

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

Highlights of the Changes in this Final Rule:

Claims:

The applicant must submit an examination support document (ESD) if an application contains more than five independent claims or more than twenty-five total claims (five/twenty-five claim threshold), counting all of the claims in any other copending application having a patentably indistinct claim.

For applications that exceed five/twenty-five claim threshold because they contain claims to more than one invention, the applicant has the option of submitting a suggested restriction requirement (SRR) and election of an invention to which there are no more than five independent claims or twenty-five total claims.

If an application exceeds the five/twenty-five claim threshold and does not contain a SRR or ESD, the USPTO will issue a notice giving the applicant time to provide an ESD or amend the application to be within the five/twenty-five claim threshold.

The change is applicable to all applications in which a first action on the merits has not been mailed by November 1, 2007. The USPTO will issue a notice in applications pending before November 1, 2007 giving the applicant time to provide an ESD or an SRR, or to amend the application to be within the five/twenty-five claim threshold.

Continued examination filings:

An application or chain of continuing applications may include two continuing applications (continuation or continuation-in-part applications), and a single request for continued examination (RCE) in any one of these three applications (the initial or two continuing applications), without justification.

The applicant may file divisional applications to the non-elected invention(s) only if the USPTO issues a restriction requirement in the prior application.

The applicant must identify the claims in a continuation-in-part application that the applicant believes are entitled to the parent application's filing date.

The USPTO will permit an applicant to have "one more" continuing application after August 21, 2007, regardless of the number of continuing applications filed before November 1, 2007.

Related applications and double patenting:

The applicant must identify other commonly owned pending applications or patents that: (1) have a claimed filing or priority date within two months of the claimed filing or priority date of the application; and (2) name at least one inventor in common with the application.

In addition, the applicant must also file a terminal disclaimer or explain how the applications (or application and patent) contain only patentably distinct claims if the applications also have the same claimed filing or priority date and contain substantial overlapping disclosure.

The USPTO may require the applicant to put all of the patentably indistinct claims in a single application unless there is good reason for multiple copending applications having patentably indistinct claims.