

Clarification of the Transitional Provisions Relating to Continuing Applications and Applications Containing Patentably Indistinct Claims

The United States Patent and Trademark Office (USPTO) published a final rule notice revising the provisions of 37 CFR 1.78 pertaining to continuing applications and applications containing patentably indistinct claims. 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 (Aug. 21, 2007), 1322 Off. Gaz. Pat. Office 76 (Sept. 11, 2007) (final rule notice). The changes to 37 CFR 1.78 in this final rule notice are effective on November 1, 2007. This notice clarifies provisions of that final rule notice concerning the “one more” continuing application provision, continuation-in-part applications filed before November 1, 2007, and the requirement for identification of certain applications that are commonly owned and have at least one common inventor.

Clarification of the Transitional “One More” Continuing Application Provision:

The final rule notice provides a transitional “one more” continuing application provision. This permits an applicant who filed more than two continuation or continuation-in-part applications of an initial application before August 21, 2007, to file “one more” continuing application on or after November 1, 2007, without a petition and showing, if there is no other application filed on or after August 21, 2007, that claims the benefit of the prior-filed applications. Specifically, the final rule notice indicated that “[w]ith respect to 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: an application is not required to meet the requirements set forth in 37 CFR 1.78(d)(1) if: (1) The application claims 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 Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, 72 Fed. Reg. at 46717 and 46736-37, 1322 Off. Gaz. Pat. Office at 76 and 93. However, under the transitional “one more” continuing application provision as set forth in the final rule notice, if applicant files another continuing application after the filing of the “one more” continuing application, the benefit claim submitted in the “one more” continuing application would no longer be proper, even when the later-filed continuing application is an application that satisfies the conditions set forth in 37 CFR 1.78(d)(1).

This notice modifies the transitional “one more” continuing application provision to permit applicant to file “one more” continuing application and any continuing applications that satisfy the conditions set forth in 37 CFR 1.78(d)(1)(ii), (d)(1)(iii), or (d)(1)(vi) (e.g., a divisional application that claims a non-elected invention that has not been examined) on or after November 1, 2007, without a petition and showing. More specifically, a continuing application that satisfies the conditions set forth in 37 CFR

1.78(d)(1)(ii), (d)(1)(iii), or (d)(1)(vi) will not be taken into account for purposes of determining whether there is an “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” under the transitional “one more” continuing application provision. For example, applicant may file “one more” continuation application on or after November 1, 2007, without a petition and showing, even if applicant already filed a divisional application that satisfies the conditions set forth in 37 CFR 1.78(d)(1)(ii) on or after August 21, 2007 (assuming applicant did not file any other continuation or continuation-in-part application on or after August 21, 2007). As another example, applicant may file a divisional application that satisfies the conditions set forth in 37 CFR 1.78(d)(1)(ii) claiming the benefit of the “one more” continuation application filed on or after November 1, 2007, without a petition and showing.

The provisions of 37 CFR 1.78(d)(1) in effect on November 1, 2007 are hereby waived to the extent that a continuing application that satisfies the conditions set forth in 37 CFR 1.78(d)(1)(ii), (d)(1)(iii), or (d)(1)(vi) will not be taken into account for purposes of determining whether there is an “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” under the transitional “one more” continuing application provision as set forth in the final rule notice. See 37 CFR 1.183.

Treatment of Continuation-In-Part Applications Filed Before November 1, 2007:

The final rule notice also revised 37 CFR 1.78(d)(3) to provide that: “[I]f an application is identified as a continuation-in-part application, the applicant must identify the claim or claims in the continuation-in-part application for which the subject matter is disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application.” The final rule notice does not provide any special applicability or compliance date for this provision of 37 CFR 1.78(d)(3). Thus, the final rule notice makes this change to 37 CFR 1.78 applicable to pending continuation-in-part applications as of November 1, 2007. The USPTO is in this notice waiving or delaying the requirement for compliance with this requirement of 37 CFR 1.78(d)(3) with respect to pending continuation-in-part applications.

First, for any continuation-in-part application in which a first Office action on the merits has been mailed before November 1, 2007, the requirement in 37 CFR 1.78(d)(3) that an applicant must identify the claim or claims in the continuation-in-part application for which the subject matter is disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application is hereby waived. This waiver does not affect the authority provided in 37 CFR 1.105(a)(1)(ix) for the Office to require that, in appropriate situations, the applicant show where a prior application provides support under the first paragraph of 35 U.S.C. 112 for the invention as defined in the claims of an application.

Second, for continuation-in-part applications filed before November 1, 2007 but for which a first Office action on the merits has **not** been mailed before November 1, 2007, the applicant may delay compliance with the requirement in 37 CFR 1.78(d)(3) that an applicant must identify the claim or claims in the continuation-in-part application for which the subject matter is disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application until February 1, 2008.

Identification of Applications Having a Common Owner and at Least One Common Inventor under 37 CFR 1.78(f)(1): The USPTO is waiving the “or within two months of” provision of 37 CFR 1.78(f)(1)(i)(A) for applications filed **before November 1, 2007**. Specifically, in an application having an actual filing date **before November 1, 2007** (“subject application”), the applicant in the subject application is **not** required to identify any other pending or patented application that does **not** have the same actual filing date or the same benefit or priority filing date as the subject application, even if the other application has an actual filing date or benefit or priority filing date within two months of the subject application. However, the applicant in the subject application is required to identify any other pending or patented nonprovisional application that has the same actual filing date or the same benefit or priority filing date as the subject application, if the conditions set forth in 37 CFR 1.78(f)(1)(i)(B) and (C)¹ are met.

For example, if the subject application has an actual filing date of August 1, 2007, and claims the benefit of a provisional application filed on August 1, 2006, and if there is another application (application “B”) that has an actual filing date of August 15, 2007, and claims the benefit of a provisional application filed on August 15, 2006 (and having an inventor in common and commonly owned with the subject application), the applicant in the subject application is not required to identify application “B”. This is because the subject application and application “B” do not have the same actual filing date or the same benefit or priority filing date (even though they have actual filing dates or benefit or priority filing dates within two months of each other).

The USPTO is also waiving the “or within two months of” provision of 37 CFR 1.78(f)(1)(i)(A) in certain instances for applications filed **on or after November 1, 2007**. Specifically, in an application having an actual filing date **on or after November 1, 2007** (“subject application”), the applicant in the subject application is **not** required to identify any other pending or patented application that has an actual filing date or benefit or priority filing date before November 1, 2007, unless: (1) the subject application has a benefit or priority filing date that is the same as the actual filing date or the benefit or priority filing date of the other application; or (2) 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 application. Thus, if the actual filing date of the subject application is on or

¹ 37 CFR 1.78(f)(1)(i)(B) and (C) pertain to the conditions of naming at least one inventor in common with the other pending or patented application, and being owned by the same person, or subject to an obligation of assignment to the same person, as the other pending or patented application.

after November 1, 2007, 37 CFR 1.78(f)(1)(i)(A), as partially waived in this notice, requires the applicant in the subject application to identify each other pending or patented nonprovisional application for which the conditions set forth in 37 CFR 1.78(f)(1)(i)(B) and (C) are met only if: (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 (2) 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.

For example, if the subject application has an actual filing date of December 1, 2007, claims the benefit of a nonprovisional application filed on August 1, 2007, and also claims the benefit of a provisional application filed on August 1, 2006, and if there is another application (application "B") that has an actual filing date of August 15, 2007, and claims the benefit of a provisional application filed on August 15, 2006 (and having an inventor in common and commonly owned with the subject application), the applicant of the subject application is not required identify application "B". This is because the subject application does not have an actual filing date or priority or benefit filing date before November 1, 2007, that is the same as the actual filing date or the benefit or priority filing date of application "B", and because the subject application does not have 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 application "B".


Comparing to the following example, if application "C" has an actual filing date of December 15, 2007, claims the benefit of a nonprovisional application filed on August 15, 2007, and also claims the benefit of a provisional application filed on August 15, 2006, the applicant in the subject application is required to identify application "C". This is because the subject application has an actual filing date or benefit or priority filing date on or after November 1, 2007 (i.e., December 1, 2007) that is within two months of the actual filing date or priority or benefit filing date of application "C" (i.e., December 15, 2007).

This notice is also clarifying the meaning of the term "examined" as used in 37 CFR 1.78(d)(1)(ii)(B): The term "examined" in 37 CFR 1.78(d)(1)(ii)(B) is limited to examination within the meaning of 35 U.S.C. 131 and 37 CFR 1.104 in a national application under 35 U.S.C. 111(a) or a national stage application resulting from an international application entering the national stage in the United States under 35 U.S.C. 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. Therefore, if an applicant files an initial application which is an international application designating the U.S. and the International Searching Authority determines that the international application lacks unity of invention under PCT Rule 13, the filing of a Demand and the examination of all the inventions in Chapter II would not preclude the applicant from filing a divisional application for each invention not elected for examination in the application after entry

into the national stage, assuming that such divisional application or applications otherwise meet the conditions set forth in 37 CFR 1.78(d)(1)(ii). The question and answer (C11) on this issue that was originally posted on September 26, 2007, will be revised for consistency with this notice.

For further information concerning this notice, please consult the Claims and Continuation Final Rule webpage which is available at <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>, and if further information is needed, please contact the Office of Patent Legal Administration, by telephone at (571) 272-7704, or by e-mail at PatentPractice@USPTO.gov.

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Patent Examination Policy