

From:

Sent: Friday, August 13, 2010 11:04 PM

To: Restriction_Comments

Subject: Comments on Proposed Changes to Restriction Practice in Patent Applications - [Docket No.: PTO-P-2010-0030]

Attn.: Linda S. Therkorn

Re: Proposed Changes to Restriction Practice in Patent Applications

Please see the comments below, also attached in pdf-format.

Dear Sir:

I thank the Office for requesting comments on the issue of Restriction Practice, and welcome the Office's willingness to embrace new approaches in this area. This practitioner, the undersigned, is inspired to submit comments by more than 11 years practicing, or assisting others in practice, before the Office, mainly in the chemical and biotechnological arts.

The comments below are predicated on a desire to see a significant reduction in the costs currently borne by Applicants in all technology areas when responding to and traversing restriction requirements. I also believe that a streamlining of restriction practice in the manner suggested will lead to certain economies in the examination of applications that are related to one another under continuation practice or in subject area.

1) The Office should adopt the Unity of Invention standard

It is my recommendation that the PTO should move to the "Unity of Invention" standard (as defined in the Articles and Rules of the Patent Cooperation Treaty) for all U.S. utility patent applications. My principal reason for making this recommendation is that the Unity of Invention standard provides a workable approach that results in a predictable form of restriction, and one where reasonable minds would agree on the outcome of applying the standard to a given case.

One of the principal problems with restriction practice as currently implemented is that not only is whether to apply restriction at all within the examiner's discretion, but the actual form of the resulting restriction is also discretionary. This leads to a lack of predictability in the outcome. It also means that different examiners apply markedly different forms of restriction in closely similar cases, or even in the same case where a change of examiner has occurred.

By contrast, I anticipate that the close linkage between the examiner's search and the unity of invention analysis, which requires identification of a special technical feature that is also 'novel' over the existing art, would lead to a more efficient examination process as well as a more predictable form of restriction when applied.

Other submissions have addressed the practicalities, from the standpoint of examiner training, of the Office adopting Unity of Invention as a uniform standard for applications under 35 U.S.C. § 111(a) and § 371. I believe that there will additionally be benefits felt in the applicant community where a consideration of ‘unity’ at the time of claim drafting is likely to lead to more tightly crafted claim sets. Specifically, I expect that an appreciation of considerations of unity at the time of claim drafting will militate in favor of fewer independent claims in place of multiple independent claims in the same statutory class that do not share particular claim elements.

2) **A restriction should require at least one (1) independent claim per group.**

In the event that the Office declines to move to a unity of invention standard, certain aspects of current restriction practice should be foreclosed. In particular, I believe that the Office should prohibit restricting between dependent claims that properly depend from, and share the same statutory class as, a common independent claim. Similarly, I recommend that the “combination/subcombination” analysis should be removed from the list of possible grounds for restriction, at least because the analysis is often applied in a confusing manner or in a manner not envisaged by the MPEP.

3) **Restriction should be appealable** (i.e., not petitionable)

If the Office adopts the Unity of Invention standard, I recommend that a restriction (allegation of lack of unity) should be an appealable matter. For example, if a restriction is predicated on a particular feature being present in the art at the time of filing, Applicant should have the option to have such a decision overturned, should the cited art not disclose the feature in question, or should the cited art not itself be prior art.

Even if the Office declines to move to a Unity of Invention standard, and seeks ways to improve current restriction practice, making restriction decisions appealable remains desirable for at least the following reasons. Some Art Units are using restriction practice as a substitute for examination on the merits. For example, a claim that could be rejected as not enabled across its entire scope is instead being subjected to a restriction/election requirement that forces the Applicant to narrow the claim’s scope, often arbitrarily, before examination on the merits commences. If the underlying basis for this truncation of claim scope is not appealable, there is a fundamental imbalance in the examination process. Additionally, the Office has recognized the detrimental impacts on Applicants that results in a poorly-applied restriction: not least of these are the increased costs of prosecuting and maintaining multiple divisional applications. In some arts, the effect of restriction on claim scope is far more severe than any amendments that are made in response to rejections over prior art. Therefore, given the salient impact of restriction practice on prosecution, I recommend that Applicants be able to appeal a ground of restriction.

4) **A restriction made 'FINAL' should apply to subsequent continuations and divisionals**

I propose that a restriction cast once in an application family should not be changed in subsequent members (CON's/DIVs), even if they are examined by different examiners from the parent application. This requirement would apply as long as the claims presented in the subsequent applications are directed to inventions to which restriction was applied in the first application.

I believe that it would be a practical and efficient use of both Office and applicant resources if, once the PTO has applied restriction to a particular claim set, thereby delineating subject matter appropriate for separate subsequent divisional filings, that the applied form of restriction is not disturbed in the subsequent divisional or continuation filings.

As an example of what can occur in current practice, a divisional can be filed with claims to a single group born out of a restriction applied to a parent case, but then itself receive a new restriction applied within the single group but not previously applied in the parent. Such practice should be foreclosed. Benefits to casting a form of restriction once within a family include efficiencies for both the Office and Applicants, in that the onus is on the Applicant to challenge what is believed to be a faulty restriction when it is first applied. Once a restriction is made 'final in a first application, predictability of outcome of restriction would then apply to all subsequent applications related by common descent.

The comments herein are solely those of the undersigned and no representation is made that the comments have been endorsed or approved by any applicant that the undersigned currently represents, or has previously represented, before the Office. Nor do the comments represent the views of any Firm with which the undersigned is or has been associated with, or is or has been a member of.

Very truly yours,

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