New Patent Rules and Continuation-in-Part Applications
Identification Requirements and Compliance Consequences

NEW PATENT RULES AND CONTINUATION-IN-PART APPLICATIONS
On Nov. 1, 2007, the U.S. Patent and Trademark Office (“Patent Office”) will implement new rules that impose a duty on the Applicant to identify claims in a Continuation-in-Part (CIP) application that are entitled to the filing date of an earlier-filed application. The following discusses this identification requirement, the consequences of failing to make the identification and related practice considerations.

CIP APPLICATIONS
Under the new patent rules, a CIP is an application that claims the benefit of the filing date of a prior-filed application and discloses new subject matter that was not disclosed in the prior-filed application. Generally, new matter in a CIP application includes a more detailed description of previously disclosed subject matter, additional data to support the invention or improvements to the invention, such as particular conditions, additional steps in a method or structures. The new matter added can, but may not always, provide support for claims that were not supported in the prior-filed application.

In the United States, the term of a patent is 20 years from the filing date of the application. The term of any patent that issues from a CIP application is 20 years from date of filing of the earliest prior application, and not the later “actual” filing date of the CIP application.

IDENTIFICATION REQUIREMENT AND CONSEQUENCE OF FAILURE TO COMPLY
The new patent rules require an Applicant to identify each claim in a CIP application that is supported by and, thus, entitled to the benefit of the filing date of a prior filed application. If the Applicant does not make the required identification, all claims of the CIP application will be treated as only being entitled to the later actual filing date of the CIP. Thus, all claims will be subject to a possible prior art rejection based on the filing date of the CIP application.

If the Applicant has not identified the claims entitled to the filing date of an earlier filed application before a first Office action on the merits, the Applicant can respond to the Office action with identification of the claims. However, if this late identification causes the examiner to conduct an additional prior art search, the second or subsequent Office action can now be made a Final action, despite the citation of new prior art.

Under the new patent rules, Applicants will likely want to avoid, to the extent possible, actions that prompt Final Office actions. Applicants will now be limited, without a petition and showing, to two continuation or CIP applications and one Request for Continued Examination (RCE) in each family of applications. Thus, any application in which an Office action has been prematurely made Final may require filing of a continuation application that could have otherwise been avoided.
ACTIONS TO BE TAKEN AND CONSIDERATIONS

CIP APPLICATIONS FILED BEFORE NOV. 1, 2007
If a CIP application was filed before Nov. 1, 2007, the effective date of the new patent rules, and a first Office action on the merits has not been mailed from the Patent Office by that date, claims that are supported by the prior-filed application must be identified by Feb. 1, 2008. However, if a first Office action on the merits has been mailed before Nov. 1, 2007, an Applicant need not identify claims in a CIP application that are supported by the earlier filed application.

On the other hand, if claims of a CIP application are not actually entitled to the filing date of the prior-filed application and only the later actual filing date of the CIP application, the Applicant need not take any action. In that case, the Patent Office will accord the claims of the CIP application the later actual filing date of the CIP application.

CIP APPLICATIONS FILED ON OR AFTER NOV. 1, 2007
For CIP applications filed on or after Nov. 1, 2007, the Patent Office encourages Applicants to comply with the identification requirement before an examiner conducts a prior art search of the invention, which is generally before a first Office action on the merits.

Similar to applications filed before Nov. 1, 2007, if claims of the CIP application are not entitled to the filing date of the prior-filed application, the Patent Office will accord the claims the actual filing date of the CIP application, and the Applicant need not take any action.

GENERAL CONSIDERATIONS
Patentable subject matter that has not been disclosed in other prior-filed applications should be pursued in a new patent application, rather than in a CIP application. This is particularly true for applications that are owned by, or subject to an obligation of assignment to, the same entity. The filing of a new application will provide the Applicant with a longer patent term—calculated from the filing date of the new application—as opposed to the filing date of an earlier filed application in the case of a CIP application.

Because of the new limitations on the number of continuation and CIP applications in the same family under the new patent rules, it is expected that the prior practice of filing a CIP application claiming priority to several prior-filed applications will be curtailed.

Additional data to support subject matter that is disclosed in a prior-filed application can be pursued, if necessary, by other means, such as by conducting interviews with examiners or submitting written declarations, rather than by filing a CIP application. Moreover, filing a new application, rather than a CIP application, directed to, for example, an improvement of a previously filed application, will provide the Applicant with more options for continued prosecution in the future.

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