

From:**Sent:** Friday, July 23, 2010 1:44 PM**To:** Restriction_Comments**Subject:** Restriction Comments -**Question 1 – Examination Burden**

I don't like the proposal to consider "examination burden" for two reasons. First, if a restriction is based in part on "examination burden" then there is a possibility that two patents may issue with claims that should have been included in the same patent. Stated differently, it increases the odds that two patents will issue for the same invention. The basis behind the notion that restriction enables a person to file a divisional application without fear of encountering a double patenting problem is that, to make a restriction requirement, the Examiner is required to find that the two groups of claims are patentably distinct. Allowing "examination burden" to be a factor in the decision making process guts this rationale. For example, presumably two sets of claims would be able to be restricted if they were (1) patentably distinct under the current standard; or (2) almost patentably distinct and which presented additional examination burden.

If consideration of the examination burden does not change the "patentably distinct" requirement into an "almost patentably distinct" standard, then why consider examination burden at all. Specifically, if two sets of claims are patentably distinct, then they are restrictable with or without consideration of the examination burden and, hence, introduction of this notion is not necessary. If consideration of the examination burden changes the standard from patentably distinct to a less strict "almost patentably distinct" then this presents a problem with the presumption that a divisional patent does not claim the same invention as the parent application.

At a minimum, the patent office should consider the implications associated with double patenting when considering whether to look at examination burden.

A second observation on the inclusion of examination burden – My gut instinct is that there will be additional burden with every set of claims. Imagine the following claim set: (1) claim to a network; (2) claim to a node on the network; (3) claim to a method of using node on the network; and (4) computer program product containing method steps. Each of these claims may be focused on the same general area, yet each contains a distinct set of considerations. The method, for example, may have the same method steps as the computer program product for implementing the method, yet it will raise 101 issues that are not raised by the computer program product. Depending on how the "examination burden" is implemented, Examiners may start restricting out claims whenever one set is rejectable under 35 USC 101 citing the additional burden of addressing the 101 issues associated with those claims. I encourage the patent office to not use "examination burden" as a criteria for restricting claims. If this standard is incorporated, very strict training and specific guidance should be provided. Further, review by SPE or other supervisor should be required whenever "examination burden" is invoked when making a restriction requirement.

question 6 - what other areas of restriction practice can be improved:

The main area that I find inequitable about restriction practice is the fact that the USPTO keeps the extra claim fees when it restricts claims out of a case. This is particularly difficult to explain to clients who do not have significant experience dealing with the US PTO.

Take the following hypothetical:

An application is filed with 4 independent claims and 30 total claims. When the application is filed, the applicant will need to pay for 10 extra claims ($10 \times \$50 = \500) and for 1 additional independent claim ($1 \times \$220 = \220). So, the total amount of extra claim fees that are required for the case is \$720.

Assume now that the Examiner looks at the case and enters a restriction requirement separating the claims into two groups:

Group I = claims 1-20

Group II = claims 21-30

Regardless of which set of claims is elected, applicants will not get what they paid for – they will not have claims in excess of 20 examined in this case.

My proposal, is that the Patent Office institute a refund process whereby the patent office will refund the extra claim fees if the benefit of the extra claims is not realized because the additional claims were carved out of the case through entry of a restriction requirement.

Returning to the unsophisticated client aspect – I explained to one of my clients that this was how the US PTO worked and they analogized this to a person ordering a car from a car dealer. The person elects to have air conditioning, leather seats, and electric windows as extras on their car. When the car arrives, it is the base model without air conditioning, with cloth seats, and with manual crank windows. If the dealer were to deliver this car to the person who ordered the car, any court in the country would find that the dealer had breached their contract and had not delivered what the person had ordered. At a minimum, the court would require the dealer to refund the extra money that was charged for the extras which weren't provided.

In this situation, the USPTO is doing precisely what the car dealer is doing. A client comes to the USPTO with a patent application and orders extra services – they pay to have extra claims searched and examined. The patent office then turns around and says that, although the client paid to have the claims searched and examined, that they are not going to do so. Then, the USPTO further refuses to repay the extra claim fees. The inequities of this practice are astounding, particularly to clients with limited budgets for filing patent applications.

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