

## New USPTO Definition: A Potential Mine Field

*Thursday, Oct 25, 2007* --- In the new rules to take effect on November 1, 2007, the U.S. Patent and Trademark Office (“USPTO”) has set forth a new definition of the divisional application which could lead to potential misunderstandings by practitioners and dire consequences to applicants.

Under past practice, the USPTO broadly defined divisional applications in M.P.E.P. §•201.06 as later-filed applications containing claims to independent or distinct inventions, whether or not a restriction requirement was made in an earlier application.

It was widely recognized that a so-called “voluntary divisional,” which was not filed in response to a restriction requirement in a parent application, did not enjoy the benefits of the third sentence of 35 U.S.C. § 121, which shields parent and divisional applications from being applied against each other for obviousness-type double patenting in the proceedings before the USPTO or in subsequent litigation “if the divisional application is filed before the issuance of the patent on the other application.”

The definition of “divisional application” proscribed by the USPTO in new 37 CFR §•1.78(a)(2) is an application that “discloses and claims only an invention or inventions that were disclosed and claimed in a prior-filed application, but were subject to a requirement to comply with the requirement of unity of invention under PCT Rule 13 or a requirement for restriction under 35 U.S.C. § 121 in the prior-filed application, and were not elected for examination and were not examined in the prior filed application.”

The intent of the definition is to provide applicants with the opportunity to pursue a divisional application in response to a restriction requirement at any time during the pendency of the application in which the restriction requirement was issued, or defer filing of the divisional application until a later time during the pendency of the two permitted continuations pursuant to 37 CFR §•1.78(d)(3).

A potential trap exists in the USPTO’s new definition of “divisional” application in that the term “divisional” is not commensurate in scope with 35 U.S.C. § 121. Applicants may be lured into a false sense of automatic compliance with the third sentence of 35 U.S.C. §•121.

That is, the USPTO’s definition of divisional includes an application directed to a non-elected invention, which was not restricted out in the immediate parent, but was restricted out in a grandparent application.

Significantly, such divisional applications may not be afforded the protections

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of 35 U.S.C. § 121. From the clear language of the statute, if the divisional application is filed after a patent issues to the original application (e.g., based on a continuation of the application in which the restriction requirement was made), the divisional would not be entitled to the protections afforded by 35 U.S.C. § 121.

Indeed, it is acknowledged in P. J. Federico's Commentary on the New Patent Act that "if two or more divisional applications are filed as a result of a multiple requirement for restriction, they each must be filed before the original application is patented in order to obtain the benefit of this provision [35 U.S.C. § 121]."

As a consequence, the claims in the divisional application could be subject to attack on the grounds of obviousness type double patenting over one or more other patents in the family.

It would appear that the USPTO did not appreciate this distinction in establishing the new definition of a divisional application.

As such, it is possible that Examiners will be unaware of potential obviousness-type double patenting issues when examining claims in a divisional application (as newly defined).

Applicants can avoid this risk of obviousness type double patenting being asserted in the above scenarios by pursuing one of the following three options.

First, if applicants receive a restriction requirement in an application, they can simply file their divisional application(s) directly off of the application in which the restriction requirement was made and prior to the issuance of that application or a sister divisional application.

Second, if applicants wish to defer filing a divisional until they have exhausted each of their as-of-right continuations in the original application family, a potential option is to file a continuation presenting claims directed to the same group of inventions presented in the original application, along with a suggested restriction requirement (SRR) and election of the claims directed to the originally elected invention.

The applicant may thereafter file a second continuation off of this continuation and follow the same course of action as in the first continuation.

A divisional application can then be filed directly from the second (last) continuation application in the original application family. This approach is analogous to the common practice of representing multiple non-elected inventions in successive divisional applications.

However, even this practice may be subject to challenge in view of the literal language of the statute although the common practice has been generally accepted as preserving the section 121 benefits for each application in which

the restricted claims are presented.

Another downside with this approach is that applicants will be forced to front the claim fees to present the non-elected invention. To minimize the fee impact, it is suggested that the minimum number of claims be presented to initiate a restriction requirement.

Perhaps the biggest risk, albeit small, is that the Examiner may not issue a restriction requirement, in which case the inventions presented in the continuation will be examined.

This leads to the undesirable result of being subjected to the claim and continuation limits of the original application family as the applicant will not longer be able to pursue a divisional application to originally restricted invention. In this instance, the applicant may not be able to obtain the needed or desired scope of protection.

Finally, a third approach is to present the claims in a divisional application filed off of the last continuation filed, and to file a Terminal Disclaimer over each of the applications in the patent family as a safeguard against a potential attack for obviousness-type double patenting.

However, filing a Terminal Disclaimer is not always desired in that to avoid obviousness double patenting it requires each patent to remain commonly assigned.

In sum, the USPTO's new definition of "divisional" application has created a series of issues which practitioners need to consider when filing divisional applications.

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