



Intellectual Property Advisory: District Court Set to Make Final Ruling on Patent Continuation Rules

By Paul M. Rivard

On October 31, 2007, the U.S. District Court for the Eastern District of Virginia issued a preliminary injunction preventing the U.S. Patent and Trademark (USPTO) from implementing its controversial rule package set to go into effect on November 1, 2007. The rules package would place severe restrictions on continued examination filings and the number of claims examined in applications. On February 8, 2008, before a packed Alexandria, Virginia courtroom that included members of the patent bar and USPTO officials, the court heard arguments from GlaxoSmithKline (GSK), Tafas, and the USPTO on summary judgment motions. Although a ruling was not made from the bench, Judge Cacheris expressed the case likely will be disposed of on summary judgment. GSK urged that the rules are substantive, not procedural, and that the rules package should be stricken because the USPTO has no substantive rulemaking authority. Tafas pointed to deficiencies in the rulemaking process and the USPTO's lack of expertise in economics. The USPTO argued that the rules are procedural, comparing the filing of multiple continuing applications to filing multiple requests for reconsideration before a tribunal, and arguing that patent applications do not confer property rights. Judge Cacheris indicated he will issue his ruling shortly, schedule permitting.

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