

From:
Sent: Friday, August 13, 2010 6:26 PM
To: Restriction_Comments
Subject: RE: Proposed Changes to Restriction Practice
Importance: High

Further to my previous comments below.

Restriction practice and unity of invention practice have as their underlying principle that a patent should be granted for only a single invention, and that examiners should be required to conduct a search for only one patentable invention in any single patent application. Therefore, the determination of whether the claims in a national stage application have “unity of invention” should be made based on the language of the claims themselves, without regard to whether the claims describe patentable subject matter over prior art.

The current “unity of invention” practice being applied by the Examining Corps to national stage applications as affirmed by the PCT Legal Administration office does not take into consideration whether the claims of the application are directed to the same invention or to separately patentable inventions. The current unity of invention practice with respect to national stage applications requires that Examiners conduct a prior art search for a common “special technical feature” set forth in the claims in order to make a “unity of invention” determination. However, the question of patentability over prior art of claims directed to different statutory categories of subject matter, plainly has no relevance whatsoever to the issue of whether claims directed to different statutory categories of subject matter relate to the same potentially patentable invention.

Further, requiring an Examiner to conduct a prior art search prior to making a determination of whether claims should be restricted because of lack of unity of invention would appear to be illogical, as one of the bases underlying restriction practice is to relieve the Examiner from having to conduct unduly burdensome searches. If the Examiner is required to conduct a prior art search prior to making a restriction requirement, then any benefit of restricting out claims from an application in terms of reducing the searching burden would appear to have been lost, as the claimed invention would have been already searched.

Respectfully submitted,

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From:

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

To: Restriction_Comments@uspto.gov

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,

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