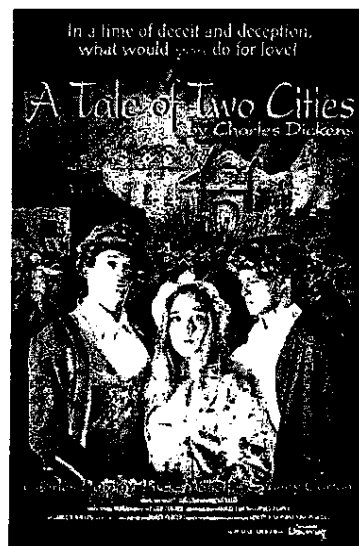


Strategies for Continued Prosecution and Extra Claims

San Francisco IP Law Association
September 13, 2007

February 2, 2008



Best of Times?

- *In re Seagate* (CAFC)
- *eBay v. MercExchange* (S. Ct.)
- H.R. 1908 – Goodbye, Marshall, Texas
- Continued increases in total application filing volume
- Plenty to analyze creatively and respond

Worst of Times?

- *KSR v. Teleflex* (S. Ct.)
- H.R. 1908 – Submission of search report (like ESD) in every application
- Long pendency, green examiners, examiner language issues, 50% allowance rate, low quality of Office actions based on management imperative to reject
- Rejections under 35 U.S.C. 101; *Macrossan/Aerotel* (UK-EPO)
- ESD (“Explicit Self Destruction”?), rebuttable presumptions, identification of related cases, limits on claims
- Explain references in IDSs but no change in inequitable conduct law

Agenda

- Highlights of rule changes
- Strategies for consideration
 - Faulty strategies
 - Applications for a related set of inventions
- What to do between now and November 1, 2007 & February 1, 2008
- New routine tasks in prosecution

Highlights of Rule Changes

- **LIMITS ON CONTINUATION APPLICATIONS AND REQUESTS FOR CONTINUED EXAMINATION (RCE)**
 - 2 continuations or CIPs as of right, 1 RCE as of right
 - Any number of RCEs, Continuations, and CIPs for cause
- **USES OF THE TWO OF-RIGHT CONTINUATIONS**
 - to continue prosecution of claims not allowed in a parent case (after using one RCE)
 - to cause consideration of newly-discovered prior art (after using one RCE)
 - to pursue broader/different claims than those allowed in a parent case
 - to "keep the chain alive" to allow claims to be custom-tailored to later-identified infringing products

Highlights of Rule Changes

- **EXPEDITED HANDLING OF CERTAIN OF-RIGHT CONTINUATIONS**
 - For scheduling purposes, of-right continuations will be treated as RCEs if the applicant expressly abandons the parent case and agrees to only pursue the invention of the parent case in the continuation

Highlights of Rule Changes—"For Cause" RCE, CON, CIP

- **Must be:**
 - Filed with a petition and \$400 fee
 - Filed to obtain consideration of an amendment, argument or evidence
 - Supported by a showing as to why the amendment, argument or evidence sought to be entered could not have been previously submitted
- If petition not granted, then the deadline for response continues running from the final Office Action
- Of-right RCE must be used before any for-cause RCEs, but applicant may file a for-cause RCE before using any of-right continuations
- Of-right continuations must be used before any for-cause continuations
- Filing a for-cause CON before using the of-right RCE is not expressly prohibited, but USPTO probably less likely to grant the petition for the continuation.
- For-cause RCEs, CONs and CIPs cannot be used merely to have newly-discovered prior art considered.
- For-cause CON or CIP is likely to be permitted only in limited circumstances, since CONs and CIPs are not filed with argument, amendments, or evidence

Highlights of Rule Changes—Retroactive Effect

- No currently-filed case will become invalid, even if its family violates the 2/1 rule
- For cases that belong to families that have already had an RCE, no further RCEs will be available after Nov. 1
- For cases that belong to families that have already had two CONs/CIPs, any number of CONs/CIPs can be filed before Nov. 1, but the CONs/CIPs will be subject to the 5/25 per-family claim limit rule.
- For every case that belongs to a family that has already had two CONs/CIPs, AND no CONs/CIPs were filed in the family between Aug. 21 and Nov. 1, a single CON/CIP can be filed after Nov. 1

Highlights of Rule Changes—5/25 Claim Limit

- No more than 5 independent claims and 25 total claims may be pending in all applications of a family
 - Divisional branches excluded
 - Issued patents excluded
 - Allowed claims excluded (allowed applications are not “pending”—72 Fed.Reg. 46726 col. 1 paragraph 2)
- Each divisional branch has a separate 5/25 claim limit for the branch
 - Divisionals cannot be used to pursue non-restricted inventions

Highlights of Rule Changes—5/25 Claim Limit

- Avoidable by filing an Examination Support Document (ESD)
 - Must be filed before the first Office Action
 - Must be updated when IDSes filed and when claims amended
 - Must include
 - Pre-examination search report
 - Listing of references
 - Mapping of limitations of claims to content of prior art references; small entities are exempt from this
 - Arguments of patentability for each independent claim, including arguments why it would not be obvious to combine the references
 - Identification of where in the specification there is support for each limitation of every claim

Highlights of Rule Changes—5/25 Claim Limit

- Possibly avoidable by filing a Suggested Restriction Requirement (SRR)
 - For cases filed before Nov. 1, SRRs may be submitted in response to requests to conform to the 5/25 rule
 - If the SRR is accepted, no refund is given for previously paid extra claims fees (even though you later cancel the claims)
 - For cases filed after Nov. 1, SRRs must be submitted within four months of filing

Highlights of Rule Changes—5/25 Claim Limit

- Retroactive Effect
 - Applies to all not-yet-allowed cases
 - Refund of extra claim fees must be requested within 2 months of canceling claims, for fees paid on or after Dec. 8, 2004, or USPTO keeps all previously paid fees

Highlights of Rule Changes—Common-Inventor Cases

- Applicant must identify all common-inventor cases with filing and/or priority dates within 2 months of each other
- An identification need not be filed in allowed cases, but allowed cases must be included in the identifications submitted in other cases
- For the purpose of identifying the cases, a two-month window around each filing date in the priority chain must be considered.
- Identification must be made within four months of the filing date—by February 1, 2008 for all now-pending cases

Highlights of Rule Changes—Common-Inventor Cases

- A rebuttable presumption is established that claims in common-inventor cases with same priority date and substantial overlapping disclosure are patentably indistinct
 - Allowed cases are excluded from the need to rebut the presumption
 - Rebuttable presumption must be rebutted within four months of the filing date
 - Rather than rebutting the presumption, an applicant may file a terminal disclaimer. However, doing so will cause the cases to be collectively subject to the 5/25 limitation on claims, and to be consolidated at the Examiner's discretion
 - Use of "incorporation by reference" could result in otherwise unrelated cases having "substantial overlapping disclosure"

Highlights of Rule Changes—Common-Inventor Cases

- Why is the USPTO doing this?
 - USPTO can require applicant to remove all claims from one of the applications. 37 CFR 1.78(f)(3)
 - When the cases have the same effective filing date and the presumption is not rebutted clearly USPTO almost certainly will require this. Standard for effective rebuttal is unknown.
 - When the cases have different effective filing dates but within the 2-month window, the USPTO still can require this, but will probably do so in more limited circumstances.
 - Main purpose of the data may be to see if one examiner can do a single search for all cases
 - Does not supplant requirements of *Dayco*

Highlights of Rule Changes—Common-Inventor Cases

- Retro-Active Effect
 - Identification of common-inventor cases due in all not-yet-allowed cases by Feb. 1, 2008
 - Presumption must be rebutted in all not-yet-allowed same-priority common-inventor cases by Feb. 1, 2008

Highlights of Rule Changes—Final Rejections

■ FIRST-ACTION FINAL REJECTIONS

- RCEs, CONs and CIPs can still have first action final rejections
- Unless the applicant was denied entry in the parent case of an amendment, argument, or new evidence

■ SECOND-ACTION FINAL REJECTIONS

- Second-action rejections with new grounds of rejection can be made final if the new grounds are
 - Necessitated by an amendment
 - Based on information submitted in an IDS under 37 C.F.R. 1.97(c)
 - Based on double-patenting
 - Necessitated by an applicant identifying a CIP claim as one that is supported by the parent case

Highlights of Rule Changes—Miscellaneous

■ CIPs

- Applicant must identify which claims are supported by parent
- Identification should be made before the search

■ New Treatment of Certain Claims

- Dependent claims that do not incorporate by reference all limitations of the parent claim are counted as independent for both fees and the 5/25 limit
- Dependent claims that change statutory category are counted as independent for both fees and the 5/25 limit

■ Priority Claim

- Priority claim must now be in a separate paragraph than the paragraph that merely recites related cases

Possible Filing-Claiming Strategies

- File SRRs in all cases where it can be reasonably argued that claims are to distinct inventions
 - Concurrently cancel all (or do not include any) claims to non-elected inventions except for one independent claim each, to permit requesting a refund (or avoid payment) of the claim fees of the cancelled (not filed) claims if the SRR is granted. If the SRR is not granted, you can always add as many claims as possible back into the case.
- When reasonable arguments for patentability exist, appeal instead of using of-right RCEs, CONs, CIPs
 - Every response should leave the case "ready for appeal".
 - Amend as necessary to avoid making arguments that are not strong enough to comfortably appeal.

Possible Filing-Claiming Strategies

- File a PCT with more than 5/25 claims. Use the information obtained from the PCT search and examination to make better use of the 5/25 claims that the case will be limited to when it enters national phase in the U.S.
 - To increase the period between priority date and examination, file a U.S. provisional, then a PCT, and then a U.S. national stage application.
- For pending CIPs that do not need a priority claim, cancel the priority claim so that they are not counted against the family to which they currently claim priority, and so that their family is not counted against them.

Possible Filing-Claiming Strategies

- If some claims are allowed, but you want to continue arguing other claims that are not, file an appeal with all claims rather than using an of-right continuation.
- If a final Office Action contains bad rejections based on newly-cited art, appeal rather than use an RCE and file a request for pre-appeal brief conference with the 5-page mini-brief.
- For applications that received first actions on the merits before Nov. 1, take advantage of their exemption from the 5/25 rule by adding new claims in these cases (or in RCEs of these cases) instead of filing continuations.

Faulty Strategies

- File separate applications, each of which contains claims to all of the inventions; file SRRs in each case, where each SRR elects a different invention; if the restrictions are granted, divisionals may be filed in each case to get more claims and continuations on the inventions pursued in the other cases
 - Problem: the invention of claims pursued in a divisional cannot have been examined in any other application

Faulty Strategies

- File a single application that contains claims to all of the inventions; file an SRR that elects the most important invention; use the continuations of the divisional cases to continue to pursue claims on the most important invention
 - Problem: the invention of claims pursued in a continuation of a divisional must be directed to the same invention as the divisional

Strategies for Related Inventions:

1. Single Original Application with Claims to All Inventions
2. Single Original Application to One Invention, CON to Claim All Other Inventions
3. Separate Applications for Each Invention, Filed on the Same Day
4. Separate Applications for Each Invention, Filed on Different Days

Strategies for Related Inventions:

1. Single Original Application with Claims to All Inventions

- **Specifics**
 - file a single "original" application with a specification that describes all of the inventions and that includes one independent claim for each of the distinct inventions
 - include with the filing a Suggested Restriction Requirement (SRR), arguing why the claims are patentably distinct
 - if the restriction requirement is granted, cancel the non-elected claims and use the available claim slots for more claims to the elected invention
 - while any application in the priority chain to the original application is pending, file divisionals for the non-elected inventions
- **PROS**
 - The divisionals may be filed serially or in parallel. The option to serially file the divisionals allows the applicant to defer both filing and prosecution costs.
- **CONS**
 - Each of the divisionals must have an inventor in common with all applications in its priority chain to the original application.
 - This option only works if there are five or fewer distinct inventions.
 - Even if the inventions are patentably distinct, the Examiner may decide to examine all claims anyway. In that case, all claims to all inventions are limited to the 5/25 claim number rule.

Strategies for Related Inventions:

2. Single Original Application to One Invention, CON to Claim All Other Inventions

- **Specifics**
 - file an application with a full set of claims for one of the inventions
 - when the original application is allowed, use one of the continuations of the pending application to file a multi-invention application as described in Option 1
- **PROS**
 - the divisionals may be filed serially or in parallel. The option to serially file the divisionals allows the applicant to defer both filing and prosecution costs.
- **CONS**
 - Uses one of the original application's continuations
 - The multi-invention application will have only one continuation (if not already used by the original application)
 - the multi-invention application will have only one RCE (if not already used by the original application)
 - Each of the divisionals must have an inventor in common with all applications in its priority chain to the original application.
 - This option only works if there are five or fewer distinct inventions.
 - Even if the inventions are patentably distinct, the Examiner may decide to examine all claims anyway. In that case, all claims to all inventions are limited to the 5/25 claim number rule.

Strategies for Related Inventions:

3. Separate Applications for Each Invention, Filed on the Same Day

- Specifics
 - File on the same day a separate application, with a full set of claims, for each invention
 - File, with each application, a listing that identifies the other applications
 - File, with each application, an explanation that rebuts the presumption that the claims are patentably indistinct
- PROS
 - The various separate applications need not have overlapping inventorship.
 - As long as you successfully rebut the presumption that the claims are patentably indistinct, you cannot be forced to consolidate the claims. Therefore, each patentably distinct invention will have the full 5/25 claims available.
- CONS
 - The applications are subject to the rebuttable presumption that they are not patentably distinct
 - This option is available only when the first application is filed.
 - All applications are prosecuted in parallel, without deferring any filing or prosecution costs.

Strategies for Related Inventions:

4. Separate Applications for Each Invention, Filed on Different Days

- Specifics
 - file on different days (e.g. 1 day apart) separate applications for each invention
 - file, with each application, a listing that identifies the other applications
- PROS
 - Not subject to the rebuttable presumption that the claims are not patentably distinct
 - The various separate applications need not have overlapping inventorship.
 - As long as you successfully rebut the presumption that the claims are patentably indistinct, you cannot be forced to consolidate the claims. Therefore, each patentably distinct invention will have the full 5/25 claims available.
- CONS
 - If inventorship is not identical, then the first-filed application may be used as a 102(e) reference against the other applications. The applicant may have to file an affidavit (131 or 132) to overcome this rejection.
 - Impact on novelty in corresponding EPO filings needs consideration.
 - This option is only available at the time the first application is filed.
 - All applications are prosecuted in parallel, without deferring any filing or prosecution costs.

Action Between Now and November 1, 2007

- **DEVELOP MECHANISM FOR IDENTIFYING COMMON-INVENTOR CASES**
 - Challenges in identification
 - File identification papers
- **FILE RCEs IN CERTAIN CASES**
 - In any pending applications that
 - currently have a Final Office Action issued;
 - an RCE has previously been filed in any case in its family (excluding divisional branches);
 - another RCE is desirable
 - The second or subsequent RCE must be filed before Nov. 1, 2007
 - After Nov. 1, 2007, no other RCE can be filed in that case

Action Between Now and November 1, 2007

- **DETERMINE NEW CLAIM GUIDELINES**
 - Strategies that result in large numbers of claims (e.g. multiple claim forms, multiple independent claims for each claim form, and full sets of dependent claims in each claim form) will no longer be viable
 - Determine conditions for filing an SRR

Action Between Now and November 1, 2007

- **DETERMINE GUIDELINES TO GOVERN CANCELLATION OF CLAIMS**
 - Determine how to respond to notices of 5/25 violation (the reply period is only 2 months)
 - Example: to minimize the decision-making cost, the default response could be to cancel all non-method dependent claims.
 - Alternative: Hold claim decision conferences in which the in-house counsel, outside attorneys, and inventors brainstorm about which claims would be most valuable to keep.
- **DETERMINE Whether to Immediately Cancel Priority Claims in Pending CIPs**
 - If you wait until final rejection or allowance, it may be too late—the required showing is stringent

New Routine Prosecution Tasks

- **AT THE TIME OF FILING**
 - In all cases, identify common-inventor cases
 - In all cases, determine whether to file an SRR
 - In some cases, file an SRR
 - In common-inventor/same-priority cases (including those already pending), file rebuttal of the presumption that the claims are patentably indistinct

New Routine Prosecution Tasks

■ DURING PROSECUTION

- In all currently-pending cases that have not yet been examined, determine whether to file an SRR and/or determine which claims to cancel
- In all currently-pending CIPs, determine whether to cancel the claim of priority
- Consider appealing rather than using an of-right RCE or CON.
- Consider filing petitions to obtain for-cause RCEs, CONs, and CIPs; be aware of large extension and/or revival fees if for-cause petitions are denied
- Make all responses "ready for appeal"

■ AT ALLOWANCE

- Determine whether claims can be added to any other application having patentably indistinct claims

Thank you

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