

## Patent Portfolio Management Strategies Under New USPTO Rules

Recent USPTO rule changes have necessitated reevaluation of patent prosecution strategies for both currently pending applications and applications filed after November 1, 2007. Below is a brief overview of the major rule changes and a few suggestions on actions that should be considered before the November 1, 2007, deadline.

### Restrictions to Continuation Practice

An application family (i.e., a chain of continuing applications) is limited to two continuation or continuation-in-part (CIP) applications and a single request for continued examination (RCE). To exceed this limit, an applicant must petition the USPTO and show why the filing could not have been made earlier. A one-time exception permits an application family already containing two or more continuations to file *one more* continuing application after August 21, 2007. For application families in which an RCE has already been filed, no further RCEs will be permitted as a matter of right after November 1, 2007. Additionally, applicants must identify which claims in a CIP application are supported in a parent application's disclosure and are entitled to an earlier priority date.

### Limits on Number of Claims

An applicant must submit an examination support document (ESD) if an application contains more than 5 independent claims or more than 25 total claims, counting all of the claims in any other co-pending application that has not yet been allowed and has at least one patentably indistinct claim (using a § 103 obviousness standard). The 5/25 limitation does not apply to applications that have received a first action on the merits (FAOM) prior to November 1, 2007.

By February 1, 2008, applicants must identify all commonly owned patent applications having a common inventor and filing or priority dates within two months of each other. If the applications have the same filing date or priority date and substantial overlapping disclosures (i.e., a disclosure that would support at least one claim in the related application), there is a rebuttable presumption that such applications contain at least one patentably indistinct claim. Applications with more than 5/25 claims and without a FAOM must be amended or an ESD must be filed within two months of notification from the USPTO.

### Ways to Obtain Additional Continuations

**DIVISIONAL APPLICATIONS:** An applicant may file a Suggested Requirement for Restriction (SRR) before a FAOM that suggests a set of claims directed toward only one invention. If the SRR is accepted, a divisional application may then be filed. The claims will not be counted toward the 5/25 total, and a new set of two continuation applications and one RCE will be allowed.

**PCT APPLICATIONS:** If an application claims priority to an initial PCT application in which no demand was filed and no U.S. national fee was paid, a total of three continuations will be permitted in that family (including the unexamined PCT application).

*continued*

**For more information on this topic, please contact:**

*Austin*

**Mike Adams**

512.370.2858

madams@winstead.com

*Dallas*

**Stan Moore**

214.745.5110

smoore@winstead.com

*Houston*

**Robert Shaddox**

713.650.2764

rshaddox@winstead.com

**WINSTEAD**  
ATTORNEYS

# WINSTEAD NEWS ALERT

**ABANDONED APPLICATIONS:** If an application claims priority to an initial U.S. application that was accorded a filing date and for which the basic filing fee was paid, but the application was abandoned for failing to comply with a Notice of Missing Parts, a total of three continuations will be permitted in the application family (including the abandoned U.S. application).

**C-I-P APPLICATIONS:** A CIP can form the basis for up to two additional continuations or CIPs if the additional continuations/CIPs contain one or more claims that are not supported by an original application and the additional continuations/CIPs do not claim priority to the original application.

Notably, these provisions will also apply to U.S. national phase applications filed after November 1, 2007, and retroactively to any national phase applications filed after August 20, 2007, regardless of the filing date of the International Application from which they derive.

## Actions Requiring Immediate Attention

- Begin identifying all commonly owned applications having common inventors and filing or priority dates within two months of each other to file with the USPTO before Feb. 1, 2008.

## Options to Consider before Nov. 1, 2007:

- In application families where an RCE has already been filed:
  - File an RCE before deadline prohibits any further RCEs.
  - File an RCE instead of a continuation to preserve the additional available continuation.
- In application families where two continuations have already been filed:
  - If one application family requires several continuations, file those before the deadline.
    - Advantages — no limit on continuations filed before Nov. 1, 2007
    - Disadvantages — the "additional" continuation is spent
- For all pending CIP applications, identify all claims that are supported by a parent application; consider not filing CIP applications in the future.
- In cases already assigned to an Examiner, consider asking for a FAOM explaining that otherwise a preliminary amendment will obviate any prior art searches.

## Options to Consider after Nov. 1, 2007:

- Wait for notice from USPTO patent applications with excessive claims that have not received a FAOM prior to Nov. 1, 2007. Amend or file SRR in response to notice.
- File a single application with more than 5/25 and concurrently file an SRR.
- File multiple applications, each with less than 5/25, and ensure that subject matter in one application is not disclosed in other related applications.
- Consider means-plus-function claims\* to capture more embodiments in fewer claims.
- Consider not traversing Restriction Requirements; instead file divisional application.
- Consider conducting Examiner interviews even prior to a first office action.

\*involves other legal considerations

### Mailing List Subscriptions

*If you would like to be added to Winstead's News Alert mailing list, please e-mail [winstead@winstead.com](mailto:winstead@winstead.com). Accordingly, you may unsubscribe from Winstead's distribution list by e-mailing [winstead@winstead.com](mailto:winstead@winstead.com) and including **remove** in the subject line. It may take up to 10 business days to remove your address from the e-mail list.*

### Disclaimer

*Content contained within this news alert provides information on general legal issues and is not intended to provide advice on any specific legal matter or factual situation. This information is not intended to create, and receipt of it does not constitute, a lawyer-client relationship. Readers should not act upon this information without seeking professional counsel.*