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The Continuing Saga of *Tafas v. Kappos*

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In its latest action in the *Tafas v. Kappos* appeal, the United States Court of Appeals for the Federal Circuit dealt independent inventor, Triantafyllos Tafas, a further victory in the ongoing saga relating to the USPTO's controversial rules package that was scheduled to become effective on November 1, 2007.

Those rules, had they become effective, would have limited the number of continuation applications and the number of requests for continued examination in an application family and would have, under certain conditions, burdened patent applicants with a requirement to conduct a patentability search and to submit to the USPTO an analysis of the prior art. On October 31, 2007, the United States District Court for the Eastern District of Virginia issued a preliminary injunction, which enjoined the USPTO from implementing the rules package. On April 1, 2008, the District Court declared the rules package null and void as not in accordance with law and in excess of statutory jurisdiction and authority. On appeal from the District Court's April 1, 2008 decision,

the Federal Circuit, on March 20, 2009, affirmed in part, vacated in part, and remanded the case back to the District Court.

The USPTO officially rescinded the rules package on October 14, 2009, effectively rendering moot a majority of the substantive issues involved. In light of this rescission, the USPTO, along with SmithKline Beecham Corp, SmithKline Beecham PLC, and Glaxo Group Limited, additional parties to the litigation, jointly moved the Federal Circuit for dismissal of the appeal and to vacate the judgment of the District Court. While Tafas joined in the motion for dismissal of the appeal, Tafas opposed the motion for *vacatur*. On November 13, 2009, the Federal Circuit granted the motion for dismissal of the appeal but denied the motion to vacate the District Court's judgment.

The Federal Circuit's denial of the motion to vacate the District Court's judgment preserves Tafas's right, under the Equal Access to Justice Act, to seek from the government an award fees and other expenses, including attorney fees.