

# ADVISORY

## SULLIVAN & WORCESTER LLP INTELLECTUAL PROPERTY ADVISORY

### Federal Circuit Vacates *Tafas* Panel Ruling

On July 6, the U.S. Court of Appeals for the Federal Circuit agreed to rehear the *Tafas* case and vacated a three-judge panel decision that authorized the U.S. Patent & Trademark Office (USPTO) to set its own rules for limiting the number of patent continuation applications and the number of claims filed in each application. The proposed rules would have required the applicant to file no more than five independent claims and 25 total claims overall (or require a supplemental "examination support document" containing information about prior art and why applicants believe their claims are patentable over it).

At the lower court, the U.S. District Court for the Eastern District of Virginia, enjoined the rules promulgated by the USPTO in 2007. Thereafter, in March of 2008, a split panel of the Federal Circuit vacated that decision by finding the USPTO did have the authority to impose non-substantive or "procedural" rulemaking. Now, the Federal Circuit will hear the issues *en banc* and determine the extent of the USPTO's rulemaking authority. Briefs are due within 30 days from the filing of the July 6 order, while oral argument will be held at a later date. The *per curiam* rehearing order was issued by 11 of the 12 Federal Circuit judges.

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