
New PTO Director Responds to Complaints and Rescinds Proposed Rules

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Two months after being confirmed as the new Director of the Patent and Trademark Office ("PTO"), David Kappos responded to complaints and on October 8th rescinded the Office's proposed regulations on continuations and claims. The PTO also agreed to join with GlaxoSmithKline in seeking to dismiss the pending Federal Circuit appeal of a district court decision that enjoined the rules from going into effect.

According to Kappos, "[t]hese regulations have been highly unpopular from the outset and were not well received by the applicant community. In taking the actions we are announcing today, we hope to engage the applicant community more effectively on improvements that will help make the USPTO more effective, responsive, and transparent to the public."

The proposed regulations would have limited the number of continuation applications available to a patent applicant as of right to only two, and only a single request for continued examination would be possible without the filing of a detailed petition. The regulations would also have limited the number of claims in a patent application to twenty-five total claims, or five independent claims, absent submission of a detailed examination support document. As Kappos highlighted in his press release, these limitations on

the ability of an applicant to freely prosecute before the Patent Office were indeed "unpopular from the outset and were not well received by the applicant community." The regulations were to take effect in November 2007, but to the relief of the patent community were enjoined in a litigation filed by an inventor, Triantafyllos Tafas, and GlaxoSmithKline. The Court of Appeals for the Federal Circuit was to review *en banc* whether the Patent Office had the authority to make the rules.

The Patent Office, along with GlaxoSmithKline but apparently not Tafas, agreed to file a motion to dismiss and vacate the district court decision. "This course of action represents the most efficient way to formally and permanently move on from these regulations and work with the IP community on new ways to take on the challenges these regulations were originally designed to address," according to Kappos. It remains to be seen exactly how the Patent Office will take on the many challenges it faces, but another of Director Kappos' recent proposals, to give patent examiners more time to review applications, may be a sign of what is to come in the months ahead.

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