

The Full Federal Circuit to Consider the Validity of USPTO's "New Rules," including Rules Placing Limits on Claims and Continuations

On July 6, 2009, the Federal Circuit agreed to reconsider the appeal of the USPTO's "new rules" en banc. In doing so, the Federal Circuit vacated its March 2009 decision by a three-judge panel in *Tafas v. Doll*. This means that all judges of the Federal Circuit will soon consider and rule on the appeal from the district court decision that blocked the implementation of these "new rules."

In 2007, the USPTO announced a number of new rules which would have created dramatic changes with respect to how patent applicants interact with the USPTO. In pertinent part, these new rules placed limits on how many continuation patent applications an applicant could file within a patent application family, how many claims an applicant could present for examination and how many Requests for Continued Examination (RCEs) an applicant could file within a patent family during the examination process. Shortly before these rules were scheduled to take effect on November 1, 2007, the United States District Court for the Eastern District of Virginia issued an injunction at the request of several parties to prohibit the USPTO from implementing these rules. Later, the District Court ruled on summary judgment that several of the new rules were invalid because the nature of these new rules exceeded the USPTO's rulemaking authority.

The USPTO appealed this closely watched case. In its divided March 2009 panel decision, the Federal Circuit concluded that the new rules which limited continuation patent applications were invalid as outside the USPTO's rulemaking authority but opened the door for implementation of other rules, such as the rules affecting claims and RCEs. However, with its decision to vacate the panel decision and re-hear the "new rules" appeal en banc, the Federal Circuit has introduced the possibility of further restricting or expanding the new rules that the USPTO will be permitted to implement. Thus, the future state of the USPTO's "new rules" remains uncertain. The parties are to file their briefs for the en banc appeal within the next month, with oral arguments to follow at a later date.

If you have any questions about this decision, please contact any of the following: Benjamin L. Volk, Jr., Richard E. Haferkamp, Kevin M. Kercher, Thomas A. Polcyn or Alan H. Norman at (314) 552-6000. You may also contact your Thompson Coburn attorney. Please visit www.thompsoncoburn.com for more information on our Intellectual Property practice.

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