

# La saga des nouvelles règles d'examen définies par l' USPTO



**Philippe Signore**

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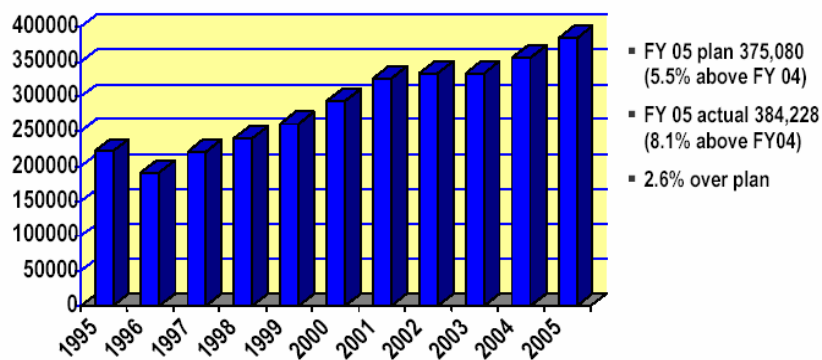


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## UPR Applications Filed



9

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MAIER  
&  
NEUSTADT  
P.C.

# FY 05 Patent Pendency

Technology Center	Average 1 <sup>st</sup> Action Pendency (months) <sup>1</sup>	Average Total Pendency (months) <sup>2</sup>
1600 - Biotechnology and Organic Chemistry	23.0	32.3
1700 - Chemical and Materials Engineering	19.7	29.7
2100 - Computer Architecture Software and Information Security	32.7	43.5
2600 - Communications	30.5	42.3
2800 - Semiconductor, Electrical, Optical Systems	14.5	24.9
3600 - Transportation, Construction, Electronic Commerce	18.4	26.9
3700 - Mechanical Engineering, Manufacturing and Products	18.3	26.3
UPR Total (as of 10/1/2005)	21.1	29.1
FY 05 Target	20.7*	31.0

<sup>1</sup> "Average 1<sup>st</sup> action pendency" is the average age from filing to first action for a newly filed application, completed during July-September FY 2005.

<sup>2</sup> "Average total pendency" is the average age from filing to issue or abandonment of a newly filed application, completed during July-September FY 2005.

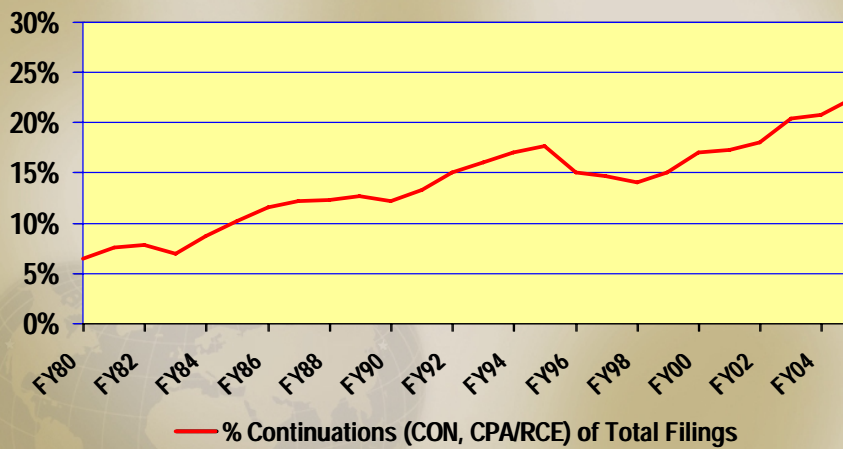
\* Assuming current input and output estimates, the agency should achieve first action pendency of 21.3 months by the end of FY 2005 and total pendency of 30.2 months.

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# Continuation Filing Percentage

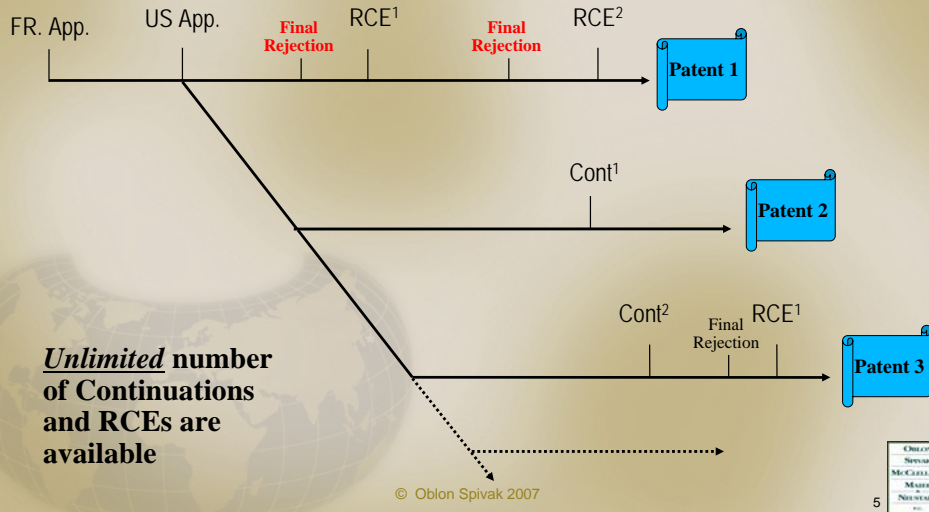


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# Continuations & Requests for Continued Examination (RCEs)



Federal Register / Vol. 71, No. 1 / Tuesday January 3, 2006 / Proposed Rules

**DEPARTMENT OF COMMERCE**

**Patent and Trademark Office**

**37 CFR Part 1**

[Docket No.: 2005-P-066]

RIN 0651-AB93

**Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice of proposed rule making.

**SUMMARY:** Continued examination practice, including the use of both continuing applications and requests for continued examination, permits applicants to obtain further examination and advance an application to final • • •

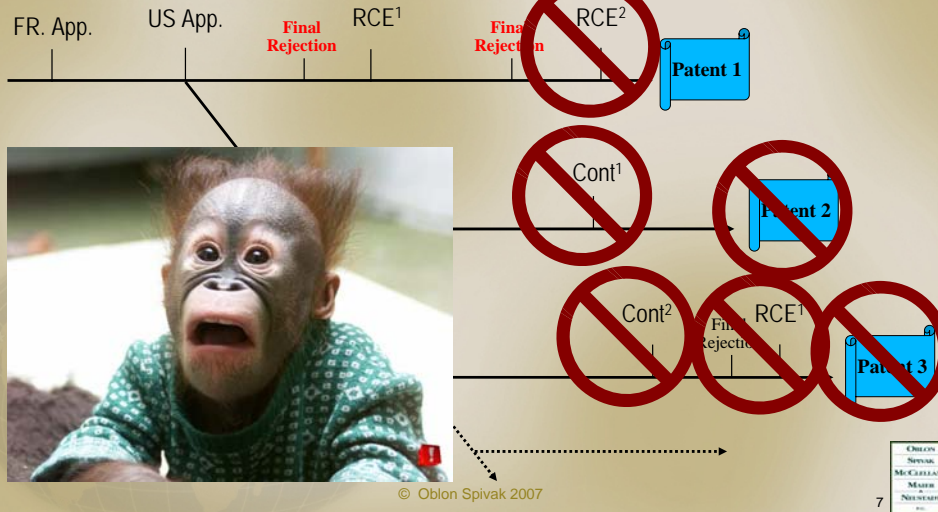
★ Only 1 cont or RCE!

★ Applicant must designate 10 claims for Examination

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# Continuations & Requests for Continued Examination (RCEs)



# January – May 2006: Public Comments

- A. Intellectual Property Organizations and Government Agencies**
1. ABA-Intellectual Property Law [PDF]
  2. American Intellectual Property Law Association (AIPLA) [PDF]
  3. Bar Association of the District of Columbia, PTC Section [PDF]
  4. Boston Patent Law Association, Committee on Patent Office Practice [PDF]
  5. Houston Intellectual Property Law Association (HIPLA) [PDF]
  6. Intellectual Property Law Association of Chicago (IPLAC) [PDF]
  7. Intellectual Property Owners Association (IPO) [PDF]
  8. Inventors Alliance, LLC [PDF]
  9. Inventors Alliance [PDF]
  10. Japanese Intellectual Property Association (JIPA) [PDF]
  11. Los Angeles Intellectual Property Law Association (LAIPLA) [PDF]
  12. Minnesota Intellectual Property Law Association (MIPLA) [PDF]
  13. Minnesota Intellectual Property Law Association (MIPLA), Intellectual Property Committee [PDF]
  14. Minnesota Intellectual Property Law Association (MIPLA), Patent Law Forum [PDF]
  15. National Association of Patent Practitioners (NAPP) [PDF]
  16. New York Intellectual Property Law Association (NYIPLA) [PDF]
  17. North Carolina Bar Association, Intellectual Property Law Section [PDF]
  18. Northern Virginia Patent Lawyers Club (NVPLC) [PDF]
  19. Ohio State Bar Association, Intellectual Property Law Section [PDF]
  20. Oregon Patent Law Association (OPLA) [PDF]
  21. Patent Public Advisory Committee of the USPTO [PDF]
  22. Pennsylvania Intellectual Property Forum [PDF]
  23. Philadelphia Intellectual Property Law Association [PDF]
  24. San Diego Intellectual Property Law Association (SDIPLA) [PDF]
  25. U.S. Department of Justice, Antitrust Division [PDF]
- B. Corporations and Associations**
1. 3M Innovative Properties Company [PDF]
  2. Affymetrix, Inc. [PDF]
  3. Altera Corporation [PDF]
  4. Amgen [PDF]
  5. Amylin Pharmaceuticals, Inc. [PDF]
  6. Anatomic Research, Inc. [PDF]
  7. Apple Computer, Inc. [PDF]
  8. Aradigm Corporation [PDF]
  9. Bally Technologies [PDF]
  10. BASF AG [PDF]
  11. Biogen Idec, Inc. [PDF]
  12. Biotechnology Industry Organization (BIO) [PDF]
  13. Brigham and Women's Hospital - CSRL [PDF]
  14. Burnham Institute for Medical Research [PDF]
  15. Business Software Alliance (BSA) [PDF]
  16. California Healthcare Institute (CHI) [PDF]
  17. Caterpillar Inc. [PDF]
  18. CIA [PDF]
  19. Ceres, Inc. [PDF]
  20. Cisco Systems [PDF]
  21. Cognex Corp. [PDF]
  22. Council on Government Relations [PDF]
  23. Eastman Kodak Company [PDF]
  24. eBay, Inc. [PDF]
  25. E. I. du Pont Nemours and Company [PDF]
  26. Eli Lilly and Company [PDF]
  27. Falbrook Technologies, Inc. [PDF]
  28. Genentech, Inc. [PDF]
  29. GlaxoSmithKline [PDF]
  30. Heritage Woods, Inc. [PDF]
  31. Honda R&D Americas, Inc. [PDF]
  32. Human Genome Sciences, Inc. [PDF]
  33. IBM Corporation [PDF]
  34. Intel Corporation [PDF]
  35. InterDigital Communication Corporation [PDF]
  36. Intuitive Surgical, Inc. [PDF]
  37. Isis Pharmaceutical, Inc. [PDF]
  38. Massachusetts General Hospital-CSRL [PDF]
  39. MacLean-Fogg Company [PDF]
  40. Maxygen, Inc. [PDF]
  41. Medarex, Inc. [PDF]
  42. Medical Device Manufacturers Association [PDF]
  43. Mendel Biotechnology, Inc. [PDF]
  44. Micron Technology, Inc. [PDF]
  45. Microsoft Corporation [PDF]
  46. Miller Patent Services [PDF]
  47. National Venture Capital Association [PDF]
  48. Neurocrine Biosciences, Inc. [PDF]
  49. Novartis Vaccines Diagnostics, Inc. [PDF]
  50. Novo Nordisk, Inc. [PDF]
  51. Oracle Corporation [PDF]
  52. Pfizer, Inc. [PDF]
  53. Pharmaceutical Research and Manufacturers of America [PDF]
  54. Procter & Gamble Company [PDF]
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DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Part 1

[Docket Nos.: PTO-P-2005-0022; PTO-P-2005-0023]

RINs 0651-AB93; 0651-AB94

**Changes To Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications**

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases relating to continuing applications and requests for continued examination practices, and for the examination of claims in patent applications. The Office is

Effective **November 1, 2007:**

A) Only 2 conts. + 1 RCE

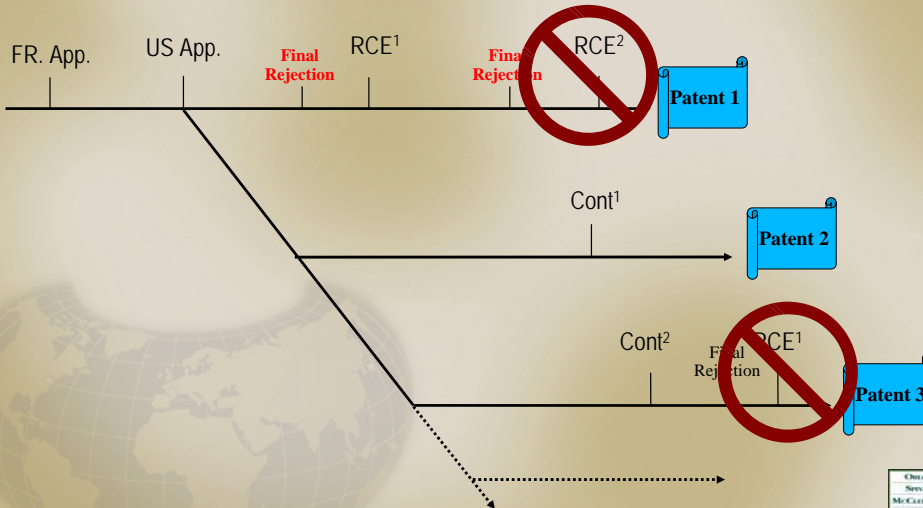
B) 5 independent claims and 25 total claims to be examined without an Examination Support Document (ESD)

C) New duty of disclosure for commonly owned applications

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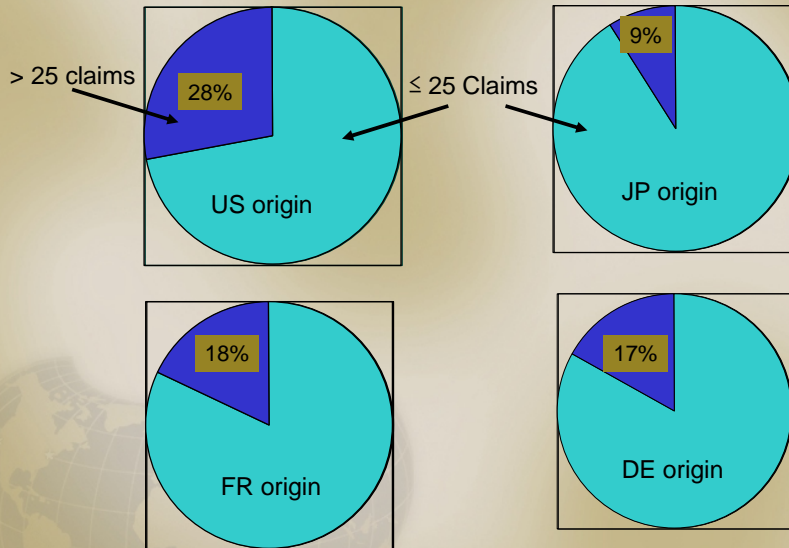
## Continuations & Requests for Continued Examination (RCEs)



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# The impact of the 5/25 Rule



Based on US *patents* issued so far in 2007

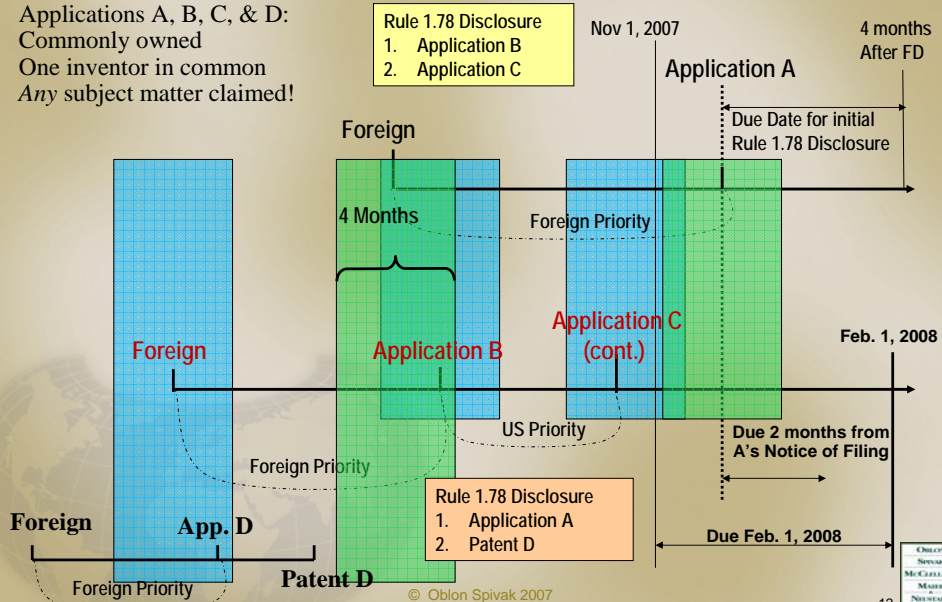
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# New Duty of Disclosure: Example

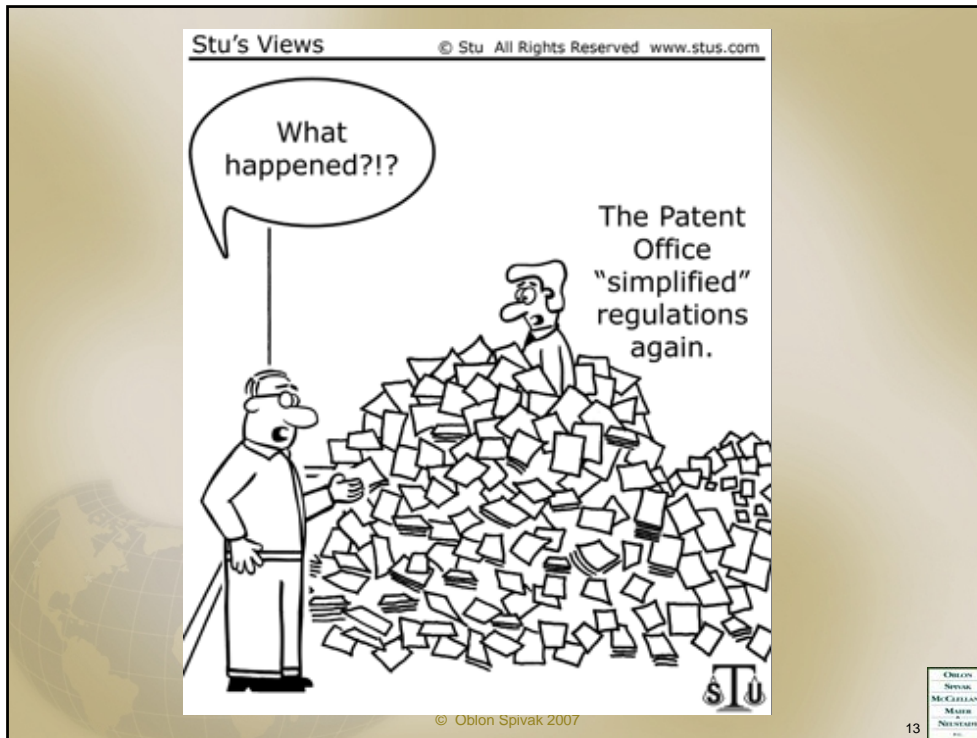
Applications A, B, C, & D:  
Commonly owned  
One inventor in common  
Any subject matter claimed!




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## USPTO Faces Revolt Over Patent Rules

By **Jacqueline Bell**, jackie.bell@portfoliomedia.com

*Friday, Oct 05, 2007* --- Facing a growing backlog of pending patent applications, the United States Patent and Trademark Office has made a highly controversial bet: That the new rules set to go into effect on Nov. 1 will help make the application process more effective and efficient. So far, that outcome is hardly the odds-on favorite among patent law practitioners.

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SPIVAK  
MC CALLANE  
MAIER  
NEUSCHAEF

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
(Alexandria Division)

October 10, 2007



Plaintiffs,

v.

JON W. DUDAS, in his official capacity  
as Under Secretary of Commerce  
for Intellectual Property and Director  
of the United States Patent and  
Trademark Office, and

UNITED STATES PATENT AND  
TRADEMARK OFFICE,

Defendants.

Civil Action No. \_\_\_\_\_

**GSK asks the Court for a  
Preliminary Injunction**

Plaintiffs SmithKline Beecham Corporation d/b/a  
GlaxoSmithKline and GlaxoSmithKline (collectively referred to as  
"GSK") for their Cause of Action against Defendant Jon W. Dudas, in his official capacity as Under  
Secretary of Commerce for Intellectual Property and Director of the United States Patent and  
Trademark Office, and Defendant United States Patent and Trademark Office ("PTO"), hereby  
allege as follows:

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Patent Law Blog (Patently-O)

OCT 25, 2007

**USPTO Continuation and Claim  
Rules: AIPLA Request Injunction  
to Halt New Rules**

Feeling some pressure from its members, the  
AIPLA has now filed an amici brief in support of  
GSK's motion for a preliminary injunction to stop  
enforcement of the PTO's new rules on  
continuations and claim count.

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CHARLES E. SCHUMER  
NEW YORK



## United States Senate

WASHINGTON, DC 20510

October 25, 2007

The Honorable Jon W. Dudas  
Undersecretary of Commerce for Intellectual Property and Director  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313

Via facsimile to: (571) 273-0085

Dear Undersecretary Dudas:

I write to raise concerns about two recently proposed rules, entitled "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims," and "Changes to Practice for the Examination of Claims in Patent Applications," published on August 21, 2007. It is my understanding that these rules are scheduled to become final on November 1, 2007. Because concerns have been raised about the potential impact of the new rules and there is a pending lawsuit in the Eastern District of Virginia seeking an injunction of the new rules, I ask that the PTO consider a delay in their implementation.

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## October 31, 2007: Judge Grants Preliminary Injunction Against USPTO



3) Plaintiffs' Motion for a Preliminary Injunction is GRANTED;

4) Defendants are preliminarily enjoined from implementing the Final Rules titled "Changes to Practice for Continuing Examination Failings, Patent Applications Containing Patentably Indistinct Claims, and Applications," 72 Fed. Reg. 51,117 (2007) (to be codified in 37 CFR 1.511, 1.512, 1.513, 1.514, 1.515, 1.516, 1.517, 1.518, 1.519, 1.520, 1.521, 1.522, 1.523, 1.524, 1.525, 1.526, 1.527, 1.528, 1.529, 1.530, 1.531, 1.532, 1.533, 1.534, 1.535, 1.536, 1.537, 1.538, 1.539, 1.540, 1.541, 1.542, 1.543, 1.544, 1.545, 1.546, 1.547, 1.548, 1.549, 1.550, 1.551, 1.552, 1.553, 1.554, 1.555, 1.556, 1.557, 1.558, 1.559, 1.560, 1.561, 1.562, 1.563, 1.564, 1.565, 1.566, 1.567, 1.568, 1.569, 1.570, 1.571, 1.572, 1.573, 1.574, 1.575, 1.576, 1.577, 1.578, 1.579, 1.580, 1.581, 1.582, 1.583, 1.584, 1.585, 1.586, 1.587, 1.588, 1.589, 1.590, 1.591, 1.592, 1.593, 1.594, 1.595, 1.596, 1.597, 1.598, 1.599, 1.600, 1.601, 1.602, 1.603, 1.604, 1.605, 1.606, 1.607, 1.608, 1.609, 1.610, 1.611, 1.612, 1.613, 1.614, 1.615, 1.616, 1.617, 1.618, 1.619, 1.620, 1.621, 1.622, 1.623, 1.624, 1.625, 1.626, 1.627, 1.628, 1.629, 1.630, 1.631, 1.632, 1.633, 1.634, 1.635, 1.636, 1.637, 1.638, 1.639, 1.640, 1.641, 1.642, 1.643, 1.644, 1.645, 1.646, 1.647, 1.648, 1.649, 1.650, 1.651, 1.652, 1.653, 1.654, 1.655, 1.656, 1.657, 1.658, 1.659, 1.660, 1.661, 1.662, 1.663, 1.664, 1.665, 1.666, 1.667, 1.668, 1.669, 1.670, 1.671, 1.672, 1.673, 1.674, 1.675, 1.676, 1.677, 1.678, 1.679, 1.680, 1.681, 1.682, 1.683, 1.684, 1.685, 1.686, 1.687, 1.688, 1.689, 1.690, 1.691, 1.692, 1.693, 1.694, 1.695, 1.696, 1.697, 1.698, 1.699, 1.700, 1.701, 1.702, 1.703, 1.704, 1.705, 1.706, 1.707, 1.708, 1.709, 1.710, 1.711, 1.712, 1.713, 1.714, 1.715, 1.716, 1.717, 1.718, 1.719, 1.720, 1.721, 1.722, 1.723, 1.724, 1.725, 1.726, 1.727, 1.728, 1.729, 1.730, 1.731, 1.732, 1.733, 1.734, 1.735, 1.736, 1.737, 1.738, 1.739, 1.740, 1.741, 1.742, 1.743, 1.744, 1.745, 1.746, 1.747, 1.748, 1.749, 1.750, 1.751, 1.752, 1.753, 1.754, 1.755, 1.756, 1.757, 1.758, 1.759, 1.760, 1.761, 1.762, 1.763, 1.764, 1.765, 1.766, 1.767, 1.768, 1.769, 1.770, 1.771, 1.772, 1.773, 1.774, 1.775, 1.776, 1.777, 1.778, 1.779, 1.780, 1.781, 1.782, 1.783, 1.784, 1.785, 1.786, 1.787, 1.788, 1.789, 1.790, 1.791, 1.792, 1.793, 1.794, 1.795, 1.796, 1.797, 1.798, 1.799, 1.800, 1.801, 1.802, 1.803, 1.804, 1.805, 1.806, 1.807, 1.808, 1.809, 1.810, 1.811, 1.812, 1.813, 1.814, 1.815, 1.816, 1.817, 1.818, 1.819, 1.820, 1.821, 1.822, 1.823, 1.824, 1.825, 1.826, 1.827, 1.828, 1.829, 1.830, 1.831, 1.832, 1.833, 1.834, 1.835, 1.836, 1.837, 1.838, 1.839, 1.840, 1.841, 1.842, 1.843, 1.844, 1.845, 1.846, 1.847, 1.848, 1.849, 1.850, 1.851, 1.852, 1.853, 1.854, 1.855, 1.856, 1.857, 1.858, 1.859, 1.860, 1.861, 1.862, 1.863, 1.864, 1.865, 1.866, 1.867, 1.868, 1.869, 1.870, 1.871, 1.872, 1.873, 1.874, 1.875, 1.876, 1.877, 1.878, 1.879, 1.880, 1.881, 1.882, 1.883, 1.884, 1.885, 1.886, 1.887, 1.888, 1.889, 1.890, 1.891, 1.892, 1.893, 1.894, 1.895, 1.896, 1.897, 1.898, 1.899, 1.900, 1.901, 1.902, 1.903, 1.904, 1.905, 1.906, 1.907, 1.908, 1.909, 1.910, 1.911, 1.912, 1.913, 1.914, 1.915, 1.916, 1.917, 1.918, 1.919, 1.920, 1.921, 1.922, 1.923, 1.924, 1.925, 1.926, 1.927, 1.928, 1.929, 1.930, 1.931, 1.932, 1.933, 1.934, 1.935, 1.936, 1.937, 1.938, 1.939, 1.940, 1.941, 1.942, 1.943, 1.944, 1.945, 1.946, 1.947, 1.948, 1.949, 1.950, 1.951, 1.952, 1.953, 1.954, 1.955, 1.956, 1.957, 1.958, 1.959, 1.960, 1.961, 1.962, 1.963, 1.964, 1.965, 1.966, 1.967, 1.968, 1.969, 1.970, 1.971, 1.972, 1.973, 1.974, 1.975, 1.976, 1.977, 1.978, 1.979, 1.980, 1.981, 1.982, 1.983, 1.984, 1.985, 1.986, 1.987, 1.988, 1.989, 1.990, 1.991, 1.992, 1.993, 1.994, 1.995, 1.996, 1.997, 1.998, 1.999, 2.000).


October 31, 2007  
Alexandria, Virginia  
/s/ James C. Cacheris  
UNITED STATES DISTRICT COURT JUDGE

**Basic reason: The rules are in conflict with the law**

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 **USPTO employees are to continue processing and examining patent applications under the rules and procedures in effect on October 31, 2007, until further notice**

This Web site will be updated and USPTO customers should monitor this Web site for any updated information.

**November 1, 2007**

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**What's next?**




**But, pending legislation could trump everything!**

Decision in winter/spring 2008  
Possible split decision:  
GSK could win on 1) Cont/RCEs limits, and 2) claims limits  
USPTO could win on disclosure of commonly owned apps  
Appeal in spring/summer 2008

Federal District Court for the Eastern District of Virginia, in Alexandria, VA

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## What's next?

### ★ More USPTO rules being proposed!

- ✦ Limits on the number of references cited in IDS
- ✦ Limits on claimed alternatives
- ✦ New Requirements for Appeals

### ★ More Court Challenges?

### ★ New Management at the USPTO?

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## *La saga des nouvelles règles d'examen définies par l' USPTO*



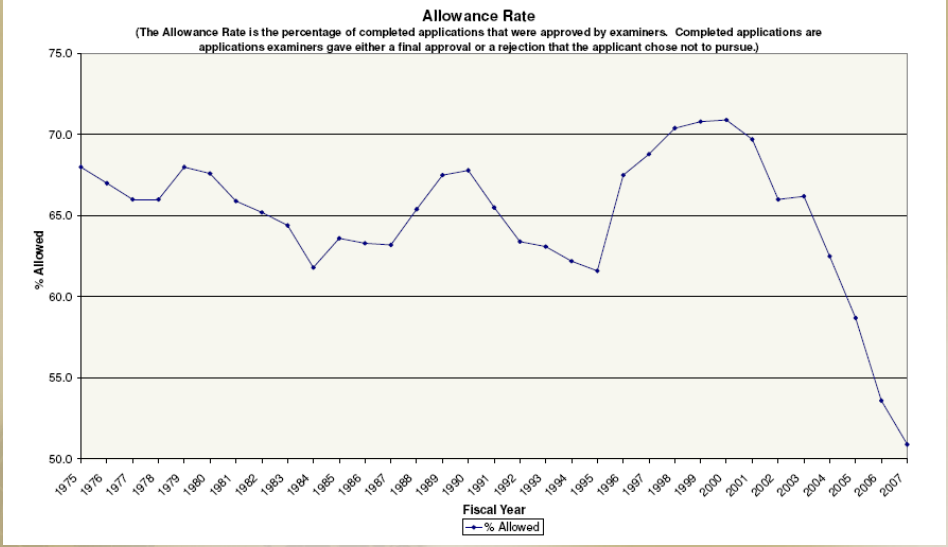
**Philippe Signore**

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**Fall, 2007**

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