2006 to revise continued examination filing practice to permit an applicant to file one (1) of the following continued examination filings without any justification: a continuation application, a continuation-in-part application, or a request for continued examination. In light of the public comment, USPTO modified the proposed changes to continued examination filing practice to increase the number of continued examination filings permitted without justification. Specifically, this final rule adopts a change to continued examination filing practice that permits an applicant to file two continuation applications or continuation-in-part applications, plus a single request for continued examination in an application family, without any justification.

Changes to divisional practice: The USPTO proposed in January of 2006 to revise divisional application practice to permit an applicant to file a divisional application of an application for the claims to a non-elected invention only if the initial application is subject to a requirement for restriction, and only if the divisional application is filed during the pendency of the initial application. In light of the public comment, USPTO modified the proposed changes to divisional application practice to increase the period during which a divisional application may be filed. Specifically, this final rule permits an applicant to file a divisional application of any application if the application is subject to a requirement for restriction. This final rule also does not require that the divisional

application be filed during the pendency of the initial application, as long as the divisional application meets the copendency requirement of 35 U.S.C. 120. Thus, this final rule allows applicants to file divisional applications in series or parallel rather than requiring that all divisional applications be filed in parallel. This final rule also permits applicant to file two continuation applications of a divisional application, plus a request for continued examination in the divisional application family, without any justification.

Changes to Practice for Examination of Claims: The USPTO proposed in January of 2006 to revise examination practice to provide that the USPTO would give an initial examination only to the claim designated by the applicant as “representative claims.” The USPTO also proposed in January of 2006 that the applicant must provide an examination support document if applicant designated more than ten representative claims for initial examination, taking into account any copending application or patent containing patentably indistinct claims. In light of the public comment, USPTO modified the proposed changes to practice for examination of claims to not adopt the representative claims approach, and increase the number of total claims that would be examined without the applicant being required to file an examination support document. Specifically, this final rule requires an applicant to submit an examination support document before the issuance of a first Office action on the merits of an application to assist in the patentability determination when the applicant presents more than five independent claims or more than twenty-five total claims in an application, taking into account any copending application containing patentably indistinct claims. Since this final rule does not also take into account patents containing patentably indistinct claims, an applicant is permitted to present up to fifteen independent claims and seventy-five total claims for each invention, via an initial application and two continuation or continuation-in-part applications prosecuted serially, without providing either an examination support document or justification.

The USPTO proposed in January of 2006 that an examination support document must include a preexamination search statement, a listing of references deemed most closely related to the subject matter of each of the claims, an identification of all of the claim limitations that are disclosed in the references, a detailed explanation particularly pointing out how each of the claims (independent and dependent) is patentable over the cited references, a concise statement of the utility of the invention as defined in each of the independent claims, and a showing of where each claim limitation finds support under 35 U.S.C. 112, ¶ 1, in the application and any prior-filed application. This final rule does not require that an examination support document include a concise statement of the utility of the invention as defined in each of the independent claims, and requires a detailed explanation particularly pointing out how each of the claims is patentable over the cited references for only the independent claims. This final rule also provides that a small entity as defined by the Regulatory Flexibility Act may claim an exemption from the requirement that an examination support document must contain an identification of all of the claim limitations that are disclosed in the references.

The USPTO also proposed that an applicant would be given a one-month time period that is not extendable under 37 CFR 1.136(a) within which to provide an examination support document if an application for which an examination support document is required, but did not include one. This final rule provides that an applicant will be given a two-month time period that is not extendable under 37 CFR 1.136(a) in an application filed on or after November 1, 2007, and that an applicant will be given a two-month time period that is extendable under 37 CFR 1.136(a) up to six months in an application filed before November 1, 2007, within which to provide an examination support document if an application for which an examination support document is required, but did not include one.

Multiple applications with overlapping disclosure and common ownership: The USPTO proposed in January of 2006 to revise, and this final rule revises, examination practice to provide that an applicant must identify other commonly owned pending applications or patents that: (1) have a claimed filing or priority date within two months of the claimed filing or priority date of the application; and (2) name at least one inventor in common with the application. In addition, this final rule also requires (as was proposed) that the applicant must also file a terminal disclaimer or explain how the applications (or application and patent) contain only patentably distinct claims if the applications also have the same claimed filing or priority date and contain substantial overlapping disclosure.