

REPORT

IMPORTANT FORTHCOMING USPTO RULEMAKINGS

April 13, 2007

As you may know, the U.S. Patent and Trademark Office (USPTO) issued three major proposed rulemakings last year. They related to (1) restricting continuation and divisional application practice, (2) restricting the number of claims that will be examined without imposition of serious cost and estoppel burdens, and (3) imposing serious cost and estoppel burdens for inclusion of numerous references and/or foreign-language references in Information Disclosure Statements (IDS's) submitted in satisfaction of the U.S. duty of disclosure.

These proposed rulemakings were strongly opposed in public comments from our firm and from hundreds of other individuals, firms and organizations. The USPTO has since been studying and revising the proposed rulemakings. On various occasions, it has hinted that it was considering dropping them; on other occasions, it has indicated that it is simply revising them.

We have now learned that the USPTO has revised (1) the continuation/divisional application proposed rulemaking and (2) the claim-number proposed rulemaking, and has submitted the revised proposed rules to the U.S. Office of Management and Budget (OMB) for approval of making them final. This is generally at least a 90-day process; in view of the controversial nature of the proposed rules and the impositions of serious substantive and financial burdens in the proposed rules, it may be a substantially longer process. However, if the OMB approves the final rules, they may become effective as early as late this summer or this fall (possibly thirty days after they are published).

In addition, it is our understanding that a revision of the IDS proposed rulemaking is now with the Commissioner of the USPTO for his final approval, and may be submitted to the OMB shortly. Thus it also could be made final and become effective late this summer or this fall if it is not delayed in the OMB review process.

The details of the revisions are not yet publicly available. We will continue to monitor the situation and keep you promptly informed of further developments. Meanwhile, please do not hesitate to contact us with any questions or comments.

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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 Oloff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.

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