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**Information Memos, Articles, White Papers****Intellectual Property: Are We Screaming Yet? (10/07)**By William Greener, *Ithaca Business Journal*, October 26, 2007

Last month, my law partner Dan Malley filled this spot with an article on the new patent rules taking effect November 1. He ended the article with the words, "&call your Congressman and scream bloody murder." That is quite radical advice from a practitioner in a field as meek and mild as patent law.

But Dan has a point. If you are an inventor or you run a company that uses the government's intellectual property system, you should have heard from your patent attorney recently to keep your checkbook open -- the game suddenly just got more expensive to play (please don't kill the messenger).

When the new patent rules go into effect next month, the tens of thousands of pending US patent applications to which the USPTO has not yet responded will need to be reviewed and likely amended in order to meet the various requirements. Suddenly, your attorney's workload has doubled, making him or her cranky -- and when is the last time that you found an attorney who works for free?

If you are listening very closely, you may hear silent screams coming from many members of the patent bar. However, we must comply because, like gravity, it's not just a good idea, it's the law!

What are some of the actions an investor must or can do to maintain the value of all the hard work and expense put into a pending application?

First, I believe it would be wise to re-examine your claims in terms of subject matter and quantity. Assuming you have not received a first office action on the merits (FOAM) from the patent office, determine (with the help of your attorney) whether two or more of the independent claims could be argued to recite different inventions. Different inventions are those that require the patent examiner to do a separate search of the art in different patent classifications. If the answer is "yes", then you may want to file a suggested restriction requirement (SRR), suggesting to the examiner that the different claim groups in the pending application be "carved out" and filed in one or more divisional (DIV) applications. This is helpful because each divisional application qualifies for its own set of 25 claims, two continuations, and one request for continued examination (RCE) application. In any event, every application will be limited to 25 total claims.

Various strategies are being debated amongst patent bloggers for structuring claims in prospective applications. One school advocates filing the application with the maximum five independent claims, each being distinct enough that the examiner may issue a restriction requirement, perhaps five-ways. (It's ironic that for as long as I have been a patent lawyer, we would argue vehemently whenever the examiner restricted an application; now we're begging them to do so.)

Anyone can tell, things are only getting more complicated, will take more time, and require more effort for inventors and examiners alike. This is just the tip of the iceberg.

A popular patent blog recently posted an essay entitled, "The difficulty of obtaining a patent," written by Charles Dickens around 1850 (<http://www.patentlyo.com/patent/2007/10/the-difficulty-.html>). At the end of the essay, Dickens writes, "No man in England could get a Patent for an Indian-rubber band, or an iron hoop, without feeing all of them [some dozen or more administrative levels each requiring a fee in order to move through the process]. Some of them, over and over again. I went through thirty-five stages. I began with the Queen upon the Throne. I ended with the Deputy Chaff-wax. Note. I should like to see the Deputy Chaff-wax. Is it a man, or what is it?" Will the legacy of English law be our ever guiding light?

[Bill Greener is a registered patent attorney and partner in the firm of Bond Schoeneck & King, PLLC ([www.BSK.com](http://www.BSK.com)). BS&K's Ithaca office is in the Cornell Business & Technology Park at 10 Brown Rd., Suite 201. 607-330-4012 [wgreener@bsk.com](mailto:wgreener@bsk.com).]

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