

Significant Changes To The US Patent System

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STOP PRESS: The USPTO rule changes discussed below were intended to come into force on 1 November 2007. However, they are now the subject of an 11th hour interim injunction against the USPTO granted in a US District Court on 31 October 2007. Although the new rules are not currently in force, the intention of the USPTO is to apply these rules retrospectively to any application under examination if, and when, the injunction is lifted. Therefore, new applicants should be aware of the following issues when planning a US patent strategy.

The US is the home of the world's largest economy, and many inventors consider the grant of a US patent to be a significant milestone on the road to protecting and commercialising an invention. Consequently, the large number of patent applications filed by applicants from the US, and other countries, has created a heavy examination workload for the United States Patent and Trademark Office (USPTO). In response, the USPTO has attempted to introduce several new rules in order to accelerate patent examination.

Number of Claims

Firstly, the USPTO prefers new inventions to be encompassed within a single, succinct patent application comprising a maximum of 25 claims. If this limit is exceeded, the USPTO would then require the applicant to restrict the number of claims during examination, or to justify the number of claims in an "examination support document".

In addition, the USPTO has proposed further rule changes in an attempt to stop applicants circumventing the new claim limit by filing several applications directed to different embodiments of the same general invention. In particular, the USPTO will seek details of any related US application if the related application has a common inventor, a common owner, and was filed within two months of the new application.

Furthermore, if the disclosure of a new application is substantially the same as any other US patent application or granted US patent, then the USPTO will reject the new application on the presumption that the claims of each application are not distinct. However, this presumption would be able to be rebutted by demonstrating that the claims of the new application are patentably distinct when compared to the claims of the earlier application.

Continuation Applications

It is common practice in the US, especially in the pharmaceutical field, to file "continuation applications" before a parent application is granted. These applications have the same invention description and priority date as the parent application, but different claims. For example, a continuation application may be directed to a preferred embodiment of an invention which was described, but not claimed, in the original application.

In a further attempt to reduce the number of applications awaiting examination, the USPTO has attempted to restrict the number of continuation applications filed from any parent application, or family of applications, to no more than two. However, this limit would not include applications which have been divided out from a parent application in response to a unity of invention objection (i.e. when an application is deemed to be directed to more than one invention).

The USPTO believes that these rule changes will reduce examination times, while promoting innovation and improving patent quality. While it is yet to be seen how effective these measures will be if, and when, they are implemented, it is clear that any US patent applicant must now operate with a heightened level of caution. In particular, contingencies for all of the above-mentioned factors should be incorporated into any US patent strategy.

A reminder: if you have any queries regarding patents, or indeed any form of intellectual property, please direct them to:

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