

---

## Court Voids PTO Final Rules

2008-04-01

Today, Senior Judge James Cacheris of the District Court for the Eastern District of Virginia issued a decision granting summary judgment in favor of the plaintiffs and voiding the US Patent and Trademark Office (USPTO) Final Rules in the two consolidated cases, *Tafas v. Dudas* and *SmithKline Beecham Corp. v. Dudas*. The court determined that the rules were “not in accordance with law’ and ‘in excess of statutory jurisdiction [and] authority” of the USPTO.

The Final Rules rejected by the court involved two sets of rules: the first limiting the number of continuation applications and requests for continued examination that an applicant may file, and the second limiting the number of claims that an applicant could present as a matter of right. Contrary to the USPTO’s arguments, Senior Judge Cacheris found that the Final Rules were substantive in nature and thus beyond the rulemaking power of the USPTO. While the USPTO argued that the rules fell within their rulemaking authority and were procedural in nature, the court found that the Final Rules were not procedural rules and did not relate only to application processing. Instead, the Final Rules were found to be “substantive rules that change existing law and alter the rights of applicants such as GSK and Tafas under the Patent Act.” The rules “constitute a drastic departure from the terms of the Patent Act as they are presently understood.”

To read the decision, please see the attachment or click [here](#).

For more more information on this or other intellectual property matters, contact the authors listed above.

---

### *Authors*



---

## Colleen Superko

RETIRED PARTNER

☎ +1 617 526 6000

---

## James B. Lampert

RETIRED PARTNER

✉ [james.lampert@comcast.net](mailto:james.lampert@comcast.net)

☎ +1 617 526 6000