

From:

Sent: Friday, August 13, 2010 3:24 PM

To: Restriction_Comments

Subject: Proposed Changes to Restriction Practice

Importance: High

Dear Director Kappos:

My comment concerns a conflict between restriction or “unity of invention” practice as it is currently being applied by the Office to applications filed as U.S. National Stage applications under 35 USC 371, and Rules 1.499 and 1.475(b) of Title 37, Code of Federal Regulations, which on their face appear to govern such practice. Specifically, where a US national stage application contains claims directed only to a single combination of categories, such as product and process of use of the product, Rule 475 mandates that the application be considered to have unity of invention. In practice in my experience, the Examining Corps uniformly ignores Rule 475 and instead applies the “special technical feature” test of PCT Rule 13.1, under which a prior art document is cited which allegedly discloses an Examiner-characterized “special technical feature” common to all claims, resulting in a finding of lack of unity of invention.

Specifically, Rule 499 provides that unity of invention during the US national stage is to be determined under Rule 475:

37 CFR 1.499. Unity of invention during the national stage

If the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may in an Office action require the applicant in the response to that action to elect the invention to which the claims shall be restricted. Such requirement may be made before any action on the merits but may be made at any time before the final action at the discretion of the examiner. Review of any such requirement is provided under §§ 1.143 and 1.144.

Rule 475 states that national stage applications containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of a number of combinations of categories, to wit:

§ 1.475 Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

The Office of PCT Legal Administration takes the position that unity of invention practice with respect to a national stage application filed under 35 USC 371 is governed by PCT Rules 13.1 and 13.2, and that 37 CFR 1.475 is allegedly “only an interpretation of and not an exception to the requirements of PCT Rule 13.1.” See attached Decision dated 17 Feb 2009. This interpretation by the Office of PCT Legal Administration essentially renders Rules 475 and 499 meaningless.

PCT Legal Administration relies on MPEP 1850, item III for its assertion that Rule 475 does not mean what its words state, and that Rule 475 does not actually govern unity of invention during the national stage. See attached Decision. However, MPEP 1850 relates to unity of invention before the **International Searching Authority**, i.e. it pertains to International applications filed in the US Receiving Office (RO) and examined by the US ISA:

“1850 Unity of Invention Before the International Searching Authority”

Contrary to PCT Legal Administration’s current position, MPEP Section 1893, and not 1850, pertains to National Stage applications filed under 35 U.S.C. 371. MPEP 1893 clearly states:

“When Claims Are Directed to Multiple Categories of Inventions:

As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1)A product and a process specially adapted for the manufacture of said product; or

(2)A product and process of use of said product; or

(3)A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4)A process and an apparatus or means specifically designed for carrying out the said process; or

(5)A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).”

It appears that there exists a need for clarification by the Director as to the meaning and purpose of 37 CFR 1.499 and 1.475 as these Rules apply to unity of invention determinations of national stage applications filed under 35 U.S.C. 371, and whether Rules 499 and 475 are to be followed by the Examining Corps in such national stage applications, instead of the current practice whereby the Examining Corps applies PCT Rules 13.1 and 13.2 to national stage applications, and ignores 37 CFR 1.475 and 1.499.

Respectfully submitted,

Vincent M DeLuca

Vincent M DeLuca

(Washington DC Office)



WASHINGTON, DC Novak Druce DeLuca + Quigg LLP 300 New Jersey Ave, NW Fifth Floor Washington, DC 20001	HOUSTON, TEXAS Novak Druce + Quigg LLP Wells Fargo Plaza Fifty-Third Floor 1000 Louisiana Houston, Texas 77002	SAN FRANCISCO, CA Novak Druce + Quigg LLP 555 Mission Street 34th Floor San Francisco, CA 94105	WEST PALM BEACH, FL Novak Druce + Quigg LLP 525 Okeechobee Blvd 15th Floor West Palm Beach, FL 33401
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Telephone 202-659-0100 Facsimile 202-659-0105	Telephone 713-571-3400 Facsimile 713-456-2836	Telephone 415-814-6161 Facsimile 415-814-6165	Telephone 561.847.7800 Facsimile 561.847.7801
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1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON DC 20005

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In re Application of :
WADLEY : DECISION
Application No.: 10/522,068 :
PCT No.: PCT/US2003/023043 :
Int. Filing Date: 23 July 2003 :
Priority Date: 25 July 2002 :
Attorney's Docket No.: 3053.138.US :
For: METHOD FOR MANUFACTURE OF CELLULAR :
MATERIALS AND STRUCTURES FOR BLAST AND :
IMPACT MITIGATION AND RESULTING :
STRUCTURE :

This is a decision from the Office of PCT Legal Administration in response to applicant's "REQUEST FOR RECONSIDERATION/REVIEW OF DECISION ON PETITION FROM RESTRICTION REQUIREMENT UNDER 37 CFR § 1.144" filed in the United States Patent and Trademark Office (USPTO) on 26 September 2008.

BACKGROUND

On 23 July 2003, applicant filed international application PCT/US2003/023043, which designated the United States and claimed a priority date of 25 July 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 05 February 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 25 January 2005.

On 21 January 2005, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of the inventor.

On 28 July 2005, the USPTO mailed a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) according a 371(c)(1), (c)(2), and (c)(4) date of 21 January 2005.

On 10 January 2007, an Office action was mailed setting forth a lack of unity requirement between Groups I and II.

On 09 May 2007, applicant filed a "Response to Restriction and Election Requirement Under 35 U.S.C. § 1.121" electing Group I with traverse. Applicants urged that the common technical feature provided a contribution over the prior art.

On 08 August 2007, an Office action was mailed addressing applicant's traversal and making the lack of unity requirement final.

On 10 December 2007, applicant filed a response again traversing the lack of unity requirement.

On 25 March 2008, an Office action was mailed again addressing applicant's traversal and making the lack of unity requirement final.

On 26 June 2008, applicant filed a "PETITION FROM RESTRICTION REQUIREMENT UNDER 37 CFR § 1.144".

On 22 September 2008, a decision was mailed indicating that the restriction requirement between Groups I and II was maintained and that the petition was denied.

On 26 September 2008, applicant filed the instant "REQUEST FOR RECONSIDERATION/REVIEW OF DECISION ON PETITION FROM RESTRICTION REQUIREMENT UNDER 37 CFR § 1.144".

On 15 October 2008, a Final Office action was mailed.

DISCUSSION

Unity of invention (not restriction) practice is applicable in national stage applications submitted under 35 U.S.C. 371. MPEP § 1893.03(d). During the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rules 13.1 and 13.2 will be followed when considering unity of invention claims. MPEP § 1850, item I.

PCT Rule 13.1 states

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT Rule 13.2 states

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

As noted in the decision mailed 26 September 2008 and the Office action mailed 10 January 2007, the examiner set forth the Lack of Unity requirement as follows:

Group I, claims 1-35, drawn to a structure.

Group II, claims 36-39, drawn to a method of constructing a structure.

The groups were indicated as lacking unity of invention because the common technical feature failed to provide a contribution over the prior art.

Applicant urges that 37 CFR 1.475(b) precludes the restriction requirement. 37 CFR 1.475(b) states in relevant part:

An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- 1) A product and a process specially adapted for the manufacture of said product; . . .

Although 37 CFR 1.475(b)(1) indicates that a national stage application containing claims to different categories of invention will be considered to have unity if the claims are drawn to a product and a process specially adapted for the manufacture of said product, this illustration is only an "interpretation[]" of and not an exception to the requirements of PCT Rule 13.1". MPEP § 1850, item III, second full paragraph. Examples are set out in Chapter 10 of the International Search and Preliminary Examination Guidelines. Paragraph 10.21 of the Guidelines clearly illustrates that if the common technical feature among the product and process is known in the art, unity is lacking.

10.21 Example 1

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is substance X. However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims. (emphasis added)

CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The period for reply set forth in the Final Office action mailed 15 October 2008 continues to run.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301