

Onerous Claim & Continuation Rules Officially Rescinded

By Brandon Warner

The PTO announced yesterday, October 8, 2009, that it will rescind the claiming and continuations rules package that has been the subject of litigation in *Tafas v. Kappos*.

You may recall our previous updates (<http://www.hoveywilliams.com/ip-alert/patent-claim-continuation-rules-challenge-lives-on-federal-circuit-issues-o/>) regarding these rules proposed by the PTO that would have limited your ability to file continuations or RCEs in both pending and future patent applications. The rules would have also effectively limited the number of claims that could be presented in an application (or “family” of associated applications), and would have required us to analyze pending applications to identify such associations. These requirements would have been burdensome and costly for patent applicants.

The near-universally unpopular rules were promulgated by the prior Dudas administration of the PTO, and have now been officially rescinded by new PTO Director David Kappos. As a brief refresher, the rules were originally published on August 21, 2007, but were never implemented due to a preliminary injunction granted on October 31, 2007 (the day before their scheduled effective date). This injunction was made permanent on April 1, 2008, a decision that was appealed by the PTO and was, until yesterday, awaiting *en banc* review by the Federal Circuit.

Director Kappos has signed a new Final Rule rescinding these highly controversial regulations, which many patent applicants felt unduly restricted their capacity to protect intellectual property. The PTO also announced that it will file a joint motion with GlaxoSmithKline (one of the plaintiffs in the *Tafas v. Kappos* litigation) to “dismiss and vacate” the federal district court decision.

In an official press release, the PTO provided the following exemplary rationale for its recent decision and change of course:

“The USPTO should incentivize innovation, develop rules that are responsive to its applicants’ needs and help bring their products and services to market,” Kappos said. “These [proposed] regulations have been highly unpopular from the outset and were not well received by the applicant community. In taking the actions we are announcing today, we hope to engage the applicant community more effectively on improvements that will help make the USPTO more efficient, responsive, and transparent to the public.”

The full press release is available at http://www.uspto.gov/news/09_21.jsp. We are pleased to report this sensible decision by the PTO and will of course continue to monitor and provide you with updates regarding future actions by the new PTO leadership that may impact your intellectual property rights.

If you have any questions or concerns about any impact this action may have on your present or future patent applications, please contact us for more information or to schedule an appointment.

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