

New PTO Rules Create Nov. 1 Requirement

Tuesday, Oct 09, 2007 --- On September 26, the United States Patent and Trademark Office (USPTO) updated its Frequently Asked Questions concerning new USPTO Rule 78(d)(1), (72 Fed. Reg. 46716, August 21, 2007). The practical effect of this explanation is that by November 1, 2007, all divisionals must be filed for any invention that was restricted in the United States, but that was examined under Chapter II in an earlier filed PCT application that designates the United States.

This includes PCT applications in series or in parallel with the U.S. application. That is, PCT applications that are in the benefit chain of the U.S. application and PCT applications (that designate the United States) that are filed separately and parallel to it.

You must file all such divisional applications before November 1, because, as explained by the USPTO, on and after November 1, applications that contain claims that were examined in an earlier filed PCT application under Chapter II will not be able to satisfy the requirements for a divisional application. This explanation was posted by USPTO with little over a month's notice before the rules take effect.

The specific Frequently Asked Questions of interest are C11 and C8. In C11, the USPTO explains:

"[I]f applicant filed a Demand and paid the additional examination fees and all of the inventions were examined in the international application, applicant may not file a divisional application. This is because under PCT Article 31, 'examination' in the international phase is contingent upon the filing of a Demand for international preliminary examination. The non-elected invention would be examined within the meaning of 37 CFR 1.78(d)(1)(ii) in the international application designating the U.S."

Without even looking at the effect this interpretation has on your future use of PCT Chapter II, look at what effect it has retroactively on Chapter II examinations that were had years ago – examinations in any examining authority that clearly do not detract from current U.S. examiner time.

For example, an applicant had a PCT Chapter II examination at the EPO of all 27 claims in the year 2000. The applicant then entered the U.S.

The U.S. examiner split the claim set into seven groups. Group I was elected. Later that application was abandoned in favor of a continuation application that is currently pending.

On September 27, out comes the above FAQ that says Chapter II examination is “examination” and that it destroys your ability to file claims that were examined under PCT Chapter II in a divisional even if they were restricted in the U.S. Have a nice day.

So – what option does the applicant have for that awful sin of filing a Chapter II Demand and having paid additional money to have the EPO examining authority examine its 27 claims - seven years ago? The only option is, that by November 1, to file ALL divisionals, in separate applications, because not to file them is to risk losing the right to file them.

That should help the backlog, no?

Seven years ago, in a land far, far away, a European Patent Office examiner put on his PCT examiner hat and “examined” the applicant’s claims under international standards of novelty, inventive step and industrial utility. U.S. obviousness, U.S. written description and U.S. enablement were not evaluated. But, now, that international examination is what the USPTO calls an examination for U.S. purposes.

Doesn’t anyone else find this interpretation by the USPTO outrageous? This is a mess! The U.S. examiner restricted the claims. The applicant had no choice. The applicant should be allowed to file a divisional application before, on, and after November 1, 2007.

Not only is the retroactive nature not justified (the examination has already been done by the examiner) but also are applicants really supposed to get every such divisional approved and on file with only about a month’s notice? How can that be? And if the USPTO's intent was always to capture PCT Chapter II examination in the net of "examination," - then why was this not clearly started earlier?

That's not even to mention that current Chapter II examination is a pale shade of its original self - with computer generated International Preliminary Examination Reports coming from at least some of the examining authorities that simply refer to the International Search Report. It's not clear how such reports significantly detract from examiner time.

Action is needed - now - to stop these rules. October 31 is just too late.

--By of Sterne, Kessler, Goldstein & Fox PLLC

Michele A. Cimbala, Ph.D., Esq. is a director at Sterne, Kessler, Goldstein & Fox PLLC. This article reflects the present thoughts of the author, and should not be attributed to Sterne, Kessler, Goldstein & Fox P.L.L.C. or any of its former, current, or future clients. The content is for purposes of discussion and should not be considered legal advice.