

## New USPTO Rules Questions and Answers

The following compilation represents questions that our attorneys have recently addressed with clients and colleagues—last updated 10/25/07. If your concerns are not addressed here, please contact us at [info@ptslaw.com](mailto:info@ptslaw.com).

**Q Do applications pending as of November 1, 2007 and canceled or abandoned, other than in response to a missing parts Rule 78(d)(1)(v), count in the limits of Rule 78(d)(1)(i)?** For example, if an applicant cancels one or more co-pending applications with patentably indistinct claims in favor of continuing prosecution of another co-pending application, do the canceled applications still count against the applicant for purposes of the forward priority claim limits of Rule 78(d)(1)(i)(B)? Is the answer the same if the PTO requires cancellation under Rule 78(f)(3), instead of the application being voluntarily abandoned by the applicant?

**A** *Claims to the benefit of an abandoned application count. The USPTO will not require cancellation or abandonment of an application, but only that indistinct claims in the pending application be put in a single application.*

**Q In the event that an applicant reviews a CIP case and determines that a claim to priority of a parent case is not required and subsequently disclaims that priority claim, will the fact that there once was a claim to priority made against the parent by that CIP (even though the priority claim is now disclaimed) still count for purposes of the limits of Rule 78(d)(1)(i)(B) applied to the parent?**

**A** *No.*

**Q If a pending case is itself not a CIP, but there is a CIP in the chain of parentage for that case, do the requirements of Rule 78(d)(3) to identify the claim of priority for each claim, apply to the claims of the pending case?**

**A** *No.*

**Q If a preliminary amendment and SRR are filed in a first co-pending case, will the provisionally nonelected claims in the SRR in that first case be considered in evaluating the one-way test for nonobviousness under Rule 78(f)(2) in a second co-pending case that is subject to Rule 78(f)(2) over the first co-pending case? If not, will the filing of the SRR be sufficient to show an intention to rebut the presumption of Rule 78(f)(2)? Similarly, will the provisionally non-elected claims in the SRR count for purposes of Rule 75(b)(3) and 75(b)(4) for any other co-pending application?**

**A** *The claims must be canceled or they must be taken into account in determining whether the applications have patentably indistinct claims.*

**Q Why is it that the patentably indistinct test for Rule 75(b)(4) does not include the limitation of at least one common inventor as is required for both Rules 78(f)(1) and 78(f)(2)? If the rebuttal**

presumption of Rule 78(f)(2) is not being used by a contractor to send out a Rule 75(b)(3) Notice, then who would be making a decision on patentably indistinct claims that would invoke Rule 75(b)(4) and when would that decision be made in the course of prosecution (i.e., before or after a FAOM)?

**A** *While there is a relationship between 37 CFR 1.75(b)(4) and 1.78(f), the rules serve different purposes and thus have different requirements.*

**Q** Neither the rules nor the comments appear to permit an applicant to counter Rule 75(b)(4) after issuance of a Notice under Rule 75(b)(3) by, for example, a) arguing against the presumption that the claims in the co-pending cases are patentably distinct; b) submitting an SRR in the co-pending case(s) other than the case for which the Notice under Rule 75(b)(3) was issued; c) abandoning the other co-pending case, d) obtaining a notice of allowance in the other co-pending case. See, for example, options described in FAQ F3 and F8. **While the actions under Rule 75(b)(3) are relatively clear and the number of options are relatively limited in the situation where there are only claims of a single case under consideration, the implications of the various ways that one or more other co-pending cases might be brought into counting claims under Rule 75(b)(4) for purposes of Rule 75(b)(3) create a large number of possible responses to the Rule 75(b)(3) limits for which there is no guidance in the rules or comments on how an applicant would respond the Rule 75(b)(3) notice. In addition, will the PTO be looking to some kind of filing timeliness made by the applicant under Rule 78(f)(2) as a prerequisite to consider any such arguments by the applicant against the application of Rule 75(b)(4)?** If so, what kind of guidance can the PTO give applicants about the nature and extent of arguments submitted to overcome the rebuttable presumption of Rule 78(f)(2) that would be sufficient to preserve the ability to continue these arguments in the face of a Rule 75(b)(3) notice that is generated because a given application exceeds the 5/25 limits only because of operation of Rule 75(b)(4)?

**A** *The applicant may always request reconsideration of any USPTO requirement, and seek review via petition under 37 CFR 1.181 of requirements not subject to appeal. Nothing in the rules precludes the applicant from mooting the requirement by canceling the indistinct claims from the other applications, abandoning the application, or obtaining an allowance of the other application, and then seeking reconsideration of the requirement for an ESD.*

**Q** **Is there any provision for petitioning or appealing a finding under Rule 75(b)(4) that claims of co-pending cases are patentably indistinct and, only as a result, an ESD is required under 75(b)(3)? If so, when and how would that process be invoked?**

**A** *The applicant may request reconsideration of 37 CFR 1.181.*

**Q** In the event that a divisional application is filed in response to a restriction requirement and is co-pending with a parent case, it appears that there are situations in which the claims of the divisional application can be counted under Rule 75(b)(3) against the limits of the parent case and/or the divisional case even though the filing of the divisional is authorized under the Rules. If, for example, a dependent claim in the divisional case recites limitations in an independent claim in the parent case, then the parent case could be one-way obvious over the divisional case once the divisional case is filed. Conversely, if a dependent claim in the parent case recites limitation in an independent claim in the divisional case, then the divisional case could be one-way obvious over the parent case.

**Will the PTO attempt to interpret the commonly owned "one or more pending nonprovisional applications" in Rule 75(b)(4) in this manner so as to force applicants to file an ESD in the situation where the co-pending cases are a parent and a divisional application that claims subject matter only claimed in a non-elected claim set cancels in response to a restriction requirement?**

**A** *No.*

**Q** In FAQ C3, the comment appears to indicate that two continuations from a divisional could be prosecuted in parallel (provided that the 5/25 limits of Rule 75(b)(3) are met); however, would this not violate Rule 78(f)(3) and what would prevent the PTO from requiring cancellation of one of the two continuation applications?

**A** *The point is that 37 CFR 1.78(d)(1) does not preclude an applicant from filing two continuing applications in parallel. However, if an applicant decides to file two continuation applications in parallel with indistinct claims, those applications will be subject to the requirements of 37 CFR 1.75(b)(4) and 1.78(f).*

**Q** While Rule 75 is not applicable to a pending case (Case A with 5/25 claims) having a FAOM as of 11/1/07, what happens if the claims in another pending case without a FAOM (Case B with 5/25 claims) are patentably indistinct from Case A? According to Rule 75(b)(3) if the number of claims in A+B exceeds the 5/25 limits, then the total number of claims is considered present in both A and B which is not consistent with the implementation language. Will the PTO simply not compare A in evaluating whether B is patentably indistinct under Rule 75(b), or will the PTO consider both A and B to have the total number of claims and exempt A from having to file an ESD but still require the ESD to be filed in case B?

**A** *Case A will be considered for Case B so that Case B (no FAOM) will have the number of claims of Case A (with FAOM) added to Case B for purposes of 75(b)(4).*

**Q** If an ESD is required by virtue of operation of Rule 75(b)(4), is it required only for the claims of the case or all of the claims in each case that have been added together? For example, assume that for cases pending after 11/1/07, Case A has 3/20 claims and Case B has 3/20 claims and the two cases are found to be patentably indistinct, but Case A has a first Action estimate of six months while Case B has a first action estimate of 24 months. Would it be possible to file an ESD for Case A, mapping only the 3/20 claims of Case A, prosecute A to final disposition before Case B gets a FAOM, and then not have to do an ESD for Case B because Case A is no longer co-pending? The language of Rule 265 seems to permit this, but it is not clear that the "claims" that must be mapped, for example, in 265(a)(3), are just the claims in a given case or the claims that are counted for purposes of Rule 75(b).

**A** *Only the claims of Case A would need to be the subject of the ESD – 10/19.*

**Q** What happens to the obligations of identification under Rule 78(f)(1) in the event that an application is assigned while the application is still pending? For example, Case A is invented by Joe who works for Company X. Company X assignees Case A to Company B while Case A is pending. Subsequent to the sale, Company B files a continuation of Case A and, unbeknownst to Company B, Company A files another application invented by Joe. The continuation and the new application have overlapping +/- two month filing dates and, thus, satisfy the requirements of Rule 78(f)(1). Is Company B required to identify the new case filed by Company A and how does the PTO envision enforcing that requirement where the new case filed by Company A is protected under the confidentiality provisions of Rule 14?

**A** *PTO indicated that once the ownership of an application has been assigned, then the commonly owned provision will be interpreted based on the current assignment and will not be held to require identification of cases of Company A for applications now owned by Company B. THIS ANSWER DOES NOT SEEM CONSISTENT WITH EITHER MPEP 804.02 or MPEP 706.02(I)(2).*

**Q** If an applicant requests and receives deferral of examination of an original application under Rule 103(d) that has not yet received a FAOM, will the claims in that deferred application count for purposes of determining the 5/25 limits under Rule 75(b)(4) in a co-pending continuation application?

**A** *Deferral under Rule 103(d) of one case will not affect the evaluation under Rule 75(b)(4) of any other co-pending cases.*

**Q** If a pending case has a Final Rejection, and an RCE after 11/1/07, will it be permitted to file a SRR in that case? In other words, is a First Action after an RCE considered a FAOM for the RCE or just another office action for an application that has already received a FAOM prior to the RCE?

**A** *No, the case has already received a FAOM prior to the filing of an RCE.*

**Q** What happens if a divisional is filed after 11/1/07 and claims beyond the scope of the divisional subject matter are attempted to be introduced? For example, if claims are added beyond the scope of the divisional subject matter and an SRR is filed, will those claims be subject to a restriction requirement, or will they simply be cancelled as unresponsive claims not within the proper scope of a 78(d)(1)(ii) divisional application?

**A** *Technically, an application presented with claims beyond the scope of the nonelected subject matter that is the proper scope of the divisional would cause the application to become a continuation instead of a divisional; however, this technical deficiency would be cured as of the cancellation of the additional claims that were nonelected in the SRR filed in the "divisional" case. NOTE: The technical deficiency is not present if the added claims subject to the SRR are within the scope of the original non-elected claims that form the divisional. CAUTION: A PTO representative indicated that there may be an opportunity for the PTO to find that the claim to priority to the parent may not be permitted (e.g., if the "divisional" would be over the 2+1 limit during the time period it was a "continuation" prior to the cancellation of the claims outside the scope of the nonelected claims from the parent case in the event that the SRR is accepted and a formal restriction requirement is issued). It was unclear whether the period of time where a claim to priority might be withdrawn would then be healed by the subsequent cancellation of the claims outside the proper scope of the divisional in the event that the SRR is accepted and a formal restriction requirement is issued.*

**Q** Assume a situation where a continuation filed after 11/1/07 has a parent chain that includes an original case followed by a CIP (the continuation is a continuation of the CIP). Let's say that the continuation includes the new subject matter of the CIP (say a figure that was added) but the claim set as submitted is supported by the original case. Would Rule 78(d)(3) apply to that newly filed continuation? The definitions under Rule 78(a) seem to suggest that regardless of the claim set in the third case, it would by definition be a continuation-in-part. If this is a problem, could it be remedied by cancelling the subject matter added in the CIP (the new figure) in the continuation filed as the third case in this family?

**A** *PTO representative indicated that clarification would be forthcoming that, where claims of continuation of CIP case are all claiming subject matter disclosed in the original case, the case would be considered a Continuation under Rule 78(a)(3) and not a Continuation-in-Part under Rule 78(a)(4).*

**Q** Previous indications had been made that provisionally unelected claims were taken into account for purposes of determining the patentably indistinct test under 78(f)(2), but this answer seems different than Rule 75(b)(5) which indicates that claims withdrawn under any of 1.141 through 1.146 (which includes the new SRR of 1.143) would not be counted for purposes of 75(b)(2). Doesn't this lead to different results for purposes of determining whether an ESD

**needs to be filed under Rule 75(b) versus whether patentably indistinct claims are required to be cancelled under Rule 78(f)?**

**A** *PTO representative indicated that clarification on this issue would also be forthcoming.*

**Q** **Is Rule 78 applicable to reexamination proceedings?** Rule 1.78(g) expressly mentions reexamination proceedings, but the paragraph on effective date of 1.78 (other than (a) or (d)(1)) only says that the remainder of Rule 78 is applicable to non-provisional applications. If this is the case, it would appear that reexamination proceedings governed by current Rule 78(c) that references the requirement to eliminate conflicting claims between pending applications and reexamination proceedings.

**A** *PTO representative indicated that reexamination proceedings are not intended to be covered by any of the provisions of Rule 78 other than new Rule 78(g) and that clarification on this issue would also be forthcoming.*

**Q** **Does Rule 78(h) require the identification under Rule 78(f)(1) of all patents and applications owned by each party to a CREATE JRA?**

**A** Yes.

***Disclaimer: Just like the FAQ on the PTO Website, the answers to these questions are not legally binding and may be withdrawn, changed or clarified.***