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“Tip of the Month”

US Patent Practice Rule Changes

The US Patent Office recently adopted new rules effective as of November 1, 2007. The changes will affect the examination of US patent applications. The subject matter of the new rules pertains to claims and continuations of patent applications. According to the US Patent and Trademark Office (USPTO), the primary goal of the new rules is to improve quality and enhance efficiency in the patent examination process.

Some of the more important changes to the rules:

1. **Divisional application.** Applicants may file a divisional application if the earlier application is subject to a restriction requirement and the divisional application claims only a non-elected invention that has not been examined. A divisional application need not be filed during the pendency of the initial patent application. Divisional applications may be filed in parallel or in series so long as an application of the patent family is still pending.
2. **New claim threshold.** Per invention, an applicant may submit 5 independent claims and 25 total claims (5/25) per application without justification or an examination support document (ESD). Note that this does not change the basic filing fee that allows 3 independent claims and 20 total claims without paying any extra claims fees. Applicant may present more than the 5/25 claims if the applicant files an ESD before the first office action on the merits.
3. The 5/25 threshold does not count withdrawn claims. Applicant may provide a suggested restriction requirement (SRR) before the first office action or a restriction requirement. The 5/25 threshold does count all of the claims present in other co-pending applications having patentably indistinct claims but not the claims in issued patents. Applicant may present up to 15/75 claims by way of an initial application and 2 continuation or CIP applications prosecuted serially.
4. Applicant may file, without a petition and showing, 2 continuation or continuation-in-part applications and 1 request for continued examination (RCE) in an application family. An application family includes the initial application and its continuation or CIP applications. Applicant may file any additional continuing application or RCE with a petition and showing.
5. With respect to divisional applications, the applicant may file without a petition and showing 2 continuation applications of a divisional application and 1 RCE in the divisional application family.

If you have any questions on how the rule changes will affect your pending applications, please give us a call at 603-669-1971 or by email at mailbox@biz-patlaw.com.

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