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## Legal Updates & News

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#### Federal Court Voids Changes to Patent Office Rules on Continuation and Claims Practice

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On April 1, 2008, the United States District Court for the Eastern District of Virginia declared void the “Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications,” 72 Fed. Reg. 46716-46843 (August 21, 2007) (“Final Rules”), proposed by the United States Patent and Trademark Office (“USPTO”). Judge James C. Cacheris granted Summary Judgment in favor of plaintiffs GlaxoSmithKline and Triantafyllos Tafas and permanently enjoined the USPTO from implementing the Final Rules that were to have taken effect on November 1, 2007.<sup>[1]</sup>

The Final Rules imposed limits on the number of continuing applications, requests for continued examination (“RCEs”), and continuation-in-part applications and the number of claims permissible as of right in a given patent application family and, in certain circumstances, added the requirement for an onerous examination support document (“ESD”).

Citing precedent from the United States Supreme Court and the United States Court of Appeals for the Federal Circuit, the court held that 35 U.S.C. § 2(b)(2) does not permit the USPTO to issue substantive rules or render substantive decisions interpreting the Patent Act. The court also based its decision on Congress’s failure to confer upon the USPTO substantive rulemaking authority as part of Patent Reform legislation proposed since 2005.

The court characterized the Final Rules as “neither procedural rules nor rules relating to application processing that have substantive collateral consequences, but substantive rules that change existing law and alter the rights of applicants...under the Patent Act.” In the court’s view, provisions of the Final Rules “which limit continuing applications, RCEs and claims, and the ESD requirement, which shifts the examination burden onto applicants, constitute a drastic departure from the terms of the Patent Act as they are presently understood.”

The court’s decision maintains the status quo for continuation and claims practice before the USPTO for the time being and pending the outcome of any appeal to the Court of Appeals for the Federal Circuit.

Please click here to [view the court’s decision](#) and here to [view the order](#).

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#### Footnotes:

[1] See *Tafas v. Dudas*, E.D. Va., No. 1:07cv846, and *SmithKline Beecham Corporation, et al. v. Dudas*, E.D. Va., No. 1:07cv1008.