

Comments re Unity of Invention Versus Restriction Practice

Issue 1: Yes. Adopting a Unity of Invention standard is conceptually logical because it focuses on the inventive concept and provides a more predictable and consistent standard. A single inventive concept can lead to an invention comprising many embodiments, but the patentability of those embodiments arises out of the inventive concept, not the nature of the embodiment (e.g., discovery of a new antibody gives rise to nucleotides encoding the antibody, methods of using the antibody, methods of producing the antibody, all of which are patentable only because the antibody is new and nonobvious). This logically leads to use of a central claiming style and streamlines the examination effort. This would not affect the presumption of validity, so long as the same central features are present in all claims.

Issue 2: The option of paying for additional searching should be treated as an alternative to immediately filing a divisional application. If this practice were adopted, the fee could be set to avoid abuse that increases examination delay and applicants opting for it would sacrifice their right to patent term adjustment based on extra search time. It may be more sensible to not offer the option and allow the applicant to file an immediate divisional, a practice that is currently available (presumably not altering the examination burden).

Issue 3: It would be preferable to give applicants an opportunity to elect which invention is searched first. This avoids surprise in cases where the USPTO interprets unity in a manner not expected by the applicant.

Issue 4: It would be more efficient to the overall process to allow for partial searches and postponing assessment of the disclosure's adequacy for the initial examination.

Issue 5: Any increased fee should be tied to those cases causing the increased burden. Where an increased fee is paid to add more inventions to a single application, subsequent fees (issue, maintenance) should also be increased to avoid abuse.

Issue 6: I would defer to those experienced with examination to best judge how to assign the work.

Issue 7: An RCE option for adding claims back in seems efficient and logical. The option should be available to all, regardless of publication status. The fee should be set the same as other RCE's, but it may be logical to increase issue/maintenance fees.

Issue 8: This option is attractive for the same reasons as #7, and fees could be handled the same way.

Issue 9: The statute already reads "independent AND distinct", which could be construed in the same manner as unity of invention. I have always regarded the MPEP construction of "and" in this context to mean "or" improper. No statutory change is required to adopt unity of invention practice.

Issue 10: The current practice of charging extra for multiple dependent claims encourages a larger number of dependent claims, even where it would be more efficient for the examiner to allow one dependent claim to refer back to numerous previous claims. The surcharge for multiple dependent claims and each claim referred to therein should be dropped in favor of a higher fee for independent claims, to be consistent with Unity of Invention practice.