



March 20, 2009

ATTORNEYS AT LAW

RICHARD D. KELLY
(703) 412-6241
RKELLY@OBLON.COM

Dear Colleagues:

Today, March 20, 2009, the Federal Circuit handed down its Decision in *Tafas v. Doll* regarding the “new rules” promulgated by the U.S. Patent and Trademark Office (PTO) in August, 2007. In its Decision, the Federal Circuit held:

- that the PTO’s limitations on continuation applications were invalid, but left open the door to limitation by “prosecution laches”;
- that the remaining rules were “non-substantive,” and thus were within the issuing authority of the PTO.

The case has been remanded to District Court to determine whether those rules that were found to be within the issuing authority of the PTO are arbitrary and capricious, conflict with the Patent Act, were properly Noticed to the public, were incomprehensibly vague, or were impermissibly retroactive. Based on the remand outlined in the Federal Circuit’s Decision, in view of the fact that rehearing *en banc* could be requested, and that the decision on remand could be appealed, it is highly unlikely that any implementation of any of the “new rules” would occur in 2009.

In view of the importance of this Decision we will provide more detailed analysis shortly, which will be posted on our website.

With best regards,

Very truly yours,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read "Richard D. Kelly".

Richard D. Kelly