

PTO appeals the ban on its rules package; uncertainty reigns

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On May 7, 2008, the PTO appealed to the Federal Circuit the ruling by a federal district court last month striking down the PTO's proposed rules to streamline patent prosecution. The PTO rules, which had been slated to go into effect on November 1, 2007, would dramatically modify patent continuation practice and restriction rules. The rules would make it more difficult and expensive to protect inventions, particularly inventions that today that are the subject of multiple applications and multiple patents. (We previously reported on the proposed rules and of the court decision setting the rules aside.)

The PTO's appeal preserves the possibility that, should the PTO win, the new rules would be implemented. Yet the normal pace of the Federal Circuit would preclude a decision on the appeal from being handed down until after a new administration is in office and, most likely, a new Director of the PTO (who is appointed by the President). The new Director may have different priorities.

For now, prudence suggests adhering to our previous suggestions: avoid unnecessary continuations and Requests for Continued Examination (RCEs), but if needed, use them as early as possible; where possible, use focused applications; and use patent searches early to learn the prior art. Meanwhile, regardless of the outcome of the appeal, the odds that the new rules will be actually implemented in their present form have diminished with the passage of time and the prospects of a new Director of the PTO. ✨