

Monday, October 12, 2009

Intellectual Property Update: Controversial Patent Rules Amendment Package Rescinded

By Susan Stone Rosenfield

On October 8, 2009, the U.S. Patent and Trademark Office (USPTO) rescinded a controversial and largely unpopular new rules package that would have had significantly curtailed patent applicants' rights.

The rules package spawned litigation that earlier was successful in blocking implementation of the rules, which would have resulted in significant changes relating to the filing of continuing patent applications and claims in patent applications. As reported in our May 16, 2008 newsletter, the USPTO was proceeding with efforts to appeal an injunction, issued by the U.S. District Court for the Eastern District of Virginia, that had prevented the USPTO from instituting the new rules. The USPTO had appealed the District Court's decision to the U.S. Court of Appeals for the Federal Circuit in an effort to proceed with implementation of the new rules. Subsequently, the Federal Circuit court maintained the injunction as to certain portions of the rules, and reversed it as to another portion of the rules. Thereafter, the Federal Circuit court began an *en banc* (full court) review of the prior decisions, and that appeal has been pending.

However, late last week the new Director of the USPTO, David Kappos, reversed course and signed a Final Rule rescinding the rules package. In addition, it was announced that the USPTO and GlaxoSmithKline, a plaintiff in the above-mentioned litigation, will file a joint motion with the Federal Circuit requesting dismissal and vacatur of the appeal.

This decision by the USPTO to rescind the rules package is greeted with relief by a variety of stakeholders, including patent practitioners and those in a variety of industries including but not limited to biotechnology and pharmaceuticals. Critics of the rules contended that the rules were beyond the USPTO's rule making authority and not in accordance with the Patent Statute, and would have effectively precluded obtaining adequate patent protection for many types of inventions.

The now-defunct rules package was ostensibly intended to improve the efficiency and quality of the patent examination process, and to reduce the mounting backlog of unexamined applications. However, efficiency was to be gained at the patent applicants' expense. These rules would have limited applicants to filing only two continuation applications and one RCE (Request for Continued Examination) and would have limited the number of claims that an application could include without requiring the applicant to provide a so-called ESD (Examination Support Document) containing prior art for which the applicant would have been obliged to search. By virtue of the Director's recent actions, these additional burdens for the patent applicant have now been removed.

quick links

- [Intellectual Property Practice](#)
- [Unsubscribe](#)
- [Acrobat Reader](#)

Phoenix
3003 N. Central Ave.
Suite 2600
Phoenix, AZ 85012
(602) 916-5000

Tucson
One S. Church Ave.
Suite 1000
Tucson, AZ 85701
(520) 879-6800

Nogales
420 W. Mariposa Rd.
Suite 200
Nogales, AZ 85621
(520) 281-3480

Las Vegas
300 S. Fourth St.
Suite 1400
Las Vegas, NV 89101
(702) 692-8000

Denver
1700 Lincoln
Suite 2900
Denver, CO 80203
(303) 291-3200



Susan Stone Rosenfield
Of Counsel
602.916.5317
srosenfield@fclaw.com