

REPORT

USPTO ISSUES NOTICE REGARDING NEW PROCEDURE FOR HANDLING PRELIMINARY AMENDMENTS FILED WITH NEW U.S. PATENT APPLICATIONS

November 17, 2005

The November 8, 2005 Official Gazette of the United States Patent and Trademark Office included a Notice describing the Patent Office's new procedure for handling Preliminary Amendments filed with new U.S. patent applications. This procedure was the subject of Oliff & Berridge's September 23, 2005 Special Report. The OG Notice confirms the Patent Office's new requirement that Preliminary Amendments amending the specification (other than the claims or the Abstract) filed with a new application must be made by submitting a substitute specification. If a substitute specification is not submitted, the Patent Office will issue a Notice to File Corrected Application Papers (NTFCAP) as described in our September 23 Special Report. With respect to continuation and divisional applications filed under 35 U.S.C. §120, the Patent Office encourages Applicants to revise the specification prior to filing so as to avoid the need for a Preliminary Amendment or substitute specification when the application is filed. The OG Notice confirms that the original Declaration from the parent application can be filed with such a revised continuation or divisional application if no new matter is added to the specification.

Interestingly, the OG Notice indicates that the Patent Office should not issue a NTFCAP if the Preliminary Amendment only amends the specification to include the specific reference to a prior non-provisional or provisional application as required by 35 U.S.C. §120 or §119(e). The OG Notice states that if the Patent Office issues a NTFCAP in such a situation, Applicant can respond by either submitting a substitute specification or by arguing that the NTFCAP was issued in error because the only amendment to the specification was to include the specific reference to a prior non-provisional or provisional application. However, we continue to recommend that the specific

reference to any prior non-provisional or provisional application be included in the application as filed in order to ensure that the time limit requirements of 37 C.F.R. §1.78 are satisfied, as discussed in our September 23 Special Report.

The OG Notice also states that for purposes of determining the number of pages of a new application, the Patent Office counts the specification (including the claims and Abstract), the drawing sheets and the pages of any Preliminary Amendment that amend the application. For example, if a new application includes an 80 page specification (including the claims and Abstract) and 20 pages of drawings, and is accompanied by a Preliminary Amendment to the claims that includes 10 pages of claims, the Patent Office would consider the application to have a length of 110 pages, which would require an additional page surcharge of \$250 for pages over 100. Thus, the OG Notice strongly encourages Applicants to make revisions to an application prior to filing so that it is not necessary to file a Preliminary Amendment with the new application.

We welcome any questions that you may have regarding the OG Notice and this new Patent Office procedure.

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Oliff & Berridge, PLC is a full-service Intellectual Property law firm based in historic Alexandria, Virginia. The firm specializes in patent, copyright, trademark, and antitrust law and litigation, and represents a large and diverse group of domestic and international clients, including businesses ranging from large multinational corporations to small privately owned companies, major universities, and individual entrepreneurs.

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This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oliff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

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