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Recent Changes in Patent Prosecution



By Ariel Rogson, Marger Johnson & McCollom

On August 21, 2007, the US Patent & Trademark Office (USPTO) announced changes to patent prosecution. These changes, which go into effect on November 1, 2007, will likely have a major impact on anyone prosecuting patents. After reading this article, you might want to check with your patent attorney as to whether there is anything you should do before November 1, 2007.

The changes are far-reaching and complicated. As described in this article, these changes could limit how broadly or specifically inventors can claim their inventions, require searches and justification of patentability before a first Office Action and possibly later amendments, limit continuations and continuations-in-part, and limit the enforceability of patents.

Please Note: A glossary of terms used in this article is provided at the end.

Continuation practice

Previously, applicants have been permitted to file as many continuation applications or continuation-in-part applications as they want. Under the new rules, applicants will be limited to two continuations or continuations-in-part. Beyond that limit, the applicant will have to file a petition, justifying further continuing applications. If the applicant has already filed two or more continuations or continuations-in-part pending before August 21, 2007, the applicant may file one additional continuation or continuation-in-part application; any further continuations or continuations-in-part will require the petition.

Where the USPTO issues or has issued a restriction requirement, divisional applications can still be filed, even after November 1, 2007 – provided the divisional application claims only a non-elected invention that has not yet been examined. Divisional patent applications do not count toward the limit of two continuation applications, and can be filed at any time provided the divisional application has a chain of co-pendency back to the original application. The language of this rule is not clear; a strict interpretation might limit an applicant to filing a divisional with only claims previously presented. If you are prosecuting a patent application in which a restriction requirement was previously issued, you might want to consult with your patent attorney about filing a divisional application now.

Requests for Continued Examination (RCEs)

Under the old rules, during the pendency of any single application, applicants were permitted to file as many RCEs as desired. Under the new rules, an applicant can file one RCE in an application family. After the first RCE has been filed in the application family, any subsequent RCE requires a petition showing why the RCE should be granted. The application family includes the application itself, any parent applications from which the application claims priority, and any child applications that claim priority from the application, among others. One issue which is still open for interpretation is whether divisional patent applications are deemed part of the application family.

For patent applications pending on November 1, 2007, any second or subsequent RCE filed in the patent application will require the

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petition and a showing why the RCE should be considered. If you are prosecuting a patent application for which a second or later RCE is needed, you should consult with your patent attorney about filing the RCE before November 1, 2007, if possible.

Examination Support Document (ESD)

For any application filed on or after November 1, 2007 that includes more than 5 independent claims or 25 total claims, an ESD will need to be filed (unless a suggested restriction requirement is submitted; if so, see below). If a compliant ESD is not submitted before the first Office Action, the applicant will need to keep the claim count below the 5/25 claim limit. The requirement of an ESD applies to both large and small entities; small entities are exempt from one aspect of the ESD, but not from the requirement as a whole.

For applications that were filed before November 1, 2007, the applicant will also have to meet the 5/25 claim requirement or submit an ESD unless the USPTO issues a first Office Action on the merits before November 1, 2007. The USPTO will mail a notice indicating whether an applicant needs to submit an ESD or amend the claims in such applications; the applicant will have two months to submit the ESD, amend the claims or file a suggested restriction requirement (see below).

The ESD is essentially an effort to shift the burden of search and examination from the USPTO to the applicant. The requirements for an ESD search are actually higher than those placed on USPTO Examiners when searching an application during examination. If you receive a notice that you need to submit an ESD, you should consult with your patent attorney about the best course of action.

Suggested Restriction Requirement (SRR)

One way to avoid the need for an ESD in an application that does not satisfy the 5/25 claim requirement is by providing a suggestion to the Examiner about how to restrict the claims in the application into two or more groups that meet the 5/25 rule. This is accomplished using an SRR. The SRR must indicate which claims are elected based on the SRR. Until the Examiner decides whether or not to accept the SRR, an ESD is not necessary. But the Examiner is not bound to agree with the SRR; the Examiner could choose a different way to restrict the claims in the patent application, or choose not to restrict the application at all. One possibility is that Examiners – in an effort to reduce their own workloads – will choose to avoid restriction requirements and force the applicant to file an ESD or reduce the claim counts.

Identification of other applications

Applicants will now be required to identify any other commonly owned applications or patents that have at least one overlapping inventor and certain conditions regarding the dates of the applications. The requirement is imposed in both applications, not merely the later-filed application. This is not an entirely new requirement; it has not been an unusual practice to identify related cases to the USPTO. But the criteria are more stringent and the effects more problematic.

New presumption that claims are patentably indistinct

Under certain circumstances, an applicant can have two or more applications in which the USPTO will presume that the claims of these applications are not patentably distinct. The applicant will be responsible for showing how the claims of these applications are patentably distinct. In addition, in both pending applications, the claim sets are considered merged for purposes of the 5/25 claim requirement. For example, assume two applications are each filed with four independent claims and 20 total claims, and which meet the required circumstances. Because the USPTO will presume that the claims are patentably indistinct, each application will be considered to have eight independent claims and 40 total claims. As a result, the applicant would be expected to submit an ESD (see above). The applicant can respond to the presumption by explaining why the applications contain patentably distinct claims, or submit a terminal disclaimer (a document that might limit the duration of the patent). The applicant must address this presumption by a USPTO-imposed deadline.

Refund of excess claim fees

If an applicant files a patent application with more than three independent claims or 20 total claims, the applicant is required to pay fees for the excess claims. Under certain circumstances, an applicant can request a refund for excess claims fees paid. But there are limits

on the circumstances under which an applicant can request the refund, and there are limits on the timing of the request.

Risks and disadvantages for clients

The changes described above pose a number of risks and disadvantages for clients seeking patents. For example, making all the claims a client might deem appropriate for a given invention often requires more than 5 independent claims and 25 total claims, in which case an ESD may be required. But fulfilling the ESD requirements for search and description of patentability for each claim is likely to be onerous and expensive. Moreover, the possibility exists that the attorney or client will be accused of "inequitable conduct" if the patent is ever litigated, or that the description of why the claims are patentable might be used against the patent owner to narrow the claim construction. Conversely, limiting claim numbers to the 5/25 rule may be leaving a lot on the table, and will be a continuing constraint if in later prosecution it becomes advisable to add more claims.

The above is only a cursory discussion about the regulatory changes. For more information about the changes, the following sources could be helpful:

- A short summary was presented in PowerPoint by the USPTO on August 23, 2007. A webcast can be found [here](#).
- The USPTO posted a set of frequently asked questions about these regulatory changes, which can be found [here](#).
- A much more detailed description can be found in the Federal Register and is available [here](#).

On August 22, 2007 – one day after the regulations were announced – a suit was filed against the USPTO, seeking to prevent the implementation of these rules. This is likely only the first of a number of suits to be filed against the USPTO regarding these rule changes. At the time this article was written, no decision had yet been made in this or any similar case.

Glossary

- Continuation application: An application that uses an earlier-filed application as support for new claims, which are different from those filed in the earlier application.
- Continuation-in-part application: A continuation application to which new matter has been added.
- Divisional application: An application that claims an invention not examined by the USPTO after a restriction requirement.
- Office Action: A paper from the USPTO, explaining what the USPTO thinks about the claimed invention: for example, whether the invention is patentable or not, and why.
- Patentably indistinct: two different claims are considered "patentably indistinct" if the USPTO considers them to claim substantially identical inventions.
- Restriction requirement: A specific type of Office Action by the USPTO, indicating that the application claims two or more inventions, and requiring the applicant to select between the inventions. The claims directed to the invention(s) that are not selected are not examined by the USPTO.
- Request for Continued Examination: A request for the USPTO to continue examining an application after a Final Office Action, which typically ends examination.

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