

July 21, 2003

Comments submitted by email, as requested, to: unity.comments@uspto.gov

Re: "REQUEST FOR COMMENTS ON THE STUDY OF THE
CHANGES NEEDED TO IMPLEMENT A UNITY OF
INVENTION STANDARD IN THE UNITED STATES"
68 FED. REG. 27536 (MAY 20, 2003)

The undersigned commentator bases the following respectful comments on 40 years of continuous personal patent application prosecution experience (corporate and law firm) and many years of counseling younger patent attorneys, especially now as the Assistant General Patent Counsel of the Xerox Corporation Intellectual Property Law Department (Xerox Square 20A, Rochester NY, 14644, Tel. 585-423-3015, FAX 585-423-5240). Also, comparable years of professional association activities. Some insights obtained from seeing prior drafts from William P. Berridge and Charles E. Van Horn are gratefully appreciated. However, this submission is made with the usual disclaimer that these comments are my own and do not necessarily reflect the views of any client or organization.

The undersigned strongly supports this initiative of the United States Patent and Trademark Office (USPTO) to conduct a study of changes needed to improve its present restriction system. The current restriction system is the direct cause of very large numbers of avoidable additional patent applications. Those many additional [separated claims, but otherwise almost identical] divisional patent applications and their prosecutions and maintenance impose very large time and effort cost burdens on both the USPTO and applicants. Also, they greatly delay or reduce the opportunity for obtaining additional and varied patent claims. The latter is needed for U.S. patents much more than in other countries. We have had nearly complete elimination of the

doctrine of equivalents, leaving only literal claim protection, or less. In the U.S. we have patent claim broadening only by the difficult and lengthy broadening reissue process, and only within an absolute two-year time bar. In patent litigation we now have frequent narrowing of even literal claim language by claim interpretation in Markman hearings and CAFC appeals.

Furthermore, it is becoming increasingly legally dangerous to split up and separately prosecute claims to the same basic subject matter in separate patent applications in the USPTO. Federal Circuit decisions have made differences in prosecution or art in one of the respective separated related applications available as defense weapons to narrow or invalidate patent claims in others.

Improper or unnecessary restriction requirements are wasteful and costly for both applicants and the USPTO. They divert scarce USPTO resources away from the fundamental purpose and focus of the application examination process of determining patentability of all claimed inventions and issuing patents in a timely manner. The time and cost burdens on the PTO clerical and examiner staff and applicants of handling all the extra paperwork (and error corrections) for tens of thousands of extra separate patent applications is obviously far greater than for handling additional claims in the same application. Furthermore, with less restrictions, the same examiner will only need to review only once, at one time, the same specification and drawings, rather than have all that work duplicated a year or more later, often by a different examiner. Thus, substantial PTO time savings and cost savings can be achieved by reducing restriction requirements and/or by allowing fee payments for examination of additional claims in the same application at the same time.

To the extent this desirable reduction in unnecessary separate patent applications and patents requires some compensating PTO fee increases, some members of Congress have suggested that the most publicly beneficial fee increases would be in the older patent (7.5 and 11.5 year) maintenance fees, because that helps to encourage the

Honorable Nicholas Godici
July 21, 2003
Page 3

reduction in older patent "deadwood" which imposes right to use and infringement study cost obstacles to the introduction of new products, as compared to increasing filing fees, issue fees, or 3.5 year maintenance fees, which would undesirably deter the filing and exploitation of new inventions. Some extra claim fees for examining extra claims that are truly 35 USC § 121 "independent *and* distinct inventions" may also be appropriate.

In conclusion, it is highly publicly desirable to implement a much better PTO "restriction" system that would reduce divisional patent applications. A system which would be more in line with the Patent Cooperation Treaty (PCT) style "unity of invention" standard would seem desirable to consider. However, it is noted that many of the questions asked by the USPTO in this Notice are (desirably) not limited to the latter subject. Thus, for example, consideration could be given to more emphasis on a simple minimum test such as the "obviousness" test required for interferences. Should not all claims which are §103 obvious in view of other claims logically be examined in the same application, irrespective of the form of the claim?

Whatever restriction system is utilized, a clear, unambiguous and correct MPEP, and constant examiner training, supervision and accountability, is essential to its successful administration.

There is an immediate need to correct and improve the present MPEP restriction basis instructions, and to improve and better supervise examiner restriction practices. MPEP Chapter 800, especially § 806.05 and its subsections, is prolix and confusing. Merely by way of examples, § 806 seems inconsistent with the 35 USC § 121 statutory requirement of "independent *and* distinct inventions" for restrictions, while §809.02(a) even encourages examiners to divide up patent applications by different *drawing figures* rather than by independent and distinct *claims*! The detailed discussion of further USPTO restriction inconsistencies in a two-part scholarly article by former USPTO expert Jon W. Henry in the September and October 2002 JPTOS is noted and recommended for review.

Honorable Nicholas Godici
July 21, 2003
Page 4

As the AIPLA has demonstrated, current USPTO restriction requirements (forcing tens of thousands of divisional applications) vary so widely between Tech Centers that there is obvious inconsistency in USPTO restriction practices, and such restrictions are currently increasing. As the AIPLA and my own 40 years of experience have also noted, historically the number of restrictions issued tends to cyclically increase until USPTO management is persuaded by public complaints to take action.

One reason why the present USPTO restriction practice system is subject to such restriction increase tendencies (or even outright abuse by some examiners), is that there are strong incentives for it, and few if any deterrents. The examiner receives much more credit for much less work [but not the applicant, or even the rest of the USPTO] by forcing the splitting up of one patent application into several applications with the same specification and drawings (and the USPTO obtains more fees). Also, under the present patent term statute, a mere restriction requirement [bizarrely] counts as if it were a real first office action, thereby "stopping the clock" on what would otherwise be a patent term extension for the applicant. Yet an examiner restriction requirement is not appealable. Petitioning from an improper restriction requirement is usually futile, especially in view of MPEP ambiguities and the time delay for a petition decision. Thus, many if not most applicants have given up even trying to petition from unnecessary restrictions. Many patent attorneys or agents also have inherent financial incentives to not fight against unnecessary USPTO restrictions, since it results in more divisional patent applications, even though that added cost and time delay rarely provides more claim protection to the client than should have been available in an unrestricted single application and patent. It only causes greatly increased filing, prosecution and maintenance fee costs for the client. However, some clients are not even being clearly informed that their total numbers of issued patents are being artificially inflated, with no real benefit, by unnecessary divisional patents containing claims that could have been obtained in a single patent. Needless to say, this is not in the public interest.

Turning now to the specific numbered questions (issues) raised in this USPTO request, the undersigned offers the following additional comments:

Issue 1:

- A. *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?*

Comment:

There is no perceived need for the USPTO to study ways to adopt EPO claim treatment practices. EPO claims have very different legal scope and interpretation, as discussed above. (The EPO also allows multiple dependencies.) U.S. applicants need much more flexibility to define various related aspects of their invention in a single application in different claim styles and scope for above-noted and other reasons. Applicants can be frustrated by the requirement in the EPO that additional features of an invention be claimed in a separate application unless the applicant is willing to include these features only in dependent claims. A single invention can encompass a number of separate features that lend novelty to a combination. Where these features are independently significant, additional applications should not have to be filed to fully protect the invention. E.g., different sub-combinations or different indicated end-uses. "A widget" and "A printer with said widget" ought to be in one patent. Likewise, many method and apparatus claims that are obvious in view of one another. There is no logical reason to require restriction where the difference between claims is a feature which is *prima facie* not novel or not independently patentable.

- B. 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?*

Comment:

As a practical matter, most examiners, other than for chemical cases, already strongly emphasize examination of independent claims. However, the law expressly requires that each claim, whether independent or dependent, must be considered on its own merits with respect to patentability. Also, the present practice of sometimes indicating allowance of certain dependent claims even if the independent claim is rejected greatly expedites prosecution. If the law were changed so that dependent claims were not searched and examined, serious problems would arise with respect to the 35 U.S.C. § 282 presumption of validity thereof.

Issue 2:

- A. 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 for lack of unity of invention in the same application?*

Comment:

Yes, applicants should have the option to pay a reasonable and actual-PTO-cost-related amount (which will be substantially less than the real costs of a divisional) for the examination of additional "inventions" (more accurately, usually different aspects of one invention) in the same application. Within reasonable limits it is appropriate for an applicant to be able to obtain related subject matter claimed in a single patent, and it will

provide significant overall USPTO cost savings, as discussed above. But this cannot be used to extract extra fees for unsupervised USPTO examiner allegations of “separate and distinct inventions” that are not.

- B. If so, should the USPTO consider any changes to the 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?*

Comment:

No. There is no logical basis for speculating that such a change, permitting applicants to pay for the examination of additional claims in a single application, would have a negative rather than positive impact on average pendency, as compared to the present USPTO restriction practice which causes the USPTO to spend the time to handle tens of thousands of additional separate divisional patent applications, the allowance of the claims of which is typically thereby delayed for years, and with reduced patent terms. By permitting the examination of multiple related inventions in a single application much greater efficiency in the overall process will be realized and overall delays in the USPTO will be reduced.

- C. 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 out for examination?*

Comment:

The assumption of increased, rather than reduced, delays here is illogical, as demonstrated in above comments which apply here as well. Also, the present patent term adjustment provisions are already far too complex, and need simplification. Revising the order of examination would be less needed with less divisionals. In reality, the PTO does not examine patent applications in order of their effective filing date anyway, as demonstrated by first action pendencies varying from 6 months to more than 4 years, "submarine" applications the PTO has failed to fully dispose of, and examiners who pick cases to work on out of order, avoid long requested interferences, and delay acting on high priority reissue examinations, or other "hot potatoes."

Issue 3:

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?

Comment:

No, applicants should always be given the opportunity to elect which "invention" is to be examined first. Given the long pendency before a first action in most cases, applicant priorities may have changed, or applicants may become aware of prior art that may make the patentability of a particular invention feature more problematic. In addition, by having examiners call applicants before imposing a search restriction, applicants may have an opportunity to persuade the examiner of the impropriety of the restriction requirement (or seek immediate supervisory review) before any search and examination

time is wasted. It makes little sense for the USPTO to waste scarce resources on the searching and examination of an invention feature in which applicants may no longer be interested.

Issue 4:

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 feature makes a contribution over the prior art?

Comment:

No. Such a “partial search” was done by some examiners (for only alleged § 101 issues) for many “software” patent applications several years ago, and was a disaster. Also, “Industrial applicability” is ambiguous and has never been a U.S. statutory criteria for patentability. [The USPTO has had enough trouble with “utility.”]

Issue 5:

Which of the following approaches should the USPTO propose in regard to any fee increases: (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)-(4) above.

Comment:

As indicated above, eliminating multiple applications and patents to protect the same subject matter will provide clear cost savings to the USPTO through reduced handling of applications, publications, patents, and other increased efficiencies, including a single examiner being able to examine at one time what would otherwise be multiple applications examined at different times. Accordingly, an assumption that the average cost of applications will *greatly* increase is unwarranted. However, assuming that fee increases must be imposed somewhat, then, as discussed above, the most publicly beneficial fee increases would be in the 7.5 and 11.5 year patent maintenance fees, because that helps to reduce right -to-use and infringement study cost obstacles to the introduction of new products without fee-detering the filing and exploitation of new patents on new inventions. Some extra fees for examining extra claims that are truly 35 USC §121 "independent *and* distinct inventions" may also be appropriate, but not at the level of unnecessary separate divisionals.

Issue 6:

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 MPEP 705; (3) maintaining the current process of a single examiner or an application; or (4) using some other option of how work is performed by examiners?

Comment:

The undersigned feels that these questions may be better answered by asking experienced USPTO examiners and their supervisors than by the undersigned. The AIPLA and others may have other suggestions. However, I suspect that keeping a single examiner responsible for timely office actions in an application will work better and faster than diffuse responsibility.

Issue 7:

Should the USPTO use its authority under the continued examination provisions of 35 U.S.C. § 132(b) (authorizes requests for continued examination or RCE practice) to permit applicants to pay an RCE fee and submit or rejoin claims to additional inventions after a 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? 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?

Comment:

This question seems to be construed differently by different patent attorneys. If what the USPTO is suggesting is to allow applicants for a fee to change the claim approach more substantially in an RCE, rather than to be forced to file a divisional, that is a good idea. But applicants should not be charged a fee for using the present "rejoinder" practice for dependent claims when a generic claim is allowed, since the initial restrictions from which rejoinder is an occasional rescue are largely necessitated by chemical case examiners simply assuming, for the first action, without basis, that no generic claims may be allowable.

Issue 8:

Should the USPTO use its authority under continued examination to permit requests that the USPTO continue examination of claims which were withdrawn from consideration? If so, how should the loss in issue and maintenance fee collections be offset relative to the current structure?

Comment:

Yes. The fee questions (and cost savings) have been addressed in other comments above.

Issue 9:

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)?

Comment:

I would hope that modification of the current restriction practice could be done without requiring any new legislation [except perhaps for fees?]. As discussed above, the MPEP needs revisions anyway. A new system that would prohibit restrictions between “unity” related inventions, in combination with an option for applicants to pay an

Honorable Nicholas Godici
July 21, 2003
Page 13

additional invention fee for examination of related inventions which do lack unity of invention, in a single application, would be the most expedient and effective way to address many of the current concerns of USPTO customers. 35 U.S.C. § 121 itself would not seem to need to be amended, as it gives discretion to the Director by the word “may” for restrictions. In any case, it is premature to consider any statutory change in 35 U.S.C. § 121 at least until the USPTO clearly describes the new practice that it intends to adopt. The USPTO could also desirably evaluate whether the most serious problems are with restriction standards and guidelines, or with examiner understanding and application, lack of examiner supervision, or other contributing factors.

Issue 10:

Do you have any other solutions to offer which are not addressed in this notice?

Comment:

Various suggestions have been above, including the need to address indicated present restriction practice problems and cost burdens immediately while consideration is also being given to new standards and new fees.

I appreciate this opportunity to provide these requested comments.

Thank you,

Paul F. Morgan
330 Oakdale Dr.
Rochester, NY 14618