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Patent and Trademark Office/Rules

PTO Will Rescind Claiming and Continuations Rules Package

The Patent and Trademark Office announced October 8, 2009, that it will rescind the claiming and continuations rules package that have been the subject of litigation in *Tafas v. Kappos*. The parties to that litigation have agreed to request the Federal Circuit to dismiss the appeal in that case and to vacate the district court decision below.

“AIPLA applauds the decision of Director Kappos to rescind this hugely unpopular rules package,” stated AIPLA’s Executive Director Todd Dickinson. “And we certainly hope the courts will act quickly and favorably on this motion. We view this as a significant step by Director Kappos towards rebuilding the relationship between the USPTO and the user community. Hopefully, we can now continue to move forward and work with the Director in a constructive way to address the challenges facing the USPTO.”

The rules, which imposed extensive limits on the way that applicants could claim inventions and file continuation applications, were declared void by a district court as substantive rules that exceeded the PTO’s rulemaking authority. On appeal, that decision was reversed by a Federal Circuit panel as to the claiming and RCE provisions, but it was affirmed as to the continuations rules, which were held to be inconsistent with the Section 120 of the Patent Act.

The Federal Circuit subsequently took the case for en banc review and vacated the panel decision. In a July 28 order, the Federal Circuit granted a 60-day stay in the en banc proceedings to give the new Administration an opportunity to reevaluate the government’s position. Subsequently, in an August 24 order, the court declared that the briefing would resume 60 days from the date of that order.

The rescission of the rules will be effective as of the publication of the decision in the Federal Register, expected early next week.

To view the PTO press release, [click here](#).