

## **Senniger Powers' Associate Michael Vander Molen Comments on New Patent Rules**

In an effort to reduce the backlog of patent applications, the USPTO has promulgated new rules governing continuation practice and limiting the number of claims that will be examined in a patent application. Senniger Powers' Associate Michael Vander Molen provides a summary of these new USPTO rules.

Under the new rules, which become effective on November 1, 2007, an applicant is entitled as a matter of right to file two continuation applications and one request for continued examination ("RCE") in each patent family. If the applicant wishes to file any third or more continuation application or second or more RCE, the applicant must first file a petition showing that the amendment, argument, or evidence sought to be entered by way of the continuation or RCE could not have been submitted earlier. Unfortunately, the new rules fail to provide any guidance as to what circumstances would meet the "could not have been submitted" requirement.

In addition, the new USPTO rules limit each application to 5 independent claims and 25 total claims unless the applicant submits an Examination Support Document ("ESD"). If an application having more than 5 independent claims or 25 total claims does not include an ESD, the applicant must either amend the claims to meet the 5/25 requirement or submit an ESD to avoid abandonment. According to the rules, an ESD must include a preexamination search statement, a listing of references most closely related to the subject matter of each claim, an identification of claim limitations disclosed by each reference, a detailed explanation of patentability, and a showing of written description support.

In response to public comments, the USPTO chose not to adopt several previously proposed rules including a rule requiring that divisional applications must be filed during pendency of the first-filed application and a rule requiring that the applicant must elect "representative" claims.

If you would like more information about the new rules, contact Michael Vander Molen at [MVanderMolen@senniger.com](mailto:MVanderMolen@senniger.com).