

From:

Sent: Wednesday, August 18, 2010 11:19 AM

To: Restriction_Comments

Subject: ABA-IPL Technical Comments on Restriction Practice

Please see the attached document for the American Bar Association Section of Intellectual Property Law's Technical Comments regarding proposed changes to restriction practice.

Thank you,

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12 August 2010

Mr. Robert Stoll
Commissioner for Patents
Mail Stop Comments – Patents
P.O. Box 1450
Alexandria, VA 22313–1450

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

Dear Commissioner Stoll:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the “Section”) to provide comments in response to the request the United States Patent and Trademark Office (the “Office”) published in the Federal Register on 14 June 2010 (PTO-P-2010-0030). These comments have not been approved by the ABA House of Delegates or Board of Governors, and should not be considered to be views of the Association.

We have seen from the present request and the separate request for comments on the Strategic Plan that the Office is considering a change to restriction practices and a potential reengineering of the classification system. It is to these two issues we wish to comment.

The Section strongly favors and encourages the Office to adopt a rule change which would replace the present restriction practice with a practice based on the Unity of Invention standard that is currently applied to International Applications under the Patent Cooperation Treaty (PCT) (the “Unity of Invention Standard”). Further, the Section believes that, to accomplish this change, no amendment is necessary to title 35 United States Code (35 USC). However, if the Office makes a determination that changes are required to 35 USC to provide for operation under the Unity of Invention Standard, the Section would favor the enactment of such legislation and would be supportive of the Office in seeking such legislation.

As provided in MPEP 1850, which implements the Unity of Invention Standard under PCT Rule 13 when the United States is the International Search Authority for an International Application, the Unity of Invention Standard requires that an international application “should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept.” Moreover, where there are groups of invention, unity of invention exists where the claims all recite “a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.” Special technical features are those features “that define a contribution which each of the inventions, considered as a whole, makes over the prior art.”

The Section has long been in favor of the Unity of Invention Standard. We believe that there are significant reasons to change from the current Restriction Practice to a Unity of

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Invention Standard in the manner that is currently applied to International Applications under the Patent Cooperation Treaty (PCT).

1. Statutory Consideration – At present, the basis for divisional applications is contained in 35 U.S.C. §121. Such provision recites that restriction may take place when there are “two or more independent and distinct inventions” which are claimed in one application; nothing in the statute requires that the Office impose a restriction on subject matter claimed, thus freeing the Office to determine by rule when—and to what extent—restriction is appropriate (*i.e.*, 35 U.S.C. §121 provides only that “the Director *may* require the application to be restricted ...”). Beyond that, no statutory definition is provided for determining when there is more than one “independent and distinct invention” claimed in a single application. Furthermore, we believe that there are no judicial decisions requiring that the determination of “independent and distinct inventions” be based upon the current restriction practice as outlined in the rules and the MPEP. Accordingly, the Section believes that the Office could move to the Unity of Invention Standard without the need for statutory modification. This position is supported by the fact that national phase PCT patent applications result in US patents that have been granted using the Unity of Invention Standard without adverse consequences. Thus, it is evident that the Unity of Invention Standard can fit well within our current statutory scheme. The Section nonetheless acknowledges that certain statutory changes, such as ones relating to search and examination fees, may be needed depending upon the implementing rules for the use of the Unity of Invention Standard. These changes need not be addressed now. Nevertheless, the Section believes that it may be possible to implement the Unity of Invention Standard without any statutory change to 35 U.S.C. § 41.

2. Increase in PCT National Phase Cases - National Phase Applications filed in the Office from PCT originated applications require US examiners to use the Unity of Invention Standard on those cases rather than utilizing US Restriction Practice. Presently, national phase applications account for about 12% of all US applications. Accordingly, all examiners should already be trained in handling the Unity of Invention Standard. The use of PCT continues to grow throughout the world (142 countries are now members of the PCT, and more are expected in the coming years), and consequently more cases are entering the United States as PCT National Phase than ever before. Additionally, as this number keeps growing, examiners have increased occasions to use the Unity of Invention Standard. For examiners to continuously shift from the current restriction practice on certain cases to the Unity of Invention Standard on other cases, makes it challenging and difficult for the examiners, and unfortunately often blurs the distinction between the two standards, causing them to possibly improperly apply an incorrect standard. Since the PCT mandates the Unity of Invention Standard be applied to National Phase applications and we are obligated by the treaty to do so, it would be more useful and practical to examiners to have a uniform standard for both US domestic, as well as PCT National Phase patent applications and thereby permit examiners to improve their handling of a uniform Unity of Invention Standard for all cases. This would improve the quality of the patent application prosecution process by the correct application of a single Unity of Invention Standard.

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3. Work Sharing – The Office, like other patent offices around the world, has realized the need for work sharing in order to avoid duplication of work and to reduce backlogs. The Office already has a number of existing programs making use of the work done by examiners in other patent offices and has a number of additional proposals for increasing such work sharing opportunities. The Patent Prosecution Highway (PPH) has been established for a number of years and has proven to be an extremely successful opportunity to make use of the work done by other examiners. The proposed Three Track System, the SHARE Project, and other proposals all focus on making use of work sharing to address backlog reduction and enhance the quality of the examination in the Office. As almost all of the patent offices around the world providing a work sharing product to US examiners already use the Unity of Invention Standard, acceptance of the Standard by the U.S. would enhance the ability to make use of such work sharing products. In fact, under the PPH System, it has been found that most of the rejections issued by US examiners after receiving allowed claims from foreign patent offices, relate to the US application with regard to Restriction Practice. Because the current US Restriction Practice differs from the Unity of Invention Standard, it increases the number of rejections requiring extra time by examiners, provides delays to applicants, and impedes effective use of the PPH, as well as other proposed work sharing programs. Changing to the Unity of Invention Standard would be consistent with the US goal of making better use of a work sharing product from other patent offices. Further, the impact of the recent introduction of the PCT PPH, and the subsequent use of this resource vehicle by even more applicants, will result in even more cases being substantively examined in the US, relying on prior work product where the Unity of Invention Standard has been applied during the PCT search and examination.

4. Reduction in Applications Filed – The Office, in trying to reduce backlogs, continuously addresses the need to reduce the number of applications, especially “rework” applications, such as RCEs. To a great extent, divisional applications also constitute “rework applications” as essentially the same text must be restudied time and time again, each time a divisional application is filed. To the extent that the Unity of Invention concept is applied, and it is permitted to retain related subject matter having unity of invention in the same application, it reduces the number of applications spanning over many years and focuses the attention of an examiner to address only once all aspects of the “same inventive concept” in all its related ways, thus reducing the total number of hours being applied to what should be considered as a related invention under a single inventive concept that makes a contribution over the prior art.

5. Searching Capabilities – Over the last few years, electronic searching capabilities have been substantially improved making it easier for examiners to search prior art electronically without the need for addressing paper documents. As a result, searching related inventions under a single inventive concept standard becomes easier by utilizing such computerized searching techniques. Method and apparatus claims relating to the same inventive concept are no longer as challenging to search as they used to be when it was necessary to search through paper files. Further, the use of electronic searching has made the historical concerns about differing classification criteria utilized by various offices far less significant. As a result, it is less of a burden on examiners today to search such inventions that relate to a same special technical feature.

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6. Business Environment – Retaining the same claims relating to a single inventive concept in a single application benefits both the applicant and third parties. Typically, claims relating to the same inventive concept all address the same commercial embodiment. An applicant having all of his or her claims to related inventions having unity of invention contained in a single patent - rather than be forced to prosecute and maintain multiple patents relating to the same commercial embodiment - is cost effective, more efficient, and easier to manage. Furthermore, it becomes very complex to portfolio management when foreign countries have a single patent on an invention while multiple patents are issued in the US. Likewise, for third parties, it is easier to address the claims relating to a single product in a single patent rather than have to address them serially in multiple patents which may issue at multiple different times from different examiners, often with different understandings and claim issues. One examiner handling a method claim and another examiner handling an apparatus claim often approach them differently and third parties are challenged to find consistency in the examiners' handling of these separate patents and difficulties in addressing what is really a single product that should be considered as a single invention in a single patent. Maintaining all of the claims in one application to be examined by one examiner provides consistency in approach to that invention and is easier for third parties to address the claim scope relating to a single commercial embodiment.

7. Markush Claims – Currently, applicants who seek patents on inventions characterized by Markush groups, or nucleic acid/amino acid sequences, or both, are faced with particularly difficult situations. Such applicants find restriction practice applied not only among claims but within a single claim. Often, rejections based upon “improper Markush Groups” burden applicants in these fields with splintering the invention into a multitude of separate applications. Not only do these rejections impose burdens on applicants, but they also provide an increased burden on the Office to search multiple inventions at different times, often within the same broad categories. We believe that, properly applied, the Unity of Invention Standard would eliminate these types of rejections and be more consistent with the case authorities, such as *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978); *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978); and *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980).

8. Harmonization – Although harmonization treaty discussions have not progressed, the Office, along with other patent offices, continue to work for the possibility of reaching harmonization among the patent offices, at least in some specific areas. The change by the Office to the Unity of Invention Standard would facilitate the ability to provide cooperative searches among patent offices, exchange between examiners, more uniformity in patent family claims, and, of course, increased work sharing benefits. To a great extent, the US Restriction Practice is unique and is different from substantially all of the other patent offices around the world which conform to the Unity of Invention Standard. For the Office to change and utilize the Unity of Invention Standard utilized uniformly by all of the other patent offices would help move harmonization forward among the various patent offices.

9. Consistency of Practice - Further, approximately 50% of the applications filed in the US originate from outside of the US. Foreign originated cases are all written and claimed under unity of invention practice. Thus, those foreign originated cases filed in the US are already

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tailored and generally claimed for unity of invention practice. This difference results in extra work by the examiners, extra delay, extra time, etc. This shortcoming could be substantially eliminated by the US accepting the Unity of Invention Standard, as has the rest of the world.

In closing, the Section appreciates the Office asking for input on how to have more timely and effective prosecution of patent applications coupled with the issuance of quality patents.

If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Very truly yours,

Marylee Jenkins
Section Chairperson
American Bar Association
Section of Intellectual Property Law