

# **Patent Prosecution Procedure: Examination, Continuing Applications, Information Disclosure and Other Proposed Rules**

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# Introduction

- Each of these published rule packages is proposed by the PTO as a solution to the problem of increased pendency
- Certain Art Units are experiencing pendencies of greater than five years
- We invited Solicitor Whealan, J. Lucas and others from the United States Patent and Trademark Office to participate in this presentation.
- Most PTO executives are at an Executive Retreat this week

# Introduction

- The pendency pendulum
- Over last thirty years, pendency has increased and decreased in noticeable cycles
- Clients file fewer applications when pendency is high and more applications when pendency is low
- Panic at the PTO?

# Introduction

## Proposed Rule Packages

- Examination of Claims
  - Limiting how many claims will get examined
  - The least controversial proposal
  - Memorializing what actually happens at the PTO
- Limiting Continuing Applications/Related Applications
  - The nuclear fly swatter
  - Will it actually save any time?

# Introduction

## Proposed Rule Packages

- Information Disclosure Statement Changes
  - Is your malpractice insurance paid up?

### Acknowledgements

Stephen G. Kunin,

Former Deputy Commissioner for Patent Examination Policy,

Special Counsel at Oblon Spivak, et al.

# Examination of Claims

- Initial examination – no more than ten designated claims
- Independent claims are automatically designated
- Dependent claims must be expressly designated
- If you fail to designate dependent claims, only the independent claims will be examined, even if there are less than ten claims in the application.

# Examination of Claims

- A designated dependent claim can only depend from another designated claim. For example, if Claim 3 depends from Claim 2 which depends from Claim 1, Claim 3 cannot be designated without also designating Claim 2.
- A claim which refers to a claim of different statutory class, i.e. “A widget manufactured according to the method of Claim 10...” is an independent claim for both fee and designation purposes.
- No decision has been reached regarding treatment of designation of claims containing Markush groups.

# Examination of Claims

- What about filing multiple related applications?
- Patentably indistinct claims in one or more non-provisional applications where:
  - the second application is assigned to the same entity, or
  - is subject to an obligation of assignment to the same entity; and
  - the patentably indistinct claim has support under 35 U.S.C. §112 in the earliest application
- In such circumstances the PTO may require elimination of the patentably indistinct claims from all but one application or, the PTO will treat all patentably indistinct claims from all applications as present in each application

# Examination of Claims

- *Examples:*
  - Ten claims submitted – independent/dependent mix, no designation
    - Only independent claims searched/examined
    - If independent claims are allowed, dependent claims are rejoined and examined only under 35 U.S.C. §101 and §112
  - Less than ten claims submitted independent/dependent mix, all claims designated
    - All claims searched and examined

# Examination of Claims

## ■ *Examples:*

- Applications containing more than ten independent claims or where the number of independent claims plus the number of dependent claims designated for initial examination is greater than ten
  - An amendment may be filed cancelling claims or changing the designation.
    - Any fees paid on or after December 8, 2004 for claims which are cancelled can be refunded as long as the request for refund is filed within two months from the date upon which the claim was cancelled. This period is not extendable.
- Applicant may also suggest a restriction requirement in the event groups of claims within the application are directed to separate and distinct inventions; or
- The applicant may file an Examination Support Document (ESD)

# Examination of Claims

## ■ Examination Support Document

- Includes a statement that a pre-examination search was conducted, including an identification of the field of search by United States class and subclass and the date of the search, where applicable, and, for database searches, the search logic or chemical structure or sequence used as a query, the name of the file or file searched and the database service, and the date of the search;
- An Information Disclosure Statement in compliance with §1.98 citing the reference or references deemed most closely related to the subject matter of each of the independent claims and designated dependent claims;
- For each reference cited, an identification of all of the limitations of the independent claims and designated dependent claims that are disclosed by the reference;

# Examination of Claims

- Examination of Support Document (cont.)
  - A detailed explanation of how each of the independent claims and designated claims are patentable over the references cited;
  - A concise statement of the utility of the invention as defined in each of the independent claims; and
  - A showing of where each limitation of the independent claims and the designated dependent claims find support under the first paragraph of 35 U.S.C. §112 in the written specification

# Examination of Claims

- Examination of Support Document (cont.)
  - If an examination support document is required, but the examination support document or pre-examination search is deemed to be insufficient, an explanation of the invention or how the independent and designated dependent claims define the invention is deemed necessary, or the claims have been amended such that the examination support document no longer covers each independent claim and each designated dependent claim, the applicant will be notified;
  - Applicant will have a one month time period within which to file a corrected or supplemental examination support document in order to avoid abandonment
  - The one month period is not extendable

# Examination of Claims

## ■ Impact

- Minimal, only rare cases exceed ten independent claims
- Do you really believe Examiners read your dependent claims?
- During an Appeal the Board's decision is always directed at one or two exemplary claims
- Will probably be implemented early next year

# Proposed Rules: Continuing Applications

- Proposed rules seek to reduce continuing applications (CON/DIV/CIP) and RCEs
- Mechanisms:
  - Refuse entry for certain claims of priority under 35 U.S.C. §§ 120, 121, 365(c)
  - Restrict RCE to one per original (non-continuing) application or divisional
  - Petition process

# Limitations on Claims of Priority

- Proposed rules are complex
- Basic propositions
  - Exhaustion of priority right by filing of first continuation, CIP or RCE
  - Multiple involuntary divisionals allowed, but must be filed during pendency of application in which restriction made
  - Some continuing applications barred/anticipated as result of refused/deleted priority claim

# Limitations on Claims of Priority

- Continuation/Continuation-in-Part
  - May claim priority of only one prior nonprovisional application
  - Benefit of prior application may not be claimed by any other application (except compliant divisional)
  - RCE in prior application precludes priority claim thereto
  - EXCEPT via petition ...

*See Proposed §1.78(d)(1)(i).*

# Limitations on Claims of Priority

- Divisionals
  - May claim priority of only one prior application
  - Involuntary Divisionals Only:
    - Prior application subject to restriction/lack of unity
    - Divisional must contain only claims that are directed to restricted invention(s), but which were not elected in prior application
  - EXCEPT via petition ...

*See Proposed §1.78(d)(1)(ii).*

# Limitations on Claims of Priority

- Special Rule for CON/CIP of involuntary divisional
  - May claim priority of divisional and single parent thereof
  - Unless, RCE filed in divisional
  - EXCEPT via petition ...

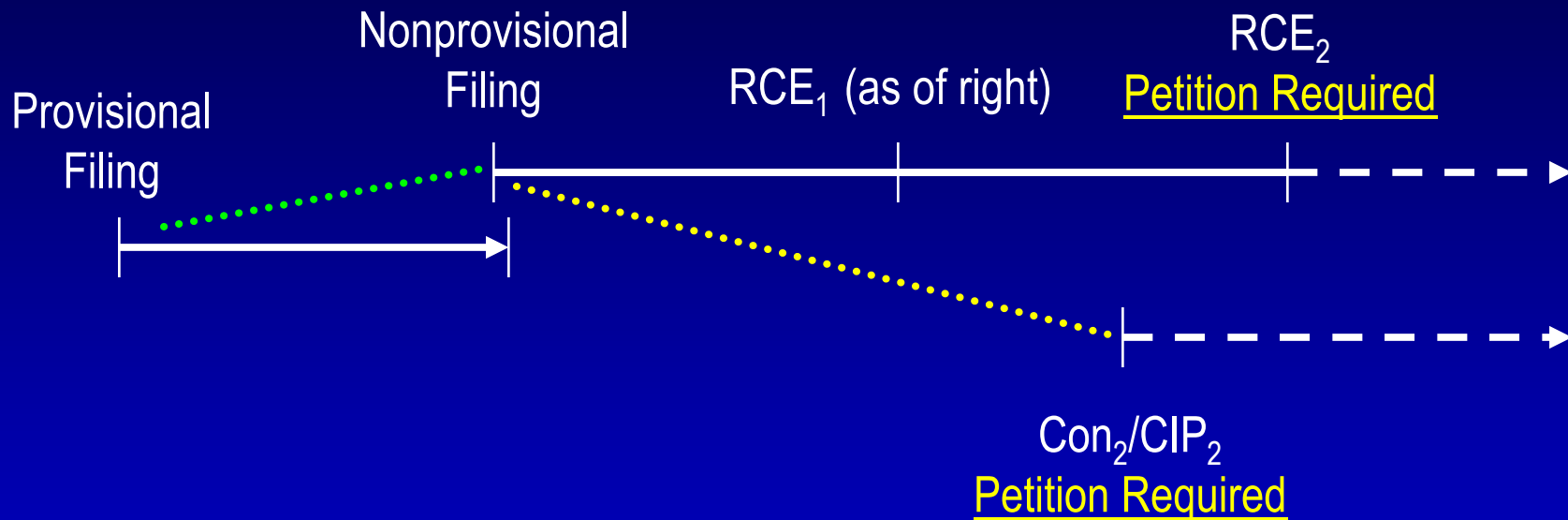
*See Proposed §1.78(d)(1)(iii).*

## Limitations on RCE

- Only a single request for continued examination (RCE) in an original or involuntary divisional application
- No RCE in a continuation or CIP
- EXCEPT via petition ...

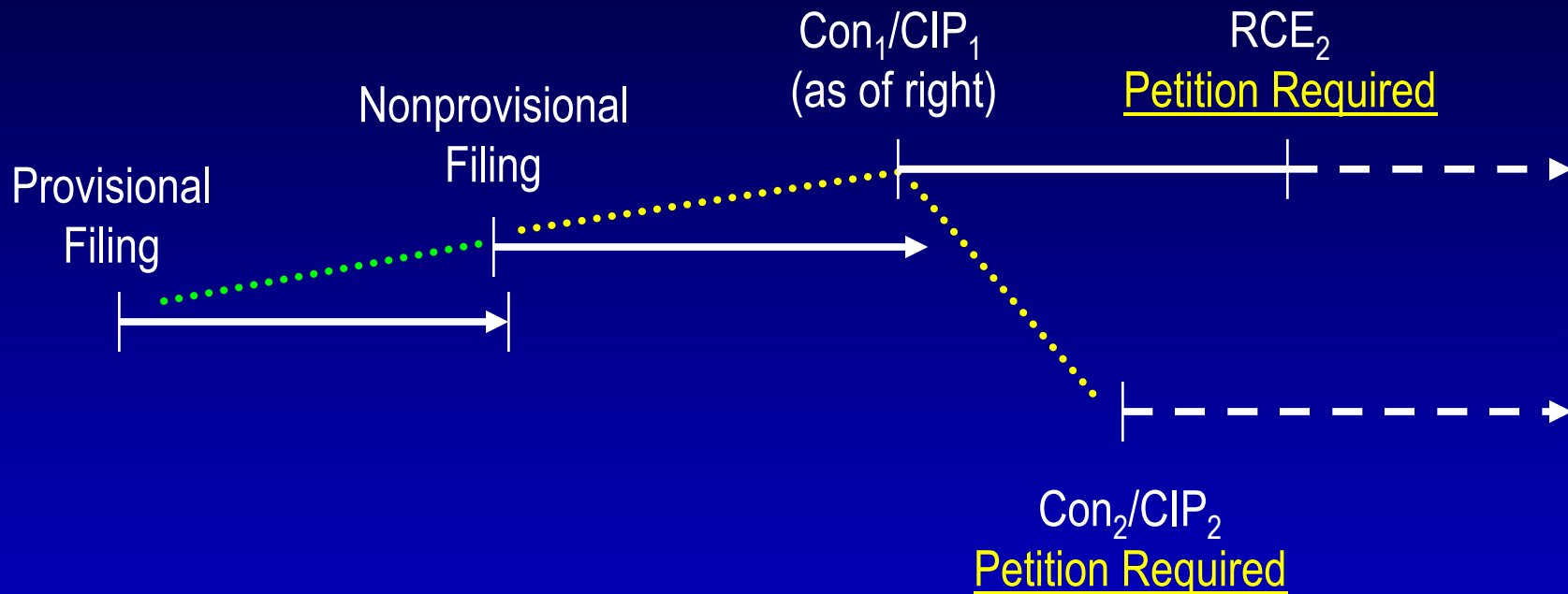
*See Proposed §1.114(f).*

# Examples (Basic Timeline, RCE)



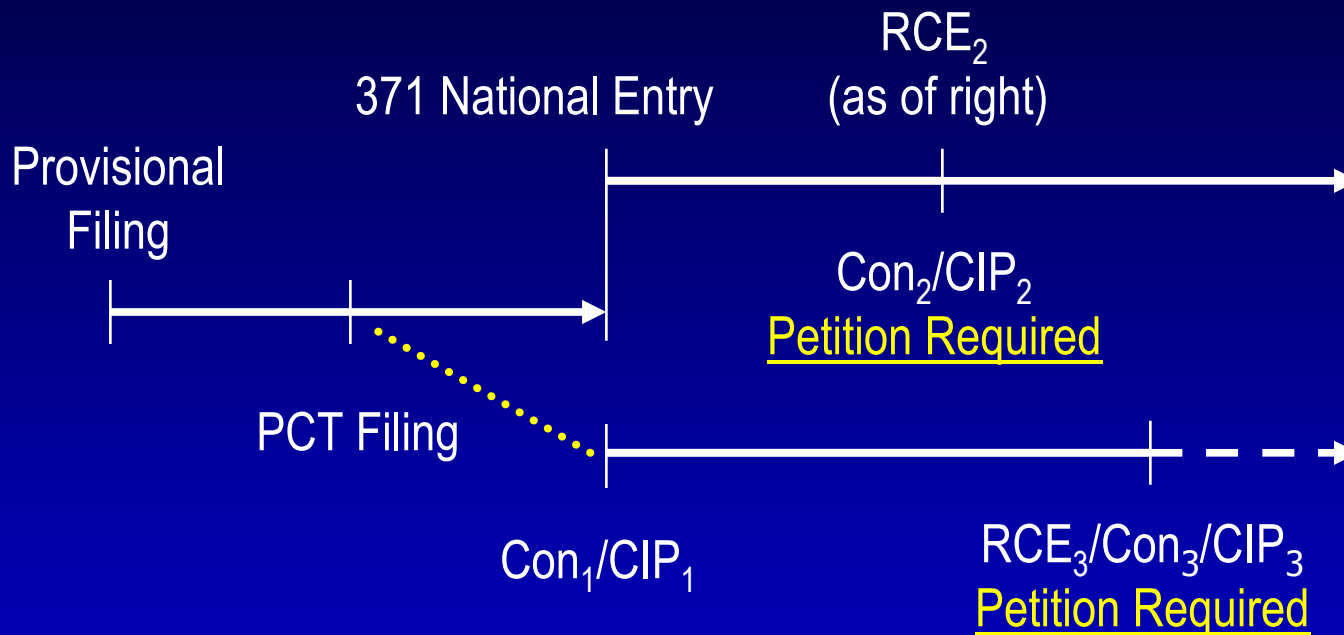
- **RCE<sub>2</sub> Petition Denied:** Application terminates (per statutory period) unless appealed.
- **CON<sub>2</sub>/CIP<sub>2</sub> Petition Denied:** gets no §120 benefit; CON<sub>2</sub>/CIP<sub>2</sub> may be barred/anticipated.

# Examples (Basic Timeline, CON)



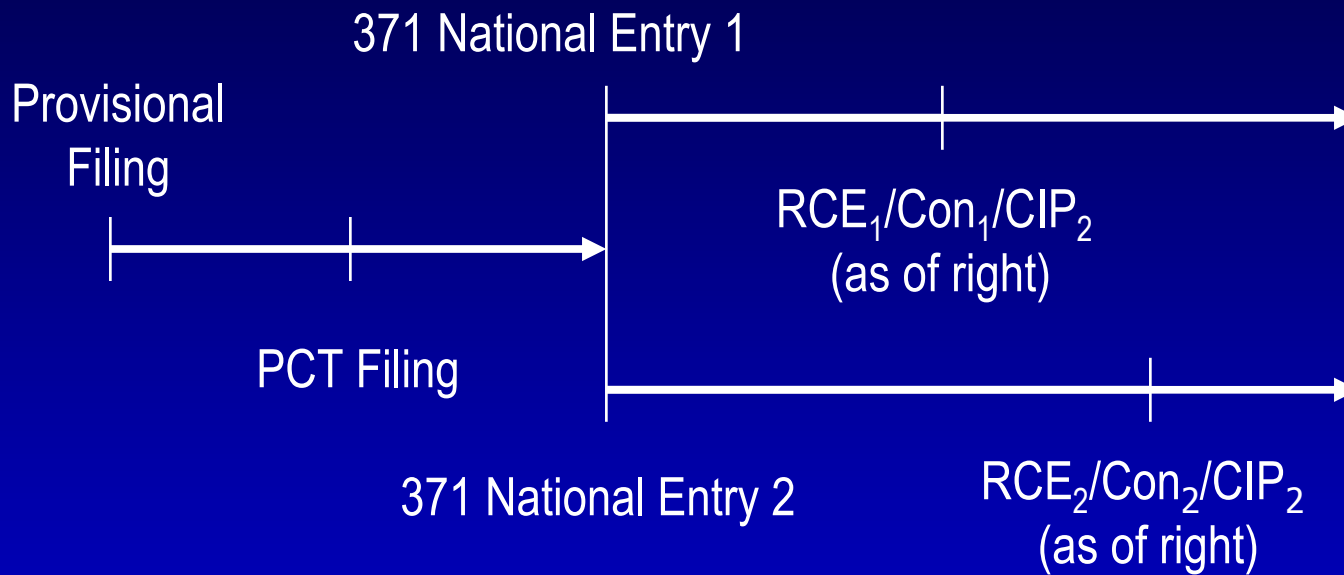
- **RCE<sub>2</sub> Petition Denied:** CON<sub>1</sub>/CIP<sub>1</sub> terminates (per statutory period) unless appealed.
- **CON<sub>2</sub>/CIP<sub>2</sub> Petition Denied:** CON<sub>2</sub>/CIP<sub>2</sub> gets benefit of CON<sub>1</sub>/CIP<sub>1</sub> only.

# Examples (Bypass Route PCT)

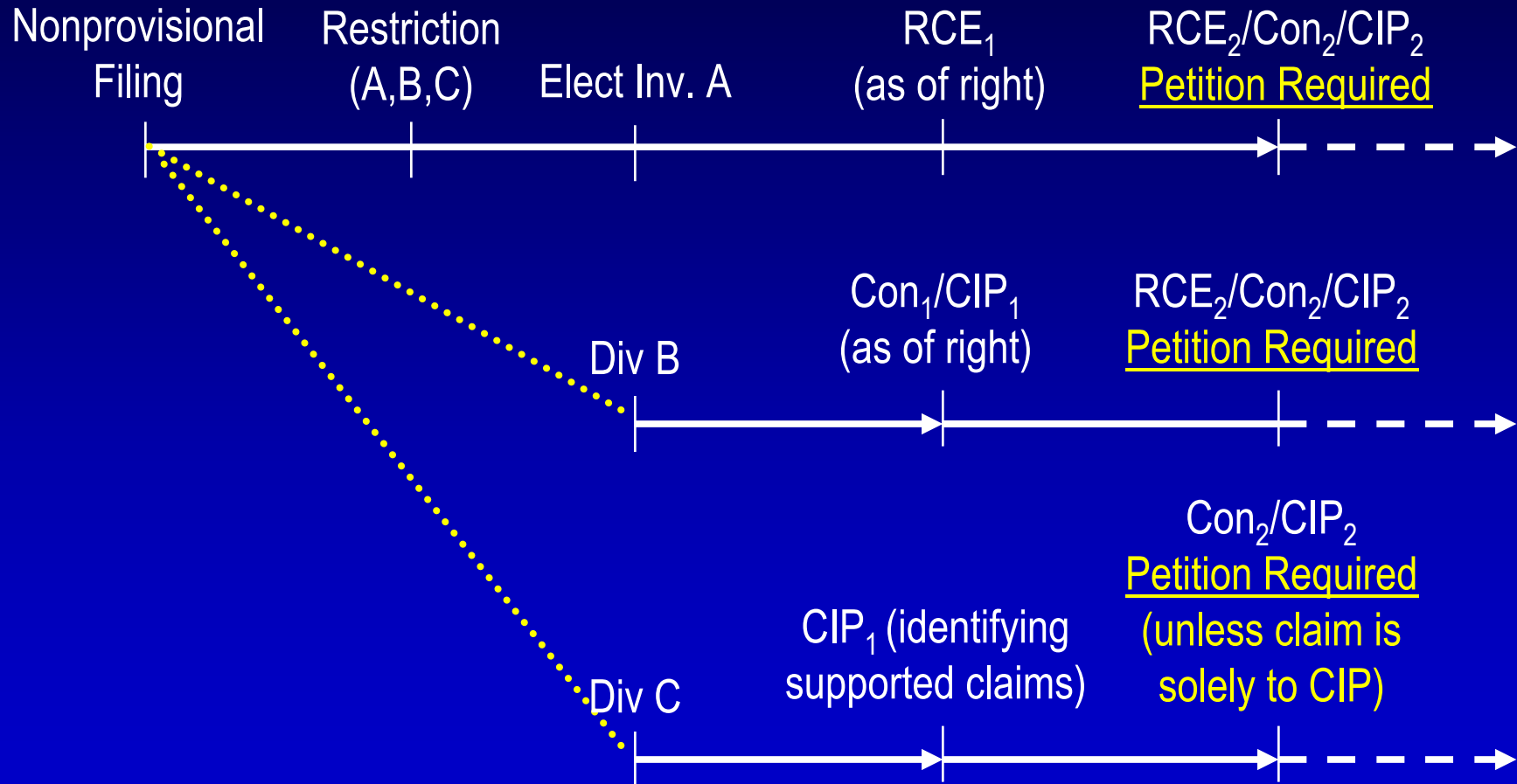


## Avoid Bypass Route Filings

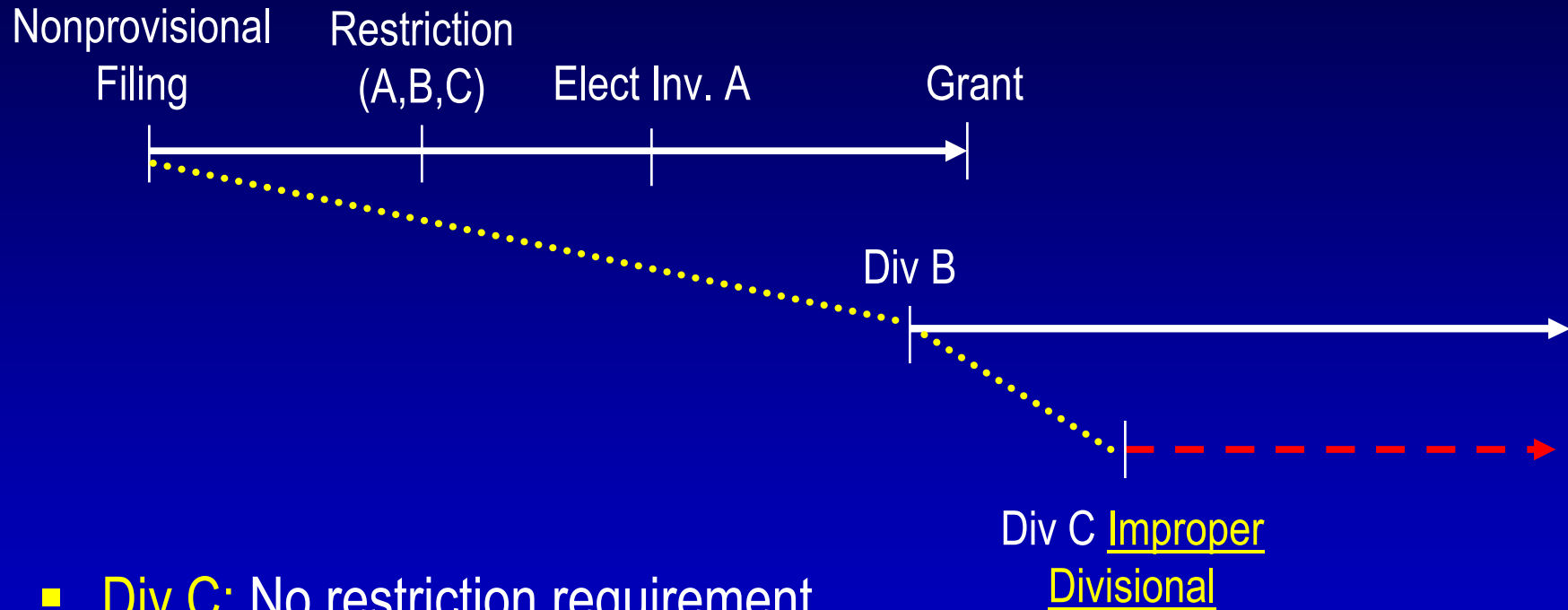
# Examples (Parallel National Entries)



# Examples (Parallel Divisional)



# Examples (Sequential Divisional)



- **Div C:** No restriction requirement in Div B; therefore no priority benefit.
- **Con C:** May claim priority of Div B (as Con), unless a CON/CIP filing claims priority of Div B or an RCE has been filed therein

# Petition under Proposed §1.78(d)(1)(iv)

## ■ Standard

- Petition including showing to the satisfaction of the Director that amendment, argument or evidence could not have been submitted:
  - during prosecution of prior application [CON/DIV/CIP]
  - prior to close of prosecution [RCE]

## ■ Timing

- Continuing Application: within 4 months from the actual filing date of the continuing application
- RCE: with RCE

# Grantable Petition (PTO Examples)

- *Example 1:*
  - Interference declared in application containing claims that correspond to the count(s) and claims that do not; AND
  - APJ suggests that claims that do not correspond to a count be cancelled and pursued separately

*See Robert S. Spar, Recent Rule Makings and Patent Practice Changes, Presentation to the National Association of Patent Practitioners, p. 41 (July 17, 2006).*

# Grantable Petition (PTO Examples)

- *Example 2:*
  - Data to support a showing of unexpected results just became available to overcome a final rejection under 35 U.S.C. §103; AND
  - Data is the result of a lengthy experimentation that was started after applicant received the rejection for the first time.

*See Spar, Recent Rule Makings and Patent Practice Changes, p. 42.*

# Grantable Petition (PTO Examples)

## ■ *Example 3:*

- Final rejection contains new ground of rejection that could not have been anticipated by the applicant; AND
- Applicant seeks to submit evidence which could not have been submitted earlier to overcome the new rejection

*See Spar, Recent Rule Makings and Patent Practice Changes, p. 43.*

## ■ *Implications:*

- What of new art cited in final rejection? Arguably, response “could not have been submitted”
- Office will probably regard entry of amendment to overcome new rejection over applied art as *insufficient* showing

# Insufficient Showing (PTO Examples)

- *Example 1:* Argument that final rejection in one of the prior applications was premature
- *Example 2:* Argument that amendment after final should have been entered in prior application
- Insufficient Showing:
  - Applicant should address propriety of final rejection or non-entry of amendment during prosecution of prior application and not collaterally in a petition for continuing application.

*See Spar, Recent Rule Makings and Patent Practice Changes, p. 44-45.*

# Consequence of Improper Filing (or Denial of Petition)

- Improper Continuing Application
  - Priority claim refused entry or deleted
  - May get no priority, priority of immediate parent only, or priority of immediate parent and its parent only
- Improper RCE
  - Treated as submission under § 1.116
  - Treated as request to withdraw appeal
  - Prosecution concludes when?  
... probably before decision on petition?

## Miscellaneous

- Continuation, divisional and CIP defined; priority claim must state relationship
- CIP must “identify which claim or claims in the [CIP] are disclosed in the manner provided by [35 U.S.C. §112(1)] in the prior filed application”
- Office will refuse/delete improper claim; failure to delete does not constitute waiver. *See* Proposed §1.78(d)(3).
- Some prohibitions are order dependent

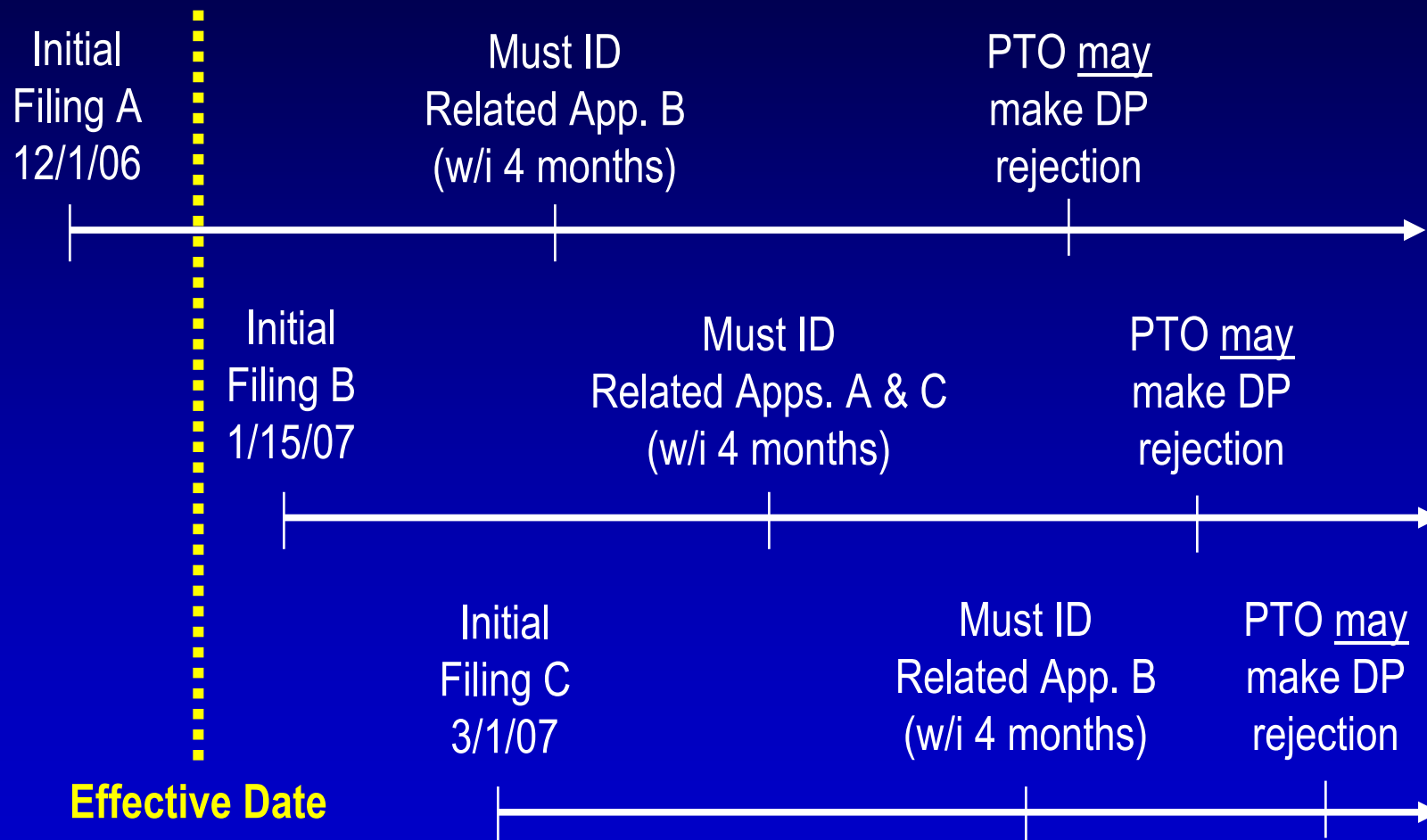
# Proposed Rules: Related Applications

- Proposed rules seek to reduce parallel applications
- Must *identify* all other applications that:
  - are commonly assigned/assignable;
  - have at least one common inventor; AND
  - have filing date (including priority) w/i 2 months of each other.
- *Rebuttable presumption* of double patenting *shall exist* if two applications:
  - have same filing date (including priority); AND
  - contain substantial overlapping disclosure.

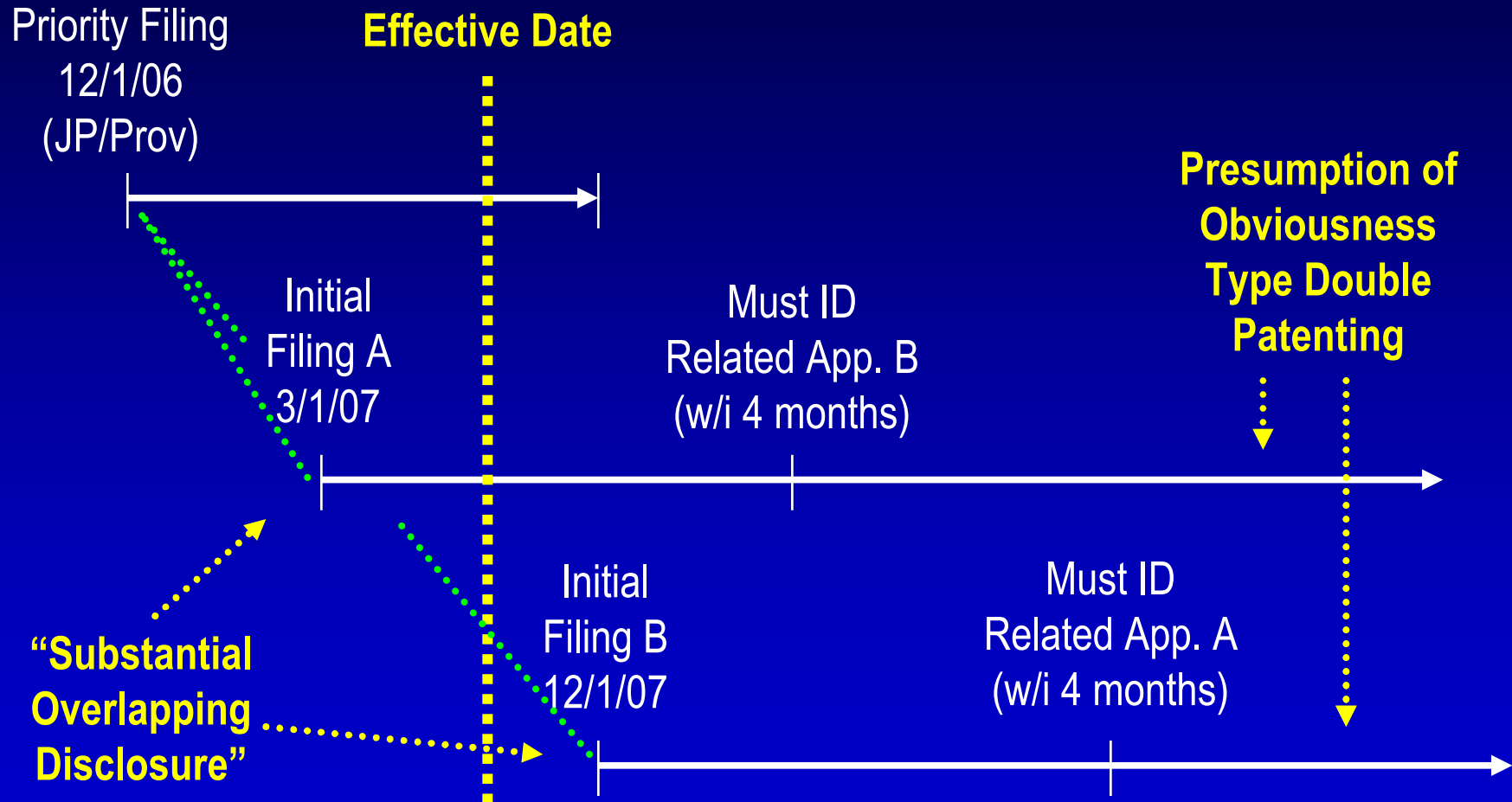
# Limiting Related Applications

- Identification requirement is bi-directional and must be submitted w/i 4 months of filing date
- If presumption operative, Applicant must:
  - Rebut by explaining to the satisfaction of the director how application contains only claims that are patentably distinct from the other applications; OR
  - File Terminal Disclaimer and explain why applications with patentably indistinct claims should be maintained
- PTO may require merger even if TD filed

# Examples (Identification Required)



# Examples (Double Patenting Presumed)



# Miscellaneous

- Presumption is self establishing.
- Rules require: (i) rebuttal or (ii) TD and explanation. ... *or What?*  
[I]t will be the applicant's responsibility to assist the Office in resolving potential double patenting situations rather than taking no action until faced with a double patenting rejection. Thus, if an Office action must include a double patenting rejection, it is because the applicant has not yet met his or her responsibility to resolve the double patenting situation .... Therefore, the inclusion of a new double patenting rejection in a second or subsequent Office action will not preclude the Office action from being made final.  
71 Fed. Reg. 55 (comments on proposed 1.78(f)(2))
- Representative Claims Rules allow accrual of claims from multiple applications having indistinct claims against limit (10)

# Effective Date Provisions

- Any application filed on or after effective date of final rule.
- But ... effectively retroactive
  - Certain divisional filings immediately foreclosed
  - Certain continuing applications immediately barred/anticipated
  - RCE immediately foreclosed in many pending matters
  - Petitions required immediately, if applicable

*See 71 Fed. Reg. at 56.*

# Practice Effects

- **Increased Stakes in Examination:** Limit on RCEs and other continuation applications will make each prosecution issue more important/adversarial.
- **Fewer Strategic Continuations:** Applicants no longer have carte blanche to “keep a continuation pending.”
- **More Reissues**
- **More Appeals and Petitions:** Strict petition standard forces appeals; more petitions challenging finality/non-entry of after final amendments so that petition for second continuation/RCE is not necessary.
- **Malpractice Claims:** Loss of rights/denial of petition

# Strategies - Prosecution

- Prosecute Like It's Your Last Shot (before appeal):
  - Responses to first actions are NOT a dry run
  - More *examiner interviews*; beware the lurking 2nd action final
  - Challenge finality (when appropriate) and *focus record* for appeal
- Appeal, Appeal, Appeal
- Avoid Terminal Disclaimers: Linked to admission of indistinct inventions
- Volunteer/Suggest Possible Restrictions:
  - Of initial large claim set, or possibly of added claims
  - Examiners will be happy to accommodate and will likely lead to more “involuntary divisionals.”

## Strategies - Filings

- **File New Applications:** Multiple original nonprovisional filings and parallel divisionals
- **Avoid CIPs:** Identifying claims supported by parent can be difficult and an admission.
- **Don't File PCT Bypass Applications:** Wastes continuation
- **Consider “Hip Pocket” Filing:** Parallel provisional with follow-on PCT may preserve opportunity for parallel US national entries
- **Consider Limited Pre-Filing Search**

# Information Disclosure Statement

- Objectives of the New IDS Rules
  - Get the IDS to the Examiner before the initial examination of an application
  - Reduce the number of IDS citations to only those which are most material
  - Provide pertinent information to the Examiner about large IDS references, foreign language references or when a large number of documents are submitted

# Information Disclosure Statement

- The muddled definition of “material”
  - Defined under Rule 56 as:
    - not cumulative
    - establishes, by itself or in combination with other information, a *prima facie* case of unpatentability; or
    - refutes or is inconsistent with the position taken by the Applicant
  - Defined by the federal circuit in *Digital Control Inc.*:
    - reasonable Examiner would consider it important
    - “but for” that information the patent would not have issued

# Information Disclosure Statement

- Currently applicants usually err on the side of disclosure
- PTO comments in 1992 note that Rule 56 places no burden on the practitioner to analyze references
- Past federal circuit cases consistently urge disclosure in case considering materiality verses cumulateness
- It's all about to change!

# Information Disclosure Statement

- Four Time Periods For New IDS Rules
- Time period one
  - Within three months of filing date
  - Within three months of entry into national stage; or
  - Prior to first office action
- Time period two
  - After time period one and before the earlier of:
    - notice of allowability; or
    - notice of intent to issue a reexamination certificate

# Information Disclosure Statement

- Time period three
  - After time period two; and
  - Before payment of issue fee
- Time period four
  - After payment of issue fee; and
  - In time to be considered by Examiner

# Information Disclosure Statement

- Disclosure Requirements
  - During time period one
    - No additional disclosure requirements during time period one unless:
      - a foreign language document is submitted; or
      - a document longer than 25 pages is submitted; or
      - more that 20 documents (cumulatively calculated) are submitted

# Information Disclosure Statement

- Disclosure Requirements (cont.)
  - Additional disclosure requirement
    - Identification of specific features or teachings that cause the document to be cited in a representative portion of the document where the specific features or teachings may be found; and
    - A correlation of the specific features or teachings which correspond to specific claim language or to specific portions of the specification that provide support for the claimed invention

# Information Disclosure Statement

- Disclosure Requirements (cont.)
  - During time period two
    - The identification required during time period one;
    - The correlation during time period one; and
    - A non-cumulative description detailing how each document is not merely cumulative of other IDS submitted materials, documents cited by the Examiner, or third party or public submissions

# Information Disclosure Statement

- Disclosure Requirements (cont.)
  - During time periods three and four
    - The identification required during time period one
    - The correlation required during time period one
    - The non-cumulative description required during time period two
    - A patentability justification either:
      - sets forth while the independent claims are patentable over the art being submitted, whether considered alone or in combination with earlier submitted art; or
      - an explanation of why the claims as amended, are patentable over that art; and
    - A certification that the art was unknown to the Applicant or was cited by a foreign patent office not more than three months prior to filing

# Information Disclosure Statement

- Updating Requirements
  - For every amendment to the claims filed after an IDS has been submitted the disclosure requirements must be reviewed and updated; or
  - Applicant must provide a statement that no update is required

# Information Disclosure Statement

- Details, Details, Details
  - The presence of an English language abstract does not convert a non-English language document into an English language document
  - When is a document longer than 25 pages?
    - Do not count sequence listings or program listings
    - Do count all drawings and cover sheets
    - You may submit partial documents by only submitting the relevant portions; however, caution is advised

# Information Disclosure Statement

- Details, Details, Details (cont.)
  - When are 21 documents not more than 20 documents?
    - Documents improperly submitted or not submitted in timely fashion are not considered and do not count
    - Documents mentioned in the specification but not submitted in an IDS do not count (and are not considered by the Examiner)
    - Documents cited in a foreign search report, and the foreign search report itself do not count

# Information Disclosure Statement

- Details, Details, Details (cont.)
  - Prior art submitted by third parties within six months of publication may be submitted without explanation
  - Prior art submitted to the Applicant by a third party member of the public under Rule 291 may be:
    - submitted by the Applicant in a proper IDS
    - submitted by the third party if the Applicant consents to the filing of a protest
    - submitted by the Applicant as a protest on behalf of the third party

# Information Disclosure Statement

- Safe Harbor Provisions
  - Proposed Rule 56(f) states disclosure requirements are met if:
    - the individual made a reasonable inquiry into the relationship between the disclosed documents and the claimed invention; and
    - the individual acted in good faith to comply
  - Everybody comfortable with that?

# Recommendations

- Are you a prosecutor or a litigator?
- Should you do a search?
- Should you limit the scope of your search?
- What about art cited by the PTO in a related case?

# Wrap Up

- Effective Dates
  - Examination of Claims
    - PTO has stated that the rules will apply to any application filed on or after the effective date; and
    - Any pending application which is not yet received a first action on the merits before the effective date, Applicant will be notified to designate ten claims
    - Likely to be Implemented

# Wrap Up

- Limiting Continuation/Related Applications
  - PTO has stated that the rule will apply to any application (including RCE, Continuation, CIP or Divisional) filed on or after the effective date
  - Currently Doubtful
- Information Disclosure Statements
  - PTO has stated the rules will apply to any IDS filed on or after the effective date
  - Likely to be implemented

**Thank You**