



Kelley Drye Wins Motion for Summary Judgment in *Tafas v. USPTO and Dudas*

April 1, 2008

Court Voids USPTO New Rules which Limit Continuations and Patent Claims

In a major, legal victory in an action brought by plaintiffs, independent inventor Dr. Triantafyllos Tafas and Glaxo Smithkline Beecham (GSK), the U.S. District Court for the Eastern District of Virginia on April 1, 2008 ruled that the U.S. Patent and Trademark Office (USPTO) new claims and continuations rules are invalid.

Kelley Drye represented Dr. Tafas in obtaining this ruling that will have far reaching positive implications in promoting innovation and advances in sciences and technology for all technology companies, whether large or small.

The patent office, in an effort to deal with a backlog attributable mainly due to business method and software patent applications, had enacted highly controversial new practice rules that would have imposed numerous arbitrary numerical limitations on the number of continuations and claims per patent application.

However, after extensive briefing and oral argument, Judge James C. Cacheris granted Tafas' and GSK's motions for summary judgment finding the USPTO's proposed limitations were an improper extension of its authority.

The court held, "Because the USPTO's rulemaking authority under 35 U.S.C. section 2(b)(2) does not extend to substantive rules, and because the Final Rules are substantive in nature, the Court finds the Final Rules are void as 'otherwise not in accordance with law' and 'in excess of statutory jurisdiction and authority.' 5. U.S.C. section 706(2)."

Dr. Tafas filed the first lawsuit seeking to invalidate and enjoin the new rules on August 23, 2007, one day after the new rules were published. Tafas claimed that the USPTO's new rules exceeded the USPTO's rule-making authority, were overly burdensome and crippled the ability of the small inventor and small emerging companies to effectively pursue patent rights and protections. In mid-October, GSK filed a similar action, which was subsequently consolidated into Tafas' case.

Kelley Drye partner William R. Golden Jr. represented Triantafyllos Tafas in this matter.