



## **Intellectual Property Advisory:**

### **Continued Examination Filings**

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On August 21, 2007, the United States Patent and Trademark Office (USPTO) issued a long-awaited rule package affecting continued examination filings, the number of claims examined in applications, and the treatment of commonly owned applications containing patentably indistinct claims. The new rules go into effect on November 1, 2007.

#### **Continued Examination Filings**

Under the new rules, an applicant is permitted to file up to two continuing applications (continuations or continuations-in-part) of an initial application, and a single request for continued examination (RCE) in any one of the three applications. The applicant may also file divisional application(s) for any non-elected invention(s) if the USPTO issues a restriction requirement. Up to two continuing applications and a single RCE may be filed for each divisional application. Additional continuations or RCEs are permitted only upon the filing of a petition and showing that the submission could not have been presented earlier.

#### **Number of Claims**

The new rules also place restrictions on the number of claims examined in an application. An application containing more than five independent claims or twenty-five total claims requires the filing of an examination support document (ESD) before a first Office Action on the merits. An ESD essentially involves conducting and analyzing the results of a pre-examination search. For purposes of counting claims, claims in co-pending applications having patentably indistinct claim(s) are counted toward the five/twenty-five claim maximum. Applicants may submit a suggested restriction requirement (SRR) accompanied by an election in applications containing more than five independent claims or twenty-five total claims. Withdrawn or cancelled claims are not counted toward the five/twenty-five claim maximum.

#### **Commonly Owned Applications with Common Inventor(s)**

Applicants must identify commonly owned pending applications or patents that: (1) have a claimed filing or priority date within two months of the claimed filing or priority date of the application; and (2) name at least one inventor in common with the application. The applicant must also file a terminal disclaimer or explain how the applications (or application and patent) contain only patentably distinct claims if the applications also have the same claimed filing or priority date and contain substantial overlapping disclosure. The USPTO may require that all patentably indistinct claims be consolidated into a single application.

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