



AMSTER, ROTHSTEIN & EBENSTEIN PATENT LAW ALERT

REHEARING EN BANC GRANTED IN *TAFAS v. DOLL*

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(July 8, 2009) On July 6, 2009, the U.S. Court of Appeals for the Federal Circuit (“the Federal Circuit”) granted a combined petition by the Plaintiff-Appellees for a panel rehearing and rehearing en banc of the Federal Circuit’s March 20, 2009 opinion, *Tafas v. Doll*, 559 F.3d 1345 (Fed. Cir. 2009) (“*Tafas III*”), which ruled on whether four rules promulgated by U.S. Patent and Trademark Office (“USPTO”) relating to patent claims and continuation practice (“the Final Rules,” 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)) exceeded the scope of the USPTO’s rulemaking authority. For a detailed discussion of the Final Rules, 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>).

In finding that the appeal was appropriate for en banc rehearing, the Federal Circuit vacated the *Tafas III* decision in which the Federal Circuit, in a three-way split panel which issued three separate opinions, had affirmed the district court’s grant of summary judgment invalidating one of the USPTO’s Final Rules and reversed the grant of summary judgment for the other three Final Rules. For a detailed discussion of the *Tafas III* decision, see Charles R. Macedo and Marion P. Metelski, *Tafas v. Doll — Round II: One Down, Three To Go*, IP Law360, March 24, 2009 (available at <http://www.arelaw.com/articles/articles.html>).

Leading up to the appeal, the Final Rules were initially challenged in the District Court for the Eastern District of Virginia, and enjoined. See *Tafas v. Dudas*, 511 F. Supp. 2d 652 (E.D. Va. 2007) (“*Tafas I*”). Ultimately, the district court found that the Final Rules were “substantive rules that change[d] existing law and alter[ed] the rights of applicants such as [Appellees] under the Patent Act,” and granted summary judgment that the four rules exceed the scope of the USPTO’s rulemaking authority. *Tafas v. Dudas*, 541 F. Supp. 2d 805, 814, 817 (E.D. Va. 2008) (“*Tafas II*”). The USPTO thereafter appealed, leading to the Federal Circuit’s decision in *Tafas III*. For a detailed discussion of the *Tafas II* decision, see Charles R. Macedo, *Tafas Verdict Is A Setback For Patent Office*, IP Law360, April 9, 2008 (available at <http://www.arelaw.com/articles/articles.html>).

The Federal Circuit will hear the appeal en banc on the basis of the briefs already on file, as well as on additional briefs from the parties discussing the issues addressed in the panel opinions. The Appellants’ additional brief is due on August 5, 2009. The Appellees’ briefs are due twenty days thereafter, on August 25, 2009, followed by the Appellants’ reply which is due on September 1, 2009.

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

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