

Patent and Trademark Office Rule Changes

A Presentation to the
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Legal Disclaimer

- The legal information contained in this presentation is offered for patent law educational purposes.
- It is suggested that a patent attorney be consulted if you want professional assurance that any actions taken as a result of this presentation are appropriate for your particular situation.
- The patent law changes frequently. Before relying upon any information contained in this presentation, you may want to consult with a patent attorney regarding the current state of the law.

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2006 PTO Changes

- Electronic filing
 - Reduced filing fee (\$75 off \$500 fee)
- Accelerated examination
 - New rules do not apply for reasons of inventor health or age
 - Requires concessions by inventor

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Proposed Changes

- First to File
- Examination of Claims
- Reduce Continuation Applications
- Information Disclosure Statements
- Eliminate Disclosure Document Program
 - Only provides evidence of invention conception
 - Similar to mailing a self-addressed invention disclosure

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Why ?

- PTO is moving the burden to inventors
- Reduces workload for PTO Examiners
- More onerous to small inventors

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First to File

- Dead in the water
- May be revived in the future

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Examination of Claims

- Application examination will be limited to
 - Independent claims and
 - Dependent claims specified by inventor
- Application initial examination will be limited to a **maximum of 10 claims**
 - Additional claims can be examined if an examination support document is submitted after a pre-examination search
- Likely result will be that it will be more expensive and more difficult to obtain a patent

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Continuation applications

- One continuation can be filed by right
 - Continuation or Continuation-in-Part
 - Does not include Divisional Applications
- The second continuation requires submitting justification to the PTO why the second is necessary
- Likely result is to make it more difficult to obtain patents on improvements to inventions

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Information Disclosure Statements

- If a search is performed or prior art is known, relevant and material art must be submitted to PTO (Same as current rule)
- Explanation of why the prior art is relevant is required if
 - A document has more than 25 pages or
 - More than 20 prior art references are reported then explanation is needed for all references