

February 11, 2016

Via email: TopicsSubmissionForCaseStudies@USPTO.gov

Attention: Michael Cygan

Re: Comments on "Request for Submission of Topics for USPTO Quality Case Studies,"
Federal Register, Vol. 80, No. 244, Dec. 21, 2015

Enclosed please find a Quality Case Study Submission entitled "Survey of Non-compliant
Restriction Requirements, including Non-compliant Lack of Unity Determinations

Please note that our topic submission is being made personally and may not reflect the views of
our employers.

Thank you for your consideration

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Quality Case Study Submission-
Survey of Non-compliant Restriction Requirements, including Non-compliant Lack of
Unity Determinations

Title: Survey of non-compliant Restriction Requirements, including non-compliant Lack of Unity Determinations

Proposal for Study: Survey the reviews OPQA has already gathered for (i) Restriction Requirements which were found non-compliant with 35 U.S.C. § 121 and the guidance in MPEP Chapter 800 and (ii) Lack of Unity Determinations which were found non-compliant with PCT Rule 13 and the guidance of MPEP Chapter 1800.

Explanation: Restriction is the process of permitting applicants to elect one invention for search and examination, when two or more inventions are claimed in a single application. In our experience as patent practitioners, we have noticed inconsistent practice with respect to the completeness and correction of restriction requirements, including lack of unity determinations.

Two forms of restriction practice are currently applied to utility applications filed at the USPTO:

Multiple inventions presented in the national phase entries of PCT applications, filed in compliance with 35 U.S.C. § 371, (“371 application”) are subject to consideration under the “unity of invention” standard of PCT Rule 13 as guided by MPEP Chapter 1800. In addition, Chapter 10 of the Patent Cooperation Treaty (PCT) International Search and Preliminary Examination (ISPE) Guidelines applies the Unity of Invention criteria to 39 claim sets representative of the various technology areas (Mechanical, Electrical, Chemical, Biotech, etc.) *See* pages 80-95 of the ISPE Guidelines.

Multiple inventions presented in applications filed under 35 U.S.C. § 111(a) (“US application) are subject to consideration under the “independent and distinct” standard of 35 U.S.C. § 121 and the guidance of MPEP Chapter 800. MPEP Chapter 800 does not include examples to demonstrate how US restriction practice should be applied to representative claim sets of different technologies.

Because the USPTO is the only major patent office in the world that applies a standard different from Unity of Invention, the USPTO is in the unique position of being able to compare compliance (or non-compliance) of the Unity of Invention Standard, in general, to that of another standard.

As part of the on-going Quality assessments, the Office of Patent Quality Assurance (OPQA) has been reviewing complete first Office actions on the merits (FAOMs) to ensure, among other things, that “the Examiner properly handled Restriction issues.” *See* “Other Prosecution Matters” on page 2 of the OPQA Review Form attached as Appendix A.

We propose a survey which would build upon the reviews and data already collected by OPQA. We suggest limiting this Case Study to OPQA reviews in which errors, non-compliances or issues pertaining to the restriction requirement or the lack of unity determination have already

been identified. We believe that the USPTO could rely upon application file metadata to sort the complete FOAMs which have already been found non-compliant (errors or needs attention) by OPQA into two groups:

- “US applications” which are subject to US restriction practice and
- “371 applications” which are subject to PCT Unity of Invention practice.

For each group, common types of restriction or unity of invention errors could be identified from a survey of FOAM reviews that OPQA has already prepared. Similar types of errors could be lumped together and then the number of errors ranked by type to create two listings of common errors. It is expected that a listing of common errors found in US Restriction Requirements and a listing of common errors found in Unity of Invention Determinations could be used for training and review purposes. Because this survey would be retrospective in nature and would rely upon a compilation of data from reviews which have already been performed, minimal Office resources would be required.

We also propose that during the course of this review, claim sets representative of the various technology areas could be created and used to demonstrate proper application of the US Restriction Practice. We anticipate that examples of US Restriction practice, as it is applied to representative claim sets, could be used as training materials and a resource for Examiners and SPEs to ensure compliance with the US restriction standard. Representative claim sets also would help practitioners draft claims for US applications in a manner that would ensure division in a manner more consistent with US restriction practice.

Our proposal relates to Pillar 1- Excellence in Work Products. Office actions which contain incorrect or incomplete restriction requirements are covered under OPQA’s in-process review compliance (percent of final and non-final actions reviewed in which no examination deficiency is found). Reducing the number of improper restriction requirements would enhance the quality of non-final and final office actions. Non-compliant restriction requirements, including non-compliant lack of unity determinations, may result in incomplete follow-on Office Actions, in which less than the full number of claims to which applicant would have been entitled (had the correct restriction been made) are examined on their merits. Also, if the examiner has not provided a clear demarcation of subject matter in the restriction requirement, or the lack of unity determination, the resulting patent(s) may contain overlapping subject matter which improperly receives benefit of the safe harbor under 35 U.S.C. § 121. Eliminating or reducing the number of noncompliant restriction and lack of unity requirements would enhance the quality of non-final and final office actions and issued patents.

Appendix A

OPQA Allowance, In-Process, Final Disposition, and Complete FAOM Reviews

OPQA ALLOWANCE, IN-PROCESS, FINAL DISPOSITION, AND COMPLETE FAOM REVIEWS

Review Category and Item				
Omitted Rejections	Complete FAOM Review	IPR Form Non-Final Actions	IPR Form Final Rejections	Allowance Review Form
35 U.S.C. 102	✓	✓	✓	✓
35 U.S.C. 103	✓	✓	✓	✓
35 U.S.C. 112 1 st , Written Description	✓	✓	✓	✓
35 U.S.C. 112 1 st , Enablement	✓	✓	✓	✓
35 U.S.C. 112 2 nd	✓	✓	✓	✓
35 U.S.C. 101 (Utility)	✓	✓	✓	✓
35 U.S.C. 101 (Non-Statutory)	✓	✓	✓	✓
Double Patenting	✓	✓	✓	✓
Other	✓	✓	✓	✓
Reasonableness of Rejections	Complete FAOM Review	IPR Form Non-Final Actions	IPR Form Final Rejections	Allowance Review Form
35 U.S.C. 102	✓	✓	✓	
35 U.S.C. 103	✓	✓	✓	
35 U.S.C. 112 1 st , Written Description	✓	✓	✓	
35 U.S.C. 112 1 st , Enablement	✓	✓	✓	
35 U.S.C. 112 2 nd	✓	✓	✓	
35 U.S.C. 101 (Utility)	✓	✓	✓	
35 U.S.C. 101 (Non-Statutory)	✓	✓	✓	
Double Patenting	✓	✓	✓	
Other	✓	✓	✓	
Clarity of Rejections	Complete FAOM Review	IPR Form Non-Final Actions	IPR Form Final Rejections	Allowance Review Form
35 U.S.C. 102	✓	✓	✓	
35 U.S.C. 103	✓	✓	✓	
35 U.S.C. 112 1 st , Written Description	✓	✓	✓	
35 U.S.C. 112 1 st , Enablement	✓	✓	✓	
35 U.S.C. 112 2 nd	✓	✓	✓	
35 U.S.C. 101 (Utility)	✓	✓	✓	
35 U.S.C. 101 (Non-Statutory)	✓	✓	✓	
Double Patenting	✓	✓	✓	
Other	✓	✓	✓	
Other Rejection Matters	Complete FAOM Review	IPR Form Non-Final Actions	IPR Form Final Rejections	Allowance Review Form
35 U.S.C. 102: Claim limitations matched to the art	✓			
35 U.S.C. 102: Statement of inherency clearly explained	✓			
35 U.S.C. 102: Statement of inherency clearly explained	✓			
35 U.S.C. 103: Claim limitations matched to the art	✓			
35 U.S.C. 103: Differences clearly stated	✓			
35 U.S.C. 103: Modification or combination of references clearly explained	✓			

35 U.S.C. 103: Motivation/reasons for obviousness present				
35 U.S.C. 103: Inherent teachings clearly explained	✓			
Other Prosecution Matters	Complete FAOM Review	IPR Form Non-Final Actions	IPR Form Final Rejections	Allowance Review Form
Interviews: Record of interview is clear and complete	✓			
Interviews: Interview was examiner-initiated and substantive in nature	✓			
Examiner properly handled Sequence Compliance Issues	✓			
Examiner properly handled Restriction issues	✓			
Examiner properly treated Claims for Priority	✓			
Examiner properly treated matters of substance in papers filed by applicant prior to examination	✓			
Search report from another office present and properly evaluated	✓			
Early and correct indication of allowable subject matter	✓			
Action provides correct suggestions to overcome rejection(s)	✓			