



## **IP LAW ADVISORY**

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### **Court Says “No Deal” to PTO Rule Changes**

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We can all breathe a little easier now, at least for a little while, when it comes to the additional obstacles to patent protection, in the form of the much-discussed “new rules,” that the U.S. Patent and Trademark Office wanted to impose on all patent applicants. The U.S. District Court for the Eastern District of Virginia has ruled in *Tafas v. Dudas* that the Office overstepped its authority in drafting and promulgating the rules that were to become effective on November 1, 2007. The Court further has permanently enjoined the Office from implementing the proposed rules.

The proposed rules would have affected such matters as how many claims, continuation applications and requests for continued examination an applicant can file for a particular invention. The rules also would have required patent applicants to conform all pending applications to the proposed standards. The intent of the Office was to reduce the examination workload that is currently causing problems with respect to the length of pendency of patent cases and with respect to the quality of work produced by the Office. While the intent of the Office may have been justifiable, the Court ruled that the manner in which the Office attempted to implement that goal was not. The Court found that the

proposed rules changed existing law and altered the rights of applicants and therefore went beyond the rule-making authority of the Office.

Although this set of rules has been struck down, we can expect the Office to take further actions to alleviate their obvious workload-related problems. The Office might try to have an appellate court reverse today’s ruling. Additionally, the Office has other rules in the pipeline and Congress has additional patent reform legislation pending that may affect us all in the near future. We could, for example, see a return to an Office requirement (from many years ago) to provide Examiners with detailed discussions of the prior art submitted by applicants – possibly coupled with a limitation on the number of prior art references that can be submitted. The other rules and the additional patent reform legislation present complex issues that we will address if the Office or Congress decides to enact them. Of course, new Office proposals may also fall outside the scope of authority of the Office similarly to the rules considered by *Tafas v. Dudas*. Accordingly, take a few relaxing breaths for now and rest assured that we will keep you informed of further developments as they occur.

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