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## United States Patent Office Publishes New Rules on Continuing Applications and Claims

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On August 21, 2007, the US Patent and Trademark Office (PTO) published new rules that make a number of controversial revisions relating to patent prosecution. Two aspects of the new rules seem to be the most important. One limits the number of continuations applications that an applicant may file; the second requires the applicant to provide an extensive "examination support document" if an application contains more than five independent or 25 total claims.

Before issuing the new rules, the PTO received over 500 comments from the public in response to an earlier notice of proposed rulemaking, and the final rules are accompanied by more than 300 comments with responses from the PTO. Many of these address the effect of the rule changes on the pharmaceutical and biotechnology industries.

The new final rules amend many different sections of 37 CFR (the Patent and Trademark Office Rules of Practice), with varying effective dates. Most of the final rules go into effect as to nonprovisional applications filed (or entering the US national stage) on or after November 1, 2007. However, they will also apply to a nonprovisional application filed prior to November 1, 2007, where a first office action on the merits is not mailed before that date.

It is important to note that the limits on the number of continuations apparently apply to continuing applications filed on or after August 21, the day the new rules were published.

### **Continuations**

Under the previous rules, there was effectively no limit on the number of continuation applications--or requests for continued examination--that could be filed. The extensive new revisions limit an applicant to two continuation applications (or continuation-in-part applications), plus one request for continued examination. Any additional continuation applications, continuation-in-part applications or requests for continued examination are permitted only if the applicant files a petition showing why the amendment, argument or evidence sought to be entered could not have been previously submitted. In addition to the permitted number of continuations and requests for continued examination, the new rules also allow an applicant to file a divisional application during the pendency of the application that was subject to the pertinent restriction requirement or the pendency

of any continuing application of such an application. Each divisional application will be entitled to file two continuing applications and one request for continued examination.

The PTO's own summary of its new "continuations" rule is somewhat complex. The new rules seem to limit the number of continuations and requests for continued examination that may be filed after the August 21, 2007, effective date. However, according to the PTO, the new rule procedure provides applicants with "one more" continuation application (filed prior to the publication date of the final rule), such that the office is not engaging in retroactive rulemaking.

A somewhat related provision, relevant to applications filed before November 1, 2007, requires applicants to identify co-pending, commonly assigned applications having at least one inventor in common and filed within two months of one another, within the time periods specified in the rules (the later of four months from the filing date or two months from the official filing receipt mail date) or by February 1, 2008, whichever is later.

### **Number of Claims**

Under the previous rules, there was no real limit on the number of claims that an applicant could present, although the claim fees could be substantial.

The revised rules seek to limit an application to no more than five independent claims and no more than 25 total claims. An applicant may file more claims, but if it wishes to do so, it must also prepare and file an extensive "examination support document" that covers all of the claims in the application. According to the revised rules, such an examination support document must include a pre-examination search statement; a listing of references deemed most closely related to the subject matter of each of the claims; an identification of all of the claim limitations that are disclosed in the references; a detailed explanation particularly pointing out how each of the independent claims is patentable over the cited references; and a showing of where each claim limitation finds support under 35 U.S.C. 112 in the application and in any prior-filed application.

The "five and 25" claims limitation will be applied independently to each of an applicant's initial applications and two continuation or continuation-in-part applications. Thus, under some circumstances, an applicant may present up to 15 independent claims and 75 total claims to a single patentably distinct invention--via an initial application and two continuation or continuation-in-part applications that are filed and prosecuted serially--without having to provide an examination support document.

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