



SCHWEGMAN ■ LUNDBERG ■ WOESSNER ■ KLUTH  
Intellectual Property Attorneys

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PATENT PROTECTION FOR HIGH TECHNOLOGY

## Proposed Rules on Continuation Practice

**MIPLA CLE STAMPEDE**  
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# Proposed Rules on Continuations

## Changes to 37 CFR §§ 1.78 & 1.114:

- **Limit the chain of applications to no more than three patent applications**
  - 37 CFR §§ 1.78(a)(1&2) -> 37 CFR §§ 1.78(a) and 1.78(d)
  - Addition of 37 CFR § 1.114(f)
- **Create presumption of Double Patenting**
  - Addition of 37 CFR §§ 1.78(f) and 1.114(f)

## No more than three patent applications by right 37 CFR §§ 1.78(a)(1&2) -> 37 CFR §§ 1.78(a) & 1.78(d)

- 1) **37 CFR § 1.78(a)** defines continuing, continuation and divisional applications:
  - A divisional application is a continuing application “that discloses and claims only an invention or invention that were disclosed and claimed in the prior-filed application, but were subject to a requirement of Unity of Invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C 121 and not elected for examination in the prior-filed application (i.e., no more self divisionals)
  
- 2) **37 CFR § 1.78(d)** sets criteria for filing continuation applications

## Criteria for filing continuation applications

### § 1.78(d)(1)(i) - Claim for priority OK if:

- 1) NPR claiming priority to single prior-filed application IFF:

No other application is claiming priority to the same application AND

No RCE filed in the prior-filed application

## No more than three patent applications by right (cont)

### § 1.78(d)(1)(ii) - Claim for priority OK if:

2) NPR is a divisional claiming priority to single prior-filed application IFF:

The prior-filed application was subject to Unity of Invention or Restriction Requirement AND

Claims are limited to the invention or inventions identified but not elected in that prior-filed application

## No more than three patent applications by right (cont)

### § 1.78(d)(1)(iii) Claim for priority OK if:

3) NPR is a continuation application or CIP that claims priority to a single prior-filed divisional application IFF:

No other application is claiming priority to the same divisional application AND

No RCE filed in the divisional application

## No more than three patent applications by right (cont)

### § 1.78(d)(1)(iv) - Claim for priority OK if:

- 4) NPR is a continuing application that claims priority to single prior-filed application IFF:

Accompanied by a petition AND

A *showing* to the satisfaction of the Director that the application is being “filed to obtain consideration of an amendment, argument or evidence that **could not** have been submitted during the prosecution of the prior-filed application”

## No more than one RCE

### 1) 37 CFR § 1.114(f)

- a) No more than one RCE in any application
- b) No RCE's in any continuing application other than divisional applications

Unless

RCE is accompanied by a petition AND

A showing to the satisfaction of the Director that the application is being “filed to obtain consideration of an amendment, argument or evidence that could not have been submitted during the prosecution of the prior-filed application”

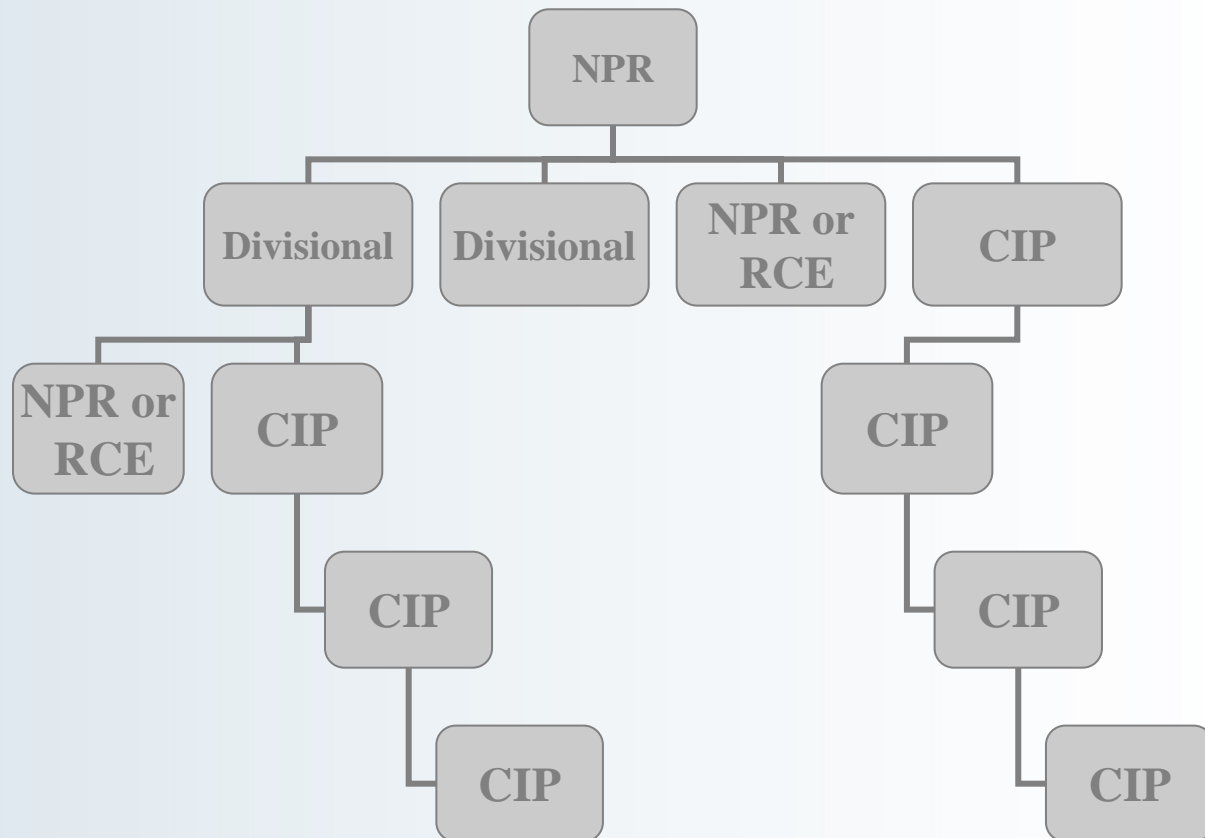


# What is an adequate showing?

Some examples from the PTO presentations:

- 1) Data to support a showing of unexpected results just became available AND the data was the result of experimentation started after the rejection was first received
- 2) The Final Rejection included a new ground of rejection AND that ground of rejection could not have been anticipated by Applicant AND the evidence to be submitted could not have been submitted earlier
- 3) An ALJ in an interference proceeding suggests that claims be filed in a continuation proceeding

# Continuation Practice



# Implications of Continuation Practice Changes

- Schedule an Examiner Interview early in the application
- Two responses and then appeal
- Never file a continuation or RCE before an appeal
- Never file a CIP

## Presumption of Double Patenting

- 37 CFR § 1.78(f) creates a rebuttable presumption of patentably indistinct claims
- 37 CFR § 1.78(h) extends the presumption to parties in a joint research agreement

## 37 CFR § 1.78(f)(1)

Must identify all applications that:

- 1) Have effective filing dates within two months of each other; AND
- 2) Name at least one inventor in common; AND
- 3) Are owned by the same person or are subject to an obligation of assignment to the same person

Must do so within four months of the actual filing date/national stage date

## 37 CFR § 1.78(f)(2)

For all applications that:

- 1) Have the same effective filing date; AND
- 2) Name at least one inventor in common; AND
- 3) Are owned by the same person or are subject to an obligation of assignment to the same person; AND
- 4) Contain substantial overlapping disclosure

There exists a rebuttable presumption that one or more claims in each application are not patentably distinct

# How to respond?

Responding to the Rebuttable Presumption of Patentably Indistinct Claims:

- 1) Explaining to the satisfaction of the Director that each application includes only claims that are patentably distinct over the claims in the other applications;

OR

- 2) Filing a terminal disclaimer AND explaining to the satisfaction of the Director why there are two or more applications that have patentably indistinct claims

# Parties to a joint research agreement

37 CFR § 1.78(h)

If parties avail themselves of 103(c)(2)(C) to overcome an obviousness rejection they must identify all applications that:

- 1) Have effective filing dates within two months of each other; AND
- 2) Name at least one inventor in common; AND
- 3) Are owned by the same person or are subject to an obligation of assignment to the same person (either party or both)

Must do so within four months of the amendment under 103(c)(2)(C)



## Implications of Presumption of Double Patenting

- File kitchen sink patent applications and let the Examiner restrict
  - Or use PCT process to guarantee requirement for unity of invention
- When you do file two or more applications with substantial overlap, never go the terminal disclaimer route

# Proposed Rules on Continuations

Thomas F. Brennan  
Shareholder, Registered Patent Attorney  
Schwegman, Lundberg, Woessner & Kluth, P.A.

(612) 373-6909  
tbrennan@slwk.com