From:
Sent: Friday, August 13, 2010 7:49 PM
To: Restriction_Comments
Subject: Request for Comments on Proposed Changes to Restriction Practice in Patent Applications

Please see the attached comments.

Respectfully submitted,
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<<Restriction Practice Comments to Commissioner.pdf>>

August 13, 2010

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop Comments – Patents

Re: Request for Comments on Proposed Changes to Restriction Practice in Patent Applications

Sir:

This letter is in response to the Notice published at 75 Federal Register, No. 113, page 33584 on June 14, 2010.

I welcome the opportunity to provide comments on this timely topic. The views expressed, however, are solely my own, and should not be attributed to either my firm or any of my firm's clients.

Over the course of nearly forty years of practice before the USPTO, I have observed that restriction practice is fraught with difficulty. Patent examiners have a very limited amount of time to examine a patent application. To enable them to make a thorough and complete examination within the time allotted, it is essential that patent applications be limited to a single inventive concept. The challenge of examining the cases on their dockets within the allotted time gives examiners a strong incentive to cut each case down to the narrowest possible scope.

At the same time, an applicant has a statutory right to claim what he or she regards as his or her invention in all of its aspects and should not be compelled to file several applications to obtain adequate patent protection for what amounts to a single inventive concept. To protect their inventions to the fullest extent possible, applicants have an incentive to present broad claims and differing types of claims that seek to embrace every possible aspect of their inventions even if those different aspects bear only a marginal relation to each other.

Restriction practice serves to balance these competing interests.

Applicants sometimes abuse examiners by including in a single application, or even in a single claim, alternatives that really have only the most tenuous relation to each other and which present completely separate examination burdens. An example might be a claim directed to a compound corresponding to the formula A-B-X-Y, where A, B, X and Y each represent any of a list of different chemical substructures, so that there is no common structural element present in all of the

compounds embraced by such a claim. Another example might be a claim which covers two unrelated alternative uses for a known material. In such cases, unity of invention as defined in *In re Harnisch* is not present, and in fairness to examiners, restriction practice should provide some tools to enable an examiner to compel an applicant to limit the scope of an application to subject matter which relates to a single invention (i.e., subject matter which exhibits unity of invention).

On the other hand, there are a number of ways in which examiners abuse restriction practice to force applicants to unnecessarily narrow the scope of their applications and file unnecessary divisional applications. Not only does this simplify the examination of the initial application for the examiner, it may well produce a second application which can be examined with minimal effort because the real work of determining the novelty, non-obviousness and utility of the claimed subject matter has already been done in the parent case.

Unnecessary divisional applications bring substantial negative consequences, both for applicants and for the Patent and Trademark Office. Applicants are subjected to significant additional costs. Just the additional expense of another filing fee, issue fee and set of maintenance fees amounts to over $10,000.00, not to mention the additional expenditures for services of counsel. Unnecessary divisional applications also add to the PTO's backlog of unexamined cases and contribute to the long pendency of US applications.

In the writer's experience, many examiners are not very familiar with what the M.P.E.P. actually says about restriction practice, but they almost all know how to work the system to impose restriction requirements, whether justified or not. And the contest over whether or not a restriction requirement is justified is a very unequal one because the examiner serves not only as an advocate for restriction, but also as the initial decision maker as to the propriety of the requirement. Moreover, applicants are not infrequently reluctant to challenge an unjustified restriction requirement for fear of offending the examiner who ultimately will decide the patentability of their invention.

The following are some examples of how examiners misuse restriction practice.

<u>Misstating that a method "as claimed" can be practiced with a different product</u>

Consider the example of an application which claims an analgesic compound and a method of using that compound to treat pain. Examiners will frequently require restriction between the compound and method of use on grounds that the treatment of pain can be effected with a different compound such as aspirin. They completely ignore the fact that the method "as claimed" specifically requires the use

of the claimed compound and does not embrace the use of aspirin. Such flawed analyses are not rare. Rather, they occur more often than not.

Failing to identify why different subject matter groups are distinct

It is commonplace in restriction requirements to encounter a statement to the effect that the different groups have acquired a distinct status in the art followed by a page-length laundry list of all possible grounds for considering subject matter to be distinct. Not only does this relieve the examiner of the burden analyzing the claimed subject matter and explaining why the groups are distinct, it forces the applicant to successively consider and refute each possible ground, which can become extremely burdensome. If an examiner makes a finding of distinctness, he or she should be required to set forth his or her reason for doing so, rather than simply using a word processor to insert form paragraphs of all possible reasons.

Refusing to address a traversal of a restriction requirement

After traversing a restriction requirement, it is not uncommon for an applicant to receive in the next office action a response which essentially ignores the traversal. A typical statement might read as follows: Applicant's traversal of the restriction requirement is unpersuasive because the inventions are distinct as stated in the previous office action. In traversing a restriction requirement it is incumbent on the applicant to point out the errors in the restriction requirement. It should likewise be incumbent upon the examiner to specifically address the points raised by the applicant in his or her traversal of the requirement.

Restrictions within a single claim

Restriction practice can be difficult enough when an examiner seeks to impose restriction between different groups of claims, but it becomes even more troublesome when an examiner seeks to force an applicant to split up a single claim. Examiners routinely ignore the statement of the Court in *In re Weber*, 580 F.2d 455, 198 USPQ 328, 331 (CCPA 1978).

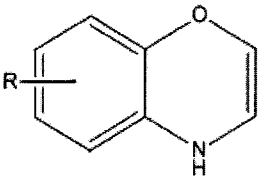
> An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," allows the inventor to claim the invention as he contemplates it. (citation omitted).
>
> As a general proposition, an applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction

> requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

Commonplace abusive practices in this regard include:

a) Requiring an applicant to elect a species and stating that the office will then determine the scope of the elected invention. It is not the province of the office to determine the scope of an applicant's invention; that is the applicant's right. By this procedure, which seems to be totally without supporting authority, an applicant never knows until after the fact what portion of his or her claim will be examined and what portion will be withdrawn.

b) Ignoring the common base structure of a group of compounds and alleging distinctness based on variations in a peripheral substituent group. Consider the example of a claim to a substituted benzisoxazine having the following formula:



in which R may be $-NH_2$ or $-OCH_3$. It is not at all unusual for an examiner to focus solely on the substituent R group and seek to require restriction on grounds that one of the compounds is an amine and the other an ether. A proper analysis should consider the compounds as wholes and not ignore the dominant common structure of the molecules.

c) Failing to account for all the claimed subject matter. It frequently occurs that an examiner will attempt to split a claimed genus into a series of sub-genuses based on subcombinations of the variables of the genus which do not account for all the possible subcombinations of the variables, with the result that a portion of the originally claimed genus does not fall within any of the proposed groupings. Such a restriction would deprive the applicant of the right to claim the omitted subject matter. Sometimes, in an attempt to make up for this defect, an examiner will include a residual group (e.g., compounds not included within any of the preceding groups). This hardly solves the problem for it does not explain how, if the

restriction is made final, the applicant can claim the residual group in a divisional application. It is hard to imagine the office accepting a claim which read: "A compound claimed in the original claim of my parent application and not embraced by any of my other divisional applications." If restriction is ever to be required within a single claim, it should clearly account for all the subject matter of the claim in groupings which, if necessary, can be made the subject of an appropriate divisional application.

In most cases, whenever the claimed compounds exhibit a common utility and a substantial shared structure, it would be better not to require restriction within a single claim, but instead to proceed in accordance with established Markush practice as set forth in M.P.E.P. § 803.02.

Presuming each individual amino acid or nucleotide sequence to be a separate invention without regard to the existence of a relationship between the sequences

Although the published PTO guidelines explicitly state that an applicant will be permitted to claim a reasonable number of related sequences in a single application, in recent years examiners have been restricting examination of applications embracing amino acid or nucleotide sequences to a single sequence on grounds that searching more than a single sequence is burdensome. Pursuant to this policy, the writer has been forced to elect a single peptide sequence from among a group of 3 protein sequences which all exhibit the same protease activity and which are identical over the course of 691 amino acids and differ only in that the second sequence includes 10 additional amino acids at the N-terminal end and the third sequence includes a further 60 amino acids at the N-terminal end. By virtue of their shared activity and common structure, the three sequences are believed to fully satisfy the requirements of a proper Markush grouping. Moreover, if a search of the shortest sequence finds it to be novel, the two longer sequences will also necessarily be novel because they fully incorporate the complete length of the shortest sequence. Although the two longer sequences would not be obvious in view of the shortest sequence, that fact by itself should not be sufficient to justify restriction. Rather, amino acid and nucleotide sequences ought to be evaluated like other compounds based on their functional and structural characteristics to determine if they represent more than a single invention.

Refusing to re-join method claims on grounds they might raise other issues

Despite the provisions of M.P.E.P. § 821.04, the writer has frequently encountered refusals to re-join method of making claims or method of use claims with allowable product claims on grounds that they "might" raise further enablement issues. Having concluded that the product is enabled, the examiner must necessarily have concluded the method of making it is enabled, and having concluded that the product has utility, the examiner must necessarily have concluded that the method of using it is enabled. The situation is particularly

galling when the subsequent divisional application is allowed by the same examiner on the first action without any enablement rejection being made. Something more than just an assertion that the method claims might raise enablement issues should be required before an examiner can refuse to re-join method of making and/or use claims to allowable product claims. At the very least, the examiner should be required to point out why the method claims are not enabled, or he should re-join and allow them.

Determining Lack of Unity of Invention based on the presence of differences in claims instead of on the absence of a shared special technical feature

Most examiners seem not to understand the standards for determining unity of invention under the Patent Cooperation Treaty. It is not infrequent that in a case containing claims to a product, the method of making that product and a method of using that product, an examiner will determine that unity of invention is lacking because the special technical feature of the product claim is the product, the special technical feature of the method of making claim is some manufacturing step, and the special technical feature of the method of use claim is the application of the product. Of course there will always be different features recited in a product claim, a method of making claim and a method of use claim. If the presence of such differences were an indication of lack of unity of invention, then unity of invention would never exist between a product, its manufacture and its use. But it's not the presence of different features in the claims that indicates lack of unity of invention, but rather the absence of a common feature. In the case in question all three claims recite the feature of the product, and the presence of this common feature establishes that unity of invention does exist.

In the face of these difficulties, I offer the following suggestions for consideration by the Office.

1. Better training for examiners. This is a suggestion made so often that it is practically a cliché. But the sad truth is that most examiners don't seem to understand restriction practice. One has the impression that they are learning from teachers who themselves don't really understand restriction practice, or from supervisors who are teaching them to cut corners in order to try to cope with the pressure to meet unrealistic production goals.

2. Switch to a unity of invention standard for judging whether or not an application is directed to a single invention. Because examiners used to search by manually reviewing bundles of paper patents sorted according to the US patent classification system, restriction practice is largely based on the US classification system. But this is an anachronism which does not reflect how a lot of searching is now done in the computer age. Moreover, the classification system is somewhat arbitrary with some subclasses having been divided up to form separate subclasses

not because the subject of the parent subclass was patentably distinct, but merely because the parent class became too large to conveniently search. The idea of unity of invention based on the presence of a linking inventive concept or technical feature is much more rational and actually better suited to determining whether or not more than one invention is present in an application.

Moreover, switching to a unity of invention standard would help harmonize US patent practice with the practices of the rest of the world. It is a real problem for applicants who file applications both in the United States and in foreign countries to maintain coordinated prosecution when different standards are used to determine whether or not an application relates to a single invention, so that corresponding applications in different countries may be required to be divided up in different ways. Switching to a unity of invention standard would surely alleviate this problem, even if it might not totally eliminate it.

In addition, switching to a unity of invention standard would promote uniformity in US patent practice. It makes no sense for an application to be evaluated by one standard if it is filed as a national stage of a PCT application and by a different standard if the same application is filed as a continuation of the PCT application. It also is confusing to examiners to have to learn two different standards and to puzzle over which of the two to apply to a given case. Switching to a single consistent standard for all applications simply makes good sense.

3. Find a way to give examiners credit for the length and complexity of the claim sets they examine. As long as examiners receive the equivalent credit for examining an application with ten claims as they do for examining an application with sixty claims, they will have every incentive to attempt to simplify their jobs by doing everything possible to limit the number of claims they examine. Through payment of excess claim fees and excess independent claim fees, applicants already pay more for a longer or more complex application, presumably to cover the increased cost of examining the additional claims. If an applicant can be required to pay more for examination of a more complex application, why can't the examiner who examines that more complex application get more credit for the job he does?

4. If more than one invention is present in an application, offer the applicant the opportunity to pay additional search and/or examination fees to have the additional inventions searched and examined in the same application instead of having to file a divisional application. This would surely be faster and less expensive than filing a divisional application and might be less expensive than (and surely faster than) preparing a Petition against a restriction requirement. As in PCT practice, the applicant should have the opportunity to pay under protest so that he could get his money back if the restriction was unjustified.

5. If a restriction is made final and the applicant still disagrees, give the applicant the right to request a telephonic or personal interview with the examiner

and a special programs examiner who is a restriction expert. This would be faster than the Petition process and possibly even less expensive for the applicant and the Office.

I sincerely hope that the foregoing comments will prove useful to your consideration of this important topic. Unjustified restrictions and unnecessary divisional applications harm the patent system as a whole. The competing interests of applicants to include as much as possible in each application and of examiners to cut each application down into the smallest possible scope must be balanced for the system to work effectively. By opening this dialogue, I believe you are taking a first step toward this important goal.

Very truly yours,

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