

Re: New USPTO Rules Limit Claims and Continuation Applications

Dear Friends and Clients:

The USPTO has issued major changes in its rules for prosecution and management of patent applications in the U.S. These rules apply to both those applications originating here in the U.S. and those entering the U.S. National Phase. While the rules substantially take effect on November 1, 2007; the changes impact all applications that have not yet received an Office Action. It is the USPTO's position that issuing this notice gives applicants sufficient time to either amend the application to meet the 25 maximum claim limit, prepare an examination support document or a suggested restriction requirement, or otherwise respond. In summary, this office expects that the workload (and costs) for U.S. filings will increase for non-provisional patent applications having more than 25 claims.

As will be noted in Part II of the attached summary, U.S. applications will also be limited in the number of continuation, divisional, continuation-in-part, or RCE applications, as well as in the practices following final action disagreement with examiners. This limitation is additionally burdensome because it applies to the "application family". It is apparent that the efforts by the USPTO to improve quality have enhanced the burden for great many clients, particularly those within the chemical, biological, electronic and business method fields.

In regards to Section III in the attached summary, there is a substantially enhanced burden upon

those applicants having multiple related applications. It is essential to assess the filing dates and the substance of any overlapping disclosures within recently filed applications or those including the same inventor in many areas for these new rules.

Please review the enclosed summary. The entire set of new rules is available through our office or on the USPTO website (www.uspto.gov). We look forward to any thoughts or concerns you may have regarding the new rules and look forward to hearing from you.

Very truly yours,
Lackebach Siegel, LLP
Andrew F. Young

Lackebach Siegel LLP

Lackebach Siegel Building

One Chase Road

Scarsdale, NY 10583

(914) 723-4300

Fax: (914) 723-4301

E-Mail: mail@Lackebach.com

www.Lackebach.com