

PTO's New Rules on Continuation Practice

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The U.S. Patent and Trademark Office (USPTO) has changed its rules governing continuing applications and Requests for Continued Examination (RCE). According to the USPTO, the changes will allow it to conduct a better and more thorough and reliable examination of patent applications. The new rules should prompt patent applicants to examine their portfolios and determine whether they should take any action before the new rules take effect on November 1, 2007.

The new rules will not have any effect on the applicant's ability to file continuing applications before they take effect. On or after November 1, the new rules will limit applicants to two continuing applications (e.g., continuations or continuations-in-part) and a single RCE in any one application family. Applicants seeking to file additional applications exceeding these limits must petition the USPTO and show that the additional application or RCE is justified.

These new limits are a significant departure from the USPTO's prior rules governing continuing applications and RCEs. However, the USPTO has adopted policies for the transition that will provide applicants some reprieve. The USPTO's "one more" policy will allow applicants to file an additional continuing application, even after November 1, without requiring a petition and showing, so long as the initial application was filed prior to August 21, 2007. Any continuations or continuations-in-part filed between August 21 and November 1 will exhaust the "one more" application allowance.

The figure below illustrates the application of this policy. The initial application (I) and two continuations (C) were filed prior to August 21, 2007. The applicant is therefore permitted "one more" continuation or continuation-in-part without petition. In this example, the "one more" application was filed prior to November 1, 2007, but note that it may have been filed after that date without a petition and showing. As a result of filing the additional application, the applicant exhausted the "one more" application allowance. Any subsequent continuation application (P) requires the appropriate petition and showing.

If you have any questions about the USPTO's rules, or their effect on your patent portfolio, please contact the Intellectual Property Group at Benesch Friedlander Coplan & Aronoff LLP.