



AMSTER, ROTHSTEIN & EBENSTEIN PATENT LAW ALERT

TAFAS V. DOLL ROUND IV: DOWN FOR THE COUNT

By Charles R. Macedo and Marion P. Metelski *

On Thursday, October 8, 2009, the USPTO announced that it was rescinding its controversial Final Rule regarding claim examination and continuation applications (“the Final Rule,” see Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, 72 Fed. Reg. 46,716 (Aug. 21, 2007).

The Final Rule, which was originally due to be implemented on November 1, 2007, sought to change Patent Practice before the USPTO in three dramatic ways:

1. limiting an applicant to filing only two continuation applications as a matter of right;
2. limiting an applicant to filing one Request for Continued Examination (“RCE”) as a matter of right; and
3. limiting an applicant to five independent claims and twenty-five total claims as a matter of right.

For a detailed discussion of that Final Rule, see Charles R. Macedo and Marion P. Metelski, “New PTO Rules On Continuing Applications and Claim Examination Practice: Learning to Count to 2 (+1 RCE) and 5/25”, NYIPLA Bulletin, Sept./Oct. 2007 (available at <http://www.arelaw.com/articles/articles.html>).

Shortly after being published in August 2007, the Final Rule was challenged in the District Court, and enjoined. See *Tafas v. Dudas*, 511 F. Supp. 2d 652 (E.D. Va. Oct. 31, 2007) (“*Tafas I*”). Ultimately, the District Court found that the Final Rules were “substantive rules that change existing law and alter the rights of applicants such as [Appellees] under the Patent Act.” *Tafas v. Dudas*, 541 F. Supp. 2d 805, 814 (E.D. Va. 2008) (“*Tafas II*”). For a detailed discussion of the *Tafas II* decision, see Charles R. Macedo and Marion P. Metelski, “*Tafas* Verdict Is A Setback For Patent Office”, *IP Law360*, April 9, 2008 (available at <http://www.arelaw.com/articles/articles.html>).

Earlier this year, in March 2009, the U.S. Court of Appeals for the Federal Circuit (“the Federal Circuit”), in a three-way split panel, affirmed the District Court’s grant of summary judgment invalidating one of the four Final Rules in question, reversed the grant of summary judgment for the other three Final Rules, and remanded the case to answer a series of specifically delineated questions left open by the Federal Circuit. For a detailed discussion of the *Tafas III* decision, see Charles R. Macedo and Marion P. Metelski, “*Tafas v. Doll* — Round II: 1 Down, 3 To Go”, *IP Law360*, March 23, 2009 (available at <http://www.arelaw.com/articles/articles.html>).

In July 2009, the Federal Circuit agreed to rehear the case en banc. However, in light of today’s decision by the USPTO to rescind these rules, that case will probably never be heard. The USPTO announced that it will be filing a joint motion with plaintiff GlaxoSmithKline in the related *Tafas v. Dudas* litigation to dismiss the pending appeal in the Federal Circuit and to vacate the decision of the U.S. District Court for the Eastern District of Virginia.

This announcement will hopefully put an end to these controversial rules.

Please feel free to contact us to learn more about this development and its impact on U.S. Patent Law.

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