

**Questions and Answers
Claims and Continuations Final Rule**

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A. Definitions

A1. What is a continuing application? (Posted on 8/21/07)

A continuing application can be a divisional application, continuation application or continuation-in-part application. See MPEP § 201.11 (“To specify the relationship between the applications, applicant must specify whether the application is a continuation, divisional, or continuation-in-part of the prior application. Note that the terms are exclusive. An application cannot be, for example, both a continuation and a divisional or a continuation and a continuation-in-part of the same application.”).

A continuing application is a nonprovisional application (or an international application designating the United States of America 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 United States of America).

A2. What is a divisional application? (Revised on 10/22/07)

A divisional application is a continuing application that discloses and claims only an invention or inventions that were disclosed and claimed in a prior-filed application, but were subject to a restriction requirement in the prior-filed application, and were not elected for examination and were not examined in any prior-filed nonprovisional application. See 37 CFR 1.78(a)(2) and 1.78(d)(1)(ii).

See also Notice “Clarification of the Transitional Provisions Relating to Continuing Applications and Applications Containing Patentably Indistinct Claims” (hereafter “Clarification Notice”) available at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>.

A3. What is a continuation application? (Posted on 8/21/07)

A continuation application is a continuing application that discloses and claims only an invention or inventions that were disclosed in the prior-filed application. See 37 CFR 1.78(a)(3).

A4. What is a continuation-in-part (CIP) application? (Posted on 8/21/07)

A CIP application is a continuing application that discloses subject matter that was not disclosed in the prior-filed application. See 37 CFR 1.78(a)(4).

A5. What is an application family? (Posted on 8/21/07)

An application family includes the initial application and its continuation or continuation-in-part applications. A divisional application family includes the divisional application and its continuation applications.

A6. What is the definition of a dependent claim? (Posted on 8/21/07)

A dependent claim must be presented in dependent form, referring back to and further limiting another claim or claims in the same application. A dependent claim is required to incorporate by reference all the limitations of the previous claim to which it refers and to specify a further limitation of the subject matter of the previous claim. See Pfizer Inc. v. Ranbaxy Labs. Ltd., 437 F.3d 1284, 1292, 79 U.S.P.Q.2d 1583, 1589-90 (Fed. Cir. 2006) (a dependent claim is required to include all the limitations of the claim from which it depends and the failure to incorporate by reference all the limitations is a violation of 35 U.S.C. 112, ¶ 4, and renders the dependent claim invalid).

A7. If applicant presented a claim that refers to another claim of a different statutory class of invention in an application and the Office treated the claim as a dependent claim for fee calculation purposes before November 1, 2007, will the Office notify the applicant if the Office subsequently treats the claim as an independent claim on or after November 1, 2007? (Posted on 9/26/07)

Yes, the Office will notify the applicant if additional excess claims fees are required due to a determination that such a claim is to be treated as an independent claim. The Office will not simply charge the additional excess claims fees to applicant's deposit account even if applicant has submitted a previous authorization before November 1, 2007 to charge excess claims fees to the deposit account.

A8. If applicant presents the following claim 1 and claim 2 in an application, will the Office treat claim 2 as a dependent claim or an independent claim? (Posted on 9/26/07)

Claim 1. A nucleic acid of SEQ ID 1.

Claim 2. A protein expressed from the nucleic acid of claim 1.

The Office will treat claim 2 as an independent claim for determining whether the application exceeds the 5/25 claim threshold and for fee calculation purposes because claim 2 does not incorporate by reference all of the limitations of claim 1 and specify a further limitation of the subject matter of claim 1. See 37 CFR 1.75(b)(1)-(2). The protein of claim 2 and the DNA of claim 1 are composed of different types of molecules. Thus, claim 2 to a protein does not further limit claim 1 to a nucleic acid.

B. Continuation and Continuation-in-Part (CIP) Applications (37 CFR 1.78)**B1. How many continuation or CIP applications are permitted without a petition? (Posted on 8/21/07)**

An applicant may file two continuation or CIP applications claiming the benefit of an initial application, plus an RCE in the application family, without any justification. An application family includes the initial application and its continuation or continuation-in-part applications. Applicant may file a third or subsequent continuation or CIP application or a second or subsequent RCE with a petition showing why the amendment, argument, or evidence sought to be entered could not have been previously submitted. See 37 CFR 1.78(d)(1) and 1.114.

B2. How will the Office treat improper benefit claims? (Posted on 8/21/07)

The Office will refuse to enter, or will delete if present, any specific reference to a prior-filed application that is not permitted by 37 CFR 1.78(d)(1). The entry of or failure to delete a specific reference to a prior-filed application that is not permitted does not constitute a waiver of the provisions of 37 CFR 1.78(d)(1). The grant of a petition under 37 CFR 1.78(d)(1)(vi), or waiver of a requirement of 37 CFR 1.78(d)(1), would be only by an explicit decision by an official who has been delegated the authority to decide such a petition or waiver. It would not occur by implication due to the entry of or failure to delete a specific reference to a prior-filed application that is not permitted by 37 CFR 1.78(d)(1).

B3. Can applicant prosecute two continuation or CIP applications in parallel, i.e., pending at the same time? (Posted on 8/21/07)

Yes, applicants choosing to file applications (whether continuing or non-continuing) in parallel are reminded that 37 CFR 1.75(b)(4) provides that if the parallel prosecuted applications are commonly owned and contain at least one patentably indistinct claim, the Office will treat each such application as having the total number of claims present in all of such applications for purposes of determining whether an examination support document is required by 37 CFR 1.75(b). See also 37 CFR 1.78(f) concerning additional provisions that are applicable if there are multiple applications that have the same claimed filing or priority date, substantial overlapping disclosure, a common inventor, and common assignee.

B4. Can applicant file a continuation or CIP application if applicant already filed an RCE in the application? (Posted on 8/21/07)

Yes, applicants are permitted to file two continuation or CIP applications and one RCE in the application family without any justification. The filing of an RCE does not preclude an applicant from filing two continuation or CIP applications.

B5. Can applicant file three RCEs rather than two continuation or CIP applications and one RCE? (Posted on 8/21/07)

No, applicant may not agree to forgo a continuation application (or CIP application) to obtain a second or third RCE, nor can an applicant agree to forgo an RCE in exchange for a third continuation or CIP application. For example, an applicant cannot file a second RCE without a petition instead of filing one of the two permitted continuation applications; and an applicant cannot file a third continuing application instead of filing an RCE.

The Office is implementing an optional streamlined continuation application procedure under which an applicant may have a continuation application placed on an examiner's amended (Regular Amended) docket. Thus, an applicant may effectively obtain the docketing benefit (*i.e.*, being placed on an examiner's amended (Regular Amended) docket) of a second and third request for continued examination without a petition by requesting that the two continuation applications permitted be treated under the optional streamlined continuation application procedure. For more information, see next question.

B6. What are the requirements for the optional streamlined continuation application procedure? (Revised on 10/22/07)

The Office is implementing an optional streamlined continuation application procedure under which an applicant may request to have a continuation application filed on or after November 1, 2007, placed on an examiner's amended (Regular Amended) docket. The examiner will normally pick up for action a continuation application that has been placed on the examiner's amended (Regular Amended) docket faster (*e.g.*, within a few months from the date the application is docketed) than an application placed on the examiner's new continuing application (New Special) docket.

The optional streamlined continuation application procedure, however, does require that the applicant provide a continuation application filed under 35 U.S.C. 111(a) and 37 CFR 1.53(b) (and not a request for continued examination under 37 CFR 1.114 or a continued prosecution application under 37 CFR 1.53(d)). Thus, the applicant must file a continuation application that meets the conditions set forth in 35 U.S.C. 111(a) and 37 CFR 1.53(b) to be accorded a filing date. The continuation application must also be complete. The Office will not docket an application for examination until the application is complete (37 CFR 1.51(b) and 1.53(f)) and in condition for publication (37 CFR 1.211). See 37 CFR 1.53(h). Thus, any delay in submitting the filing fee and oath or declaration (or copy of the oath or declaration from the prior-filed application under 37 CFR 1.63(d)) will delay the docketing of a continuation application even if the applicant has requested that the continuation application be given streamlined docketing.

Please note that the continuation application must claim the benefit of the prior-filed application in compliance with 37 CFR 1.78. The Office will not place the continuation application on the examiner's amended (Regular Amended) docket if the benefit claim of the prior-filed application(s) is improper. For example, if the continuation application is

a third or subsequent continuation application, the Office will not place the continuation application on the examiner's amended (Regular Amended) docket until applicant files a petition and showing in compliance with 37 CFR 1.78(d)(1)(vi) and the Office grants the petition. Therefore, applicant should file the petition and showing upon the filing of the application.

The following conditions must also be met for the continuation application to be placed on an examiner's amended (Regular Amended) docket rather than on the new continuing application (New Special) docket:

1. The application must disclose and claim only an invention or inventions that were disclosed and claimed in the prior-filed application;
2. The applicant must agree that any election in response to a requirement to comply with the requirement of unity of invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C. 121, including an election of species requirement, in the prior-filed application carries over to the continuation application;
3. The prior-filed application must be under a final Office action (37 CFR 1.113) or under appeal at the time of filing the continuation application;
4. The prior-filed application must be expressly abandoned upon filing of the continuation application, with a letter of express abandonment under 37 CFR 1.138 being concurrently filed in the prior-filed application; and
5. Applicant must request that the continuation application be placed on an examiner's amended (Regular Amended) docket.

This procedure is not applicable to design applications because the continued prosecution application procedures of 37 CFR 1.53(d) currently provide design applicants with an optional streamlined continuation application procedure.

This optional streamlined continuation application procedure concerns only the placement of the continuation application on an examiner's amended (Regular Amended) docket. The continuation application is otherwise treated as a new application for patent. For example, (1) the application filing fees including the basic filing fee, search and examination fees, and any required excess claims fees (and not the request for continued examination fee set forth in 37 CFR 1.17(e)) are required; (2) the continuation application will be assigned a new application number; and (3) the continuation application is subject to the patent term provisions of 35 U.S.C. 154(b) and 37 CFR 1.702 *et seq.* as a new continuation application (and not a request for continued examination in the prior-filed application).

B7. Can applicant file one more continuation or CIP application if the initial application was abandoned before examination? (Revised on 10/22/07)

Applicant may file an "extra" continuation or CIP application (*e.g.*, a third continuation application) without a petition if the following conditions are met:

1. The initial nonprovisional application became abandoned due to the failure to timely reply to an Office notice issued under 37 CFR 1.53(f); and

2. The initial nonprovisional application does not claim the benefit of any other nonprovisional application or international application designating the United States. See 37 CFR 1.78(d)(1)(v).

The applicant must pay the basic filing fee for the initial application and the initial application must be entitled to a filing date in order for the continuation or CIP application to claim the benefit of the initial application. Therefore, if an applicant files a continuation or CIP application to correct informalities rather than completing an application for examination under 37 CFR 1.53, the applicant may file an “extra” continuation or CIP application without there being a requirement for a petition and showing under 37 CFR 1.78(d)(1)(vi).

B8. Can applicant file one more continuation or CIP application of an international application that did not enter the national stage? (Revised on 10/22/07)

Applicant may file an “extra” continuation or CIP application (e.g., a third continuation application) of an international application designating the United States without a petition if the following conditions are met:

1. A Demand and the basic national fee have not been filed in the international application; and
2. The international application does not claim the benefit of any other nonprovisional application or international application designating the United States. See 37 CFR 1.78(d)(1)(iv).

B9. Can applicant file an application on the improvements of an invention? (Posted on 8/21/07)

Applicant may file an application on the improvements to the invention disclosed in a prior-filed application as a CIP application or a new application without claiming the benefit of the prior-filed application. Applicant is permitted to file two continuation or CIP applications without a petition and showing. Applicant may also file any third or subsequent CIP application with a petition and showing. For the CIP application to actually receive the benefit of the filing date of the prior-filed application, 35 U.S.C. 120 requires that the subject matter of at least one claim of the continuation-in-part application must be disclosed in the prior-filed application in the manner provided by 35 U.S.C. 112, ¶ 1. See Studiengesellschaft Kohle m.b.H. v. Shell Oil Co., 112 F.3d 1561, 1564-65, 42 U.S.P.Q.2d 1674, 1677-78 (Fed. Cir. 1997). In addition, the term of any resulting patent will be measured under 35 U.S.C. 154(a)(2) from the filing date of the prior-filed application, even if the later-filed application never receives any benefit from the prior-filed application. See Abbott Labs. v. Novopharm Ltd., 104 F.3d 1305, 1309, 41 U.S.P.Q.2d 1535, 1537 (Fed. Cir. 1997) (rejecting patentee’s argument that it should not be bound by the filing date of the prior-filed application because the later-filed application never received any actual benefit from the prior-filed application). To maximize the term of any resulting patent, applicant should file the application containing only claims directed to the improvements, without claiming the benefit of the prior-filed application rather than a CIP application.

B10. What happens if applicant inadvertently fails to identify the claims in a CIP application for which the subject matter is disclosed in the manner provided by 35 U.S.C. 112, ¶ 1, in the prior-filed application? (Revised on 10/22/07)

For CIP applications in which a first Office action on the merits (FAOM) has not been mailed before November 1, 2007, applicant must identify the claim or claims in the CIP application for which the subject matter is disclosed in the manner provided by 35 U.S.C. 112, ¶ 1, in the prior-filed application. See 37 CFR 1.78(d)(3). Any claim in the CIP application for which the subject matter is not identified as being disclosed in the manner provided by 35 U.S.C. 112, ¶ 1, in the prior-filed application, will be treated as entitled only to the actual filing date of the CIP application, and will be subject to prior art based on the actual filing date of the CIP application. To avoid any unnecessary delay in the prosecution of the application, applicant should provide the identification before the examiner begins to conduct a prior art search. If the failure to identify the claims for which the subject matter is disclosed in the manner provided by 35 U.S.C. 112, ¶ 1, in the prior-filed application, causes the examiner to include a new prior art rejection in a second or subsequent Office action, the inclusion of the new prior art rejection will not preclude the Office action from being made final.

Furthermore, in situations in which it is not readily apparent where the specification of the application, or an application for which a benefit is claimed, provides written description support and enablement under 35 U.S.C. 112, ¶ 1, for a claim or a limitation of a claim, the examiner may require the applicant to provide such information under 37 CFR 1.105(a)(1)(ix).

B11. If applicant filed a continuation application without any fees and the application is later abandoned due to applicant's failure to respond to a notice to file missing parts requiring the fees and a surcharge, will such a continuation application count as one of the two permitted continuation or CIP applications, without a petition? (Revised on 10/22/07)

Yes, a continuation application that is abandoned during preexamination processing will count as one of the two permitted continuation or CIP applications without a petition and showing.

The provision of 37 CFR 1.78(d)(1)(v) applies to an initial application that does not claim the benefit of any other nonprovisional application or international application designating the United States. If the initial application was abandoned during preexamination processing, applicant may file an "extra" continuation or CIP application (e.g., a third continuation application) without a petition if the conditions set forth in 37 CFR 1.78(d)(1)(v) are met. However, this provision does not apply to a continuation application. Please note that the basic filing fee of the application must be timely paid in order for any later-filed application to claim the benefit of the application. Also see question B7.

B12. If applicant filed an initial application "A", a first continuation application "B" claiming the benefit of application "A", a second continuation application "C" claiming the

benefit of applications “A” and “B”, and a CIP application “D” claiming the benefit of applications “A”, “B” and “C”, can applicant subsequently delete the benefit claim in application “D” so that applicant may file two additional continuation applications of application “D” and one RCE in the application family of application “D”? (Posted on 9/26/07)

If applicant deletes the benefit claim in application “D”, applicant may file two continuation or CIP applications and one RCE in the application family of application “D” without a petition and showing. Applicant should file the amendment deleting the benefit claim as soon as possible, preferably before the FAOM, to avoid unnecessary delay in the prosecution.

Once the amendment deleting the benefit claim in application “D” is entered, the Office will treat application “D” as an initial application. Application “D” 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 application “D”. For example, if the application “A” has been published more than 1 year prior to the actual filing date of application “D”, the publication of application “A” may be used as prior art under 35 U.S.C. 102(b) against application “D”.

Please note that applicant may not subsequently add the benefit claim back to application “D” because the Office may accept a late benefit claim only if the delay is unintentional.

B13. If applicant filed an initial application and an international application designating the U.S. that claims the benefit of the initial application, and the international application did not enter the U.S. national stage, can applicant file two continuation or CIP applications claiming the benefit of the initial application, but not the international application, without a petition? (Posted on 9/26/07)

Yes, applicant may file two continuation or CIP applications claiming the benefit of the initial application, but not the international application that did not enter the U.S. national stage, without a petition and showing. However, applicant may not file two continuation or CIP applications claiming the benefit of the international application designating the U.S. and the initial application, without a petition and showing. In addition, applicant may not file two continuation or CIP applications claiming the benefit of the initial application, without a petition and showing, if the international application entered the U.S. national stage.

B14. Since an RCE cannot be filed in a design application, can an applicant file two continuation or CIP applications and one Continued Prosecution Application (CPA) under 37 CFR 1.53(d) for an initial design application, without a petition and showing? (Posted on 9/26/07)

No, applicant may file only two continuation or CIP applications for a design application, without a petition and showing. If a continuation application is filed for a design application, it may be filed as a CPA under 37 CFR 1.53(d) or as a continuation application under 37 CFR 1.53(b).

C. Divisional Applications and Continuation Applications of a Divisional Application (37 CFR 1.78)

C1. When can an applicant file a divisional application? (Revised on 10/22/07)

Applicant may file a divisional application of a prior-filed application for the claims to a non-elected invention that has not been examined, if the prior-filed application was subject to a requirement for restriction. The divisional application must contain only claims directed to an invention or inventions that were identified in the restriction requirement but were not elected for examination and were not examined in any other nonprovisional application filed under 35 U.S.C. 111(a) or national stage application resulting from an international application entering the national stage in the United States under 35 U.S.C. 371.

The divisional application need not be filed during the pendency of the application subject to a requirement for restriction, as long as the copendency requirement of 35 U.S.C. 120 is met. Thus, applicant may file the divisional application during the pendency of the application that was subject to a requirement for restriction or the pendency of any continuing application of such an application.

C2. How many continuation or CIP applications of a divisional application can applicant file without a petition? (Posted on 8/21/07)

Applicant may file two continuation applications of the divisional application plus an RCE in the divisional application family, without a petition and showing. See 37 CFR 1.78(d)(1)(iii) and 1.114. A divisional application family includes the divisional application and its continuation applications. In addition, applicant may file a third or subsequent continuation application or a second or subsequent RCE in the divisional application family with a petition and showing.

37 CFR 1.78(d)(1)(iii) does not permit a CIP application of a divisional application. The rule is designed to permit an applicant to complete prosecution with respect to an invention that was disclosed and claimed in a divisional application, and not to permit an applicant to seek patent protection for a new invention that merely bears some relationship to an invention that was disclosed and claimed in a divisional application.

37 CFR 1.78(d)(1)(i) provides a mechanism for applicants to seek patent protection for a new invention that is an improvement of an invention or inventions that were disclosed and claimed in an initial or continuing (including a divisional) application.

C3. Can applicant prosecute the continuation applications of a divisional application in parallel? (Posted on 8/21/07)

An applicant may continue prosecution of a divisional application via two continuation applications (in parallel or serially). The Office, however, will treat each application prosecuted in parallel as having the total number of claims present in all of such

applications for purposes of determining whether an examination support document is required by 37 CFR 1.75(b), if the continuation applications contain at least one patentably indistinct claim.

C4. Can applicant file a “voluntary” divisional application? (Posted on 8/21/07)

Applicants may file a so-called “voluntary” divisional application as a continuation application when the prior-filed application was not subject to a requirement for restriction. Applicant may file two such continuation applications without a petition and showing. Applicant likewise may file a third or subsequent continuation application with a petition and showing pursuant to 37 CFR 1.78(d)(1)(vi).

35 U.S.C. 121 provides that “[i]f two or more independent and distinct inventions are claimed in one application, the Director **may** require the application to be restricted to one of the inventions.” (Emphasis added.) Thus, 35 U.S.C. 121 authorizes, but does not compel, the Director to require that an application containing two or more independent and distinct inventions be restricted to one of the inventions. The Office typically decides whether to issue a restriction requirement when an application contains two or more independent and distinct inventions based upon, *inter alia*, the burden on the Office to search and examine more than one invention. See MPEP § 803.

Furthermore, applicant may suggest a requirement for restriction (SRR) under 37 CFR 1.142(c), if the application contains claims to two or more independent and distinct inventions. In such case, applicants may file a divisional application for the claims to a non-elected invention that has not been examined if the initial application is subject to a requirement for restriction. The divisional application is not required to be filed during the pendency of the application subject to a requirement for restriction, as long as the copendency requirement of 35 U.S.C. 120 is met. Applicant may file two continuation applications of a divisional application plus an RCE in the divisional application family.

C5. When can applicant rely on a requirement for restriction in the prior-filed application to file a divisional application? (Posted on 8/21/07)

Applicants cannot rely upon a requirement for restriction (including an election of species) to file a divisional application in situations where:

1. The applicant traverses the requirement for restriction;
2. The requirement for restriction may be conditional, 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
3. The claims to the non-elected invention may be rejoined at the request of the applicant (see MPEP § 821.04 et seq.).

This is because when the requirement for restriction is withdrawn in the prior-filed application, any divisional application that has been filed as the result of the restriction requirement of the prior-filed application will not be proper under 37 CFR 1.78(a)(2) and 1.78(d)(1)(ii). Under 37 CFR 1.78(a)(2) and 1.78(d)(1)(ii), the prior-filed application to

which a divisional application claims the benefit must be subject to a requirement to comply with the requirement of unity of invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C. 121. 37 CFR 1.78(a)(2) and 1.78(d)(1)(ii) also require a divisional application to contain **only** claims directed to a non-elected invention that has **not** been examined.

For an application that contains a generic claim in which a requirement for an election of species has been made, applicants should conclude prosecution of the generic claim in the initial application and its continuation or continuation-in-part applications, including exhaustion of any available appeals, before even filing a divisional application to a non-elected species. If applicant no longer wants to pursue the generic claim, applicant may file a divisional application directed to a non-elected species. If applicant files a divisional application directed to a non-elected species, applicant should:

1. Cancel the claims to the non-elected species and the generic claim in the prior-filed application before a rejoinder or reinstatement occurs;
2. Not present the non-elected claims and the generic claim in any continuation or continuation-in-part application of the initial application; and
3. Not present the generic claim in the divisional application or any continuation application of the divisional application.

Under the Office's rejoinder practice, an applicant may request rejoinder of claims to a non-elected invention that depend from or otherwise require all the limitations of, an allowable claim. See MPEP § 821.04 et seq. Applicants may retain claims to a non-elected invention in an application for possible rejoinder in the event of the allowance of a claim to the elected invention. If applicant cancels all of the claims directed to a nonelected invention **before** rejoinder occurs and files a divisional application, the restriction requirement will not be withdrawn and the non-elected claims that are now canceled will not be rejoined. This will preserve applicant's rights under 35 U.S.C. 121 and 37 CFR 1.78(d)(1)(ii). See MPEP § 821.04(b).

Similarly, applicant cannot rely on the restriction requirement in these situations to avoid the requirement for an ESD because the reinstated or rejoined claims are taken into account for the purposes of determining whether an application exceeds the 5/25 claim threshold. See 37 CFR 1.75(b)(5).

C6. What happens if a restriction requirement is withdrawn and applicant already filed a divisional application? (Posted on 8/21/07)

Under 37 CFR 1.78(a)(2) and 1.78(d)(1)(ii), the prior-filed application to which a divisional application claims the benefit must be subject to a requirement for restriction. Additionally, the invention claimed in the divisional application must not have been elected for examination and must not have been examined in any prior-filed application. Thus, a divisional application will be improper when the claims to the non-elected invention have not been canceled and the requirement for restriction is withdrawn in the prior-filed application (or when the invention claimed in the divisional application has been examined in the prior-filed application). Furthermore, since the claims of the prior-

filed application and the divisional application would be drawn to the same invention, both applications may be subject to a double patenting rejection (see MPEP § 821.04) and the provisions of 37 CFR 1.75(b)(4) (determining number of claims for purposes of threshold when multiple applications contain patentably indistinct claims).

For example, where claims directed to a product and to a process of making and/or using the product are presented in the same application and subject to a requirement for restriction, the applicant may request rejoinder of the non-elected process claims that depend from or otherwise require all the limitations of an allowable product claim. See MPEP § 821.04(b). Upon rejoinder of claims to a non-elected process invention, the requirement for restriction between the elected product and non-elected process invention is withdrawn. Thus, the rejoinder of non-elected process claims after allowance of the elected product claims may result in a prior or subsequently filed “divisional” application **not** being a proper divisional application under 37 CFR 1.78(a)(2) and 1.78(d)(1)(ii) because the prior-filed application is no longer subject to a requirement for restriction. Applicant may avoid this problem by canceling the non-elected process claims and claiming them in a divisional application before rejoinder occurs. In such a situation, because the non-elected claims have been canceled, the restriction requirement cannot be withdrawn. This will preserve applicant’s rights under 35 U.S.C. 121 and 37 CFR 1.78(d)(1)(ii).

If the applicant chooses to retain the non-elected claims and files a divisional application claiming the non-elected invention and then the restriction requirement is withdrawn in the prior-filed application, the benefit claim under 37 CFR 1.78(d)(1)(ii) in the later-filed divisional application would no longer be proper. Thus, the later-filed application would not be entitled to the benefit of the prior-filed application. If applicant still desires to maintain the later-filed application, applicant must delete or correct the benefit claim to indicate that the application is a continuation application if the requirements set forth in 37 CFR 1.78(d)(1)(i) can be met. If applicant no longer wants to maintain the later-filed application, applicant may abandon the application before the examination has been made of the application and may request a refund of any previously paid search and excess claims fees.

Furthermore, when a restriction requirement is withdrawn, the reinstated or rejoined claims will be taken into account for the purposes of determining whether an application exceeds the 5/25 claim threshold. See 37 CFR 1.75(b)(5).

C7. If a restriction requirement is issued after the FAOM, can applicant file a divisional application on the withdrawn claims to a non-elected invention that has been examined? (Posted on 9/26/07)

If applicant files an amendment that adds claims to another invention after the FAOM, and in response to the amendment, the examiner makes a restriction requirement (*e.g.*, an election by original presentation, see MPEP § 821.03), applicant may file a divisional application for the withdrawn claims to the non-elected invention that has not been examined.

If the application originally contained the claims to more than one invention and a restriction requirement was not made before the FAOM, a restriction requirement will not be made after a FAOM without an approval by the appropriate TC director. The Office expects this situation to be rare.

If such a restriction requirement is made with an approval by the appropriate TC director, the written restriction requirement will include an express waiver of the requirement that the non-elected invention has not been examined to permit applicant to file a divisional application for the non-elected invention.

Applicant may avoid such a late restriction requirement by filing a suggested restriction requirement before the FAOM.

C8. If applicant filed an initial application which is an international application designating the U.S. and the international application contains two inventions, can applicant file one continuation application and submit a suggested restriction requirement (SRR) in the continuation application rather than file two continuation applications? Will the Office count the withdrawn claims in determining whether the continuation application exceeds the 5/25 claim threshold? (Revised on 10/10/07)

Yes, an applicant may file a continuation application and submit an SRR in the continuation application in lieu of filing two separate continuation applications. If the SRR is accepted and the examiner makes a restriction requirement, applicant may file a divisional application for the claims to the non-elected invention that has not been examined. *See* C11 for more information on divisional applications of an international application.

The Office will not count the withdrawn claims in determining whether an application exceeds the 5/25 claim threshold. Therefore, if the elected invention in the continuation application is drawn to 5/25 or fewer claims, applicant is not required to file an ESD before the FAOM.

C9. If a restriction requirement is made in the continuation application of an initial application, can the applicant file a divisional application for the claims to the non-elected invention that has not been examined? (Posted on 9/26/07)

Yes, such a divisional application may claim the benefit of the continuation application in which the restriction requirement was made and the initial application. Applicant may file two continuation applications of the divisional application and one RCE in the divisional family, without a petition and showing.

C10. If applicant filed a divisional application for a non-elected invention that has not been examined, can applicant submit new or amended claims in the divisional application that was not present in the prior-filed application? (Posted on 9/26/07)

Yes, applicant may submit new or amended claims in the divisional application if the claims are directed to the non-elected invention that was identified in the restriction requirement and that has not been examined. Please note that applicant may not present claims to other inventions not identified in the restriction requirement.

C11. If applicant filed an initial application which is an international application designating the U.S. and the International Searching Authority determined that the international application lacks unity of invention under PCT Rule 13, would the filing of a Demand and payment of additional examination fees preclude the applicant from filing a divisional application for each invention not elected for examination in the application after entry into the national stage? (Revised on 10/10/07)

No. The applicant may file a divisional application for each non-elected invention that was not elected for examination and not examined in the national stage application (or in a bypass continuation application), assuming that such divisional application otherwise meets the conditions set forth in 37 CFR 1.78(d)(1)(ii). The term “examined” in 37 CFR 1.78(d)(1)(ii)(B) is limited to examination within the meaning of 35 USC 131 and 37 CFR 1.104 in a national application under 35 USC 111(a) or a national stage application resulting from an international application entering the national stage in the United States under 35 USC 371. The term “examined” in 37 CFR 1.78(d)(1)(ii)(B) does not include the international phase examination under PCT Article 31 that occurs as a result of the filing of a Demand for international preliminary examination.

See Pre-OG Notice “Clarification of the Transitional Provisions Relating to Continuing Applications and Applications Containing Patentably Indistinct Claims” available at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>.

C12. If applicant received a restriction requirement in the initial application and elected invention “A” in the initial application, and then applicant filed a divisional application that contains the claims to the non-elected invention “B” that has not been examined, can applicant file two continuation or CIP applications to present claims to the elected invention “A” claiming the benefit to the divisional application and the initial application? (Revised on 9/27/07)

No, the continuation applications claiming the benefit of divisional application under 37 CFR 1.78(d)(1)(iii) cannot contain claims to an invention other than the non-elected invention “B”.

However, applicant may file a single continuation application for invention “A” claiming the benefit under 37 CFR 1.78(d)(1)(i) of the divisional application and the initial application. In this situation, applicant may not file the second continuation application for invention “A” claiming the benefit under 37 CFR 1.78(d)(1)(i) of the first

continuation application, the divisional application and the initial application because 37 CFR 1.78(d)(1)(i) permits a continuation or CIP application of an initial application claiming the benefit of no more than two prior-filed applications. Furthermore, applicant may only file one continuation application for invention “B” claiming the benefit under 37 CFR 1.78(d)(1)(iii) of the divisional application.

In comparison, if applicant files the continuation applications directly claiming the benefit of the initial application, applicant may file two continuation or CIP applications of the initial application to present claims to the elected invention “A”. See 37 CFR 1.78(d)(1)(i). Furthermore, applicant may file two continuation applications of the divisional application to present claims to the non-elected invention “B”. See 37 CFR 1.78(d)(1)(iii).

C13. A divisional application is defined in 37 CFR 1.78(a)(2) as being an application that “discloses and claims only” an invention restricted from an earlier application. How will the Office apply the “discloses only” requirement of 37 CFR 1.78(a)(2)? (Posted on 9/26/07)

Applicant may not add any new subject matter that was not disclosed in the prior-filed application in a divisional application as defined by 37 CFR 1.78(a)(2). If applicant wishes to add new subject matter that was not disclosed in the prior-filed application, applicant may file a CIP application. Alternatively, applicant may file a new application without claiming the benefit of the prior-filed application presenting claims directed to the new subject matter.

D. Requests for Continued Examination (RCE) (37 CFR 1.114)**D1. How many RCE are permitted to be filed in an application family without a petition? (Posted on 8/21/07)**

Applicant may file two continuation or CIP applications plus a single RCE in an application family without a petition and showing. See 37 CFR 1.78 and 1.114(f). An application family includes an initial application and its continuation or CIP applications. For example, if applicant previously filed an RCE in the initial application, applicant is precluded from filing an RCE in the continuation application of the initial application, unless applicant files a petition and showing in compliance with 37 CFR 1.114(g).

Furthermore, applicant may file a single RCE in a divisional application family. A divisional application family includes the divisional application and its continuation applications. For example, if applicant already filed an RCE in the divisional application, applicant is precluded from filing an RCE in the continuation application of the divisional application, unless applicant files a petition and showing in compliance with 37 CFR 1.114(g).

Accordingly, applicant may file a single RCE in the initial application family and a single RCE in the divisional application family, without a petition and showing. For example, applicant may file an RCE in the initial application and an RCE in the divisional application, without a petition and showing.

D2. Does the filing of an RCE preclude applicant from filing a continuation or CIP application? (Posted on 8/21/07)

Applicants are permitted to file two continuation or CIPs and a single RCE without a petition and showing. Thus, filing an RCE does not preclude an applicant from filing a first or second continuation application (or continuation-in-part application).

D3. Can applicant forgo filing a continuation application to obtain a second RCE without filing a petition and showing? (Posted on 8/21/07)

An applicant may not agree to forgo a first or second continuation application (or CIP application) to obtain a second or third RCE, nor can applicant forgo a RCE to obtain a third continuation or CIP application. For example, an applicant cannot file two RCEs without a petition and showing in an application instead of filing one of the two permitted continuation applications.

D4. What are the requirements for filing a second or subsequent RCE in an application family? (Posted on 8/21/07)

If applicant wishes to file a second or subsequent RCE, applicant is required to file the following: (1) the request; (2) a submission under 37 CFR 1.114(c); (3) the fee set forth in 37 CFR 1.17(e) (the RCE fee); (4) a petition under 37 CFR 1.114(g); (5) the petition

fee set forth in 37 CFR 1.17(f); and (6) a showing that the amendment, argument, or evidence sought to be entered could not have been submitted prior to the close of prosecution in the application in compliance with 37 CFR 1.114(g).

D5. Can applicant file a second or subsequent RCE including only an information disclosure statement (IDS) as the submission required by 37 CFR 1.114(c)? (Posted on 8/21/07)

Since a petition under 37 CFR 1.114(g) requires a showing that there is an amendment, argument, or evidence that could not have been submitted prior to the close of prosecution in the application, a petition under 37 CFR 1.114(g) for an RCE including only an IDS as the submission required by 37 CFR 1.114(c) (*i.e.*, not including an amendment, argument, or evidence) would **not** be granted.

D6. Does the filing of an RCE with a petition and showing under 37 CFR 1.114(g) toll the time period for reply running in the previous Office action? (Posted on 8/21/07)

The filing of an improper RCE, including an RCE with a petition under 37 CFR 1.114(g) that is not grantable, will not stay any period for reply or other proceedings. This is consistent with the current practice for requests for continued examination. See MPEP § 706.07(h), subsection V (the mere RCE and fee will **not** operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application).

D7. If applicant previously filed an RCE in an application family before the effective date of the final rule, can applicant file “one more” RCE in the application family on or after the effective date without a petition and showing? (Posted on 8/21/07)

The changes to 37 CFR 1.114 apply to any application in which an RCE is filed on or after November 1, 2007. Thus, applicant is precluded from filing a second RCE in an application family without a petition and showing on or after November 1, 2007.

E. Petitions Related to Additional Continuing Applications and Requests for Continued Examination (RCE)

E1. If applicant wishes to file a third or subsequent continuation or CIP application, what are the petition requirements? (Posted on 8/21/07)

Within 4 months from the actual filing date of the continuation or CIP application (or the date on which the national stage commenced), applicant must file:

1. A petition in compliance with 37 CFR 1.78(d)(1)(vi);
2. The fee set forth in 37 CFR 1.17(f);
3. An amendment, argument, or evidence; and
4. 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.

E2. Can applicant submit a new set of claims instead of an amendment? (Posted on 8/21/07)

The phrase, “a showing that **the amendment**, argument, or evidence sought to be entered could not have been submitted” (emphasis added) inherently encompasses a showing as to why a new claim could not have been previously submitted. A new claim presented in a continuing application is considered to be an amendment to the claims of the prior-filed application. Thus, by using the word “amendment” in the standard of 37 CFR 1.78(d)(1)(vi) and 1.114(g), the Office intended to capture new claims sought to be introduced in a third or subsequent continuation or CIP application or second or subsequent RCE.

Applicant should file a clean set of claims in the continuation or CIP application rather than a preliminary amendment under 37 CFR 1.115 and 1.121.

E3. If applicant wishes to file a second or subsequent RCE, what are the petition requirements? (Posted on 8/21/07)

Applicant must file the RCE with the following:

1. A petition in compliance with 37 CFR 1.114(g);
2. The fee set forth in 37 CFR 1.17(f);
3. An amendment, argument, or evidence (not an IDS); and
4. A showing that the amendment, argument, or evidence sought to be entered could not have been submitted prior to the close of prosecution in the application.

E4. Is there any situation where the Office will grant a petition automatically? (Posted on 8/21/07)

The Office will decide petitions under 37 CFR 1.78(d)(1)(vi) and 1.114(g) based on their substantive argument and the facts in the record and apply the standard in a consistent

manner. There are no situations that will result in a per se or pro forma grant of a petition under 37 CFR 1.78(d)(1)(vi) or 1.114(g).

E5. Can the applicant submit a statement that the amendment, argument, or evidence sought to be entered could not have been submitted earlier as the required showing? (Posted on 8/21/07)

Such a statement will not be considered a sufficient showing.

E6. What are some of the factors that the Office may consider when deciding on a petition? (Posted on 8/21/07)

The Office will determine on a case-by-case basis whether the applicant's showing as to why the amendment, argument or evidence sought to be entered could not have been submitted earlier is satisfactory. In addition to the showing submitted by the applicant, the Office may review the prosecution history of the initial application and the prior continuing applications or require additional information from the applicant in deciding a petition. If an amendment, argument or evidence could be submitted during the prosecution of the initial application, two continuation or CIP applications, and an RCE in an application family, applicant must present such an amendment, argument or evidence earlier rather than wait to submit it later in an additional continuing application or RCE. Applicants should not rely upon the availability of additional continuing applications or RCEs in prosecuting an application.

The following are some factors that the Office may consider when deciding whether to grant a petition under 37 CFR 1.78(d)(1)(vi) or 1.114(g):

1. Whether applicant should file an appeal or a petition under 37 CFR 1.181 (e.g., to withdraw the finality of an Office action) rather than a continuing application or RCE;
2. The number of applications filed in parallel or serially with substantially identical disclosures; and
3. Whether the evidence, amendments, or arguments are being submitted with reasonable diligence.

With respect to the first factor (whether applicant should be filing an appeal or a petition under 37 CFR 1.181 rather than a continuing application or RCE), if the showing relates to an issue that should be petitioned or appealed, the Office will likely not grant the petition for an additional continuing application or RCE. Applicant should address any issues pertaining to inadequate examination by seeking review via a petition under 37 CFR 1.181 or an appeal, rather than by filing a continuing application or RCE.

If the disagreement between the examiner and applicant is procedural in nature (e.g., an objection), then applicant should file a petition under 37 CFR 1.181.

For example, an applicant should file a petition under 37 CFR 1.181 to request the withdrawal of the finality of an Office action when the finality was premature, or to review the examiner's refusal to enter an after-final amendment.

The Office will likely not grant a petition under 37 CFR 1.78(d)(1)(vi) or 1.114(g) if applicant argues only that an amendment after final rejection should have been entered in the prior-filed application because the final was premature.

Applicant should have addressed the non-entry in the prior-filed application and not later in a petition under 37 CFR 1.78(d)(1)(vi) or 1.114(g) for a continuing application or RCE.

If the issue goes to the merits of a rejection, applicant should file an appeal to the BPAI under 35 U.S.C. 134 and 37 CFR 41.31.

With respect to the second factor (the number of applications filed in parallel or serially with substantially identical disclosures), the higher the number of applications with identical or substantially identical disclosures or the higher the number of applications in the chain of prior-filed copending applications, the more opportunities applicant had to present the amendment, argument or evidence. Accordingly, a petition under 37 CFR 1.78(d)(1)(vi) or 1.114(g) is less likely to be granted.

With respect to the third factor (whether the evidence, amendments, or arguments are being submitted with reasonable diligence), the Office will focus on whether the evidence or data submitted with the petition to meet the showing under 37 CFR 1.78(d)(1)(vi) or 1.114(g) was presented in a reasonably diligent manner. This will take into account the condition of the application at the time of examination (e.g., whether the initial application was in proper form for examination by the time of the first Office action in the initial application, or whether it was necessary to first issue Office actions containing rejections under 35 U.S.C. 112 or objections to have the application placed in proper form for examination), the consistency of the Office's position during prosecution (e.g., whether applicant received wholly new prior art rejections versus prior art rejections slightly modified to address the amendments), and the earnestness of the applicant's efforts to overcome outstanding rejections (e.g., whether replies fully addressed all of the grounds of rejection or objection in the Office actions, or whether amendments or evidence were submitted only when arguments were failing to persuade the examiner).

E7. Is it sufficient to show that the examiner made new arguments or a new ground of rejection in a final Office action? (Posted on 8/21/07)

The mere fact that the examiner made new arguments or a new ground of rejection in a final Office action would not be considered a sufficient showing. The Office will decide each petition on a case-by-case basis focusing on whether the new ground of rejection in the final Office action could have been anticipated by the applicant.

E8. Is it sufficient to show that the applicant added new subject matter in the CIP application? (Posted on 8/21/07)

The mere fact that the subject matter was not present at the time of filing the prior-filed application would not be a sufficient showing. The Office will decide these petitions on a case-by-case basis based on the prosecution history of the prior-filed application, as well as the records of the CIP application. The Office will consider the showing of why the new subject matter sought to be entered could not have been previously submitted in the prior-filed application. The Office will also consider the amendment, including any new claims, to determine whether the claims in the CIP application are directed to the new subject matter or mainly to the subject matter disclosed in the prior-filed application.

For example, if the new subject matter is not being claimed in the CIP application, but merely being added to circumvent the rule, the Office will not grant the petition.

Furthermore, 35 U.S.C. 120 requires that the prior-filed application disclose the subject matter of at least one claim of the later-filed application in the manner provided by 35 U.S.C. 112, ¶ 1, for the later-filed application to actually receive the benefit of the filing date of the prior-filed application. Thus, any claim in the CIP application that is directed to the subject matter **not** disclosed in the manner provided by 35 U.S.C. 112, ¶ 1, in the prior-filed application would be entitled **only** to the actual filing date of the CIP application (not the filing date of the prior-filed application), and subject to prior art based on the actual filing date of the CIP application. Applicant should not claim the benefit of the prior-filed application if all of the claims in the CIP application are directed to the new subject matter. The CIP application would not be entitled to the benefit of the filing date of the prior-filed application, and the term of any patent resulting from the CIP application will be measured under 35 U.S.C. 154(a)(2) from the filing date of the prior-filed application. That is, applicant would not receive any benefit of the earlier application but would have a patent term that is measured from the filing date of the earlier application. If there are any claims in the CIP application that are directed solely to subject matter disclosed in the prior-filed application, applicant must submit those claims in the prior-filed application rather than filing a CIP application, unless applicant provides a showing as to why these claims could not have been previously submitted.

E9. If the independent claims are finally rejected as unpatentable in a second continuation application in which applicant did not file an ESD, but the dependent claims contain allowable subject matter, and rewriting the dependent claims as independent claims would result in the application containing more than five independent claims, will the Office's patentability determination be a sufficient showing for filing an additional continuation application? (Posted on 9/26/07)

The Office will decide such petitions on a case-by-case basis. For example, some of the factors that the Office may consider include: (1) when did the examiner indicate the subject matter is allowable; and (2) why applicant did not file an ESD in compliance with 37 CFR 1.265 in the initial application and its continuation applications. Here, the mere

fact that the dependent claims contain allowable subject matter in a second continuation application is not a sufficient showing.

E10. Are there examples of a showing that the Office would consider sufficient for granting a petition for a third or subsequent continuation application? (Posted on 9/26/07)

One example would be that in a continuation application, an interference is declared in an application containing both claims corresponding to the counts and claims not corresponding to the counts, and the Administrative Patent Judge suggests that the claims not corresponding to the counts be canceled from the continuation application in the interference and pursued in a separate application. For more information and examples on the showing, *see* Final Rule, 72 *Fed. Reg.* at 46767-79.

E11. Who will be deciding the petitions for third or subsequent continuing applications and second or subsequent RCEs? (Posted on 9/26/07)

The authority to decide petitions under 37 CFR 1.78(d)(1)(vi) and 1.114(g) has been delegated to the Deputy Commissioner for Patent Examination Policy (who may further delegate this authority to officials under the Deputy Commissioner for Patent Examination Policy).

F. Number of Claims Permitted without an Examination Support Document (ESD) (37 CFR 1.75(b))**F1. How many claims are permitted in each application without triggering the requirement for an ESD? (Posted on 8/21/07)**

An applicant may present up to 5 independent claims or 25 total claims (5/25 claim threshold), counting all of the claims in any other application having a patentably indistinct claim, without an ESD. If an ESD in compliance with 37 CFR 1.265 is not filed before the issuance of a first Office action on the merits, the application must remain at 5 or fewer independent claims and 25 or fewer total claims. See 37 CFR 1.75(b).

In determining whether an application exceeds the 5/25 claim threshold:

- Withdrawn claims are not taken into account, unless they are reinstated or rejoined (see 37 CFR 1.75(b)(5));
- Claims of any other application having a patentably indistinct claim will be taken into account (not just the patentably indistinct claims) (see 37 CFR 1.75(b)(4));
- Multiple dependent claims and claims that depend from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in the multiple dependent claim (see 37 CFR 1.75(c));
- A claim that refers to another claim but does not incorporate by reference all of the limitations of the claim to which such claim refers will be treated as an independent claim; and
- A claim that refers to a claim of a different statutory class of invention will also be treated as an independent claim.

F2. How many claims are permitted in a continuation or CIP application if applicant did not file an ESD in the prior-filed application? (Posted on 8/21/07)

Applicant may present up to 5 independent claims or up to 25 total claims in a continuing application without an ESD. Applicant is also permitted to present more than 5 independent claims or more than 25 total claims in a continuing application, if the applicant files an ESD in compliance with 37 CFR 1.265 before the first Office action on the merits of the continuing application, regardless of whether an ESD has been filed in the prior-filed application.

Therefore, for each invention, an applicant is permitted to present up to 15 independent claims and 75 total claims via an initial application and two continuation or CIP applications without providing either an ESD or justification, as long as those applications are either prosecuted serially or contain patentably distinct claims.

F3. If an application contains more than 5 independent claims or more than 25 total claims and an ESD is inadvertently omitted, will the Office provide a notice to the applicant before the first Office action on the merits? (Posted on 8/21/07)

Applicant will be notified if the application contains more than 5 independent claims or more than 25 total claims but an ESD in compliance with 37 CFR 1.265 has been omitted. See 37 CFR 1.75(b)(3).

For applications filed under 35 U.S.C. 111(a) on or after November 1, 2007, and applications entering the national stage after compliance with 35 U.S.C. 371 on or after November 1, 2007:

If the non-compliance appears to have been inadvertent, the notice will set a two-month time period that is not extendable under 37 CFR 1.136(a) within which, to avoid abandonment of the application, the applicant must comply with the requirements set forth in 37 CFR 1.75(b).

If it is prior to the first Office action on the merits and it appears that the omission of an ESD was inadvertent, a notice under 37 CFR 1.75(b)(3) will set a two-month time period within which the applicant must:

1. File an ESD in compliance with 37 CFR 1.265 that covers each claim (whether in independent or dependent form); or
2. Amend the application such that it contains no more than 5 independent claims and no more than 25 total claims.

This two-month time period is not extendable under 37 CFR 1.136(a) and the failure to reply to such a notice will result in abandonment of the application. Once the Office issues a notice under 37 CFR 1.75(b)(3), the applicant may **not** simply submit a suggested requirement for restriction (SRR) under 37 CFR 1.142(c).

For applications filed under 35 U.S.C. 111(a) before November 1, 2007 (and applications that entered the national stage after compliance with 35 U.S.C. 371 before November 1, 2007) in which a first Office action on the merits was not mailed before November 1, 2007:

The Office will provide these applicants with an opportunity to submit:

1. An ESD under 37 CFR 1.265;
2. A new set of claims such that the application contains 5 or fewer independent claims and 25 or fewer total claims; or
3. A SRR under 37 CFR 1.142(c).

Specifically, the Office will issue a notice setting a two-month time period that is extendable under 37 CFR 1.136(a) or (b) (up to additional 4 months) within which the applicant must exercise one of these options in order to avoid abandonment of the application.

The Office, however, may combine such a notice with a requirement for restriction, in which case the applicant must make an election responsive to the restriction requirement and, if there are more than 5 independent claims or more than 25 total claims drawn to the elected invention, the applicant must also:

1. File an ESD in compliance with 37 CFR 1.265; or
2. Amend the application such that it contains 5 or fewer independent claims and 25 or fewer total claims directed to the elected invention.

Thus, if such a notice is combined with a requirement for restriction, the applicant does not have the option of replying to such notice with a SRR.

F4. If an ESD was not filed before the first Office action on the merits of an application and applicant filed an amendment such that the application would contain more than 5 independent claims or more than 25 total claims, how would the Office treat such an amendment? (Posted on 8/21/07)

If an ESD in compliance with 37 CFR 1.265 was **not** filed before the issuance of a first Office action on the merits of an application, an amendment that results in the application containing more than 5 independent claims or more than 25 total claims will be treated as non-responsive. The Office will not enter such an amendment and will not consider the amendment on the merits, but merely place the amendment into the application file.

If the non-compliance with 37 CFR 1.75(b) appears to have been inadvertent, the Office would give the applicant a two-month time period that is not extendable under 37 CFR 1.136(a) within which to provide an amendment that does **not** result in the application containing more than 5 independent claims or more than 25 total claims.

F5. If applicant filed two or more nonprovisional applications containing at least one patentably indistinct claim, can the applicant present 5 independent claims and 25 total claims in each application without an ESD? (Posted on 8/21/07)

If an applicant filed two or more nonprovisional applications that contain at least one claim that is patentably indistinct and the applications are commonly owned, the Office will treat the claims of all such pending applications as being present in each of the applications for purposes of determining whether each application exceeds the 5/25 claim threshold (and not just the claim that is patentably indistinct). See 37 CFR 1.75(b)(4).

37 CFR 1.75(b)(4) precludes an applicant from submitting multiple applications to the same subject matter (with claims that are patentably indistinct), each with 5 or fewer independent claims or 25 or fewer total claims, for the purpose of avoiding the requirement to submit an ESD in compliance with 37 CFR 1.265.

For example, if application “A” contains only one claim that is patentably indistinct from the claims in application “B”, application “A” and application “B” are owned by the same company, and each application contains 3 independent claims and 20 total claims, the Office will treat each application as having 6 independent claims and 40 total claims in determining whether each application exceeds the 5/25 claim threshold.

F6. If applicant prosecutes a continuation application of an initial application and the initial prior-filed application in parallel, will the Office treat each application as having the claims of both applications? (Posted on 8/21/07)

If the continuation application and the initial prior-filed application contain at least one patentably indistinct claim, the Office will treat each application as having the total

number of claims from both applications for purposes of determining whether each application exceeds the 5/25 claim threshold.

F7. Since a continuation application must have copendency with the prior-filed application, will the Office treat the continuation application as having the claims of the continuation application and the prior-filed application, if the prior-filed application is no longer pending when the Office is examining the continuation application? (Posted on 8/21/07)

No, the Office will not treat the continuation application as having the claims of the prior-filed application if the prior-filed application is no longer pending. The Office will treat the prior-filed application as no longer pending for purposes of 37 CFR 1.75(b)(4) if:

1. A notice of allowance is issued, unless the application is withdrawn from issue (37 CFR 1.313);
2. The Office recognizes the application is abandoned;
3. A notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141 is filed, unless the appeal is terminated; or
4. A civil action under 35 U.S.C. 145 or 146 is commenced, unless the civil action is terminated.

F8. Will the Office notify applicant if the application exceeds the 5/25 claim threshold counting the claims of another application having a patentably indistinct claim? (Posted on 8/21/07)

If the application exceeds the 5/25 claim threshold counting the claims of another application that contains at least one patentably indistinct claim, the Office will mail a notice requiring an ESD in the application if it is before the first Office action on the merits and if the omission of an ESD was inadvertent.

The notice will set a two-month time period that is not extendable under 37 CFR 1.136(a) within which, to avoid abandonment of the application, the applicant may:

1. Cancel the patentably indistinct claim(s) from all but one application;
2. File an ESD before FAOM; or
3. Amend the application(s) such that the applications together contain no more than 5 independent claims and no more than 25 total claims.

If a first Office action on the merits has been issued, the Office will mail a notice. The notice will set a two-month time period that is not extendable under 37 CFR 1.136(a) within which, to avoid abandonment of the application, the applicant must:

1. Cancel the patentably indistinct claim(s) from all but one application; or
2. Amend the application(s) such that the applications together contain no more than 5 independent claims and no more than 25 total claims.

F9. Will the Office count the claims of other applications that contain at least one patentably indistinct claim if the other applications do not have the same filing date or the same benefit or priority date? (Posted on 8/21/07)

The provisions of 37 CFR 1.75(b)(4) do not depend upon the relative filing dates of the nonprovisional application and the one or more other nonprovisional applications. If the applications are commonly owned and contain at least one patentably indistinct claim, the Office will treat the claims in all of the applications as present in each application for the purposes of determining whether each application exceeds the 5/25 claim threshold.

F10. Will the Office count withdrawn claims for the purposes of determining whether an application exceeds the 5/25 claim threshold? (Posted on 8/21/07)

Claims withdrawn from consideration as drawn to a non-elected invention will not, unless they are reinstated or rejoined, be taken into account in determining whether an application exceeds the 5/25 claim threshold. See 37 CFR 1.75(b)(5).

In addition, withdrawn claims are not taken into account in determining whether a copending application contains a claim that is patentably indistinct from a claim in such application for purposes of determining whether the application exceeds the 5/25 claim threshold.

F11. When withdrawn claims are reinstated or rejoined, will the Office notify the applicant? (Posted on 8/21/07)

Claims reinstated (e.g., as a result of a request for reconsideration of the requirement) or rejoined (e.g., upon allowance of a generic claim) in the application are taken into account in determining whether an application exceeds the 5 independent claim and 25 total claim threshold.

Unless an ESD in compliance with 37 CFR 1.265 was filed before the issuance of a first Office action on the merits of an application, the application must remain at or under the 5/25 claim threshold.

Therefore, if an ESD was **not** filed before the issuance of a first Office action on the merits of the application, and the reinstatement or rejoinder of non-elected claims results in the application containing more than 5 independent claims or more than 25 total claims, the Office will give the applicant a two-month time period within which to amend the application to contain 5 or fewer independent claims and 25 or fewer total claims.

This two-month time period is not extendable under 37 CFR 1.136(a). The failure to file such an amendment will result in abandonment of the application.

F12. When will a reinstatement or a rejoinder most likely occur? (Posted on 8/21/07)

Since claims reinstated or rejoined in the application are taken into account in determining whether an application exceeds the 5 independent claim and 25 total claim threshold, applicants cannot rely upon a requirement for restriction to avoid submitting an

ESD before the issuance of a first Office action on the merits of an application. This is especially true where:

1. The applicant traverses the requirement for restriction;
2. The requirement for restriction may be conditional, such as a requirement for election of species in an application that contains a claim that is generic to all of the claimed species (hereafter “generic claim”) (see MPEP § 809), or a requirement for restriction in an application that contains a linking claim (e.g., a subcombination claim linking plural combinations); or
3. The applicant plans to request rejoinder of the claims to the non-elected invention (see MPEP § 821.04 et seq.).

Thus, applicants are advised to file an ESD in compliance with 37 CFR 1.265 in the application before the first Office action on the merits if they anticipate the occurrence of any of the aforementioned three situations.

F13. What happens if the Office determines a claim that is generic to all of the claimed species including claims to a non-elected species is allowable? (Posted on 8/21/07)

When an application contains a generic claim and the examiner makes a provisional restriction requirement, requiring an election of species for initial search and examination purposes, the applicant must elect a single species. The requirement is provisional because the restriction will be withdrawn upon allowance of the generic claim.

The examiner will determine the patentability of the elected species and generic claim. Upon the allowance of the generic claim, the provisional restriction requirement will be withdrawn, as explained above. The claims of the non-elected species then will be rejoined. The Office will count the rejoined claims together with the other pending claims to determine whether the application exceeds the 5/25 claim threshold. See 37 CFR 1.75(b)(5).

If the application contains more than 5 independent claims or 25 total claims (counting the rejoined claims) and the applicant did not file an ESD in compliance with 37 CFR 1.265 before the issuance of a first Office action on the merits in the application, then the applicant must amend the application to contain no more than 5 independent claims and no more than 25 total claims. Therefore, applicants cannot rely upon a provisional requirement for restriction to avoid submitting an ESD before the issuance of the first Office action on the merits of the application.

F14. Can applicant request a rejoinder of a withdrawn claim that contains all the limitations of an allowable elected claim if an ESD was not filed before the first Office action on the merits of the application? (Posted on 8/21/07)

If applicant did not file an ESD in compliance with 37 CFR 1.265 before the first Office action on the merits, applicant cannot request a rejoinder of the withdrawn claims when the elected claims are subsequently found allowable, unless the total number of claims (counting the withdrawn claims) does not exceed the 5/25 claim threshold.

For example, an application contains 3 independent claims and 25 total claims directed to a product and 3 independent claims and 25 total claims directed to a process of making the product. The applicant elected the claims directed to the product in response to a restriction requirement. The claims to the process are withdrawn from further consideration. If applicant did not file an ESD in compliance with 37 CFR 1.265 before the first Office action on the merits, applicant cannot request the rejoinder of the process claims when the product claims are subsequently found allowable, unless the number of claims to both the product and process does not exceed the 5/25 claim threshold (e.g., applicant amends the application such that it contains no more than 5/25 claims).

However, if applicant filed an ESD in compliance with 37 CFR 1.265 before the first Office action on the merits, applicant may request a rejoinder of the withdrawn process claims that depend from or otherwise require all the limitations of an allowable product claim when the elected product claims are subsequently found allowable. A supplemental ESD will be required when the process claims are rejoined if the previous ESD did not cover the process claims.

F15. If the examiner indicates the dependent claims are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, can applicant rewrite such dependent claims as independent claims in an application that would contain more than five independent claims when such an amendment is entered, and is an ESD required to be filed with such an amendment? (Posted on 9/26/07)

If the applicant filed an ESD in compliance with 37 CFR 1.265 before the first Office action on the merits (FAOM), such an amendment may be entered. A supplemental ESD is not required if the previously-filed ESD covers each of the claims including the amended claims.

If the applicant did not file an ESD in compliance with 37 CFR 1.265 before the FAOM, the application may not be amended to contain more than five independent claims or more than twenty-five total claims. See 37 CFR 1.75(b)(1). Accordingly, such an amendment will be treated as nonresponsive and will not be entered. See Question F4 for more information. In this situation, filing an ESD after the FAOM with such an amendment will not result in the entry of the amendment.

F16. If the initial application and a continuation application contain patentably indistinct claims and are commonly owned, can the applicant present five independent claims and twenty-five total claims in each application if the applicant does one of the following: (1) cancels the patentably indistinct claims from all but one of the applications; (2) rebuts the rebuttable presumption under 37 CFR 1.78(f)(2), or (3) files a terminal disclaimer in accordance with 37 CFR 1.321(c)? (Posted on 9/26/07)

If applicant cancels the patentably indistinct claims from all but one of the applications or rebuts the rebuttable presumption under 37 CFR 1.78(f)(2), or one of the applications is no longer considered pending for purposes of 37 CFR 1.75(b) (*e.g.*, the initial application has been allowed (also see question F7)), then each application may have five independent claims and twenty-five total claims.

However, each application will be treated as having all of the claims of both applications, if applicant files a terminal disclaimer in accordance with 37 CFR 1.321(c), unless one of the applications is no longer considered pending for purposes of 37 CFR 1.75(b) (*e.g.*, the application has been allowed).

F17. How would the Office determine when an ESD was “inadvertently” omitted? (Posted on 9/26/07)

If the omission of an ESD is an isolated instance, then generally the omission would be considered inadvertent. Where, however, a particular individual (*e.g.*, applicant or attorney) has a pattern of not including an ESD where required, then the Office would be less inclined to consider such an omission as being inadvertent. The Office will not generally question whether the omission of an ESD was inadvertent unless there is a reason to do so.

F18. Is a restriction requirement or a requirement for information under 37 CFR 1.105 considered a FAOM? (Posted on 9/26/07)

No, a restriction requirement, or a requirement for information under 37 CFR 1.105, by itself will not be considered a FAOM. If the restriction requirement or a requirement for information is combined with a FAOM in a single Office action, then the Office action will be considered a FAOM.

F19. If applicant filed an application in which a first Office action on the merits (FAOM) has not been mailed before November 1, 2007, when will the Office mail a notice under 37 CFR 1.75(b)(3) to require an examination support document (ESD) in compliance with 37 CFR 1.265? (Posted on 10/22/07)

Under 37 CFR 1.75(b)(3), applicant will be notified if the application contains more than 5/25 claims and a SRR has not been filed. For such an application, the Office will estimate when (the date) the application is expected to be picked up in the ordinary course of business for action. At present, the Office expects that notices will generally be mailed approximately 6 to 9 months before the estimated date the application is expected to be picked up for action.

For applications filed before November 1, 2007 in which FAOM has not been mailed before November 1, 2007, the notice will provide a two-month time period for reply that is extendable under 37 CFR 1.136(a), up to maximum of six months if the notice is the first notice under 37 CFR 1.75(b)(3) issued in the application. *See* Final Rule, 72 Fed. Reg. at 46728 (at the bottom of the middle column).

For applications filed on or after November 1, 2007, the notice will provide a two-month time period for reply that is not extendable under 37 CFR 1.136(a).

F20. If, in response to a notice under 37 CFR 1.75(b)(3), applicant filed an amendment to cancel claims so that the application will no longer exceed the 5/25 claim threshold, can applicant subsequently file, before a FAOM or a restriction requirement, a SRR and a second amendment to add more claims without an ESD so that the application will contain more than 5 independent claims or more than 25 claims? (Posted on 10/22/07)

No, the Office notified the applicant in the notice under 37 CFR 1.75(b)(3) that the application contained more than 5/25 claims and an ESD in compliance with 37 CFR 1.265 had been omitted. In response to such a notice, an applicant cannot simply cancel claims instead of submitting a compliant ESD for purposes of responding to the notice and then subsequently amend the application to later contain more than 5/25 claims. If an applicant does so, the Office will not consider the omission of an ESD to be inadvertent. Accordingly, the Office will not enter the second amendment. The amendment will simply be placed in the application file. However, if an applicant submits a compliant ESD in response to the notice, then applicant may later file an amendment such that the amended application contains more than 5/25.

F21. If applicant filed an application on or after November 1, 2007, that contains more than 5/25 claims and two or more inventions and applicant did not file a SRR and an ESD, will the Office determine whether a restriction requirement should be made before mailing a notice under 37 CFR 1.75(b)(3) requiring an ESD to cover each of the claims in the application? (Posted on 10/22/07)

In applications that contain more than 5/25 claims without an ESD and a SRR, the Office will generally mail the notice under 37 CFR 1.75(b)(3) before determining whether a restriction requirement should be made. In certain limited situations, however, the Office may mail a notice accompanied by a restriction requirement. In response to such a notice, the applicant must make an election responsive to the restriction requirement within the two-month time period for reply set forth in the notice. This time period is not extendable under 37 CFR 1.136(a). If the elected invention has less than 5/25 claims, the applicant is not required to file an ESD. If the elected invention has more than 5/25 claims, the applicant is required to file an ESD in compliance with 37 CFR 1.265 that covers each elected claim. The ESD is not required to cover the non-elected claims.

G. Dependent Claims (37 CFR 1.75(b))

G1. What is the definition of a dependent claim? (Posted on 8/21/07)

A dependent claim must be presented in dependent form, referring back to and further limiting another claim or claims in the same application. A dependent claim is required to incorporate by reference all the limitations of the previous claim to which it refers and to specify a further limitation of the subject matter of the previous claim. See Pfizer Inc. v. Ranbaxy Labs. Ltd., 437 F.3d 1284, 1292, 79 U.S.P.Q.2d 1583, 1589-90 (Fed. Cir. 2006) (a dependent claim is required to include all the limitations of the claim from which it depends and the failure to incorporate by reference all the limitations is a violation of 35 U.S.C. 112, ¶ 4, and renders the dependent claim invalid).

G2. Will the Office consider any claim that is in dependent form a dependent claim? (Posted on 8/21/07)

A claim that refers to another claim but does not incorporate by reference all the limitations of the claim to which such claim refers will be treated as an independent claim for the purposes of determining whether an application exceeds the 5/25 claim threshold, and for the purposes of fee calculation under 37 CFR 1.16 or 1.492. See 37 CFR 1.75(b)(2). For examples of such claims, see: In re Thorpe, 777 F.2d 695, 696, 227 U.S.P.Q. 964, 965 (Fed. Cir. 1985) (“product by process” claim 44); In re Kuehl, 475 F.2d 658, 659, 177 U.S.P.Q. 250, 251 (C.C.P.A. 1973) (claim 6); and Ex parte Rao, 1995 WL 1747720, *1 (BPAI 1998) (claim 8).

A claim that refers to a claim of a different statutory class of invention will also be treated as an independent claim for the purposes of determining whether an application exceeds the 5/25 claim threshold, and for the purposes of fee calculation under 37 CFR 1.16 or 1.492. For example, if a method claim refers to a composition claim (e.g., “A method of using the composition of claim 1 comprising...”), it will be treated as an independent claim.

For more examples of such claims, see: Thorpe, 777 F.2d at 696, 227 U.S.P.Q. at 965 (“product by process” claim 44); Ex parte Porter, 25 U.S.P.Q.2d 1144, 1145 (BPAI 1992) (claim 6); and Ex parte Blattner, 2 U.S.P.Q.2d 2047, 2047-48 (BPAI 1987) (claim 14).

G3. If applicant disagrees with the Office determination that a claim is an independent claim for fee calculation, what action can the applicant take? (Posted on 8/21/07)

If applicant disagrees with the Office’s determination that a claim is an independent claim, applicant should provide a showing of how the claim is a dependent claim in compliance with 35 U.S.C. 112, ¶ 4, and 37 CFR 1.75(b) either in a reply to a notice requiring a claim fee or in a request for a refund.

Applicant may minimize issues related to fee calculation for claims by drafting claims that are in compliance with 35 U.S.C. 112, ¶ 4, and 37 CFR 1.75(b) (e.g., not presenting

claims that refer to another claim of a different statutory class of invention or claims that refer to another previous claim but do not incorporate by reference all of the limitations of the previous claim). The determination of whether a claim is independent or dependent could be difficult when applicant did not clearly draft the claim as an independent claim or a dependent claim under 35 U.S.C. 112, ¶ 4.

G4. What is the definition of a multiple dependent claim? (Posted on 8/21/07)

A multiple dependent claim is any dependent claim which refers to more than one other claim in the alternative only. A multiple dependent claim cannot serve as a basis for any other multiple dependent claim (see 37 CFR 1.75(c)).

G5. How would the Office treat a multiple dependent claim for the purposes of determining whether an application exceeds the 5/25 claim threshold? (Posted on 8/21/07)

For fee calculation purposes under 37 CFR 1.16 or 1.492 and for purposes of determining whether an application exceeds the 5/25 claim threshold, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein (and 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). The fee set forth in 37 CFR 1.16(j) is also required in any application which includes a multiple dependent claim.

For example:

Claim 4. A device according to claim 1, 2, or 3, further comprising ...

Claim 5. A device according to claim 4, further comprising...

For fee calculation purposes under 37 CFR 1.16 or 1.492 and for purposes of determining whether an application exceeds the 5/25 claim threshold, claim 4 will be considered to be 3 claims and claim 5 will also be considered to be 3 claims.

H. Suggested Requirements for Restriction (SRR) (37 CFR 1.142(c))**H1. When can applicant file a suggested requirement for restriction (SRR)? (Posted on 8/21/07)**

Applicant may submit a SRR if two or more independent and distinct inventions are claimed in the application before the earlier of a first Office action on the merits or a requirement for restriction in the application. Any SRR must also be accompanied by an election without traverse of an invention to which there are no more than 5 independent claims and no more than 25 total claims, and identify the claims to the elected invention.

H2. If the Office issues a restriction requirement, can applicant reply to the Office's requirement by filing a SRR? (Posted on 8/21/07)

No, once the Office issues a requirement for restriction, the applicant may not simply submit an alternative SRR, but instead must make an election (with or without traverse) responsive to the Office-issued requirement for restriction. A reply containing only an SRR will not be considered a *bona fide* reply.

H3. If a SRR is accepted, will the Office notify the applicant? (Posted on 8/21/07)

If a SRR is accepted and there are 5 or fewer independent claims and 25 or fewer total claims to the elected invention (as required by 37 CFR 1.142(c)), the Office will simply treat the non-elected claims as withdrawn from consideration and proceed to act on the application (assuming the application is otherwise in condition for action). The Office action will set out the requirement for restriction under 37 CFR 1.141(a), *e.g.*, in the manner that an Office action on the merits would contain a written record of a requirement for restriction previously made by telephone. See MPEP § 810.

H4. If a SRR is not accepted, can the examiner make a different restriction requirement? (Posted on 8/21/07)

If a SRR is not accepted, the applicant will also be notified. The refusal to accept a SRR may result in the examiner making a different restriction requirement or making no restriction requirement. An application containing claims to two or more independent and distinct inventions typically is not restricted to a single invention if the search and examination of all of the claims in the application can be made without serious burden (see MPEP § 803).

If the examiner makes a restriction requirement (which includes an election of species requirement) different from the SRR, the applicant will be notified of the restriction requirement. The applicant will be given a two-month time period* within which the applicant must make an election consistent with the Office-issued restriction requirement in order to avoid abandonment of the application. The applicant must make an election (with or without traverse) responsive to the Office-issued requirement for restriction. If

an application subject to an Office-issued requirement for restriction contains more than 5 independent claims or more than 25 total claims, the reply must also either:

1. Amend the application to contain no more than 5 independent claims and no more than 25 total claims to the elected invention and/or species; or
2. Include an ESD in compliance with 37 CFR 1.265 that covers each claim (whether in independent or dependent form) to the elected invention and/or species.

*The two-month time period for reply is not extendable under 37 CFR 1.136(a) for all applications.

H5. If a SRR is not accepted and the examiner makes no restriction requirement, will the Office notify the applicant? (Posted on 8/21/07)

If the examiner does **not** make a restriction requirement, the applicant will simply be given a notice under 37 CFR 1.75(b)(3). The notice will set a two-month time period* within which, to avoid abandonment of the application, the applicant must:

1. Amend the application to contain no more than 5 independent claims and no more than 25 total claims; or
2. File an ESD in compliance with 37 CFR 1.265 that covers each claim (whether in independent or dependent form) pending in the application.

*The two-month time period for reply is not extendable under 37 CFR 1.136(a) for all applications.

H6. If a SRR is not accepted, can applicant seek review of the nonacceptance? (Posted on 8/21/07)

If an applicant's SRR is refused, the examiner may make a different restriction requirement or make no restriction requirement. 35 U.S.C. 121 authorizes, but does not compel, the Director to require that an application containing two or more independent and distinct inventions be restricted to one of the inventions. A decision not to restrict an application to a single invention is not an action or requirement within the meaning of 37 CFR 1.181(a). Thus, any review of an examiner's requirement for restriction that differs from a SRR will only concern the appropriateness of the examiner's restriction requirement and will not address the appropriateness of the applicant's SRR or compare the examiner's restriction requirement and the SRR.

H7. If applicant submitted a SRR that includes an election of species, is applicant required to identify the claims to the elected species? (Posted on 8/21/07)

Yes, applicant must make an election without traverse of a species to which there are no more than 5 independent claims and no more than 25 total claims, and identify the claims to the elected species.

H8. Are there any guidelines on SRR? (Posted on 9/26/07)

Applicant is not required to file a SRR in any application. Applicant may file a SRR in any pending nonprovisional application. The following may assist applicants in drafting a SRR: Timeliness: Applicant must file the SRR prior to the earliest of the first Office action on the merits or a restriction requirement made by the examiner.

Applications: The application must contain claims to two or more independent and distinct inventions.

Identification of the inventions: Applicant should clearly identify the independent and distinct inventions.

Explanation: Applicant should provide an explanation why the inventions are independent or distinct as claimed. See MPEP §§ 808.01, 802.01, 806.05-806.05(j), and 806.06, 806. In addition, applicant may explain why there is a burden on the examiner if the restriction is not required. See MPEP §§ 803.02, 808 and 808.02. For example, appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02 may be included.

Election without traverse: The SRR must be accompanied by an election without traverse of an invention to which there are no more than 5 independent claims and no more than 25 total claims.

Identification of claims: Applicant must identify the claims to the elected invention. Applicant should also identify the claims to each invention.

H9. If, in response to a notice under 37 CFR 1.75(b), applicant filed a SRR in an application filed before November 1, 2007, that contains more than 5/25 claims, will the Office provide another notice if the Office does not accept the SRR? (Posted on 10/22/07)

Yes, the Office will notify the applicant if the SRR is not accepted. The notice will set forth a two-month time period for reply. This time period is not extendable under 37 CFR 1.136(a).

If the examiner does not make a different restriction requirement, the notice will require applicant to file an ESD in compliance with 37 CFR 1.265 to cover each of the claims or to amend the application so that it would contain no more than 5 independent claims and no more than 25 total claims.

If the examiner does make a different restriction requirement, the notice will be accompanied by the restriction requirement. In response to such a notice, the applicant must make an election responsive to the restriction requirement. If the elected invention has less than 5/25 claims, the applicant is not required to file an ESD. If the elected invention has more than 5/25 claims, the applicant is required to file an ESD in compliance with 37 CFR 1.265 that covers each elected claim. The ESD is not required to cover the non-elected claims.

I. Examination Support Document (ESD) (37 CFR 1.265)

I1. What are the differences between the requirements for an accelerated examination support document (AESD) and the requirements for an examination support document under 37 CFR 1.265? (Posted on 8/21/07)

A comparison chart is available on the USPTO web site.

I2. Are there ESD guidelines similar to the AESD guidelines posted on the USPTO web site? (Revised on 9/26/07)

Yes, the USPTO posted the ESD guidelines on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/esdguidelines090607.pdf>.

I3. Is searching the English abstracts in a foreign patent document database sufficient for searching foreign patent documents in a preexamination search under 37 CFR 1.265(b)? (Posted on 9/26/07)

Yes, a full text search in a non-English language is not required.

I4. The Regulatory Flexibility Act (RFA) defines small entity as one that is independently owned and not dominant in its industry, but it also allows the agency to publish regulations for determination of small entity. Which regulations did USPTO publish for establishing the definitions of small entity for Regulatory Flexibility Act purposes? (Posted on 9/26/07)

The RFA provides that an agency may establish one or more definitions of small business, small organization, or small governmental jurisdiction, which are appropriate to the activities of the agency, after consultation with the Office of Advocacy of the Small Business Administration and after opportunity for public comment. The USPTO has established the following definition of “small business” for Regulatory Flexibility Act purposes with respect to patent-related regulations: a business or other concern: (1) whose number of employees, including affiliates, does not exceed 500 persons; and (2) which has not assigned, granted, conveyed, or licensed (and is under no obligation to do so) any rights in the invention to any person who made it and could not be classified as an independent inventor, or to any concern which would not qualify as a non-profit organization or a small business concern under this definition. *See Business Size Standard for Purposes of United States Patent and Trademark Office Regulatory Flexibility Analysis for Patent-Related Regulations*, 71 *Fed. Reg.* 67109, 67112 (Nov. 20, 2006), 1313 *Off. Gaz. Pat. Office* 60, 63 (Dec. 12, 2006) (notice). The USPTO has not established any definition for small organization or small governmental jurisdiction for Regulatory Flexibility Act purposes. *See Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications*, 72 *Fed. Reg.* 46716, 46743-44 (Aug. 21, 2007) (final rule).

I5. Under the Small Business Administration size standard regulations, in some circumstances the definition of a “small business” may include companies which are larger

than 500 employees, depending upon the industry (as stated in 13 CFR 121.201). Such companies would clearly be outside the present USPTO definition of a small entity set forth in 37 CFR 1.27. Would such companies be considered as “small entities” for the purpose of the exemption from the ESD requirement in 37 CFR 1.265(a)(3)? (Posted on 9/26/07)

37 CFR 1.265(f) provides an exemption to applications filed by a small entity as defined by the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) with respect to the requirement in 37 CFR 1.265(a)(3) that an examination support document must include an identification of all of the claim limitations (whether in independent or dependent form) that are disclosed by the cited references. The USPTO has established the standard set forth in 13 CFR 121.802 for paying reduced patent fees as the definition of “small business” for Regulatory Flexibility Act purposes with respect to patent-related regulations. *See Business Size Standard for Purposes of United States Patent and Trademark Office Regulatory Flexibility Analysis for Patent-Related Regulations*, 71 *Fed. Reg.* 67109, 67112 (Nov. 20, 2006), 1313 *Off. Gaz. Pat. Office* 60, 63 (Dec. 12, 2006) (notice). Therefore, a “small business” for Regulatory Flexibility Act purposes, and thus for purposes of 37 CFR 1.265(f), is a business or other concern that meets the SBA business size standard for the purpose of paying reduced patent fees in 13 CFR 121.802 (not the small business size standards set forth in 13 CFR 121.201).

I6. If applicant properly submitted a certification under 37 CFR 1.265(f) when filing the initial ESD before the FAOM (therefore, the initial ESD is not required to include the identification under 37 CFR 1.265(a)(3) of claim limitations of each of the claims that are disclosed by the references cited in the listing of references), is applicant required to file a supplemental ESD due to a loss of entitlement to small entity status as defined by the Regulatory Flexibility Act? (Posted on 9/26/07)

No, once applicant filed a proper certification under 37 CFR 1.265(f) with the initial ESD in compliance with 37 CFR 1.265 before the FAOM of the application, applicant is not required to file a supplemental or corrected ESD due to a loss of entitlement to small entity status as defined by the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*)(RFA). However, if a supplemental or corrected ESD is required under 37 CFR 1.265(e), applicant must file the supplemental or corrected ESD that includes the identification of claim limitations of each of the claims that are disclosed by the references cited in the listing of references in compliance with 37 CFR 1.265(a)(3). For example, if applicant lost the entitlement to small entity status as defined by RFA before filing an amendment to the claims, and the claims are amended such that the initial ESD no longer covers each of the claims, applicant must file a supplemental ESD that includes the identification of claim limitations of each of the claims that are disclosed by the references cited in the initial ESD in compliance with 37 CFR 1.265(a)(3).

J. Commonly Owned Applications and Patents (37 CFR 1.78(f))

J1. When does an applicant have to identify other commonly owned applications and patents? (Revised 10/22/07)

If the subject application has an actual filing date before November 1, 2007, and has not been allowed, applicant must identify other pending or patented applications if the following conditions are met:

1. The subject application has the same actual filing date or benefit or priority filing date* as the actual filing date or the benefit or priority filing date of the other pending or patented application (taking into account any filing date for which a benefit is sought under title 35, United States Code);
2. The subject application names at least one inventor in common with the other pending or patented application; and
3. The subject application is owned by the same person, or subject to an obligation of assignment to the same person, as the other pending or patented application. See 37 CFR 1.78(f)(1) and Clarification Notice.

If the subject application has an actual filing on or after November 1, 2007, and has not been allowed, applicant must identify other pending or patented applications if the following conditions are met:

1. The subject application has a benefit or priority filing date before November 1, 2007, that is the same as the actual filing date or the benefit or priority filing date of the other pending or patented application, or the subject application has an actual filing date or benefit or priority filing date on or after November 1, 2007, that is the same as or within two months of the actual filing date or the benefit or priority filing date of the other pending or patented application;
2. The subject application names at least one inventor in common with the other pending or patented application; and
3. The subject application is owned by the same person, or subject to an obligation of assignment to the same person, as the other pending or patented application. See 37 CFR 1.78(f)(1) and Clarification Notice.

*This includes the actual filing date of the application, any foreign priority date, and the filing date of any prior-filed provisional application, nonprovisional application, and international application.

For example, if both application “A” and application “B” claim the benefit of the same prior-filed application, the applicant of application “A” must identify application “B” and the applicant of application “B” must identify application “A.”

J2. What does the phrase “taking into account any filing date for which a benefit is sought under title 35, United States Code” in 37 CFR 1.78(f)(1) and (f)(2) mean? (Posted on 8/21/07)

The phrase “taking into account any filing date for which a benefit is sought under title 35, United States Code” in 37 CFR 1.78(f)(1)(i)(A) and (f)(2)(i)(A) means any filing date for which a benefit (or priority) is sought or claimed under 35 U.S.C. 111, 119, 120, 121, 363, or 365. Thus, if an application claims the benefit of or priority to other applications, “the filing date of [the application], taking into account any filing date for which a benefit is sought under title 35, United States Code,” is the actual filing date of the application as well as the filing date of each application to which the application claims a benefit or priority.

For example, if an application has a filing date of December 1, 2006, and claims the benefit of a nonprovisional application that was filed on June 1, 2004, and claims the priority of a foreign application that was filed on June 1, 2003, for purposes of 37 CFR 1.78(f)(1) and (f)(2) the filing date of the application “taking into account any filing date for which a benefit is sought under title 35, United States Code,” is December 1, 2006, June 1, 2004, and June 1, 2003.

J3. Can applicant submit the identification of other commonly owned applications and patents in the specification, such as under the cross-reference to related applications section? (Revised on 10/22/07)

The identification of other commonly owned pending applications and patents under 37 CFR 1.78(f)(1) must be submitted on a separate paper. Applicant may use USPTO form (SB/206), “Listing of Commonly Owned Applications and Patents” available on the USPTO web site and Electronic Filing System (EFS-Web) in October 2007. Applicant is encouraged to use the USPTO form and submit it electronically to ensure faster and more accurate processing.

J4. What does the phrase “owned by the same person, or subject to an obligation of assignment to the same person” in 37 CFR 1.78(f) mean? (Posted on 8/21/07)

The phrase “owned by the same person, or subject to an obligation of assignment to the same person” in 37 CFR 1.78(f)(1)(i)(C), 1.78(f)(2)(i)(C) and 1.78(f)(3) has the same meaning as it does in 35 U.S.C. 103(c). See MPEP § 706.02(1)(2) for a discussion of the definition of this phrase as it is used in 35 U.S.C. 103(c).

J5. What does the phrase “has not been allowed” in 37 CFR 1.78(f) mean? (Posted on 8/21/07)

The phrase “has not been allowed” in 37 CFR 1.78(f)(1)(i), 1.78(f)(2)(ii) and (iii) means a notice of allowance under 37 CFR 1.311 has not been mailed in the application, or a notice of allowance under 37 CFR 1.311 has been mailed in the application but the application has been withdrawn from issue.

For example, the identification of such one or more other pending or patented nonprovisional applications under 37 CFR 1.78(f)(1)(i) is not required in an application

in which a notice of allowance has been mailed, unless the application is withdrawn from issue.

J6. Is there any timeliness requirement for submitting the identification of commonly owned applications and patents? (Posted on 8/21/07)

Applicant must submit the identification within the later of:

1. Four months from the actual filing date of a nonprovisional application filed under 35 U.S.C. 111(a);
2. Four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371; or
3. Two months from the mailing date of the initial filing receipt in the other nonprovisional application that is required to be identified. See 37 CFR 1.78(f)(1)(ii).

J7. Can applicant file the related application outside the 2-month window to avoid the identification requirement? (Posted on 8/21/07)

The identification requirement of other commonly owned pending applications or patents under 37 CFR 1.78(f)(1) does not supplant an applicant's duty to bring other applications that are "material to patentability" of an application (e.g., applications containing patentably indistinct claims) to the attention of the examiner. See Dayco Prod., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1365-69, 66 U.S.P.Q.2d 1801, 1806-08 (Fed. Cir. 2003); see also MPEP § 2001.06(b). Thus, applicants are cautioned against intentionally filing related applications outside of this two-month window in an attempt to avoid the requirement to identify other applications that are material to the patentability of the application at issue. See Cargill, Inc. v. Canbra Foods, Ltd., 476 F.3d 1359, 1367-68, 81 U.S.P.Q.2d 1705, 1711 (Fed. Cir. 2007) (there is no such thing as a good faith intent to deceive).

J8. When does the rebuttable presumption exist that a nonprovisional application contains at least one claim that is patentably indistinct from at least one of the claims in the one or more other pending or patented nonprovisional applications? (Posted on 8/21/07)

A rebuttable presumption exists that a nonprovisional application contains at least one claim that is patentably indistinct from at least one claim in another pending application or patent if the following conditions are met:

1. The application has a claimed filing or priority date* that is the same as the claimed filing or priority date* of the other pending application or patent, taking into account any filing date for which a benefit is sought under title 35, United States Code;
2. The application names at least one inventor in common with the other pending or patented application;
3. The application is owned by the same person, or subject to an obligation of assignment to the same person, as the other pending or patented application.
4. The application and the other pending application or patent contain substantially overlapping disclosure. Substantial overlapping disclosure exists if the other pending

or patented nonprovisional application has written description support under 35 U.S.C. 112, ¶ 1, for at least one claim in the nonprovisional application. See 37 CFR 1.78(f)(2)(i).

J9. If the rebuttable presumption under 37 CFR 1.78(f)(2) exists, what action(s) is required? (Posted on 8/21/07)

If the rebuttable presumption under 37 CFR 1.78(f)(2)(i) exists and the application has not been allowed, the applicant must either:

1. Rebut this presumption by explaining how the application contains only claims that are patentably distinct from the claims in each of such other pending applications or patents; or
2. Submit a terminal disclaimer in accordance with 37 CFR 1.321(c).

In addition, if the other commonly owned application is pending and applicant files a terminal disclaimer, the applicant must explain why there are two or more pending nonprovisional applications which contain patentably indistinct claims. Unless applicant presents good and sufficient reasons for such multiple applications, the Office may require elimination of the patentably indistinct claims from all but one of the applications. See 37 CFR 1.78(f)(3).

J10. Is applicant required to explain why there are two pending nonprovisional applications which contain patentably indistinct claims when applicant files a continuation or CIP application of an allowed application? (Posted on 8/21/07)

An applicant is not required to provide an explanation under 37 CFR 1.78(f)(2)(ii)(B) for a continuation application or CIP application of a prior-filed application that has been allowed, provided that the prior-filed application is not withdrawn from issue.

Furthermore, where the other nonprovisional application containing patentably indistinct claims is allowed, the Office will not count the claims of the allowed application in determining whether the total number of claims present in all of the copending nonprovisional applications containing patentably indistinct claims exceeds the 5 independent claim and 25 total claim threshold.

A terminal disclaimer in accordance with 37 CFR 1.321(c) will, however, be required in each nonprovisional application containing patentably indistinct claims to overcome any obviousness-type double patenting rejection.

J11. Is applicant required to file a rebuttal or a terminal disclaimer when applicant files a continuation or CIP application of an allowed application? (Posted on 8/21/07)

Applicant must submit either a rebuttal or a terminal disclaimer in accordance with 37 CFR 1.321(c) in the continuation or CIP application.

The applicant, however, is not required to rebut the presumption or submit a terminal disclaimer in the allowed prior-filed application.

Nevertheless, a terminal disclaimer in accordance with 37 CFR 1.321(c) will be required in each nonprovisional application containing patentably indistinct claims to overcome any obviousness-type double patenting rejection.

J12. Is there any timeliness requirement for submitting the rebuttal or terminal disclaimer? (Posted on 8/21/07)

If the rebuttable presumption under 37 CFR 1.78(f)(2)(i) exists and the application has not been allowed, applicant must submit a rebuttal or a terminal disclaimer (with an explanation, if required) within the later of:

1. Four months from the actual filing date of a nonprovisional application filed under 35 U.S.C. 111(a);
2. Four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in a nonprovisional application entering the national stage from an international application under 35 U.S.C. 371;
3. The date on which a claim that is not patentably distinct from a claim in one or more other pending or patented applications is presented; or
4. Two months from the mailing date of the initial filing receipt in the one or more other pending or patented applications.

J13. Is applicant required to submit a good and sufficient reason for two or more pending nonprovisional applications containing patentably indistinct claims that have different claimed filing or priority dates? (Posted on 8/21/07)

The Office may require that an applicant provide good and sufficient reason whenever there are two or more commonly owned pending nonprovisional applications with patentably indistinct claims, regardless of the relative filing dates of the applications. See 37 CFR 1.78(f)(3). A good and sufficient reason is not required if the application has been issued as a patent. Unless applicant presents good and sufficient reasons for such multiple applications, the Office may require elimination of the patentably indistinct claims from all but one of the applications.

If the patentably indistinct claims are not eliminated from all but one of the applications, the Office will treat each application as having the total of all of the claims for purposes of determining whether each application exceeds the 5/25 claim threshold. See 37 CFR 1.75(b)(4).

J14. What is an example of a good and sufficient reason for having two or more commonly owned pending applications with patentably indistinct claims? (Posted on 8/21/07)

Examples where an applicant may have a good and sufficient reason include:

1. An applicant filed a continuation application after the mailing of a notice of allowance in the prior-filed application, but the allowance of the prior-filed application was subsequently withdrawn by the Office; or

2. An interference was declared in an application that contains both claims corresponding to the count and claims not corresponding to the count, the BPAI suggests that the claims not corresponding to the count be canceled from the application in interference and pursued in a separate application, and the applicant filed a continuation application to present the claims not corresponding to the count.

These examples are merely illustrative and not exhaustive.

J15. What are the consequences for failing to identify commonly owned applications and patents? (Posted on 8/21/07)

If applicant inadvertently fails to identify the other commonly owned applications or patents in compliance with 37 CFR 1.78(f)(1) in a timely manner, applicant should submit the identification to the Office as soon as practical.

If the submission necessitates a new rejection based upon double patenting (including an obviousness-type double patenting rejection) in a second or subsequent Office action on the merits, the examiner may make such an action final (assuming that the conditions for making a second or subsequent action final are otherwise met).

The Office may also refer any registered practitioner who repeatedly fails to comply with the rule requirements to the Office of Enrollment and Discipline for appropriate action. Applicants and practitioners are strongly encouraged to revise their practices to ensure timely submissions of the required identification. Applicants and registered practitioners are reminded of their duties under 37 CFR 10.18 and other professional responsibility rules, and the consequences of any violations (e.g., 37 CFR 10.18(c), 10.18(d) and 10.23).

J16. What are the consequences for failing to rebut the presumption under 37 CFR 1.78(f)(2)? (Posted on 8/21/07)

The Office will treat the other applications as having at least one claim that is patentably indistinct from the claims in the application under examination. Therefore, the Office will treat each application as having the total of all of the claims for the purposes of determining whether each application exceeds the 5/25 claim threshold. See 37 CFR 1.75(b)(4). The Office will also require applicant to file a terminal disclaimer. If the other applications are pending, the Office will require an explanation as to why there are two or more pending applications that contain patentably indistinct claims. Furthermore, a rejection based upon double patenting (including an obviousness-type double patenting rejection) will be made in any subsequent Office action, unless a terminal disclaimer has been filed.

J17. Is applicant required to identify divisional applications under 37 CFR 1.78(f)(1) and rebut the rebuttable presumption under 37 CFR 1.78(f)(2) in a divisional application? (Posted on 9/26/07)

Yes, applicant is required to identify any divisional applications that meet the conditions set forth in 37 CFR 1.78(f)(1)(i), and applicant is required to rebut the presumption under 37 CFR 1.78(f)(2) in a divisional application that meets the conditions set forth in 37 CFR 1.78(f)(2)(ii).

For example, if applicant filed a divisional application of an initial application and the initial application is pending and has not been allowed, applicant must identify the divisional application in the initial application. Applicant may rebut the presumption under 37 CFR 1.78(f)(2) by explaining that the divisional application was filed in response to a restriction requirement made in the initial application and the divisional application contains claims to only a non-elected invention(s) that have been withdrawn in the initial application.

J18. If applicant filed an initial application “A” and a divisional application “B” of the initial application “A”, and applicant also filed another initial application “C” that has one common inventor, common assignee and a filing date within two months from the filing date of the divisional application “B” (but not within two months from the filing date of the initial application “A”), which applications are required under 37 CFR 1.78(f)(1) to be identified in each application? (Posted on 9/26/07)

Assuming all of the applications are pending and have not been allowed, applicant is required under 37 CFR 1.78(f)(1) to: (1) identify the divisional application “B” in the initial application “A”; (2) identify the initial application “A” and application “C” in the divisional application “B”; and (3) identify the divisional application “B” in application “C”.

J19. What does “patentably indistinct” as the term appears in 37 CFR 1.78 mean? (Posted on 9/26/07)

The standard for “patentably indistinct” as the term appears in 37 CFR 1.78 is the same as one-way distinctness in an obviousness-type double patenting analysis. See MPEP § 804(II)(B)(1)(a).

J20. What would be an adequate explanation under 37 CFR 1.78(f)(2)(ii) to rebut the presumption of patentably indistinct claims? (Posted on 9/26/07)

The presumption under 37 CFR 1.78(f)(2)(i) may be rebutted by a showing that the claims in the identified applications and/or patents are directed to a separate invention, or by pointing to a unique claim element(s) in the independent claim(s) of the application that patentably distinguishes them from the claims in the other application and/or patent that gave rise to the presumption.

J21. How does the Office determine whether two applications have substantial overlapping disclosure or not? (Posted on 9/26/07)

Substantial overlapping disclosure exists if the other pending or patented nonprovisional application has written description support under 35 U.S.C. 112, first paragraph, for at least one claim in the nonprovisional application.

J22. Can the examiner issue a requirement for information if the examiner discovers a commonly owned application that satisfies the conditions set forth in 37 CFR 1.78(f)(1)(i) or contains at least one patentably indistinct claim, but it was not identified by the applicant? (Posted on 9/26/07)

Yes, the examiner may issue a requirement for information under 37 CFR 1.105. The requirement for information (if sent separately from an action on the merits) will provide a shortened statutory period of two months that is extendable under 37 CFR 1.136(a) (see MPEP § 704.13) within which, to avoid abandonment of the application, applicant must respond.

Applicant must identify:

1. Other applications that meet the conditions specified in 37 CFR 1.78(f)(1)(i);
2. Other applications that meet the conditions specified in 37 CFR 1.78(f)(2)(i); and
3. Other applications that contain patentably indistinct claims.

Otherwise, applicant must submit a statement stating that there is no other application that meets the conditions specified in 37 CFR 1.78(f)(1)(i) or 1.78(f)(2)(i), or contains patentably indistinct claims.

For each application identified by the applicant (or by the examiner) that meets the conditions specified in 37 CFR 1.78(f)(2)(i), applicant must also either:

1. Rebut the presumption that the applications include patentably indistinct claims; or
2. File a terminal disclaimer. If the applications are pending, applicant must also explain why there are two or more applications containing patentably indistinct claims.

J23. If applicant files a continuation application of an initial application, is applicant required to identify the continuation application in the initial application and identify the initial application in the continuation application under 37 CFR 1.78(f)(1)? (Posted on 9/26/07)

If the applications are commonly owned and have at least one common inventor, applicant must identify the initial application in the continuation application and must identify the continuation application in the initial application that has not been allowed. However, if the initial application has been allowed, applicant is not required to identify the continuation application in the allowed initial application.

J24. If an applicant filed a U.S. nonprovisional application and a corresponding international application designating the U.S. at the same time, is applicant required to identify the international application under 37 CFR 1.78(f)(1) in the nonprovisional application? (Posted on 9/26/07)

Under 37 CFR 1.78(f)(1), applicant is not required to identify the international application in the nonprovisional application until the international application enters the U.S. national stage. If the international application is entering the U.S. national stage, applicant must identify the international application in the nonprovisional application within two months from the mailing date of the initial filing receipt in the international application entering the national stage. However, if the international application does not enter the U.S. national stage, applicant is not required to identify the international application in the nonprovisional application.

J25. May an assignee simply submit a listing of all its pending applications and patents (e.g., where the company has 1,000 applications and patents) regardless of inventorship and filing dates to satisfy the identification requirement under 37 CFR 1.78(f)(1)? (Posted on 9/26/07)

No, such a submission will not be considered a proper identification under 37 CFR 1.78(f)(1).

J26. If the claims of application #1 is patentably distinct from the claims of application #2, but the claims of application #2 is not patentably distinct from the claims of application #1, so that the claims of the applications are distinct in only one way, are the claims of the applications “patentably indistinct” for purposes of 37 CFR 1.78(f) and 1.75(b)(4)? (Posted on 9/26/07)

Yes, the test for “patentably indistinct” as the term appears in 37 CFR 1.78(f) and 1.75(b)(4) is a one-way obviousness-type double patenting analysis. See MPEP § 804(II)(B)(1)(a).

K. Effective Date Provisions of the Final Rule

Please note that the questions in this section have been renumbered: K1-K4 as KA1-KA4; K5-K6 as KB1-KB2; K7-K8 as KC1-KC2; K9-K10 as KD1-KD2; and K11 as KE1.

KA1. What is the effective date for the rule changes in this final rule? (Renumbered on 9/26/07)

The effective date is November 1, 2007.

KA2. Do the changes to 37 CFR 1.78 apply to applications filed before November 1, 2007? (Revised on 9/26/07)

Yes, the changes to 37 CFR 1.78 (except for 37 CFR 1.78(a) and 1.78(d)(1)) are applicable to any nonprovisional application filed before November 1, 2007 that is pending on or after November 1, 2007.

The changes to 37 CFR 1.78(a) and 1.78(d)(1) are applicable to any application filed on or after November 1, 2007, or any application entering the national stage after compliance with 35 U.S.C. 371 on or after November 1, 2007.

Except as otherwise indicated in the final rule, any application filed under 35 U.S.C. 111(a) on or after November 1, 2007, or any application entering the national stage after compliance with 35 U.S.C. 371 on or after November 1, 2007, seeking to claim the benefit under 35 U.S.C. 120, 121, or 365(c) and 37 CFR 1.78 of a prior-filed nonprovisional application or international application must either: (1) meet the requirements specified in one of 37 CFR 1.78(d)(1)(i) through (d)(1)(v); or (2) include a grantable petition under 37 CFR 1.78(d)(1)(vi).

The final rule contains a waiver of 37 CFR 1.78(d)(1) for certain applications. For applications that claim the benefit under 35 U.S.C. 120, 121, or 365(c) only of nonprovisional applications or international applications filed before August 21, 2007, those applications are not required to meet the requirements set forth in 37 CFR 1.78(d)(1) if: (1) the applications claim the benefit under 35 U.S.C. 120, 121, or 365(c) only of nonprovisional applications filed before August 21, 2007 or applications entering the national stage after compliance with 35 U.S.C. 371 before August 21, 2007; and (2) there is no other application filed on or after August 21, 2007 that also claims the benefit under 35 U.S.C. 120, 121, or 365(c) of such prior-filed nonprovisional applications or international applications. *See Final Rule, 72 Fed. Reg. at 46717, 46736-37.*

More simply put, this waiver of 37 CFR 1.78(d)(1) provides applicants with “one more” continuation or CIP application of a second or subsequent continuing application (continuation application or continuation-in-part application) that was filed prior to August 21, 2007, without a petition under 37 CFR 1.78(d)(1)(vi). Thus, an applicant may file a single continuation or CIP application on or after November 1, 2007, without meeting the requirements specified in 37 CFR 1.78(d)(1)(i) through (d)(1)(v), or

including a petition under 37 CFR 1.78(d)(1)(vi), even if the prior-filed application was a second or subsequent continuation or CIP application.

It should be noted that the purpose of this provision is to ensure that an applicant may file “one more” continuation or CIP application of an application that was filed prior to August 21, 2007, without a petition and showing, and not to provide an “extra” continuation or CIP application for applications filed prior to August 21, 2007. If an application filed before August 21, 2007 is not a continuing application or is only the first continuing application, this provision will not entitle an applicant to file a third or subsequent continuation or continuation-in-part application without a petition and showing.

The final rule does not impact an applicant’s ability to file continuing applications between August 21, 2007 and October 31, 2007. Any continuing application filed between August 21, 2007 and October 31, 2007 will be taken into account in determining whether an applicant may file “one more” continuing application on or after November 1, 2007, without a petition.

KA3. If applicant filed an initial application and more than two continuation or CIP applications before August 21, 2007, can applicant file another continuation or CIP application on or after November 1, 2007, without a petition? (Revised on 9/26/07)

Yes, applicant may file “one more” continuation or CIP application on or after November 1, 2007, without a petition and showing. *See* Final Rule, 72 *Fed. Reg.* at 46717, 46736-37. However, if applicant filed one or more continuation or CIP applications between August 21, 2007 and November 1, 2007, applicant may not file any additional continuation or CIP application on or after November 1, 2007, without a petition and showing.

Please note that applicant may not file “one more” (*i.e.*, third) continuation or CIP application if applicant did not file any continuation or CIP application before August 21, 2007 or applicant only filed a single continuation or CIP application of an initial application before August 21, 2007.

KA4. If applicant filed one continuation or CIP application before August 21, 2007, can applicant file two more continuation or CIP applications on or after November 1, 2007, without a petition? (Revised on 9/26/07)

No, applicant may file only the second continuation or CIP application on or after November 1, 2007, without a petition and showing if applicant only filed one continuation or CIP application before August 21, 2007. Applicant may file a third or subsequent continuation or CIP application on or after November 1, 2007, with a petition and showing.

KA5. How many continuing applications can an applicant file between August 21, 2007 and October 31, 2007, without a petition? (Posted on 9/26/07)

The changes to 37 CFR 1.78(d)(1) are applicable to nonprovisional applications filed (or that entered the national stage) on or after November 1, 2007. Therefore, applicant may file as many continuation or CIP applications as applicant wants between August 21, 2007 and October 31, 2007, without a petition and showing, regardless of the number of previously filed continuing applications. Please note that for continuation or CIP applications in which a FAOM is not issued before November 1, 2007, that contain patentably indistinct claims and are commonly owned, the Office will treat the claims of all such pending applications as being present in each of the applications for purposes of determining whether each application exceeds the 5/25 claim threshold under 37 CFR 1.75(b) for requiring an ESD. For more information, see 37 CFR 1.75(b)(4) and 1.78(f)(2).

KA6. If applicant filed an initial application between August 21, 2007 and October 31, 2007, how will the changes to 37 CFR 1.78 and 1.114 apply to the initial application and its continuing applications? For example, since the initial application was filed before November 1, 2007, can applicant file as many continuation applications and RCEs as applicant wants without a petition? (Posted on 9/26/07)

The changes to 37 CFR 1.78(d)(1) are applicable to any continuing application filed on or after November 1, 2007. Applicant may file two continuation or CIP applications of the initial application on or after November 1, 2007, without a petition and showing. Applicant may file a third or subsequent continuation or CIP application of the initial application on or after November 1, 2007, with a petition and showing. The changes to 37 CFR 1.114 apply to any RCE filed on or after November 1, 2007. Applicant may file one RCE in the application family without a petition and showing after November 1, 2007. Applicant may also file a second or subsequent RCE in the application family on or after November 1, 2007, with a petition and showing.

KA7. If applicant filed an initial application between August 21, 2007 and October 31, 2007, can applicant file an extra continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition? (Posted on 9/26/07)

No, applicant may not file an extra continuation or CIP application under the effective date provision, without a petition and showing. Applicant may file two continuation or CIP applications on or after November 1, 2007, without a petition and showing, if applicant did not file any continuation or CIP application before November 1, 2007. But, if applicant filed two continuation or CIP applications before November 1, 2007, applicant may not file a third continuation or CIP application on or after November 1, 2007, without a petition and showing.

KA8. If applicant filed a second continuation or CIP application between August 21, 2007 and October 31, 2007, can applicant file an extra continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition? (Posted on 9/26/07)

No, applicant may not file an extra continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition and showing. *See* Final Rule, 72 *Fed. Reg.* at 46736-37.

KA9. If applicant filed an initial application before August 21, 2007 and did not file any continuation or CIP applications before August 21, 2007, how many continuation or CIP applications are permitted to be filed on or after November 1, 2007, without a petition? Can applicant file “one more” continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition? (Posted on 9/26/07)

Any continuation or CIP applications filed between August 21, 2007 and October 31, 2007, would be taken into account in determining the number of continuation or CIP applications that an applicant may file on or after November 1, 2007, without a petition and showing.

If applicant did not file any continuation or CIP application between August 21, 2007 and October 31, 2007, applicant may file two continuation or CIP applications on or after November 1, 2007, without a petition and showing.

If applicant filed one continuation or CIP application between August 21, 2007 and October 31, 2007, applicant may file one continuation or CIP application on or after November 1, 2007, without a petition and showing.

If applicant filed more than two continuation or CIP applications between August 21, 2007 and October 31, 2007, applicant may not file any continuation or CIP application on or after November 1, 2007, without a petition and showing.

Applicant may not file “one more” continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition and showing.

KA10. If applicant filed an initial application and one continuation or CIP application before August 21, 2007, how many continuation or CIP applications are permitted to be filed on or after November 1, 2007, without a petition and can applicant file “one more” continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition? (Posted on 9/26/07)

Any continuation or CIP applications filed between August 21, 2007 and October 31, 2007, would be taken into account in determining the number of continuation or CIP applications that an applicant may file 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 any continuation or CIP application on or after November 1, 2007, without a petition and showing.

Applicant may not file “one more” continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition and showing.

KA11. If applicant filed an initial application and more than one continuation or CIP application before August 21, 2007, how many continuation or CIP applications are permitted to be filed on or after November 1, 2007, without a petition and can applicant file “one more” continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition? (Posted on 9/26/07)

Any continuation or CIP applications filed between August 21, 2007 and October 31, 2007, would be taken into account in determining: (a) the number of continuation or CIP applications that an applicant may file on or after November 1, 2007, without a petition and showing; and (b) whether applicant may file “one more” continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition and showing.

If applicant did not file any continuation or CIP application between August 21, 2007 and October 31, 2007, applicant may file “one more” continuation or CIP application under the effective date provision 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 any continuation or CIP application on or after November 1, 2007, without a petition and showing. In addition, applicant may not file “one more” continuation or CIP application under the effective date provision on or after November 1, 2007, without a petition and showing.

KA12. If applicant filed an initial application “A” and two continuation or CIP applications “B” and “C” (in parallel) before August 21, 2007, can applicant file a continuation or CIP application for application “B” and a continuation or CIP application for application “C” on or after November 1, 2007, without a petition (*i.e.*, “one more” continuation or CIP application for each prior-filed continuation or CIP application)? (Posted on 9/26/07)

No, applicant may only file “one more” continuation or CIP application in the application family on or after November 1, 2007, without a petition and showing. For example, applicant may file a continuation or CIP application for application “B” on or after November 1, 2007, without a petition and showing, and a continuation or CIP application for application “C” on or after November 1, 2007, with a petition and showing.

KA14. If applicant filed an initial application and three continuation or CIP applications and an RCE before August 21, 2007, and the initial application is still pending, can applicant file two additional continuation or CIP applications of the initial application and an RCE in the second additional continuation or CIP application on or after November 1, 2007, without a petition? (Posted on 9/26/07)

No, applicant may only file “one more” continuation or CIP application on or after November 1, 2007, without a petition, regardless of whether the initial application is pending. Furthermore, applicant may not file a second or subsequent RCE on or after November 1, 2007, in an application family, without a petition and showing.

KA15. Do the changes to 37 CFR 1.78(a) and (d)(1) apply to design applications? (Posted on 9/26/07)

Yes, applicant may file two continuation or CIP design applications for an initial design application. Applicant may not file any RCE in a design application. A continued prosecution application (CPA) under 37 CFR 1.53(d) is a continuation application. See question B14.

KA16. If applicant filed a CIP application before November 1, 2007, is applicant required to identify before November 1, 2007, the claims in that CIP application for which the subject matter is disclosed in the manner provided by 35 U.S.C. 112, ¶ 1, in the prior-filed application, which was also filed before November 1, 2007? (Revised on 10/22/07)

No, applicant is not required to identify before November 1, 2007, the claims in such a CIP application for which the subject matter is disclosed in the prior application filed before November 1, 2007.

For any CIP application in which a first Office action on the merits (FAOM) has been mailed before November 1, 2007, applicant is not required under 37 CFR 1.78(d)(3) to identify the claims in a CIP application that are supported by the prior-filed application.

For any CIP application filed before November 1, 2007, in which a FAOM has not been mailed before November 1, 2007, applicant is required to submit the identification by February 1, 2008. This is because the changes to 37 CFR 1.78 (except 1.78(a) and 1.78(d)(1)) are applicable to any nonprovisional application pending on or after November 1, 2007 and the compliance date for this requirement is February 1, 2008. *See* Clarification Notice.

If an Office action on the merits was mailed before February 1, 2008, the next Office action cannot be made final if it contains a new ground of rejection necessitated by applicant’s identification of the claims in a CIP for which the subject matter is disclosed in the prior-filed application.

KB1. If applicant filed an RCE in an application before November 1, 2007, can applicant file another RCE on or after November 1, 2007 without a petition? (Renumbered on 9/26/07)

No, applicant may only file a second or subsequent RCE on or after November 1, 2007, in an application if it is accompanied by a petition and showing in compliance with 37 CFR 1.114(g). Effective on November 1, 2007, applicant may file a single RCE in an

application family. An application family includes the initial application and its continuation or CIP applications.

KB2. Can applicant file an RCE in a continuation or CIP application of a prior-filed application in which an RCE was previously filed before November 1, 2007? (Renumbered on 9/26/07)

No, applicant may only file a single RCE in an application family, without a petition and showing, on or after November 1, 2007. An application family includes the initial application and its continuation or CIP applications.

KB3. Can applicant file “one more” RCE on or after November 1, 2007 in an application family without a petition? (Posted on 9/26/07)

No, if the RCE filed on or after November 1, 2007 is a second or subsequent RCE in the application family, applicant is required to file a petition and showing.

KB4. If applicant filed two continuation or CIP applications before August 21, 2007, and the third continuation or CIP application on or after November 1, 2007, but applicant did not file any RCE in the application family, can applicant file an RCE in the third continuation or CIP application on or after November 1, 2007, without a petition? (Posted on 9/26/07)

Yes, applicant may file an RCE in the third continuation or CIP application without a petition and showing because applicant did not previously file any RCE in the application family.

KB5. Can applicant file a second or subsequent RCE in an application or an application family between August 21, 2007 and October 31, 2007, without a petition and showing? (Posted on 9/26/07)

Yes, applicant may file a second or subsequent RCE before November 1, 2007 without a petition and showing.

KC1. Can applicant present more than 5 independent claims or 25 total claims in an application filed before November 1, 2007 without filing an ESD in compliance with 37 CFR 1.265? (Renumbered on 9/26/07)

The changes to 37 CFR 1.75, 1.142(c), and 1.265 are applicable to any nonprovisional application filed under 35 U.S.C. 111(a) on or after November 1, 2007, and to any nonprovisional application entering the national stage after compliance with 35 U.S.C. 371 on or after November 1, 2007.

The changes to 37 CFR 1.75, 1.142(c), and 1.265 are also applicable to any nonprovisional application filed before November 1, 2007, in which a first Office action on the merits was not mailed before November 1, 2007.

Therefore, applicant may present more than 5 independent claims or 25 total claims in an application in which a first Office action on the merits was mailed before November 1, 2007, without an ESD.

However, applicant may not present more than 5 independent claims or 25 total claims in an application in which a first Office action on the merits was not mailed before November 1, 2007, without an ESD.

KC2. If the Office issued a restriction requirement, but not a first Office action on the merits, before November 1, 2007, can applicant present more than 5 independent claims or 25 total claims in an application, without an ESD? (Renumbered on 9/26/07)

Since a first Office action on the merits was not mailed before November 1, 2007, the application will be subject to the changes to 37 CFR 1.75 and 1.265.

Accordingly, if the applicant elected an invention that is drawn to 5 or fewer independent claims and 25 or fewer total claims, an ESD will not be required. However, if the applicant elected an invention that is drawn to more than 5 independent claims or more than 25 total claims, the Office will notify applicant that an ESD in compliance with 37 CFR 1.265 is required.

The notice will provide a two-month time period that is extendable under 37 CFR 1.136(a) or (b) (up to maximum of 6 months). To avoid the abandonment of the application, the applicant must within this time period either submit an ESD in compliance with 37 CFR 1.265 or amend the application to contain no more than 5 independent claims and no more than 25 total claims to the elected invention.

KC3. If applicant filed an initial application and received a FAOM of the initial application before August 21, 2007, applicant also filed a continuation application on or after November 1, 2007, and the initial application is no longer pending, can applicant present more than 5/25 claims in the continuation application, without an ESD? (Posted on 9/26/07)

No, applicant may not present more than five independent claims or more than twenty-five total claims in the continuation application without filing an ESD in compliance with 37 CFR 1.265 before a FAOM of the continuation application. The changes to 37 CFR 1.75(b) apply to the continuation application because applicant did not receive a FAOM in the continuation application before November 1, 2007.

KC4. If applicant filed an initial application that contains more than 5/25 claims and applicant received a FAOM of the initial application before August 21, 2007, can applicant file two continuation applications (in parallel or in series) on or after November 1, 2007 so that each continuation application may contain 5/25 or fewer claims to avoid filing an ESD assuming the initial application was abandoned upon the filing of the continuation

applications, or can applicant file one continuation application and submit a suggested restriction requirement? (Posted on 9/26/07)

If the continuation applications are being prosecuted in parallel, commonly owned, and have at least one patentably indistinct claim, the Office will treat each continuation application as having the total of all of the claims for the purposes of determining whether each continuation application exceeds the 5/25 claim threshold for requiring an ESD. Therefore, unless the applicant rebuts the presumption of patentably indistinctness, filing more than one continuation application in this situation will not prevent the Office from requiring an ESD in each continuation application. If the continuation applications are prosecuted in series (*e.g.*, the first continuation application has been allowed), each continuation application may contain 5/25 or fewer claims without an ESD.

Alternatively, applicant may file a single continuation application and submit a suggested restriction requirement if the continuation application claims more than one invention. If the suggested restriction requirement is accepted and the examiner makes a restriction requirement, applicant may file a divisional application for the non-elected invention that has not been examined in the initial application.

KC5. If applicant filed an RCE before November 1, 2007, but has not received an Office action after the filing of the RCE, can applicant present more than 5 independent claims or 25 total claims in the application without an ESD? (Posted on 9/26/07)

Yes, an ESD will not be required because the filing of an RCE is not a filing of a new application. The Office action after the filing of the RCE is not considered as the FAOM of the application. The FAOM of the application was issued before the filing of the RCE.

However, if applicant filed a continuation application rather than an RCE and the FAOM of the continuation application was not issued before November 1, 2007, applicant may not present more than 5 independent claims or 25 total claims in the continuation application without an ESD in compliance with 37 CFR 1.265 before the FAOM of the continuation application.

KD1. Is applicant required to identify commonly owned applications and patents in an application filed before November 1, 2007? (Renumbered on 9/26/07)

For applications filed before November 1, 2007, applicants must comply with the requirements in 37 CFR 1.78(f)(1) within the time periods specified in 37 CFR 1.78(f)(1)(ii), or by February 1, 2008, whichever is later.

KD2. Does the rebuttable presumption of patentably indistinct claims apply to applications filed before November 1, 2007? (Renumbered on 9/26/07)

Yes, applicants must comply with the requirements in 37 CFR 1.78(f)(2) within the time periods specified in 37 CFR 1.78(f)(2)(iii), or by February 1, 2008, whichever is later.

KE1. Can applicant obtain a refund of excess claims fees paid in an application filed before November 1, 2007? (Renumbered on 9/26/07)

The changes to 37 CFR 1.117 are applicable to any nonprovisional application filed before, on, or after November 1, 2007, with respect to any fee under 37 CFR 1.16(h), (i), or (j) or 1.492(d), (e), or (f) paid on or after December 8, 2004.

Therefore, regardless of the filing date of the application, applicant may request a refund of any excess claims fee paid for a canceled claim if:

1. The excess claims fee was paid on or after December 8, 2004;
2. The amendment canceling the claim is filed before an examination on the merits has been made of the application; and
3. The request for a refund is filed on or after November 1, 2007, and within two months from the filing of the amendment canceling the claim.

L. Reissue Applications and Reexamination Proceedings

L1. Do the changes to the continuing application practice and the RCE practice apply to reissue applications and reexamination proceedings?

The changes to 37 CFR 1.78 and 1.114 apply to reissue applications, but they do not apply to reexamination proceedings. Applicant may file two reissue continuation applications plus an RCE in the reissue application family, without a petition and showing. The benefit claims in the application for patent that is being reissued will not be taken into account.

For example, even if the application for the original patent was a second continuation application, applicant may still file two reissue continuation applications. However, an applicant may not use the reissue process to add to the original patent benefit claims under 35 U.S.C. 120, 121, or 365(c) that do not satisfy one or more of the conditions set forth in 37 CFR 1.78(d)(1)(i) through 1.78(d)(1)(vi) to the original patent, if the application for the original patent was filed on or after November 1, 2007.

L2. Do the changes to 37 CFR 1.75 apply to reissue applications and reexamination proceedings?

The changes to 37 CFR 1.75 are applicable to reissue applications, but they do not apply to reexamination proceedings. Specifically, the changes apply to reissue applications filed on or after November 1, 2007, as well as to any reissue application in which a first Office action on the merits (37 CFR 1.104) was not mailed before November 1, 2007.

However, 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 or addition of a claim or claims, or by an amendment to the specification which changes a claim or claims.

M. Final Practice

M1. Did the Office retain the first action final practice?

Yes, the Office is retaining its first action final rejection practice. The Office has a first action final rejection practice under which the first Office action in a continuing application, or in the prosecution of a request for continued examination, may be made final under certain circumstances. See MPEP §§ 706.07(b) and 706.07(h), paragraph VIII.

Applicants are reminded that it would not be proper for the Office to make a first Office action final in a continuing application or after a request for continued examination if the application contains material which was presented after final rejection or the close of prosecution but was denied entry because: (1) new issues were raised that required further consideration and/or search; or (2) the issue of new matter was raised. See MPEP §§ 706.07(b) and 706.07(h). Thus, applicants may guard against first action final rejection in a continuing application or after a request for continued examination by first seeking entry of the amendment, argument, or new evidence under 37 CFR 1.116.

M2. When can a second Office action be made final?

A second or any subsequent Office action on the merits may be made final, except when the Office action contains a new ground of rejection that is not:

1. Necessitated by applicant's amendment of the claims, including amendment of a claim to eliminate unpatentable alternatives;
2. Necessitated by applicant's providing a showing that a claim element that does not use the phrase "means for" or "step for" is written as a function to be performed and does not otherwise preclude application of 35 U.S.C. 112, ¶ 6;
3. Based on information submitted in an IDS filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p);
4. Based upon double patenting (statutory or obviousness-type double patenting); or
5. Necessitated by applicant's identification of the claim or claims in a CIP application for which the subject matter is disclosed in the manner provided by 35 U.S.C. 112, ¶ 1, in the prior-filed application.

N. Patent Term Adjustment (PTA) (37 CFR 1.704)

N1. If an application was filed under 35 U.S.C. 111(a) with more than 5 independent claims or 25 total claims, but an ESD in compliance with 37 CFR 1.265 was not filed within 4 months from the filing date of the application, are there patent term adjustment (PTA) consequences of the failure to file the ESD?

There will be a reduction of any PTA when there is a failure to comply with 37 CFR 1.75(b). If the application is filed on or after November 1, 2007, any PTA will be reduced by the number of days in the period between the following beginning and ending dates.

The beginning date of the period is the day after the date that is 4 months from the filing date of the application.

The ending date of the period is the filing date of:

1. An ESD in compliance with 37 CFR 1.265;
2. An election of an invention that is drawn to 5 or fewer independent claims and 25 or fewer total claims responsive to a requirement for restriction;
3. An amendment that results in the application containing 5 or fewer independent claims and 25 or fewer total claims; or
4. A suggested requirement for restriction (SRR) accompanied by an election without traverse of an invention to which there are no more than 5 independent claims and no more than 25 total claims. See 37 CFR 1.704(c)(11).

37 CFR 1.704(c)(11) is applicable only to applications under 35 U.S.C. 111(a) filed on or after November 1, 2007, or international applications that have commenced the national stage after compliance with 35 U.S.C. 371 on or after November 1, 2007.

If the application is filed before November 1, 2007, there is no reduction to any PTA, unless the applicant failed to properly reply to an Office notice requiring an ESD in compliance 37 CFR 1.265 (or other appropriate action) within three months of the date the notice was mailed to the applicant.

N2. If applicant filed a SRR accompanied by an election without traverse of an invention for which there are no more than 5 independent claims and no more than 25 total claims, but the SRR is not accepted, are there PTA consequences?

The examiner's acceptance of a SRR accompanied by an election without traverse of an invention to which there are no more than 5 independent claims and no more than 25 total claims would be sufficient to obviate the need for an ESD under 37 CFR 1.265. If the SRR is not accepted, the applicant will be notified and given a time period within which the applicant must either file an ESD in compliance with 37 CFR 1.265 or amend the application such that it contains no more than 5 independent claims and no more than 25 total claims. Failure to timely reply to such a notice would result in the abandonment of

the application. The abandonment of an application results in any PTA being reduced under 37 CFR 1.704(c)(3).

N3. If applicant filed an amendment that will present more than 5 independent claims or more than 25 total claims in an application in which an ESD was not filed before the issuance of a first Office action on the merits, are there PTA consequences for the failure to comply with 37 CFR 1.75(b)?

If the application is filed on or after November 1, 2007, any PTA will be reduced by the number of days in the period between the following beginning and ending dates.

The beginning date of the period is the day after the date that is the filing date of the amendment resulting in the application exceeding the 5/25 claim threshold.

The ending date of the period is the filing date of an amendment resulting in the application containing 5 or fewer independent claims and 25 or fewer total claims.

If the application was filed under 35 U.S.C. 111(a) before November 1, 2007 (or an international application that had commenced the national stage after compliance with 35 U.S.C. 371 before November 1, 2007), there would not be a reduction to any PTA, unless the applicant failed to properly reply to an Office notice requiring an amendment that will result in the application containing 5 or fewer independent claims and 25 or fewer total claims within three months of the date the notice was mailed to the applicant.

N4. If a supplemental ESD is required because of an amendment to the claims (see 37 CFR 1.265(e)) and applicant fails to file a supplemental ESD, are there PTA consequences for the failure?

If the application is filed on or after November 1, 2007, any PTA will be reduced by the number of days in the period between the following beginning and ending dates.

The beginning date of the period is the day after the date that is the filing date of the amendment to the claims that triggers the requirement for a supplemental ESD.

The ending date of the period is the filing date of:

1. A supplemental ESD in compliance with 37 CFR 1.265;
2. An amendment that results in the application containing 5 or fewer independent claims and 25 or fewer total claims; or
3. An amendment that cancels the subject matter that triggers the requirement for a supplemental ESD.

O. Refund of Excess Claims Fees (37 CFR 1.117)**O1. Can applicant request for a refund of the excess claims fees paid by canceling the excess claims?**

If an amendment canceling a claim is filed before an examination on the merits has been made of the application, the applicant may request a refund of any excess claims fee under 37 CFR 1.16(h), (i), or (j) or under 37 CFR 1.492(d), (e), or (f) paid on or after December 8, 2004, for such claim.

Thus, if an applicant decides to cancel the claims in excess of 5 independent claims and in excess of 25 total claims rather than provide an ESD in compliance with 37 CFR 1.265, the applicant may request a refund of any fee for such claim that is paid on or after December 8, 2004.

O2. What does “an examination on the merits has been made of the application” mean?

“[A]n examination on the merits has been made of the application” for purposes of 37 CFR 1.117(a) once a first Office action on the merits, notice of allowability or allowance, or action under Ex parte Quayle is shown in the Patent Application Locating and Monitoring (PALM) system as having been counted. For purposes of 37 CFR 1.117(a), “before” means at least one day before.

O3. Can applicant obtain a refund of any excess claims fees paid in an application filed before November 1, 2007?

If the amendment canceling a claim is filed before an examination on the merits has been made of the application, applicant may file a request for refund of any excess claims fee paid on or after December 8, 2004 for such claim.

However, if a request for refund is not filed within two months from the date on which the claim was canceled, the Office may retain the excess claims fee paid in the application. This two-month period is not extendable.

O4. Can applicant obtain a refund of any excess claims fee paid for a claim that is withdrawn from consideration before an examination on the merits has been made of the application, but not canceled?

The Office will not refund any excess claims fee paid for a withdrawn claim because claims that are withdrawn due to a restriction requirement are still pending in the application. 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 U.S.C. 131. The Office thus lacks authority to grant a refund either on the basis of: (1) the withdrawal from consideration of a claim directed to a non-elected invention or species; or (2) the cancellation of a claim after an examination on the merits has been made of the application under 35 U.S.C. 131.

If an amendment canceling a claim is not filed before an examination on the merits, the Office will not refund any part of the excess claims fee paid in the application except as provided in 37 CFR 1.26.

O5. Will the date on any certificate of mailing or transmission under 37 CFR 1.8 be taken into account in determining whether an amendment was filed before an examination on the merits has been made of the application?

The date indicated on any certificate of mailing or transmission under 37 CFR 1.8 will not be taken into account in determining whether an amendment canceling a claim was filed before an examination on the merits has been made of the application.

O6. Will the Office consider an amendment filed on the same day in which an Office action is counted to be before an examination on the merits has been made of the application?

If an amendment canceling a claim is filed and an Office action is counted on the same day, the Office will treat the amendment canceling a claim as **not** filed before an examination on the merits has been made of the application even if the amendment was filed earlier on the same day as the Office action is counted.

O7. Can applicant obtain a refund of any excess claims fee paid if the patent fee provisions of the Consolidated Appropriations Act expire?

The patent fee provisions of the Consolidated Appropriations Act expire (in the absence of additional legislation) on September 30, 2007 (at the end of fiscal year 2007). Therefore, in the absence of subsequent legislation, the refund provision in 37 CFR 1.117 will likewise expire on September 30, 2007 (at the end of fiscal year 2007), regardless of the date on which the excess claims fee was paid.