PTO Rule Changes Still Up in the Air; Federal Circuit Approves Most but Remands for Further Consideration

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On March 20, 2009, the Federal Circuit issued its decision in*Tafas v. Doll*, an appeal by the PTO from the Eastern District of Virginia's decision to enjoin the PTO from implementing the Claims and Continuation Final Rules. The opinion can be found here: Tafas v Doll.pdf . The Claims and Continuation Final Rules limit the number of requests for continued examination (Final Rule 114), require submission of a new "examination support document" when filing a certain number of claims (Final Rules 75 and 265), and limit the number of continuation applications that can be filed (Final Rule 78). With Judge Prost writing for the majority, the Court upheld Final Rules 75, 114 and 265, finding them to be procedural rather than substantive, and therefore within the rulemaking authority of the PTO. The Court struck down Rule 78, however, as inconsistent with 35 USC § 120, which states that any continuation or continuation-in-part application "shall" be granted priority to the patent application upon satisfaction of certain requirements.

Judge Bryson wrote a concurrence in striking down Rule 78, which left open the possibility that it could be redrafted in a way that would save it, and Judge Rader dissented with respect to Final Rules 75, 114, and 265, concluding that all of them were substantive and therefore beyond the PTO's rulemaking authority. The Court ultimately remanded the case to the Eastern District of Virginia to address: "whether any of the Final Rules, either on their face or as applied in any specific circumstances, are arbitrary and capricious; whether any of the Final Rules conflict with the Patent Act in ways not specifically addressed in this opinion; whether all USPTO rulemaking is subject to notice and comment rulemaking under 5 U.S.C. § 553; whether any of the Final Rules are impermissibly vague; and whether the Final Rules are impermissibly retroactive."

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