



## **MBHB snippets<sup>®</sup> ALERT: *Tafas v. Doll***

In a [55-page opinion](#) issued earlier today, the Federal Circuit determined that the four rules at issue in *Tafas v. Dudas* are procedural, but that Rule 78 is inconsistent with 35 U.S.C. § 120 (*i.e.*, that portion of the rule which limits the number of continuation applications), and therefore, affirmed-in-part, vacated-in-part, and remanded. Judge Prost authored the opinion for the panel, with Judge Bryson filing a concurring opinion and Judge Rader filing an opinion concurring in part and dissenting in part. Judge Prost concluded that:

[T]he Final Rules 75, 78, 114, and 265 are procedural rules that are within the scope of the USPTO's rulemaking authority. However, we find that Final Rule 78 conflicts with 35 U.S.C. § 120 and is thus invalid. Accordingly, we affirm the district court's grant of summary judgment that Final Rule 78 is invalid, vacate its grant of summary judgment with respect to Final Rules 75, 114, and 265, and remand for further proceedings consistent with this opinion.

Because of the complexity of this case and the numerous arguments presented on appeal and before the district court, we think it is important to expressly summarize what we believe remains for the district court on remand. This opinion does not decide any of the following issues: whether any of the Final Rules, either on their face or as applied in any specific circumstances, are arbitrary and capricious; whether any of the Final Rules conflict with the Patent Act in ways not specifically addressed in this opinion; whether all USPTO rulemaking is subject to notice and comment rulemaking under 5 U.S.C. § 553; whether any of the Final Rules are impermissibly vague; and whether the Final Rules are impermissibly retroactive.

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