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U.S. PTO RULE CHANGES IN CLAIMS PRACTICE¹
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The USPTO has instituted rule changes pertaining to the examination of claims. The new rules were published on August 21, 2007, and have an effective date of November 1, 2007. A summary of the new rules is shown below.

1. **The new rules apply to which applications?**
 - A. Applications filed on or after November 1, 2007.
 - B. Applications entering the national stage on or after November 1, 2007.
 - C. Applications in which a First Office Action on the Merits (FAOM) was not mailed before November 1, 2007.
2. **What is the new 5/25 claim threshold?**
 - A. Applicant may present up to five (5) independent claims or twenty-five (25) total claims in an application, without an Examination Support Document (ESD). This is the 5/25 claim threshold.
 - B. Applicant may present more than 5 independent claims or more than 25 total claims, if the applicant files an ESD before the FAOM.
 - C. The 5/25 claim threshold does not count or include withdrawn claims.
 - D. The 5/25 claim threshold does count all of the claims present in other copending applications having a patentably indistinct claim, but not the claims in issued patents.
3. **What happens when an application has more than 5 independent claims or more than 25 total claims?**
 - A. The USPTO will issue a Notification to an applicant, if all of the following occur:
 - (i) application has more than 5 independent claims or more than 25 total claims;
 - (ii) no ESD was filed;
 - (iii) no Suggested Requirement for Restriction (SRR) was accepted; and
 - (iv) no FAOM was issued.
 - B. In response to such a Notification, the applicant will have two months to either file an ESD or amend the application to contain no more than 5/25 claims.
4. **What is a Suggested Requirement for Restriction (SRR)?**
 - A. The Suggested Requirement for Restriction (SRR) is a document the applicant can file in the USPTO in order to request a Restriction Requirement.
 - B. If application contains claims to more than one invention, the applicant may file the SRR. The SRR must include an election of an invention to no more than 5/25 claims, and also must be filed before the earlier of the FAOM and a Restriction Requirement.
5. **What is an Examination Support Document (ESD)?**
 - A. If the applicant files an Examination Support Document (ESD), the applicant may be permitted to present more than 5 independent claims or more than 25 total claims.
 - B. An ESD must include:
 - (i) a preexamination search statement;
 - (ii) a listing of references deemed most closely related to the subject matter of each claim;
 - (iii) an identification of claim limitations disclosed by each reference;
 - (iv) a detailed explanation of patentability of the claims; and
 - (v) a showing of support under the first paragraph of 35 USC 112.

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