

Changes to USPTO Rules on Number of Claims Examined

August 2007

CHANGES TO RULES TAKE EFFECT ON NOVEMBER 1, 2007 AND AFFECT ANY APPLICATION THAT HAS NOT HAD A FIRST OFFICE ACTION BEFORE NOVEMBER 1, 2007

On August 21, 2007, the United States Patent and Trademark Office (USPTO) published changes to the USPTO's rules of patent examination practice. The new rules affect the filing of continuation and continuation-in-part (CIP) applications, requests for continued examination (RCEs), and the **number of claims** that will be examined.

Since the rules relating to the number of claims that will be examined apply to any existing application that has not received a First Office Action before November 1, 2007, this update will describe only the new rules relating to the number of claims that would be examined. In a subsequent document we will consider the rules related to continuation and CIP applications.

Under the new rules, an applicant may present, without an Examination Support

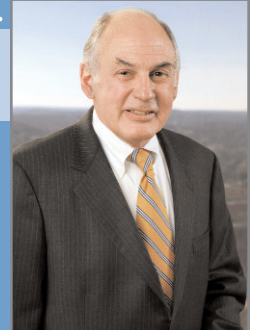
Document (ESD), up to five independent claims or 25 total claims in an application. In order to file more than five independent claims or 25 total claims, an ESD must be filed before the First Office Action. For applications that are currently pending at the USPTO and have more than five independent claims or more than 25 total claims, there is the option of either filing a Suggested Restriction Requirement (SRR), amending the claims to bring them within the limits or filing an ESD.

For applications that are presently at the USPTO, have not received a First Office Action and have more than five independent claims or 25 total claims, the USPTO may send a notice requiring an ESD or an amendment. After such notice a Suggested Restriction Requirement cannot be filed.

An ESD must include a preexamination search statement, a listing of references considered most closely related to the subject matter of each claim, identification of the claim limitations disclosed by each reference, a detailed explanation of patentability, and a showing of support for the claim in the

ORLANDO
LOPEZ

is a Partner in
the Firm's
Intellectual
Property /
SciTech Group



specification. For a number of reasons, we suggest avoiding, if possible, the filing of an ESD. However, if it is necessary to file an ESD, we have developed methodologies for doing so efficiently.

If you have questions related to an existing patent application, please contact your patent attorney at Burns & Levinson LLP. If you desire additional information on the proposed rules or any other related information, please contact Dr. Orlando Lopez, Esq. at Burns & Levinson LLP.

Burns & Levinson's Intellectual Property / SciTech Group works in partnership with its clients in developing, protecting, enforcing and commercially exploiting intellectual property rights across a broad spectrum of industries and markets. Our experienced team of professionals assists emerging and established companies, as well as individuals, with their complete intellectual property needs. For questions regarding this IP Update, please contact **Orlando Lopez** at 617.345.3243 / olopez@burnslev.com.

If you would like to be added to or removed from the mailing list for B&L Intellectual Property Updates or other Burns & Levinson publications, please send your name, email address and notice to clientservices@burnslev.com or call Judy Crowley at 617.345.3632.