



Claims and Continuations Final Rule



Background

- In January of 2006, the Office proposed rule changes to practice for:
 - Continued examination filings;
 - Patent applications containing patentably indistinct claims; and
 - Examination of claims in patent applications.
- The goal is to improve quality and enhance efficiency in the patent examination process.



Background

- The Office provided an extended comment period to ensure that the public would have sufficient time to submit written comments on the proposed changes.
- The Office also conducted town hall meetings and presentations at various locations in the United States.



Background

- The Office received over 500 written public comments
 - From intellectual property organizations, companies, law firms, inventors, universities, and government agencies.
- The Office carefully analyzed and considered the public comments.
- The Office has made appropriate modifications to the proposed rule changes in response to the public comments.



Changes in Response to Public Comments

- Divisional applications need not be filed during the pendency of the initial application.
 - Divisional applications may be filed in parallel or in series.
- Increased the number of continued examination filings permitted without justification.



Changes in Response to Public Comments

- Did not adopt “representative claims” examination approach.
- Changed claims threshold from 10 representative claims per invention to 5 independent claims and 25 total (5/25) claims per application.
 - Permits up to 15/75 claims per invention without justification or examination support document (ESD).
- Reduced ESD requirements.



Claims and Continuations Final Rule

- The Claims and Continuations Final Rule was published on August 21, 2007, in the Federal Register.
 - *Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications*, 72 FR 46715 (August 21, 2007) (final rule).
 - The final rule is available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>.
- The effective date is November 1, 2007.



Overview of Claims and Continuations Final Rule



Continued Examination Filings

37 CFR 1.78(d) and 1.114

- Applicants may file, without a petition and showing:
 - Two continuation or continuation-in-part (CIP) applications; and
 - A single request for continued examination (RCE) in an application family.
 - An application family includes the initial application and its continuation or CIP applications.
 - An applicant may file two continuation or CIP applications regardless of whether an RCE has been filed.
- Applicant may file any additional continuing application or RCE with a petition and showing.



Continuing Applications

37 CFR 1.78(d)

- Applicants may file a divisional application if:
 - The prior-filed application is subject to a requirement for restriction; and
 - The divisional application claims only a non-elected invention(s) that has not been examined.
- Applicants may file divisional applications in parallel or in series.
 - A divisional application is not required to be filed during the pendency of the initial application, as long as the copendency requirement of 35 USC 120 is met.



Continued Examination Filings

37 CFR 1.78(d) and 1.114

- Applicants may file, without a petition and showing:
 - Two continuation applications of a divisional application (but not a CIP); and
 - A single RCE in the divisional application family.
 - A divisional application family includes the divisional application and its continuation applications.
- Applicant may also file any additional continuing application or RCE in the divisional family with a petition and showing.



Examination of Claims

37 CFR 1.75(b)

- Applicants may present, without an ESD, up to:
 - Five (5) independent claims, and
 - Twenty-five (25) total claims in an application (5/25 claim threshold).
- Applicant may present more than 5/25 claims, if applicant files an ESD before the first Office action on the merits (FAOM).



Examination of Claims

37 CFR 1.75(b)

- The 5/25 claim threshold does not count withdrawn claims.
 - Applicant may provide a suggested restriction requirement (SRR) before first Office action or a restriction requirement.
- The 5/25 claim threshold does count all of the claims present in other copending application(s) having a patentably indistinct claim, but not the claims in issued patents.
 - Applicant may present up to 15/75 claims via an initial application and 2 continuation or CIP applications prosecuted serially.



Applications Containing Patentably Indistinct Claims - *37 CFR 1.78(f)(1)*

- Applicants must identify other commonly owned application(s) or patent(s) that has:
 - An inventor in common with the application; and
 - A claimed filing or priority date within two months of the claimed filing or priority date of the application.



Applications Containing Patentably Indistinct Claims - *37 CFR 1.78(f)(2)*

- There is a rebuttable presumption that the application and the other application(s) or patent(s) contain at least one patentably indistinct claim,
 - If the other commonly owned application or patent also has:
 - Substantial overlapping disclosure with the application, and
 - A claimed filing or priority date that is the same as the claimed filing or priority date of the application.



Applications Containing Patentably Indistinct Claims - 37 CFR 1.78(f)(3)

- For commonly owned pending applications that contain at least one patentably indistinct claim,
 - The Office will treat each application as having the total number of claims present in all of the applications for determining whether each application exceeds the 5/25 claim threshold. *See* § 1.75(b)(4).
 - In the absence of good and sufficient reason, the Office may require elimination of the patentably indistinct claims from all but one of the applications.



First Action Final Practice

72 Fed. Reg. 46722

- The Office proposed to eliminate first action final practice when it proposed allowing an applicant to file one continuation or CIP application or one RCE without a petition and showing.
- Since this final rule permits an applicant to file two continuation or CIP applications plus one RCE in an application family, the Office is retaining the first action final rejection practice in a continuing application or after an RCE.
 - Applicants may guard against first action final rejection by seeking entry of the amendment, argument, or new evidence after final rejection under § 1.116.



Second Action Final Practice

72 Fed. Reg. 46722-23

- A second or subsequent Office action may be made final, except when the action contains a new ground of rejection that is not:
 - Necessitated by an amendment of the claims, including an amendment to eliminate unpatentable alternatives;
 - Based on an IDS filed after a FAOM with the fee;
 - Based upon a double patenting rejection;
 - Necessitated by an identification of claims in a CIP application that is supported by a prior-filed application; or
 - Necessitated by a showing that a claim element is a means- (or step-) plus-function claim element.



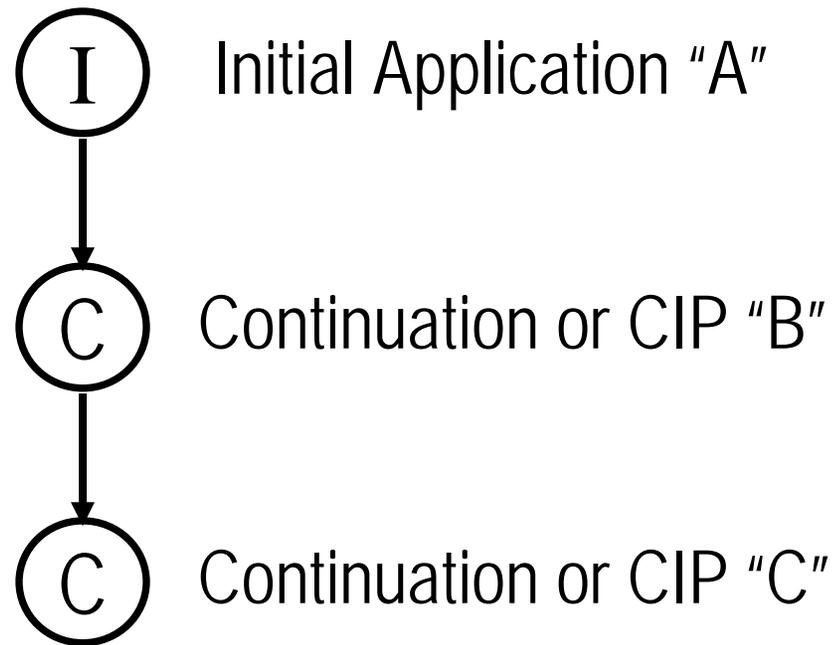
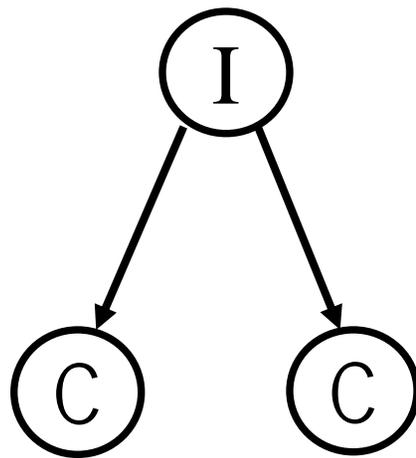
Examples of Continuing Applications and Requests for Continued Examination



Continuing Applications

37 CFR 1.78(d)(1)(i)

Applicant may file two continuation or CIP applications (parallel or serial) without a petition and showing. For example:

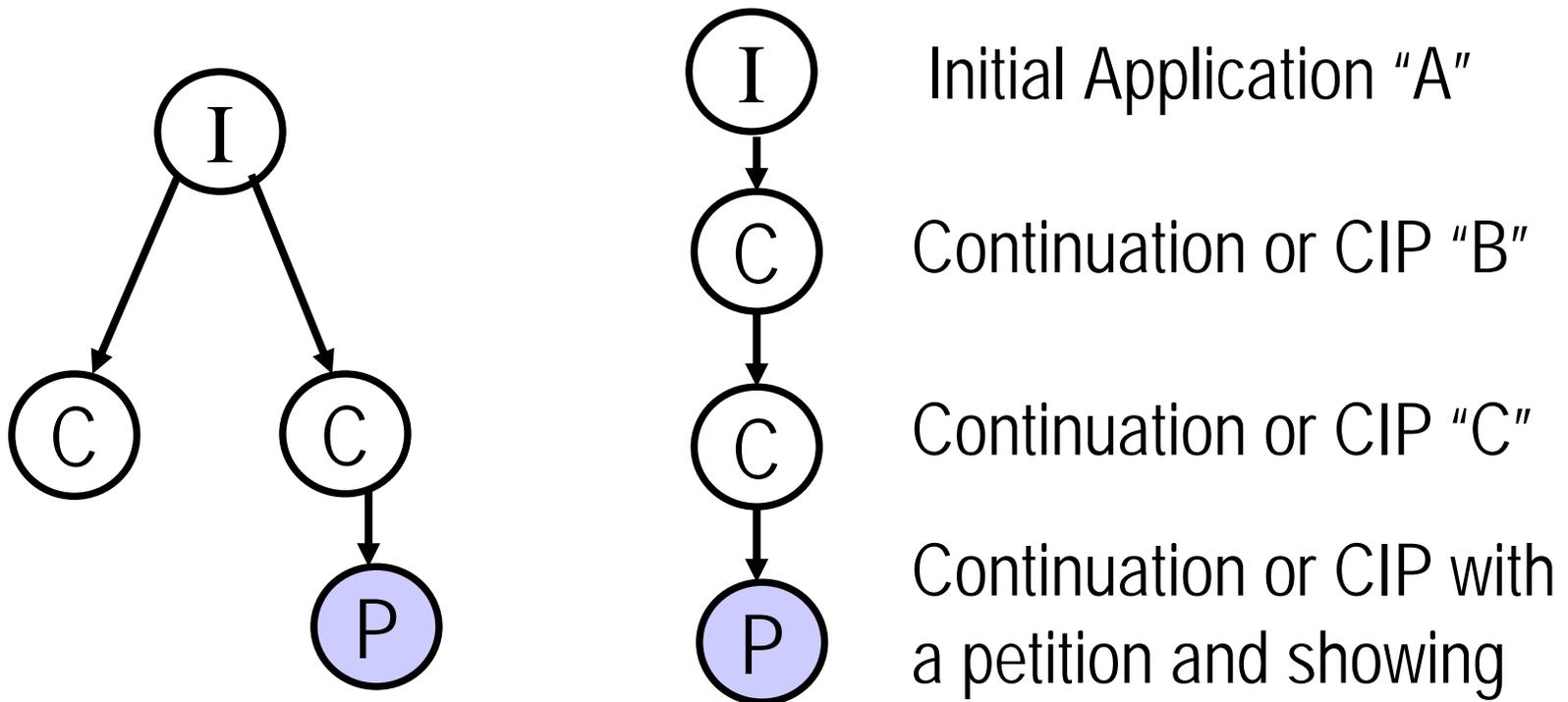




Continuing Applications

37 CFR 1.78(d)(1)(vi)

Applicant may file a third or subsequent continuation or CIP application with a petition and showing. For example:

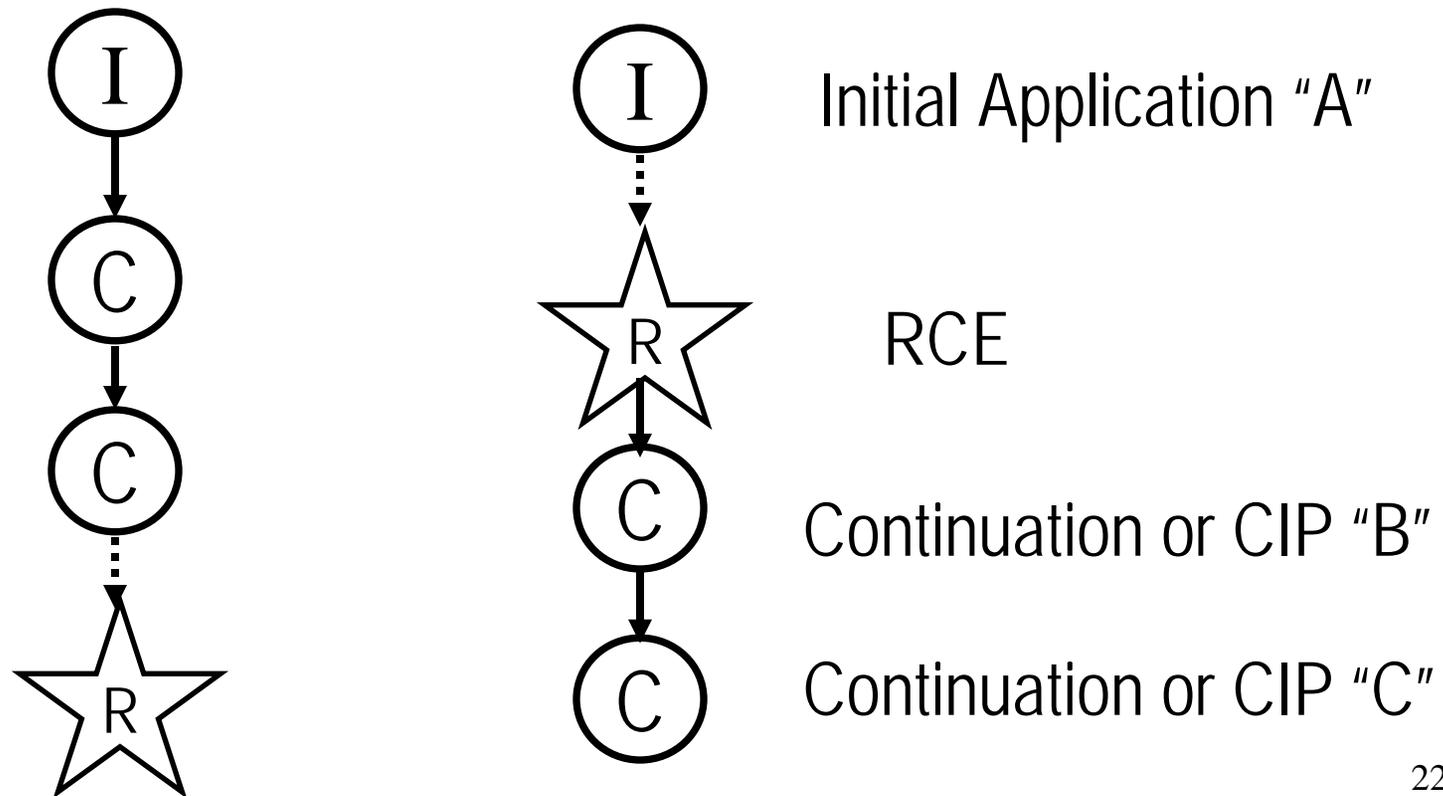




Request for Continued Examination

37 CFR 1.114(f)

Applicant may file a single RCE in an application family, without a petition or showing. For example:

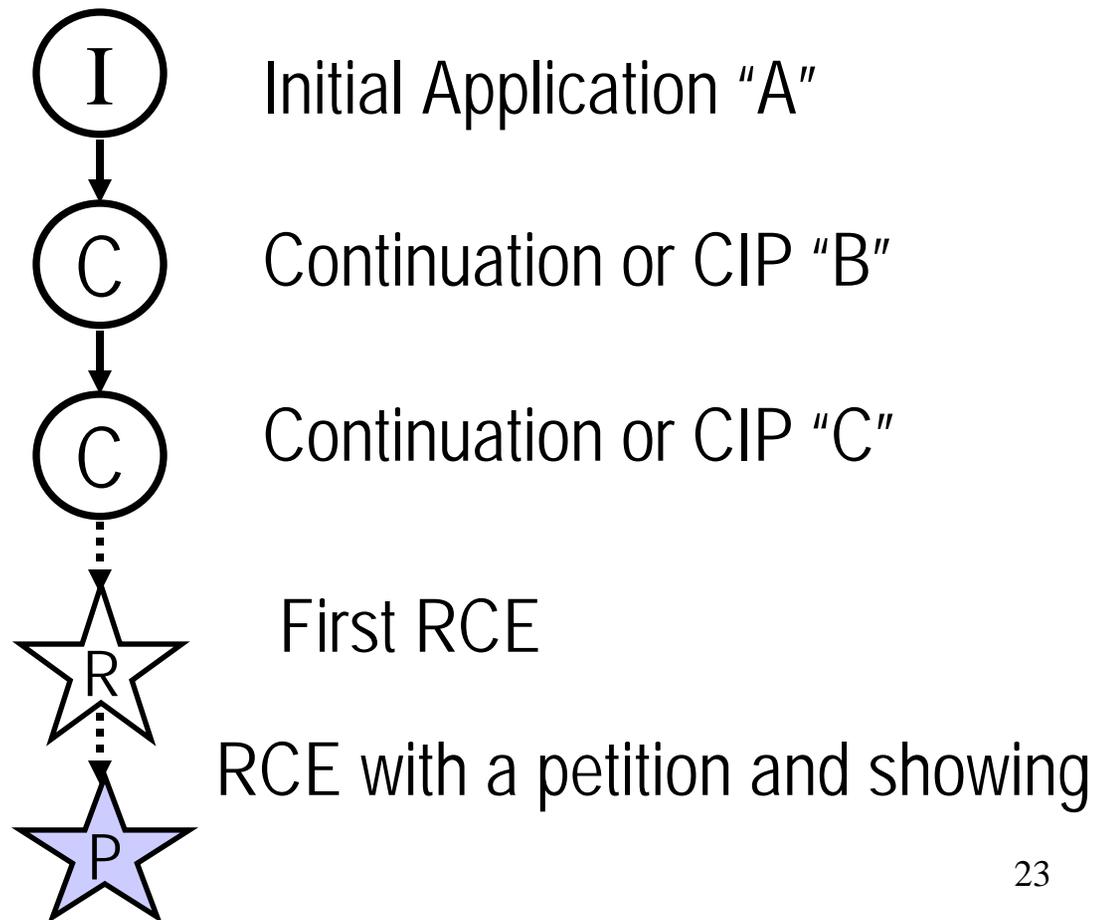




Request for Continued Examination

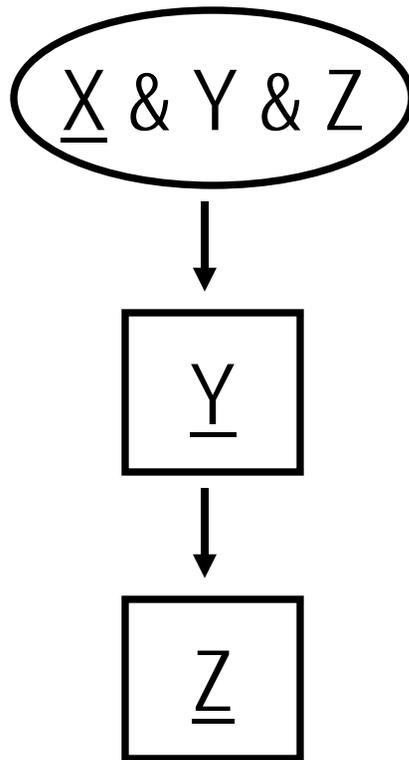
37 CFR 1.114(g)

Applicant may file a second or subsequent RCE with a petition and showing. For example:





Divisional Applications



For example: the initial application discloses and claims inventions "X", "Y", and "Z"; the application is subject to a 3-way restriction requirement; and applicant elected invention "X" for examination in the initial application.

Divisional Application #1 claims only invention "Y", a non-elected invention that was not examined in the initial application.

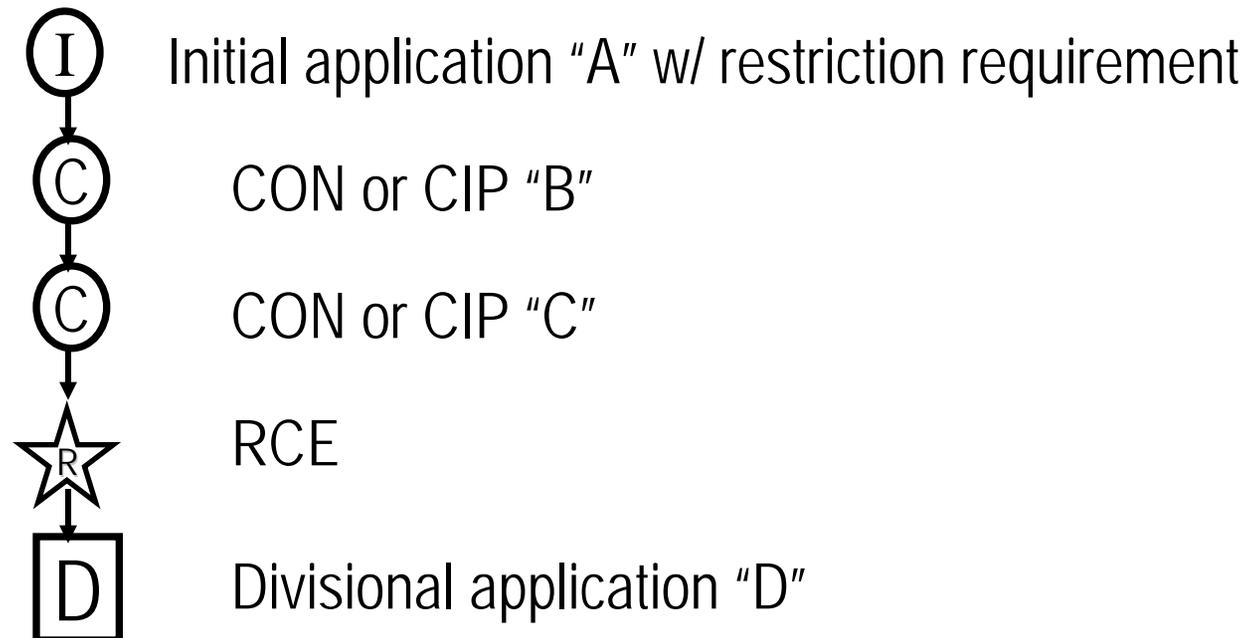
Divisional Application #2 claims only invention "Z", a non-elected invention that was not examined in the initial application and the divisional application #1.



Divisional Applications

37 CFR 1.78(d) and 1.114(f)

A divisional application is not required to be filed during the pendency of the initial application, as long as the copendency requirement of 35 USC 120 is met. For example:



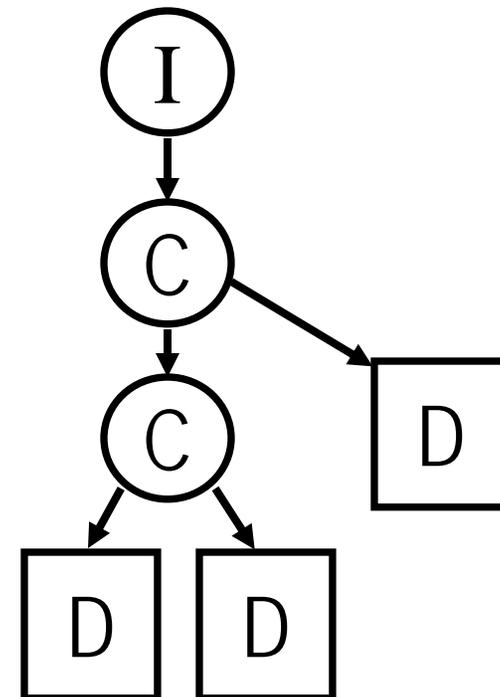
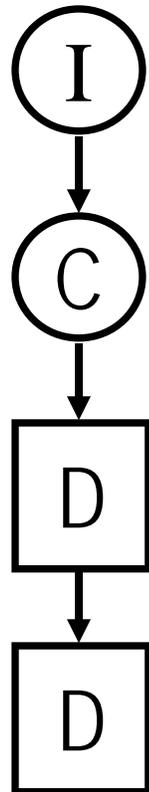


Divisional Applications

37 CFR 1.78(d)(1)(ii)

Applicant may file the divisional applications in parallel or in series.

For example:

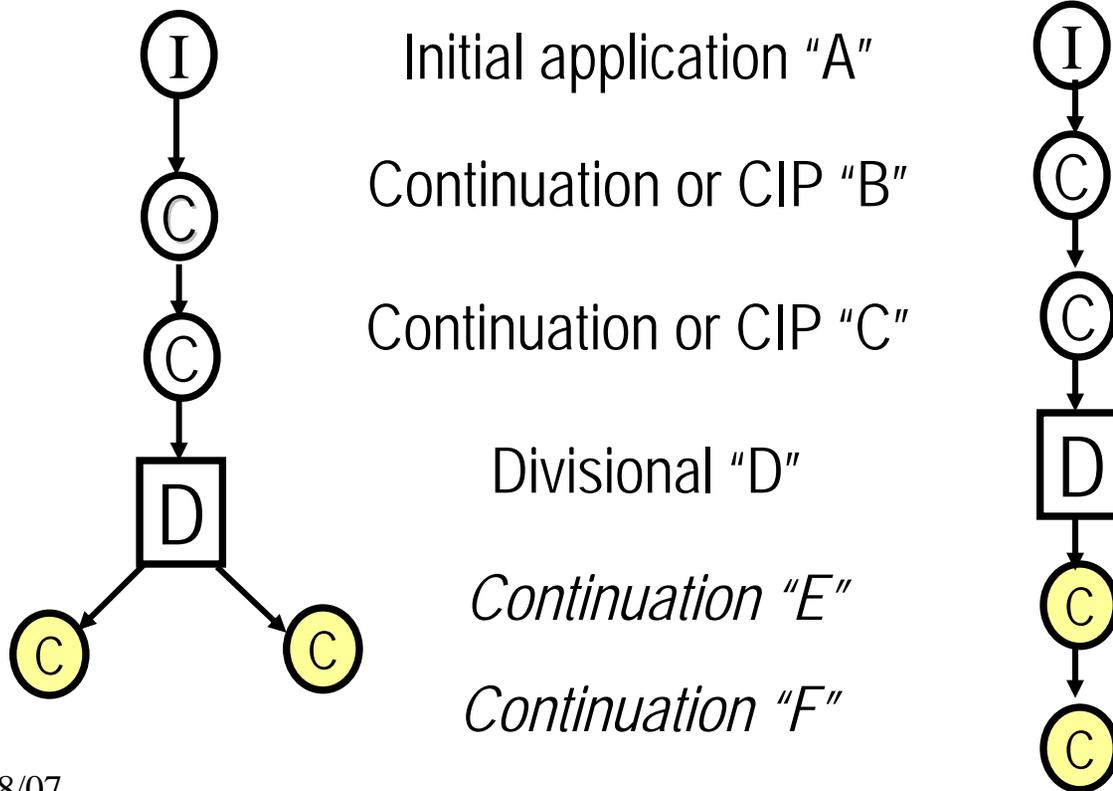




Divisional Applications

37 CFR 1.78(d)(1)(ii) and (iii)

Applicant may file two continuation applications (but not CIPs) of a divisional application, without a petition and showing. For example:

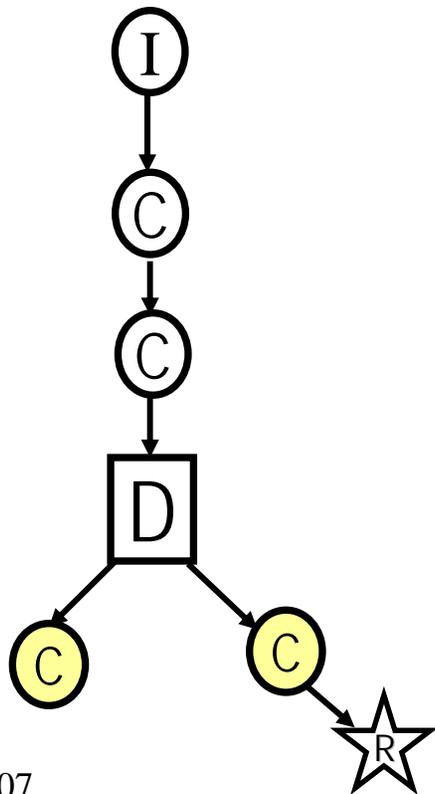




Request for Continued Examination

37 CFR 1.114(f)

Applicant may file a single RCE in a divisional application family, without a petition and showing. For example:





Effective Date Provisions

Effective Date: November 1, 2007

Publication Date of the Final Rule: August 21, 2007

Compliance Date for 37 CFR 1.78(f): February 1, 2008



Continuing Applications

37 CFR 1.78(a) and (d)

- The rule changes to continuing application practice under §1.78(a) and § 1.78(d)(1) are applicable to:
 - Applications* filed on or after November 1, 2007; and
 - Applications entering the national stage on or after November 1, 2007.
- This final rule does not impact an applicant's ability to file continuing applications between August 21, 2007 and October 31, 2007.

*Including reissue applications, but not reexamination proceedings.



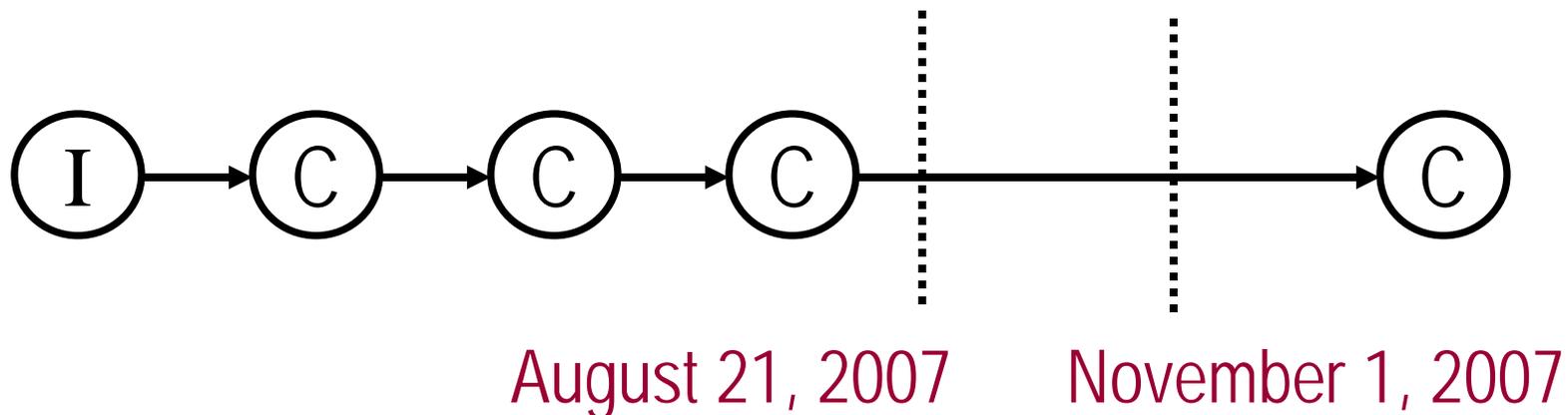
Transitional Practice for Continuing Applications *72 Fed. Reg. 46736-37*

- Applicant may file “one more” continuation or CIP application, without a petition and showing for applications filed (or entered the national stage) before August 21, 2007.
- Any continuation or CIP application filed between August 21, 2007 and October 31, 2007 will be taken into account in determining whether an applicant may file “one more” continuation or CIP application.



Transitional Practice for Continuing Applications *72 Fed. Reg. 46736-37*

Applicant may file “one more” continuation or CIP application on or after November 1, 2007, for applications filed before August 21, 2007, without a petition and showing. For example:





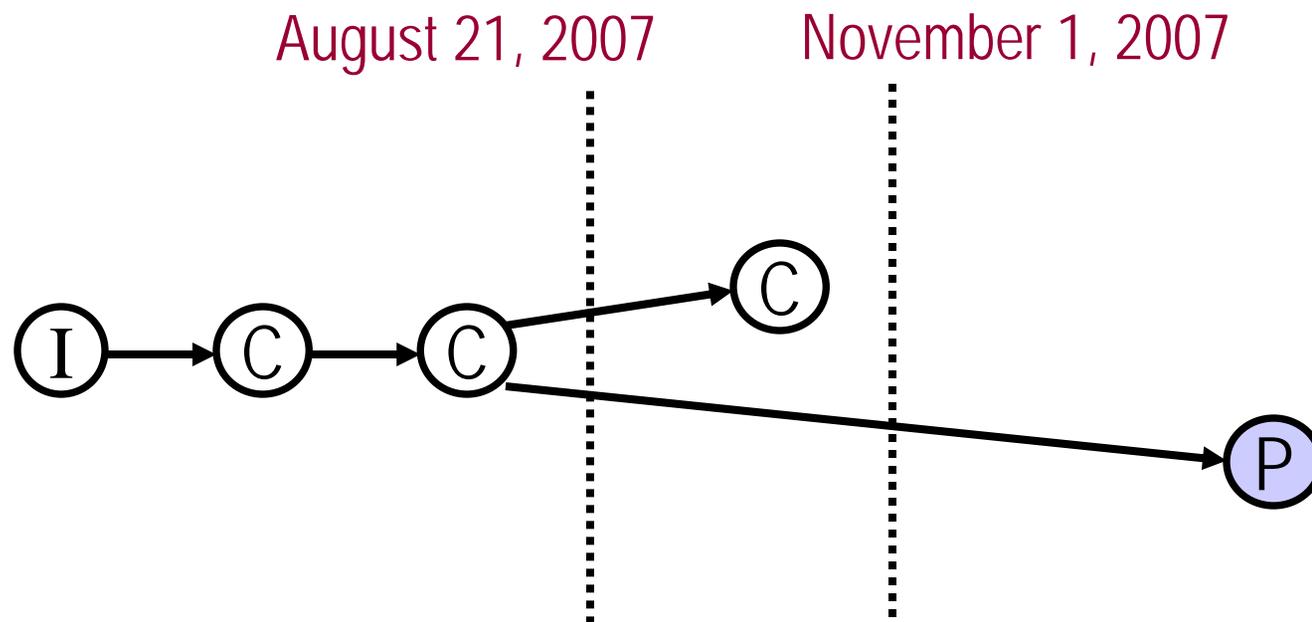
Transitional Practice for Continuing Applications *72 Fed. Reg. 46736-37*

- Applicant may not file “one more” continuation or CIP application on or after November 1, 2007, without a petition and showing if
 - Applicant filed one or more continuation or CIP applications between August 21, 2007 and October 31, 2007.
- Applicant may not file an “extra” (*i.e.*, third) continuation or CIP application on or after November 1, 2007, without a petition and showing if
 - Applicant filed fewer than two continuation or CIP applications before August 21, 2007.



Transitional Practice for Continuing Applications *72 Fed. Reg. 46736-37*

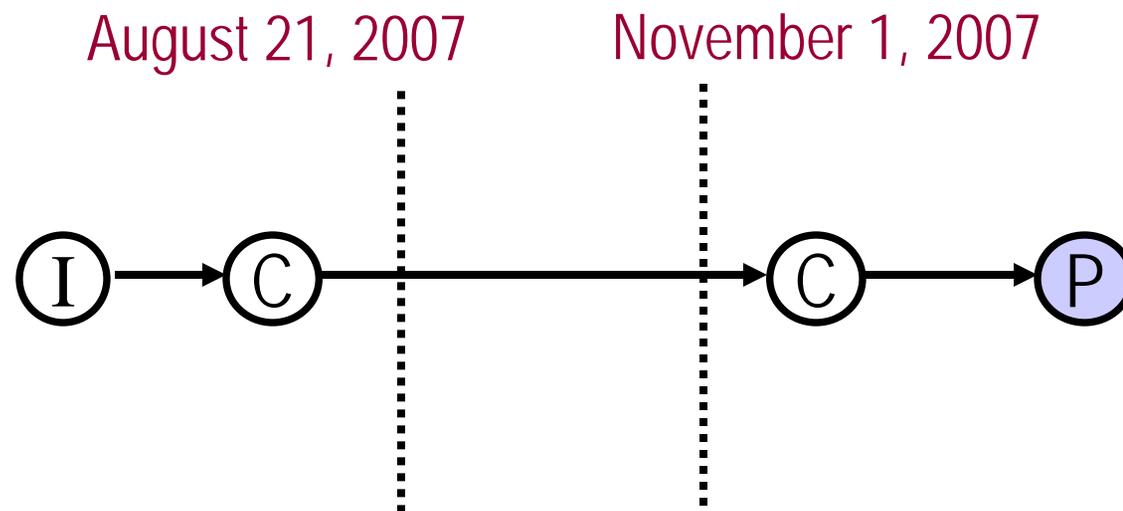
Applicant may not file “one more” continuation or CIP application on or after November 1, 2007, without a petition and showing if applicant filed one or more continuation or CIP applications between August 21, 2007 and October 31, 2007. For example:





Transitional Practice for Continuing Applications *72 Fed. Reg. 46736-37*

Applicant may not file an “extra” (*i.e.*, third) continuation or CIP application on or after November 1, 2007, without a petition and showing if applicant filed fewer than two continuation or CIP applications before August 21, 2007. For example:





Request for Continued Examination

37 CFR 1.114

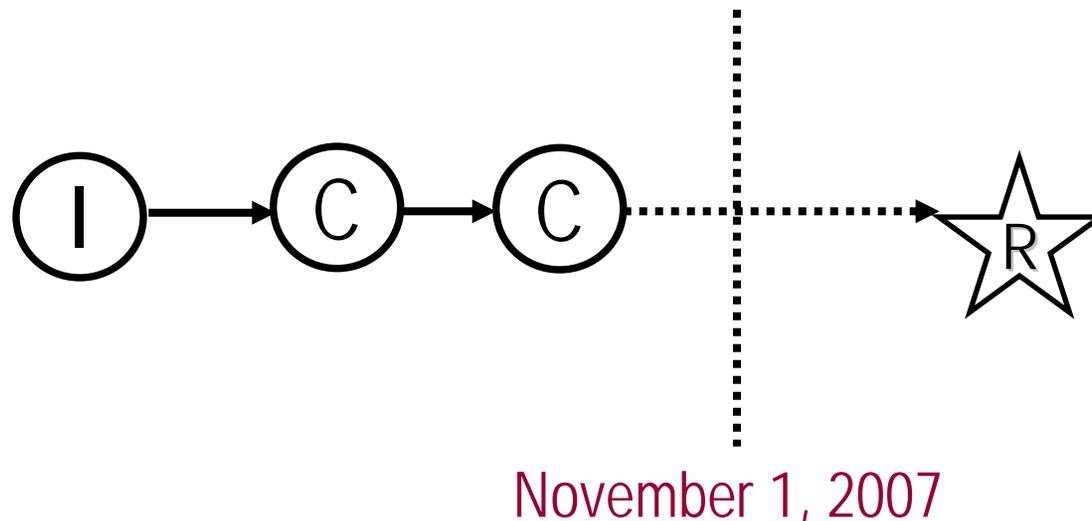
- The rule changes to RCE practice under § 1.114 are applicable to:
 - Any RCE filed on or after November 1, 2007.
- Any RCE filed on or after November 1, 2007, that is a second or subsequent RCE in an application family will require a petition and showing.



Request for Continued Examination

37 CFR 1.114

Applicant may file one RCE in an application family on or after November 1, 2007, without a petition and showing. For example:

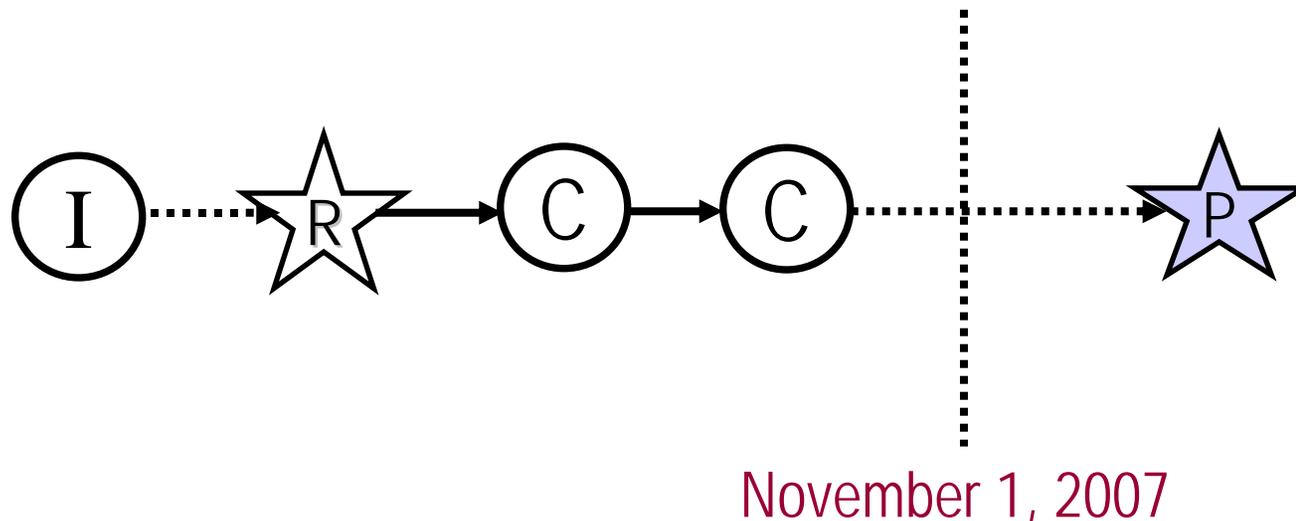




Request for Continued Examination

37 CFR 1.114

Applicant may file a second or subsequent RCE in an application family on or after November 1, 2007, with a petition and showing. For example:





Examination of Claims

37 CFR 1.75(b)

- The rule changes to examination of claims practice under § 1.75 are applicable to:
 - Applications* filed on or after November 1, 2007;
 - Applications entering the national stage on or after November 1, 2007; and
 - Applications* in which a FAOM was not mailed before November 1, 2007.
 - For example, applicant is required to file an ESD in an application that contains more than 5/25 claims if a FAOM was not mailed before November 1, 2007.

*Including reissue applications, but not reexamination proceedings.



Examination of Claims

37 CFR 1.75(b)

- An ESD will not be required in a reissue application if the reissue application does not seek to change the claims in the patent being reissued.
 - A change in the claims in the patent being reissued is sought either by:
 - An amendment to a claim or addition of a claim; or
 - An amendment to the specification which changes a claim.



Applications Containing Patentably Indistinct Claims - *37 CFR 1.78(f)*

- The rule changes to § 1.78(f) are applicable to:
 - Applications pending on or after November 1, 2007.
- For applications filed before November 1, 2007,
 - Applicant must comply with the requirements under §§1.78(f)(1) and 1.78(f)(2):
 - Within the time periods set forth in §§ 1.78(f)(1) and 1.78(f)(2); or
 - By February 1, 2008, whichever is later.



Continuing Applications and Requests for Continued Examination

37 CFR 1.78 and 1.114



Continuing Applications

37 CFR 1.78(a)(1)

- A continuing application is a nonprovisional application (or an international application designating the U.S.) that claims the benefit under 35 U.S.C. 120, 121, or 365(c) of a prior-filed nonprovisional application (or international application designating the US).
- A continuing application can be:
 - A divisional application;
 - A continuation application; or
 - A continuation-in-part (CIP) application.



Continuing Applications

37 CFR 1.78(a)(2)

- A divisional application is a continuing application that
 - Discloses and claims only an invention(s) that was disclosed and claimed in a prior-filed application, but
 - Was subject to a requirement for restriction in the prior-filed application, and
 - Was not elected for examination and was not examined in any prior-filed application. *See also § 1.78(d)(1)(ii).*



Continuing Applications

37 CFR 1.78(a)(3) and (a)(4)

- A continuation application is a continuing application that discloses and claims only an invention(s) that was disclosed in the prior-filed application.
- A CIP application is a continuing application that discloses subject matter that was not disclosed in the prior-filed application.



Continuing Applications

37 CFR 1.78(a)

- Applicants may file a “voluntary” divisional application as a continuation application, if the prior-filed application is not subject to a restriction requirement.
 - Applicant may file 2 continuation or CIP applications plus a RCE in an application family without a petition and showing.
 - Applicant may also file a suggested requirement for restriction (SRR) in the prior-filed application if there are claims to two or more inventions.



Continuing Applications

37 CFR 1.78(d)

- Any benefit claim to a prior-filed nonprovisional application must satisfy at least one of the paragraphs in § 1.78(d)(1) :
 - § 1.78(d)(1)(i) – Conditions for 2 CONs or CIPs of an initial application.
 - § 1.78(d)(1)(ii) – Conditions for divisional applications.
 - § 1.78(d)(1)(iii) – Conditions for 2 CONs of a divisional application.
 - § 1.78(d)(1)(iv) – Conditions for an “extra” CON or CIP of an international application in which a Demand and the basic national fee have not been filed.
 - § 1.78(d)(1)(v) – Conditions for an “extra” CON or CIP for a nonprovisional application abandoned in preexamination.
 - § 1.78(d)(1)(vi) – Conditions for a third or subsequent CON or CIP filed with a petition and showing.



Continuing Applications

37 CFR 1.78(d)

- If applicant presents a benefit claim that is not permitted by § 1.78(d)(1):
 - The Office will refuse to enter the improper benefit claim and refuse the benefit of the filing date of the prior-filed application.
 - The application will be treated as entitled only to the actual filing date and will be subject to prior art based on the actual filing date of the application.
 - For example, if the prior-filed application is published more than 1 year prior to the actual filing date of the application, the publication can be used as prior art under 35 USC 102(b).



Continuing Applications

37 CFR 1.78(d)(3)

- Applicant must identify the claims in a CIP application that are supported by the prior-filed application.
 - Any claims that are not identified will be subject to prior art based on the actual filing date of the CIP application.
 - A new ground of rejection necessitated by a late submission of such an identification will not preclude a second or subsequent action from being made final.
- The examiner may require applicant to identify where (by page and line or paragraph number) the specification of the application or the prior-filed application provides support and enablement for a claim. *See* § 1.105(a)(1)(ix).



Continuing Applications

37 CFR 1.78(d)

- Applicant may request to have a continuation application placed on an examiner's amended (Regular Amended) docket under the optional streamlined continuation application procedure, if:
 - The continuation application is complete including a specification, at least one claim, and drawings (if required), and is filed on or after November 1, 2007;
 - The application discloses and claims only an invention(s) that was disclosed and claimed in the prior-filed application;
 - The applicant agrees that any election in response to a restriction requirement carries over to the continuation application;
 - The prior-filed application is under final or appeal; and
 - The prior-filed application is expressly abandoned upon filing of the continuation application.



Continuing Applications

37 CFR 1.78(d)

- Applicant cannot rely upon a restriction requirement to file a divisional application in the following situations:
 - Applicant traverses the restriction requirement;
 - The restriction requirement is provisional, such as a requirement for election of species in an application that contains a claim that is generic to all of the claimed species (*see* MPEP 809); and
 - The claims to the non-elected invention may be rejoined at the request of the applicant (*see* MPEP 821.04 *et seq.*).



Continuing Applications

37 CFR 1.78(d)

- When a restriction requirement is withdrawn in these situations, any divisional application that has been filed as a result of the restriction requirement will not be proper under §§ 1.78(a)(2) and 1.78(d)(1)(ii).
- Applicant may delete the benefit claim or change the benefit claim, if appropriate (*e.g.*, to a continuation or CIP application if conditions under § 1.78(d)(1)(i) are satisfied).



Continuing Applications

37 CFR 1.78(d)

- For an application that contains a generic claim,
 - Applicant should conclude prosecution of the generic claim in the initial application and its continuation or CIP applications, including exhaustion of any available appeals, before filing a divisional application to a non-elected species.
- For an application that contains withdrawn claims that could be rejoined under the rejoinder practice,
 - Applicant should cancel the withdrawn claims before filing a divisional application to the non-elected invention.



Continuing Applications

37 CFR 1.78(d)

- Applicant also cannot rely upon the restriction requirement in these situations to avoid the requirement of an ESD.
 - The reinstated or rejoined claims will be taken into account in determining whether the application exceeds the 5/25 claim threshold. *See* § 1.75(b)(5).
 - For example, if the application exceeds the 5/25 claim threshold after the withdrawn claims are reinstated or rejoined and an ESD was not filed before FAOM, the Office will notify applicant and require applicant to amend the application such that it contains no more than 5/25 claims.



Continuing Applications

37 CFR 1.78(d)(1)(iv)

- Applicant may file an extra continuation or CIP application without a petition and showing, if the following conditions are satisfied:
 - The prior-filed application is an international application designating the US;
 - A Demand has not been filed and the basic national fee has not been paid in the prior-filed application; and
 - The prior-filed application does not claim any benefit of any other nonprovisional application or international application designating the US.



Continuing Applications

37 CFR 1.78(d)(1)(v)

- Applicant may file an extra continuation or CIP application without a petition and showing, if the following conditions are satisfied:
 - The prior-filed application is an application under 35 USC 111(a);
 - The prior-filed application became abandoned due to the failure to timely reply to an Office notice issued under §1.53(f) (*e.g.*, a notice to file missing parts);
 - The prior-filed application does not claim any benefit of any other nonprovisional application or international application designating the US.



Petition and Showing

37 CFR 1.78(d)(1)(vi) and 1.114(g)

- Applicant may file a third or subsequent continuation or CIP application or a second or subsequent RCE if applicant files:
 - A petition in compliance with § 1.78(d)(1)(vi) or 1.114(g);
 - The petition fee set forth in § 1.17(f);
 - An amendment, argument, or evidence; and
 - A showing that the amendment, argument, or evidence sought to be entered could not have been submitted during the prosecution of the prior-filed application, or prior to the close of prosecution in the application.

Note: “An amendment, argument, or evidence” includes any new claims in a continuing application, but not an IDS.



Petition and Showing

37 CFR 1.78(d)(1)(vi) and 1.114(g)

- The petitions will be decided on a case-by-case basis as to whether applicant's showing is sufficient.
- The Office may review the prosecution history of the prior-filed application(s) or require additional information.
- The Office may also consider the following factors:
 - Whether applicant should file an appeal or a petition under §1.181 rather than a continuing application or an RCE.
 - The number of applications filed in parallel or in series with substantially identical disclosures; and
 - Whether the amendment, argument, or evidence was submitted with reasonable diligence.



Examination of Claims

37 CFR 1.75(b)



Examination of Claims

37 CFR 1.75(b)

- Applicants may present, without an examination support document (ESD), up to:
 - 5 independent claims, and
 - 25 total claims in an application.
- Applicant may present more than 5/25 claims, if applicant files an ESD in compliance with § 1.265 before a FAOM.



Examination of Claims

37 CFR 1.75(b)

- If an ESD in compliance with § 1.265 is not filed before FAOM, the application must remain at 5/25 or fewer claims.
- In determining whether an application exceeds the 5/25 claim threshold:
 - Withdrawn claims are not taken into account, unless they are reinstated or rejoined (§ 1.75(b)(5)); but
 - Claims of other commonly owned applications having a patentably indistinct claim will be taken into account (not just the patentably indistinct claims) (§ 1.75(b)(4)).



Examination of Claims

37 CFR 1.75(b)

- If an application contains claims to more than one invention, applicants may file a suggested requirement for restriction (SRR) under § 1.142(c).
- Any SRR must be:
 - Accompanied by an election without traverse of an invention to no more than 5/25 claims, identifying the elected claims; and
 - Filed before the earlier of a FAOM or restriction requirement.
 - Once the Office issues a restriction requirement, applicant may not simply submit an alternative SRR.



Examination of Claims

37 CFR 1.75(b)

- If the SRR is accepted,
 - The claims to the non-elected invention(s) will be withdrawn;
 - The claims to the elected invention will be examined; and
 - The FAOM will set out the restriction requirement,
 - In a manner similar to a restriction requirement previously made by telephone (*see* MPEP 810).

Note: Excess claims fees cannot be refunded for withdrawn claims that are not canceled prior to FAOM. *See* 35 USC 41(a)(2).



Examination of Claims

37 CFR 1.75(b)

- If a SRR is not accepted in an application containing more than 5/25 claims, the applicant will be notified.
 - The examiner may make either no restriction requirement or a different restriction requirement.
- If the examiner does not make a restriction requirement,
 - The notice will provide a two-month time period that is not extendable under § 1.136(a).
 - To avoid abandonment, the applicant must:
 - File an ESD in compliance with § 1.265; or
 - Amend the application to contain no more than 5/25 claims.



Examination of Claims

37 CFR 1.75(b)

- If the examiner makes a different restriction requirement,
 - The notice will provide a two-month time period that is not extendable under § 1.136(a).
 - Applicant must make an election to avoid abandonment.
 - If the elected invention is drawn to more than 5/25 claims, applicant must also:
 - File an ESD in compliance with § 1.265 that covers each elected claim; or
 - Amend the application to contain no more than 5/25 claims to the elected invention.



Examination of Claims

37 CFR 1.75(b)(3)

- Applicant will be notified if:
 - The application contains more than 5/25 claims;
 - An ESD has been inadvertently omitted;
 - A SRR is not filed; and
 - It is before FAOM.



Examination of Claims

37 CFR 1.75(b)(3)

- For applications filed (or that entered the national stage) on or after November 1, 2007 and that contain more than 5/25 claims without an ESD, applicant will be notified:
 - The notice will set a two-month time period that is not extendable under § 1.136(a).
 - To avoid abandonment, applicant must:
 - File an ESD in compliance with § 1.265; or
 - Amend the application to contain no more than 5/25 claims.



Examination of Claims

72 Fed. Reg. 46728

- For applications in which a FAOM was not mailed before November 1, 2007 and that contain more than 5/25 claims without an ESD:
 - The notice will set a two-month time period that is extendable under § 1.136(a), up to maximum of six months.
 - To avoid abandonment, applicant must:
 - File a SRR;
 - File an ESD in compliance with § 1.265; or
 - Amend the application to contain no more than 5/25 claims.



Examination of Claims

37 CFR 1.75(b)(3)

- For applications in which a FAOM was not mailed before November 1, 2007 and that contain more than 5/25 claims without an ESD (continued):
 - The notice may be combined with a restriction requirement.
 - To avoid abandonment, applicant must make an election.
 - If the elected invention is drawn to more than 5/25 claims, applicant must also:
 - File an ESD in compliance with § 1.265 that covers each elected claim; or
 - Amend the application to contain no more than 5/25 claims to the elected invention.



Examination of Claims

37 CFR 1.75(b)

- If an ESD in compliance with § 1.265 was not filed before FAOM, an amendment that results in the application containing more than 5/25 claims will be treated as non-responsive.
 - The notice will set a two-month time period that is not extendable under § 1.136(a).
 - To avoid abandonment, applicant must file an amendment that does not result in the application containing more than 5/25 claims.



Examination of Claims

37 CFR 1.75(b)(4)

- For commonly owned applications containing at least one patentably indistinct claim (that is not a withdrawn claim),
 - The Office will treat each application as having the total number of claims present in all of the applications (and not just the claim that is patentably indistinct), for the purposes of determining whether each application exceeds the 5/25 claim threshold.



Examination of Claims

37 CFR 1.75(b)(4)

- For example, applications “A” and “B” are commonly owned and each contains 3/20 claims.
 - If application “A” contains a claim that is patentably indistinct from the claims in application “B”,
 - The Office will treat each application as having 6/40 claims.
 - In response to a notice under § 1.75(b), applicant must:
 - Cancel the patentably indistinct claim(s) from all but one application;
 - File an ESD before FAOM in applications “A” and “B”; or
 - Amend the application(s) such that both applications taken together contain no more than 5/25 claims.



Examination of Claims

37 CFR 1.75(b)(4)

- The Office will treat the application as no longer pending for purposes of § 1.75(b)(4) if:
 - A notice of allowance is issued;
 - The application is recognized as abandoned;
 - A notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 USC 141 is filed; or
 - A civil action under 35 USC 145 or 146 is commenced.



Examination of Claims

37 CFR 1.75(b)

- A dependent claim must:
 - Be in dependent form;
 - Refer back to another claim(s) in the same application;
 - Incorporate by reference all the limitations of the previous claim to which it refers; and
 - Specify a further limitation of the subject matter of the previous claim.



Examination of Claims

37 CFR 1.75(b)(2)

- For determining whether an application exceeds the 5/25 claim threshold and for claims fees calculation purposes,
 - A claim that does not incorporate by reference all the limitations of the claim to which it refers will be treated as an independent claim.
 - A claim that refers to a claim of a different statutory class of invention will also be treated as an independent claim.
 - For example, a method of using the composition of claim 1 comprising....



Examination of Claims

37 CFR 1.75(b)(4)

- For determining whether an application exceeds the 5/25 claim threshold and for claims fees calculation purposes (continued),
 - A multiple dependent claim will be considered to be that number of claims to which direct reference is made therein.
 - A claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim.
 - In the following example, each claim will be considered to be 3 claims:
 - Claim 4. A device according to claim 1, 2, or 3, further comprising...
 - Claim 5. A device according to claim 4, further comprising...



Examination Support Documents (ESD)

37 CFR 1.265



Examination Support Document

37 CFR 1.265

- If applicant presents more than 5/25 claims in an application, an ESD in compliance with § 1.265 is required before FAOM.
 - The information will assist the examiner in the determination of the patentability of the claims, such as:
 - Determining the effective filing date of each claim;
 - Interpreting the claims before a prior art search; and
 - Understanding the invention, the state of the art, and the most closely related prior art cited by the applicant.



Examination Support Document

37 CFR 1.265(a)

- An ESD must include:
 - A preexamination search statement;
 - Listing of references deemed most closely related to the subject matter of each claim;
 - Identification of claim limitations disclosed by each reference;
 - Detailed explanation of patentability; and
 - Showing of support under 35 USC 112, ¶ 1.



Examination Support Document

37 CFR 1.265(a)(1) and (b)

- A preexamination search statement must include:
 - A statement that a preexamination search in compliance with § 1.265(b) was conducted.
 - An identification of:
 - The field of search by US class and subclass, the date of the search; and
 - For database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search (in the manner set forth in MPEP 719.05.)



Examination Support Document

37 CFR 1.265(a)(1) and (b)

- A preexamination search under § 1.265(b) must:
 - Be directed to the claimed invention; and
 - Encompass all of the limitations of each of the claims, giving the claims the broadest reasonable interpretation.



Examination Support Document

37 CFR 1.265(a)(1) and (b)

- The preexamination search must encompass all the limitations of the independent claims and the dependent claims separately from the claim(s) from which they depend.
 - For example, if independent claim 1 recites elements “A”, “B”, and “C”, and dependent claim 2 recites element “D”, even if applicant cannot find one of the elements “A”, “B”, and “C”, applicant must still search for element “D”.



Examination Support Document

37 CFR 1.265(a)(1) and (b)

- The preexamination search must involve:
 - U.S. patents and patent application publications;
 - Foreign patent documents; and
 - Non-patent literature.
- These sources cannot be eliminated,
 - Unless the applicant justifies with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated source.
 - The justification must be included in the preexamination search statement.



Examination Support Document

37 CFR 1.265(a)(2) and (c)

- The listing of references must include:
 - A list identifying each cited reference in compliance with §§1.265(c)(1) and (c)(2);
 - A legible copy of each cited reference, except for U.S. patents and patent application publications; and
 - Any existing English language translation of each cited non-English language reference.



Examination Support Document

37 CFR 1.265(a)(2)

- The references that would be most closely related to the subject matter of each claim include any reference that discloses:
 - The greatest number of limitations in an independent claim;
 - A limitation of an independent claim that is not shown in any other reference; or
 - A limitation of a dependent claim that is not shown in any other reference.
- Applicant must consider all of the references that applicant has knowledge of, regardless of the source.



Examination Support Document

37 CFR 1.265(a)(3)

- To identify all of the claim limitations that are disclosed by each reference, applicant may map the limitations of each claim to the reference.
 - For each claim, identifying where the cited reference discloses a feature(s), showing(s) or teaching(s) that is relevant to each limitation of such claim.



Examination Support Document

37 CFR 1.265(a)(3)

- Applicant must identify at least one appearance in the reference of a specific feature, showing, or teaching for which the reference is being cited.
 - Applicant would not need to specifically point out more than one occurrence.
 - However, applicant should do so where the additional appearance may not be apparent and may have some additional significance.



Examination Support Document

37 CFR 1.265(a)(3)

- If applicant recognizes that a reference is relevant for more than one feature, showing, or teaching, the applicant would need to specifically identify:
 - Each additional feature, showing, or teaching; and
 - The portion where the feature, showing, or teaching appears in the document.
- A mere statement indicating that the entire reference, or substantially the entire reference, is relevant would not be sufficient.



Examination Support Document

37 CFR 1.265(a)(4)

- The ESD must include a detailed explanation that particularly points out how each of the independent claims is patentable over the references cited in the listing of references.
 - Applicant must set out with particularity, by reference to one or more specific claim limitations, why the claimed subject matter is not described in the references, taken as a whole.
 - A general statement that all of the claim limitations are not described in a single reference will not be sufficient.



Examination Support Document

37 CFR 1.265(a)(4)

- Applicant must explain why a person of ordinary skill in the art would not have combined the references to arrive at the claimed subject matter.
- The applicant must also explain why the claim limitations referenced render the claimed subject matter novel and non-obvious over the cited prior art.



Examination Support Document

37 CFR 1.265(a)(5)

- An ESD must include a showing of where each limitation of the claims finds support under 35 USC 112, ¶ 1, in the written description of the specification.
 - If the application claims the benefit of a prior-filed application(s), the showing must also include where each claim limitation finds support in each such application.
 - Applicant must identify each means- (or step-) plus-function limitation and the corresponding structure, material, or acts.



Examination Support Document

37 CFR 1.265(d)

- A supplemental ESD is required:
 - When applicant presents an amendment to the claims that is not encompassed by the previous ESD; and
 - When applicant files an IDS that includes a reference that is deemed as closely, or more closely, related to the subject matter of at least one claim than the references provided in the previous ESD.



Examination Support Document

37 CFR 1.265(e)

- Applicant will be notified if:
 - The ESD or preexamination search is deemed to be insufficient; or
 - The claims have been amended such that the ESD no longer covers each claim.



Examination Support Document

37 CFR 1.265(e)

- The notice will provide a two-month time period that is not extendable under § 1.136(a).
- To avoid abandonment, the applicant must within the time period either:
 - File a corrected or supplemental ESD; or
 - Amend the application such that it contains no more than 5/25 claims.



Examination Support Document

37 CFR 1.265(f)

- If an ESD is accompanied by a certification under § 1.265(f), the ESD is not required to include an identification of claim limitations disclosed by each reference under § 1.265(a)(3).
 - This exemption applies only to applications filed by a small entity as defined by the Regulatory Flexibility Act (5 USC 601 *et seq.*).
 - Questions related to whether an entity meets this definition may be directed to the Small Business Administration.
 - An entity that meets the definition of a small entity set forth in § 1.27 for paying reduced fees may or may not meet this definition.



Patent Applications Containing Patentably Indistinct Claims

37 CFR 1.78(f)



Identification of Other Applications

37 CFR 1.78(f)(1)(i)

- Applicant must identify other commonly owned application(s) or patent(s) that has:
 - An inventor in common with the application; and
 - A claimed filing or priority date within two months of the claimed filing or priority date of the application taking into account the actual filing date, any foreign priority date, and filing date of a prior-filed provisional or nonprovisional application for which a benefit is claimed.



Identification of Other Applications

37 CFR 1.78(f)(1)(i)

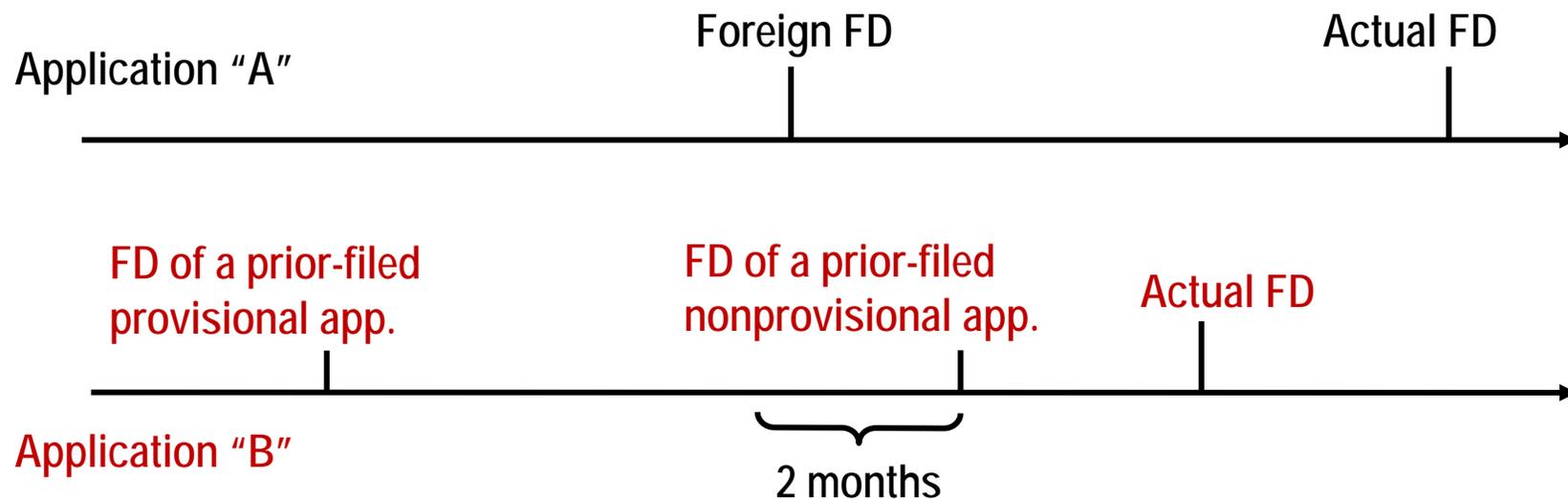
- For example, if application “A” and application “B” are commonly owned, have at least one common inventor, and claim the benefit of the same prior-filed nonprovisional application,
 - Applicant for application “A” must identify application “B”;
and
 - Applicant for application “B” must identify application “A”.



Identification of Other Applications

37 CFR 1.78(f)(1)(i)

- For the example below, applicant for application “A” is required to identify application “B” and applicant for application “B” is required to identify application “A” because the foreign priority date of application “A” is within two months from the filing date of a prior-filed nonprovisional application for which benefit is claimed in application “B”.





Identification of Other Applications

37 CFR 1.78(f)(1)(ii)

- Applicant must submit the identification of other commonly owned applications or patents within the later of:
 - Four months from the actual filing date of the application or from the date on which the national stage commenced; or
 - Two months from the mailing date of the initial filing receipt in the other application.



Applications Containing Patentably Indistinct Claims - *37 CFR 1.78(f)(2)(i)*

- A rebuttable presumption will exist that the application and the other commonly owned application(s) or patent(s) contain at least one patentably indistinct claim,
 - If the other application or patent has:
 - An inventor in common with the application;
 - A claimed filing or priority date that is the same as the claimed filing or priority date of the application; and
 - Substantial overlapping disclosure with the application.
 - Substantial overlapping disclosure exists if the other application or patent has support for at least one claim in the application.



Applications Containing Patentably Indistinct Claims - *37 CFR 1.78(f)(2)(ii)*

- If the rebuttable presumption under § 1.78(f)(2) exists, applicant must either:
 - Rebut the presumption by explaining how the application contains only patentably distinct claims; or
 - Submit a terminal disclaimer.
- If the other application is pending, applicant must also explain why there are two or more pending applications which contain patentably indistinct claims.



Applications Containing Patentably Indistinct Claims - *37 CFR 1.78(f)(2)(iii)*

- If the rebuttable presumption under § 1.78(f)(2)(i) exists, applicant must submit a rebuttal or a terminal disclaimer within the later of:
 - Four months from the actual filing date of the application or from the date on which the national stage commenced;
 - The date on which a patentably indistinct claim is presented; or
 - Two months from the mailing date of the initial filing receipt in the other application.



Applications Containing Patentably Indistinct Claims - 37 CFR 1.78(f)(3)

- For commonly owned pending applications that contain at least one patentably indistinct claim,
 - The Office will treat each application as having the total number of claims present in all of the applications for the purposes of determining whether each application exceeds the 5/25 claim threshold. *See* § 1.75(b)(4).
 - In the absence of good and sufficient reason, the Office may require elimination of the patentably indistinct claims from all but one of the applications.



Refund of Excess Claims Fees

37 CFR 1.117



Refund of Excess Claims Fees

37 CFR 1.117

- Applicants may request a refund of any excess claims fees paid on or after December 8, 2004 for a claim:
 - If the amendment canceling the claim is filed before an examination on the merits has been made of the application.
 - The amendment must be filed at least one day before a FAOM, notice of allowability or allowance, or action under *Ex parte Quayle* is shown in the PALM system as having been counted.
 - Certificate of mailing or transmission under § 1.8 will not be taken into account.



Refund of Excess Claims Fees

37 CFR 1.117

- The request for refund must be filed within two months from the filing of the amendment canceling the claim.
 - This time period is not extendable.
- The Office will not refund any excess claims fee paid for a withdrawn claim that is not canceled before FAOM.
 - The Consolidated Appropriations Act authorizes a refund only for a claim that has been canceled before an examination on the merits has been made of the application under 35 USC 131.



Patent Term Adjustment (PTA)

37 CFR 1.704



Patent Term Adjustment (PTA)

37 CFR 1.704

- A failure to comply with § 1.75(b) in an application will cause a reduction of any PTA.
 - Example #1: In an application that contains more than 5/25 claims and no ESD (and no SRR), applicant did not file an ESD until after four months from the filing date of the application.
 - Example #2: In an application in which an ESD was not filed before FAOM, applicant filed an amendment resulting in the application containing more than 5/25 claims.



Patent Term Adjustment

37 CFR 1.704

- Any PTA will be reduced by the number of days beginning on the day after the date that is the later of:
 - The filing date of the amendment resulting in the noncompliance with § 1.75(b);
 - Four months from the filing date of the application; or
 - Four months from the date on which the national stage commenced.



Patent Term Adjustment

37 CFR 1.704

- Any PTA will be reduced by the number of days ending on the filing date of:
 - An ESD in compliance with § 1.265;
 - An election of an invention in response to a restriction requirement that is drawn to no more than 5/25 claims;
 - An amendment resulting in the application containing no more than 5/25 claims; or
 - A SRR accompanied by an election of an invention that is drawn to no more than 5/25 claims.



More Information

- For more information,
 - Please visit the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>; or
 - Contact the Office of Patent Legal Administration at (571) 272-7704 or e-mail to PatentPractice@uspto.gov.



Thank you !!