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**From:** mbanner@bannerwitcoff.com  
**Sent:** Monday, July 21, 2003 8:12 PM  
**To:** unity.comments@uspto.gov  
**Subject:** Comments on Unity of Invention

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To: Committee Members of ABA Committee 103

Re: Response to USPTO Issues for Comment Regarding Unity of Invention

Dear Committee 103 Members:

Enclosed is a response to the issues that the USPTO has requested comments in Federal Register Vol. 68, No. 97, Tuesday, May 20<sup>th</sup>, 2003. I have carefully considered your comments and have incorporated them in these responses. **Please vote yes or no to the Response. We need your vote by Friday, June 27.**

Issue 1: Unity of Invention as practiced in the EPO is interlinked to EPC-style claim drafting and EPO claim treatment practice, including certain limitations on claiming that are not present in current United States patent practice. For example, the EPO (under EPC rule 29(2)) usually allows only one independent claim per category of invention (category of invention is that of product, process or apparatus of use), and emphasizes the search and examination of independent claims. In contrast, the USPTO searches and examines every claim, independent and dependent, and every limitations of every claim. In addition, EPC-style claim drafting is generally termed "central claiming". In central claiming, the inventive concept is essentially claimed in the independent claim. If the independent claim is found allowable, the EPO examination will not be unduly concerned with respect to the dependent claims, according to EPO Guidelines, C-III, 3.6.

Should the USPTO study ways to adopt EPO claim treatment practice, including normally allowing only one independent claim per category of invention, when considering ways to adopt a Unity of Invention standard, and why?

Should the USPTO emphasize the examination of independent claims and modifying the examination of dependent claims in the same fashion as the EPO?

If so, would there be any reason to consider changes to the presumption of validity under 35 U.S.C. 282 of those dependent claims?

Response to Issue 1: Current US restriction practice, when applied in compliance with 35USC§121, case law, and the MPEP, is based on a sensible approach to examination. US restriction practice allows more than one independent claim in each category as long as that claim is directed to the same invention. Unity of Invention practice, however, only permits one independent claim for each category. Restriction is not proper under current restriction practice in the US unless the claims of other categories are directed to a different invention. To require the filing of divisional applications, or paying large fees for additional independent claims in each category, in addition to the presently existing additional claim fees (over 3 independent claims and over 20 total claims), would greatly increase the fees for applicants who desire broad coverage of their inventions through a plurality of independent claims. The Unity of Invention approach would render broad coverage a cost prohibitive approach for many applicants. In addition, it could greatly increase the backlog of the USPTO and slow the examination process.

Restricting the number of independent claims in a US patent would also weaken the US patent system for various reasons. US patent practice emphasizes claim interpretation in infringement suits. It is therefore advantageous to include claims that claim an invention in

various different ways. The inability to use several different independent claims to claim an invention in several different ways would limit the potential coverage that is currently available through the US patent system.

US claiming practice has recognized that inventions lie in combinations, and the courts have consistently rejected “gist of the invention” arguments for both patentability and infringement. This approach of the US patent system is in direct contravention to the “central claiming” approach of European practice. To adopt a “central claiming” approach to examination would alter fundamental precepts of US patent law. Because of the significant changes that would result from a Unity of Invention approach of examination, the current standard of presumption of validity would need to be changed.

In addition, US claiming practice has restrictive rules regarding alternative language and Markush group claiming. These rules were carefully established to coincide with US patent practice. These same requirements do not exist under PCT practice or under European practice in most jurisdictions. Hence, Unity of Invention is better suited to PCT and European practice than to US practice.

The Unity of Invention standard is also impractical and wasteful of examining resources. As pointed out in the request for comment, “the determination of whether an invention makes a contribution over the prior art can only be done after a prior art search for the common feature has been performed.” The result is that searches must be performed prior to application of a Unity of Invention rejection on “common technical features” that may be in areas in which the examiner has no expertise. Current US restriction practice does not require such a search.

A test used by the USPTO to determine patentable distinctness for restriction practice is whether a separate search is required. Although this test has been abused by examiners to some extent, the fundamental concepts of this approach are based on efficiency in searching and examination. Unity of Invention is not based on efficiency in searching.

Further, Unity of Invention can cause inefficiencies in examination. For example, Unity of Invention can be raised at any time during the prosecution of an application. This could potentially cause serious procedural problems for applicants. A frequent and proper response to a new prior art rejection is to cancel an independent claim and amend two or more dependent claims to become separate independent claims. Under the “common technical feature” standard, this process would result in a lack of Unity of Invention rejection. In order to reach this point in prosecution, the two claims were closely enough related to be examined without a serious search burden. Being forced to divide claims at the end of a long prosecution could result in severe prejudice of an applicant’s substantive rights. Hence, it would be unproductive under US law to apply such a Unity of Invention rejection.

Further, the public interest would not be served by such a Unity of Invention rejection. These claims may be so closely related that the public could be genuinely burdened with a situation of multiple harassment if these two patents were assigned to two different owners.

Issue 2: In United States restriction practice, the applicant can file a subsequent application that is directed to an invention that was divided out of the parent application. These are called Divisional applications. Divisional applications are typically subsequently filed and are not normally examined concurrently with the parent application. Divisional applications retain the benefit of the filing date of the original application if the conditions set forth in 35 U.S.C. 120 are met. This allows an applicant to continue to pursue protection for the inventions subject to restriction that were in the original application without being affected by double patenting. All member states of the Paris Convention for the Protection of Industrial Property

(1967) (including Japan and all EPC member states), as well as the EPO, also provide for the filing of Divisional applications. However, the PCT does not yet provide for the filing of Divisional international applications. Consequently, the PCT rules provide for applicant to pay for the search and examination of additional inventions that “lack unity” in a single international application. Adoption of a Unity of Invention standard could, in some instances, require examining more inventions during the examination of a single application than occurs presently, thereby possibly causing delay in the examination of other applications if examination resources are limited. This could increase the USPTO’s average patent pendency time.

If the USPTO adopts a Unity of Invention standard, should the USPTO provide applicants the option of a PCT-style Unity of Invention practice to pay for additional inventions that lack Unity of Invention in the same application?

If so, should the USPTO consider any changes to patent term adjustment under 35 U.S.C. 154(b) for applications which have more inventions examined in a single application under a Unity of Invention standard than are permitted under current practice?

In view of the fact that examining multiple inventions in a single application could cause examination delay in other applications, what other revisions to patent term adjustment provisions under 35 U.S.C. 154(b) should be considered by the USPTO, or should the USPTO also consider revising the order that cases are taken up for examination?

Response to Issue 2: The PCT style “additional invention fee” procedure identified in Issue 2 benefits both the USPTO and applicants and should be adopted, whether or not the substantive “Unity of Invention” test of Issue 1 is adopted. Any opportunity to examine related claims together should be seized by the USPTO, in order to increase overall efficiency and reduce backlogs. In many cases, a plurality of inventions in any single application will be closely enough related that efficiencies can be realized by examining these inventions together, in accordance with the “additional invention fee” procedure.

When two or more inventions in a single application are patentably distinct, as required for a restriction under 35 U.S.C. 121, such an “additional invention fee” procedure is a very fair way to identify and allocate costs for examination and searches. On the other hand, charging additional fee for more than one independent claim in a particular category under the Unity of Invention standard is not a fair way of charging fees since the fees are not directly related to the costs for searching and examination. Further, the Unity of Invention approach creates additional administrative overhead for both the USPTO and applicants and is a wasteful process.

As pointed out in the USPTO comments, the “additional invention fee” procedure may slow the overall examination process and increase the backlog of pending applications. Current patent term extension rules tend to ameliorate the deleterious effects of a delayed examination, however. Hence, the overall effect of having a PCT style Unity of Invention practice would probably benefit applicants and should be adopted, assuming the Unity of Invention standard is adopted by the USPTO, which we oppose.

As to whether the USPTO should consider changes to the patent term adjustment law, the answer depends upon the available resources of the USPTO. If the current fee diversion is eliminated, changes to the patent term extension law may not be required.

Issue 3: Under the PCT, examination proceeds on the basis of the first claimed invention if applicant does not pay for additional inventions that lack unity.

Should the USPTO adopt, for national applications, the practice currently used under the PCT of examining the first claimed invention where there is a holding of lack of Unity of Invention?

Optionally, where Unity of Invention is lacking: (1) Should the USPTO examine the first claimed product, or the first claimed invention if there are no product claims; or (2) should applicant be given the opportunity to elect an invention to be examined?

Response to Issue 3: Assuming the Unity of Invention standard is adopted by the USPTO, which we oppose, the applicant should be given the opportunity to choose the group of claims to be examined as is currently done under restriction practice. Both the USPTO and applicant benefit when the USPTO resources are focused on the invention that is most important to the applicant, and where the applicant is allowed to make a choice based on information that may not have been available when the application was filed much earlier.

Issue 4: A determination of lack of Unity of Invention is predicated on assessing whether a common feature (referred to as a “special technical feature” in the context of PCT Rule 13) defines a contribution over the prior art. Certain PCT member states assess this requirement only with respect to patentable advances over prior art. However, issues of lack of support, enablement, clarity, or conciseness, generally resulting from excessive breadth of claims or excessive numbers of claims, may occur that render examination unduly burdensome. In such circumstances, some International Authorities will make a “partial search” declaration to limit the extent of search and examination. The USPTO does not follow this practice. On the other hand, it may be viewed that if the common feature or “special technical feature” is not adequately supported by the disclosure or lacks utility (“industrial applicability” in the PCT context), the special technical feature does not make a contribution over the prior art.

When adopting the Unity of Invention standard, should the USPTO follow the practice of performing only a “partial search” if the examination of the entire scope of the claims is unduly burdensome due to non-prior art issues?

Alternatively, should the USPTO assess adequacy of the disclosure and industrial applicability in addition to the prior art when determining whether the claims’ common features makes a contribution over the prior art?

Response to Issue 4: Assuming a Unity of Invention standard is adopted by the USPTO, which we oppose, the examination should assess the adequacy of the disclosure under the three requirements of paragraph 1 of 35 U.S.C. 112 and should determine whether such a common feature constitutes statutory subject matter (not industrial applicability) during the examination. Again, however, the common feature standard of Unity of Invention constitutes a significant limitation on US claiming practice that should not be adopted. Valuable examination time may be wasted in determining a common feature that is normally not important to the primary purposes of the examination process.

Issue 5: The USPTO’s 21<sup>st</sup> Century Strategic Plan is predicated on a certain level of revenue to provide the resources needed to meet quality and timeliness goals. The Plan currently does not account for any additional resource requirements, and any corresponding revenue shortfalls, that may result from adopting a Unity of Invention standard. Statutory fees under 35 U.S.C. 41(a) and (b), in the aggregate, are set to cover USPTO operating costs. If the average

cost of processing patent applications goes up, the USPTO will need to increase fees. Assuming that there will be extra costs of examination under Unity of Invention, possible increases would be: (1) all filing fees; (2) all filing fees and an additional fee for examination of claims that lack Unity of Invention with an elected invention; (3) increased issue and/or maintenance fees of all applications; (4) increased issue and/or maintenance fees for applications paying the additional invention fee; or (5) a combination of two or more of (1) through (4) above.

Which of the above approaches should the USPTO propose in regard to any fee increases?

Response to Issue 5: If a Unity of Invention standard is adopted by the USPTO, which we oppose, and that adoption raises USPTO costs, then the USPTO should absorb those costs. Applicants should not have to pay for adoption of a standard by the USPTO that requires more USPTO overhead.

Issue 6: Adopting a Unity of Invention standard would impact the number of inventions that would be examined in a single application, and require examining multiple inventions that cross multiple disciplines in a single application. Due to the current level of technical specialization in the Patent Examination Corps, the USPTO will have to consider the impact any change would have on the ability of the USPTO to maintain high quality examination.

How should work be assigned to ensure that examination quality would not suffer if examiners have to examine multiple inventions from different disciplines in a single application?

Should the USPTO consider: (1) Using team examination, similar to the EPO where applications are examined using three-person teams called “examination divisions”; (2) extending the use of patentability report procedures provided for in section 705 of the Manual of Patent Examining Procedure (8<sup>th</sup> ed. 2001) (Rev. 1, Feb. 2003); (3) maintaining the current process of a single examiner on an application; or (4) using some other option of how work is performed by examiners?

Response to Issue 6: Assuming such a process is adopted, which we oppose, the USPTO should have the flexibility to employ whatever procedure is best for examining and searching a specific application to insure that the application receives a thorough examination in an efficient manner. Team examinations require additional resources and may slow the searching and examination process. Further, team approaches tend to drive up costs and dilute accountability. The Bar has a great deal of concern about dealing with a committee or a proxy. Hence, accountability is an important issue for consideration by the USPTO if this process is adopted.

Issue 7: One way of adopting aspects of Unity of Invention without making any statutory changes would be for the USPTO to use its authority under the continued examination provisions of 35 U.S.C. 132(b) (authorizes request for continued examination or RCE practice) to permit applicants to pay an RCE fee and submit or rejoin claims to additional inventions after prosecution has been closed on a first invention, so long as the claims presented with the RCE fee either depend from or otherwise include the features of the allowed claims which make a contribution over the prior art. In this option, most applications will continue to be examined under the USPTO’s current restriction practice. Under any new provisions to implement this option, when a claim is determined to be allowable, the applicant would be entitled to request continued examination under the Unity of Invention standard. The required submission would

be additional claims that either depend from or otherwise include the features of the earlier-examined claims that are in condition for allowance (if such additional claims were not previously pending in the application).

Should the USPTO consider this option?

Should this option be available only to applicants whose applications are published?

If so, how should the new RCE fee be set relative to the current fee structure?

Response to Issue 7: We oppose this procedure since it appears to be a process for simply collecting more fees and adding additional administrative overhead costs. For claims that are made dependent on allowed claims, the examination is nugatory, and such claims should automatically be included in any system at examination, without further cost other than an excess claims fee. Also, requiring the filing of an RCE would delay the examination, is inefficient and could possibly raise prosecution laches problems. If adopted, however, the new RCE fee should be significantly lower.

Issue 8: As a second example of adopting aspects of Unity of Invention without making any statutory changes, the USPTO could use its authority under continued examination to permit requests that the USPTO continue examination of claims which were withdrawn from consideration. This option would require applicants to make a decision to request continued examination rather than file a divisional application, to pay a fee for the treatment of one additional invention, and to present claims drawn only to that additional invention. This option would be available in addition to the continuing option of filing a divisional application.

Should the USPTO consider this option?

If so, how should the loss in issue and maintenance fee collections be offset relative to the current structure?

Response to Issue 8: This issue raises the further complications that may arise from adoption of a Unity of Invention standard. Again, it is extremely important that claims be examined efficiently. When claims are closely enough related to be presented in a single application, it would rarely be more efficient to have these claims examined in a serial fashion, as would be required for additional independent claims under a Unity of Invention standard, rather than in the parent application. Further, USPTO procedures should provide for prompt examination of all related claims, especially after enactment of GATT. A procedure that requires an applicant to hold allowed claims in abeyance, and delay initial examination of others, weakens the U.S. Patent system. Further, prosecution laches problems are also raised by this issue.

With respect to collection of fees, the amount of the fees should be based on the number of inventions included in the application and other factors. Excessive fees, such as a new filing fee, should not be changed for each independent claim. As pointed out above, adoption of a Unity of Invention standard by the USPTO increases administrative costs and is a wasteful approach to considering searches and examination by the USPTO. If the USPTO decides to adopt the Unity of Invention standard, the USPTO should absorb those costs.

Issue 9: In view of the previous questions and the range of issues and options, should the USPTO consider: (1) seeking a change to 35 U.S.C. 121 to adopt a Unity of Invention standard (and if so, what would such statutory change be, including whether such a statute would provide

for applicants to pay for additional inventions that lack Unity of Invention to be examined in the same application); (2) maintaining the current restriction practice in the USPTO; and/or (3) modifying the USPTO rules and procedures to adopt aspects of Unity of Invention practice without making any statutory changes (if so, in what manner should rule changes be made)?

Response to Issue 9: The Unity of Invention standard should not be adopted by the USPTO. The current test for identifying multiple inventions under the current restriction practice of the USPTO, as articulated by the courts, 35 USC § 121 and the MPEP is clearly a more efficient and better way of approaching these issues and is better suited for the refined methods of obtaining and enforcing patent rights under U.S. patent law. Adoption of a Unity of Invention standard would add wasteful administrative procedures and potentially weaken U.S. Patent Law. Further, there is a potential for significant and unnecessary fee increases that constitute an unreasonable tax on innovation. The fee bill, which similarly attempted to unreasonably raise the cost of additional claims in an application, was uniformly rejected by the patent bar.

Although the USPTO should maintain its current practice of restriction because of the advantages of such a practice and the fact that restriction practice does not have the inherent administrative overhead costs that would be associated with adoption of a Unity of Invention standard, restriction practice needs to conform to the existing rules and statutes better. For example, current practice with respect to election of species should be studied, especially with respect to claiming sequences in biotech applications. The current substantive “single sequence” rule applied in Group 1600, any practice of intra-claim restriction, and any refusal to examine a claim as drafted by an applicant without identification of any statutory requirement, is directly contrary to law. The procedures applied in Group 1600 with regard to current restriction practice should be carefully monitored for compliance with proper and legal U.S. restriction practice. Let’s not throw out the baby with the bath water.

Further, if a Unity of Invention standard is adopted and fees are required to obtain multiple independent claims for a single invention in an application, the US patent system would be weakened. Many companies, including small companies and individuals that do not have the money to pursue a plurality of independent claims, would not obtain broader protection. Certainly, this is an opportunity for the USPTO to collect more fees, but this should not be done at the expense of adopting a less efficient process with more administrative overhead that could have the overall effect of weakening the US patent system.

Issue 10: Do you have other solutions to offer which are not addressed in this notice?

Response to Issue 10: 1. The PCT and the EPO should consider restriction practice as an alternative because it is an inherently better approach to searching and examination, rather than the US adopting a less efficient system that may weaken the US patent system.

2. The U.S. may wish to consider a Unity of Invention type of approach in which a plurality of independent claims, without limitation, can be included in a single application. Claims of different categories could be included in the same application. Fee structures for such an approach would need to be determined.



3. A new system of examiner productivity points should be created which fairly compensates the examiners for the work that is done in an application. Such a new system could be designed to not place a premium on restrictions, which leads to questionable restriction practices, but fairly compensates the examiner for work performed. Such a process would lead to greater efficiencies and reduce administrative overhead.