

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

Section-By-Section Summary of the Changes in this Final Rule:

37 CFR 1.17: 37 CFR 1.17(f) is amended to include references to petitions under 37 CFR 1.78(d)(1)(vi) and 1.114(g).

37 CFR 1.26: 37 CFR 1.26(a) is amended to add “[e]xcept as provided in § 1.117 or § 1.138(d)” to the provision that a change of purpose after the payment of a fee will not entitle a party to a refund of such fee.

37 CFR 1.26(b) is amended to include references to 37 CFR 1.117(b) and 1.138(d) because these sections also specify time periods within which certain refunds must be requested.

37 CFR 1.52: 37 CFR 1.52(d)(2) is amended to refer to 37 CFR 1.78(b) (rather than 37 CFR 1.78(a)) for consistency with the changes to 37 CFR 1.78 in this final rule, and also for consistency with the change to 37 CFR 1.78 (concerning claiming the benefit of a provisional application) made in September of 2005.

37 CFR 1.53: 37 CFR 1.53(b) and (c)(4) are amended to refer to 37 CFR 1.78, rather than specific paragraphs of 37 CFR 1.78. 37 CFR 1.53(b) is also amended to add references to 37 CFR 1.78(a)(2) for the definition of a divisional application, 37 CFR 1.78(a)(3) for the definition of a continuation application, and 37 CFR 1.78(a)(4) for the definition of a continuation-in-part application.

37 CFR 1.75: 37 CFR 1.75(b) is amended to provide for dependent claims (previously in 37 CFR 1.75(c)) and to clarify that a dependent claim must contain a reference to a claim previously set forth in the same application, incorporate by reference all the limitations of the previous claim to which such dependent claim refers, and specify a further limitation of the subject matter of the previous claim.

37 CFR 1.75(b)(1) (new) provides that an applicant must submit an examination support document (ESD) before the issuance of a first Office action on the merits if the application contains more than five independent claims or more than twenty-five total claims. 37 CFR 1.75(b)(1) also provides that an application may not be amended to contain more than five independent claims or more than twenty-five total claims if an ESD has not been submitted before the issuance of a first Office action on the merits in the application.

37 CFR 1.75(b)(2) (new) provides for claims in dependent form that are effectively independent claims. 37 CFR 1.75(b)(2) provides that a claim that contains a reference to

another claim but that does not incorporate by reference all of the limitations of such claim will be treated as an independent claim. 37 CFR 1.75(b)(2) also provides that a claim that contains a reference to a claim of a different statutory class of invention will also be treated as an independent claim.

37 CFR 1.75(b)(3) (new) provides for situations in which an application contains more than five independent claims or more than twenty-five total claims but an examination support document has not been provided. 37 CFR 1.75(b)(3) provides that if the non-compliance with 37 CFR 1.75(b) appears to have been inadvertent, the applicant will be given a notice that sets a two-month time period within which the applicant must comply with the requirements set forth in 37 CFR 1.75(b) to avoid abandonment of the application. This two-month time period is not extendable under 37 CFR 1.136(a).

If a notice under 37 CFR 1.75(b)(3) is mailed before the first Office action on the merits, or at any time in an application in which an ESD was filed before the first Office action on the merits, the applicant is required to: (1) file an ESD or supplemental ESD that covers each claim, or (2) amend the application such that it contains no more than five independent claims and no more than twenty-five total claims. If a notice under 37 CFR 1.75(b)(3) is mailed after the first Office action on the merits of an application in which an ESD was not filed before the first Office action on the merits, the applicant is required to amend the application such that it contains no more than five independent claims and no more than twenty-five total claims. A suggested requirement for restriction (SRR) is not a proper reply to a notice under 37 CFR 1.75(b)(3).

37 CFR 1.75(b)(4) (new) provides that commonly-owned applications containing patentably indistinct claims will be treated as a single application for claim counting purposes.

37 CFR 1.75(b)(5) (new) provides that claims withdrawn from consideration will not, unless they are reinstated or rejoined, be taken into account in determining whether an application exceeds the five independent claim and twenty-five total claim threshold set forth in 37 CFR 1.75(b).

37 CFR 1.75(c) is amended to move the provisions related to dependent claims, other than multiple dependent claims, to 37 CFR 1.75(b). 37 CFR 1.75(c) is amended to provide that multiple dependent claims and claims depending 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 for claims counting purposes.

The changes to 37 CFR 1.75 apply to all applications in which a first Office action on the merits has not been mailed by November 1, 2007. The USPTO will issue a notice in applications filed before November 1, 2007 giving the applicant time to provide an ESD or an SRR, or to amend the application to fall under the five independent claim and twenty-five total claim threshold. The following distinctions between a notice under 37

CFR 1.75(b)(3) issued in applications filed on or after November 1, 2007 and a notice issued in applications before November 1, 2007 should be noted: (1) a SRR is a proper reply to a notice issued in applications filed before November 1, 2007, but a SRR will not be a proper reply to a notice issued in applications filed on or after November 1, 2007; and (2) the time period set in the initial notice issued in applications filed before November 1, 2007 is extendable under 37 CFR 1.136(a), but the time period set in the initial notice issued in applications filed on or after November 1, 2007 is not extendable under 37 CFR 1.136(a).

37 CFR 1.76: 37 CFR 1.76(b)(5) is amended to refer to 37 CFR 1.78(b)(3) and (d)(3) for consistency with the changes to 37 CFR 1.78.

37 CFR 1.78: 37 CFR 1.78(a) (new) sets out definitions of continuing application, continuation application, divisional application, and continuation-in-part application.

37 CFR 1.78(a)(1) defines a continuing application as 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. 37 CFR 1.78(a)(1) also indicates that an application is not a continuing application if the application only claims the benefit under 35 U.S.C. 119(e) of a provisional application, claims priority under 35 U.S.C. 119(a)-(d) or 365(b) to a foreign application, or claims priority under 35 U.S.C. 365(a) or (b) to an international application designating at least one country other than the United States of America. (A request for continued examination under 37 CFR 1.114 is not a filing of a new application, but it is in fact continued examination of the same application.)

37 CFR 1.78(a)(2) defines a divisional application as a continuing application as defined in 37 CFR 1.78(a)(1) that discloses and claims only an invention or inventions that were disclosed and claimed in a prior-filed application, but were 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 in the prior-filed application, and were not elected for examination and were not examined in any prior-filed application.

37 CFR 1.78(a)(3) defines a continuation application as a continuing application as defined in 37 CFR 1.78(a)(1) that discloses and claims only an invention or inventions that were disclosed in the prior-filed application.

37 CFR 1.78(a)(4) defines a continuation-in-part application as a continuing application as defined in 37 CFR 1.78(a)(1) that discloses additional subject matter that was not disclosed in the prior-filed application.

The new definitions in 37 CFR 1.78(a) would apply to any application (initial or continuing application) filed on or after November 1, 2007.

37 CFR 1.78(b) (new) sets out the requirements for a claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application (provisions of former 37 CFR 1.78(a)(4) and (a)(5) with no substantive change).

37 CFR 1.78(c) (new) sets out the requirements for submitting a delayed claim under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application (provisions of former 37 CFR 1.78(a)(6) with no substantive change).

37 CFR 1.78(d) (new) sets out the requirements for a claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional application or an international application designating the United States (provisions of former 37 CFR 1.78(a)(1) and (a)(2) with changes).

37 CFR 1.78(d)(1)(i) contains the provisions that an application or chain of continuing applications may include no more than two continuation or continuation-in-part applications without a petition and showing why the amendment, argument, or evidence presented could not have been previously submitted (requests for continued examination are provided for in 37 CFR 1.114).

37 CFR 1.78(d)(1)(ii) provides that an applicant may file divisional applications to the non-elected invention(s) that have not been examined in the prior-filed application. 37 CFR 1.78(d)(1)(ii) requires that any divisional application be the result of 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 in the prior-filed application.

37 CFR 1.78(d)(1)(iii) provides that an applicant may file no more than two continuation applications of a divisional application without a petition and showing.

37 CFR 1.78(d)(1)(iv) provides for “one more” continuation or continuation-in-part application if the applicant files a continuing application of an international application in which no Demand and no national stage entry have been filed, and the international application does not claim the benefit of any other nonprovisional application or international application.

37 CFR 1.78(d)(1)(v) provides for “one more” continuation or continuation-in-part application if the applicant files a continuation or continuation-in-part application to correct informalities rather than completing the initial application.

37 CFR 1.78(d)(1)(vi) provides that an applicant may file a third or subsequent continuation or continuation-in-part application with a petition showing why the amendment, argument, or evidence presented could not have been previously submitted.

The provisions of 37 CFR 1.78(d)(1) would apply to any continuing application filed on or after November 1, 2007. The final rule provides that the USPTO will permit an applicant to have “one more” continuing application on or after the publication date of the final rule in the Federal Register without a petition and showing, regardless of the number of continuing applications filed before the publication date of the final rule in the Federal Register.

37 CFR 1.78(d)(2) contains the provisions of former 37 CFR 1.78(a)(1).

37 CFR 1.78(d)(3) provides that 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.

37 CFR 1.78(d)(4) and (d)(5) contain the provisions of former 37 CFR 1.78(a)(2).

37 CFR 1.78(d)(6) provides that cross-references to applications for which a benefit is not claimed must be located in a paragraph separate from the paragraph containing the references to applications for which a benefit is claimed.

37 CFR 1.78(e) (new) sets out the requirements for submitting a delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed nonprovisional application or international application designating the US (provisions of former 37 CFR 1.78(a)(3) with no substantive change).

37 CFR 1.78(f) (new) sets out provisions relating to applications and patents that have common ownership.

37 CFR 1.78(f)(1) provides that the applicant must identify other commonly owned pending applications or patents that: (1) have a filing date (including any effective filing date or priority date) within two months of the filing date (including any effective filing date or priority date) of the application; and (2) name at least one inventor in common with the application.

37 CFR 1.78(f)(2) provides that a rebuttable presumption shall exist that a nonprovisional application and other commonly owned applications and patents covered by 37 CFR 1.78(f)(1) contain patentably distinct claims if they have the same filing date (including any effective filing date or priority date) and contain substantial overlapping disclosure. If the rebuttable presumption exists, the applicant must also file a terminal disclaimer or explain how the applications (or application and patent) contain only patentably distinct claims within the time periods set forth in 37 CFR 1.78(f)(2).

37 CFR 1.78(f)(3) provides that 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 to contain patentably indistinct claims (provisions of former 37 CFR 1.78(b) with no substantive change).

37 CFR 1.78(g) (new) contains provisions relating to applications or patents under reexamination naming different inventors and containing patentably indistinct claims (provisions of former 37 CFR 1.78(c) with no substantive change).

37 CFR 1.78(h) (new) contains provisions pertaining to the treatment of parties to a joint research agreement under the CREATE Act.

37 CFR 1.78(i) (new) provides that the time periods set forth in 37 CFR 1.78 are not extendable (the time periods set forth in 37 CFR 1.78 are not currently extendable, but this fact is stated in 37 CFR 1.78(a)(2)(ii) and (5)(ii)).

37 CFR 1.104: 37 CFR 1.104(a)(1) is amended to add the phrase “and other requirements” to the phrase “the examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules” to address situations in which the requirement is based upon Office practice as set forth in the MPEP.

37 CFR 1.104(b) is also amended to delete the sentence “[h]owever, matters of form need not be raised by the examiner until a claim is found allowable.”

37 CFR 1.105: 37 CFR 1.105(a)(1) is amended to provide that an applicant may be required to set forth where (by page and line or paragraph number) in the specification of the application, or any application the benefit of whose filing date is sought, there is support for the invention as defined in the claims under 35 U.S.C. 112, ¶ 1.

37 CFR 1.110: 37 CFR 1.110 is amended to refer to 37 CFR 1.78, rather than a specific paragraph (paragraph (c)) of 37 CFR 1.78, and to relocate the phrase “when necessary for purposes of an Office proceeding” for clarity.

37 CFR 1.114: 37 CFR 1.114(a) is amended to make clear that an applicant may not file an unrestricted number of requests for continued examination, that a request for continued examination must include a petition under 37 CFR 1.114(g) unless the conditions set forth in 37 CFR 1.114(f)(1), (f)(2), or (f)(3) are satisfied, and that a request for continued examination must be identified as a request for continued examination.

37 CFR 1.114(f) (new) provides the circumstances under which a request for continued examination may be filed without a petition under 37 CFR 1.114(g) (new).

37 CFR 1.114(f)(1) provides that an applicant may file a (single) request for continued examination without a petition in an application if no request for continued examination was filed in the application, in any parent application, or in any child application.

37 CFR 1.114(f)(2) provides that an applicant may file a (single) request for continued examination without a petition in an application if the application is a divisional application and no request for continued examination has been filed in the divisional application, or in any child application of the divisional application.

37 CFR 1.114(f)(3) provides that an applicant may file a (single) request for continued examination without a petition in an application if the application is a continuation application of a divisional application, and no request for continued examination has been filed in the continuation application, in the divisional application, or in any other application claiming the benefit of the divisional application.

37 CFR 1.114(g) (new) provides that a request for continued examination must include a fee and a petition showing why the amendment, argument, or evidence presented could not have been previously submitted, except as provided in 37 CFR 1.114(f) (new).

37 CFR 1.114(h) (new) provides that the filing of an improper request for continued examination, including a request for continued examination with a petition under 37 CFR 1.114(f) that is not grantable, will neither stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

37 CFR 1.117: 37 CFR 1.117 (new) implements the excess claims refund provision of the Consolidated Appropriations Act, 2005. 37 CFR 1.117(a) provides that 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 fee paid on or after December 8, 2004, for such claim under 37 CFR 1.16(h), (i), or (j) or under 37 CFR 1.492(d), (e), or (f).

37 CFR 1.117(b) provides that if such 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, and that this two-month period is not extendable.

37 CFR 1.136: 37 CFR 1.136(a)(1) is amended to add “[t]he reply is to a notice requiring compliance with § 1.75(b) or § 1.265” to the enumerated list of replies to which the extension of time provision of 37 CFR 1.136(a) is not applicable.

37 CFR 1.142: 37 CFR 1.142(a) is amended to state that an examiner “may” (rather than “will”) require restriction if two or more independent and distinct inventions are claimed in a single application for consistency with the current restriction practice set forth in the 35 USC 121 and in the MPEP 803.

37 CFR 1.142(c) (new) is added to provide for a SRR. 37 CFR 1.142(c) provides that if two or more independent and distinct inventions are claimed in a single application, the applicant may submit a SRR. 37 CFR 1.142(c) further provides that any SRR must be

submitted prior to the first Office action on the merits in the application or requirement for restriction, whichever is earlier, be accompanied by an election without traverse of an invention to which there are no more than five independent claims and no more than twenty-five total claims, and identify the claims to the elected invention. 37 CFR 1.142(c) finally provides that if the SRR is accepted (the applicant will also be notified if the SRR is refused), an Office action will contain a requirement for restriction under § 1.142(a) (i.e., the restriction requirement will be set forth in a subsequent Office action so that the applicant will have a right to file a divisional application), and that any claim to the non-elected invention or inventions, if not canceled, is withdrawn from further consideration. If an applicant's SRR is refused, the examiner may make a different restriction requirement or make no restriction requirement. The applicant will be notified in an Office action. That Office action may include a notice under 37 CFR 1.75(b)(3) requiring applicant to file an ESD or amend the application to contain no more than five independent claims or no more than twenty-five total claims.

37 CFR 1.145: 37 CFR 1.145 is amended to state that an applicant "may" (rather than "will") be required to restrict the claims to the invention previously claimed if the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed for consistency with the current restriction practice set forth in the 35 USC 121 and in the MPEP 803.

37 CFR 1.265: 37 CFR 1.265 (new) is added to set forth what an "examination support document" (required under 37 CFR 1.75(b)(1) for applications containing more than five independent claims or more than twenty-five total claims) entails.

37 CFR 1.265(a) provides that an examination support document must include: (1) a statement that a preexamination search was conducted; (2) a listing of the reference or references deemed most closely related to the subject matter of each of the claims; (3) for each reference cited, an identification of all the limitations of each of the claims that are disclosed by the reference; (4) a detailed explanation particularly pointing out how each of the independent claims is patentable over the cited references; and (5) a showing of where each limitation of each of the claims (whether in independent or dependent form) finds support under the first paragraph of 35 U.S.C. 112 in the written description of the specification.

37 CFR 1.265(b) specifies the requirements for the preexamination search required by 37 CFR 1.265(a)(1).

37 CFR 1.265(c) specifies the requirements for the listing of references required under 37 CFR 1.265(a)(2).

37 CFR 1.265(d) provides that the applicant must also file a supplemental examination support document if there is an IDS that cites a reference or references that are as close or

more closely related to the subject matter of one or more claims than the references cited in the listing of references required under 37 CFR 1.265.

37 CFR 1.265(e) provides for situations in which an examination support document is defective or inadequate.

37 CFR 1.265(f) provides an exemption for small entities as defined by the Regulatory Flexibility Act (RFA) from the requirement in 37 CFR 1.265(a)(3) that an examination support document must, for each cited reference, include an identification of all the limitations of each of the claims that are disclosed by the reference. An applicant wishing to invoke this exemption must provide a certification that he or she is a small entity as defined by the RFA because a small entity for purposes of paying reduced patent fees is not necessarily a small entity as defined by the RFA.

37 CFR 1.495: 37 CFR 1.495(g) provides that if the documents and fees contain conflicting indications as between an application under 35 U.S.C. 111 and a submission to enter the national stage under 35 U.S.C. 371, the documents and fees will be treated as a submission to enter the national stage under 35 U.S.C. 371.

37 CFR 1.704: 37 CFR 1.704(c) is amended to provide that the failure to comply with 37 CFR 1.75(b) is a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application under 35 U.S.C. 154(b)(2)(C). 37 CFR 1.704(c)(11) (new) provides for a patent term adjustment reduction equal to the period: (1) beginning on the later of (a) the filing date of the amendment resulting in non-compliance with 37 CFR 1.75(b), or (b) four months from the filing date or national stage commencement date of the application, and (2) ending on the filing date of: (a) an examination support document in compliance with 37 CFR 1.265, (b) an election in reply to a requirement under 37 CFR 1.142(a), 1.146 or 1.499 resulting in compliance with 37 CFR 1.75(b), (c) an amendment resulting in compliance with 37 CFR 1.75(b), or (d) a suggested restriction requirement in compliance with 37 CFR 1.142(c).

Summary of the Changes to Final Practice:

The final rule also indicates that the USPTO is retaining current first action final practice and is revising second action final practice to provide that 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 information disclosure statement 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 the claims in a continuation-in-part application for which the subject matter is disclosed in the prior-filed application.