FEDERAL CIRCUIT GRANTS PETITION TO REHEAR TAFAS *EN BANC*

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The U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") issued an order on July 6, 2009 regarding the *Tafas et al. v. Doll et al.* decision of March 20, 2009 (case number 08-1352, hereinafter referred to as *Tafas III*). The order was in response to a joint petition for rehearing filed by GlaxoSmithKline and Triantafyllos Tafas ("Appellees"). In the order, the Federal Circuit agreed to rehear the issues regarding the Final Rules proposed by the U.S. Patent and Trademark Office ("USPTO") *en banc*, that is, by all judges of the court.

Issues regarding the Final Rules were considered in *Tafas III*, which was heard by a three-judge panel of the Federal Circuit. In *Tafas III*, the Federal Circuit considered whether the USPTO had authority to issue the Final Rules, and whether the Final Rules were inconsistent with provisions of the Patent Act. The Federal Circuit held that the Final Rules were within the rulemaking authority of the USPTO. However, the Federal Circuit decided that Final Rule 78, which is directed to continuation applications, is inconsistent with the provisions of 35 U.S.C. §120 of the Patent Act, which accords a continuation application the earlier filing date of its parent application. (*See*, *Federal Circuit Decision in Tafas Regarding Final Rules* at www.brundidge-stanger.com/docs/TafasIII-CourtofAppealsDecision1.pdf).

As a result of the order issued on July 6, 2009, all judges of the Federal Circuit will reconsider the above-described conclusions reached in *Tafas III*. The appeal will be based on briefs already of record and any additional briefs that discuss the issues addressed in the panel opinions. Accordingly, it is possible that a different conclusion may be reached regarding the Final Rules.