

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 Restriction, Including Lack of Unity Determinations in PPH Applications, where the USPTO is the Office of Later Examination."

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 Restriction, Including Lack of Unity Determinations in PPH Applications, where the USPTO is the Office of Later Examination

Title: Survey of Restriction Requirements, including Lack of Unity Determinations, set forth in Patent Prosecution Highway (PPH) cases, where the USPTO is the Office of Later Examination (OLE).

Proposal for Study: We propose that the USPTO survey Restriction Requirements, including Lack of Unity Determinations, set forth in U.S. applications accepted into the Patent Prosecution Highway (PPH) program, where the USPTO is the OLE.

Explanation: In our experience as patent practitioners, we have noticed (i) inconsistencies in the manner in which Unity of Invention under PCT Rule 13 is applied by USPTO as compared to other patent offices in the world, and (ii) disparities in the scope of invention or number of claims under examination following a lack of unity determination set forth by the USPTO as compared to other patent offices.

Variation is to be expected when the subject matter in the U.S. application lacks one-to-one correspondence with the subject matter under review by another office. For example, when the claim set of the U.S. application varies either in scope or category of inventions from that of the corresponding PCT, national or regional application under review in another office, any restriction requirement or unity of invention determination set forth by the USPTO and that of the other office may result in different groupings of the claims under examination.

Also, when the claims of the U.S. application are not entitled to the same effective filing date as the claims in the corresponding PCT, national or regional application under review in another office, the pool of prior art available to the USPTO may not be consonant with the pool of prior art available to the other office, thereby frustrating the goals of international harmonization and work-sharing. Because PCT Rule 13 defines unity of invention in terms of “contribution over the prior art,” different pools of prior art may reasonably result in different lack of unity determinations and even different patentability outcomes. These differences impact efforts for patent harmonization- “the alignment of laws and procedures among intellectual property systems to ensure consistency and clarity of rights for the world’s innovators.”¹

Since 2006, and in conjunction with several other offices, the USPTO has offered expedited examination under the PPH program. Applicants who have received a favorable examination on patent claims in one participating office (the office of earlier examination, or “OEE”) can request accelerated examination of a corresponding application filed in a second patent office (the office of later examination, or “OLE”). The PPH program encourages

¹ “Harmonization: The Time is Now” available at

examiners in an OLE to consider and use the search and examination results which had been obtained in an OEE. The PPH program provides for more consistent and efficient processing, by accelerating examination, improving the quality of examination and avoiding duplication of work.

On Feb, 20, 2014, in order to consolidate and streamline ongoing international work-sharing initiatives, the USPTO announced its participation with twenty-two other patent offices in the Global PPH and IP5 PPH pilot programs.² U.S. applications will be subject to the same eligibility requirements for participation in either the Global PPH program or the IP5 PPH program.

In brief, in order to be eligible for participation, the U.S. application must have the same earliest priority date or filing date as that of the corresponding application filed in another Global/IP5 PPH and must contain at least one claim indicated by the OEE as allowable or patentable. All claims in the U.S. application must be of same or similar scope and be directed to the same category of invention as the allowable or patentable claims in the corresponding OEE application. For example, if only product claims were examined and found allowable by the OEE, a U.S. application which also includes claims to a method of use would not be eligible for participation in the Global PPH or IP5 PPH pilot programs.

The eligibility requirements of the Global/IP5 PPH program screen out applications with different claim sets and/or different effective priority dates. In short, we believe the Global/IP5 PPH program is creating a population of applications which can be used to compare how the USPTO's restriction practice, including Unity of Invention practice aligns with that of other PPH participating offices. We believe that the eligibility requirements of the Global/IP5 PPH program ensure that a survey of restriction requirements and lack of unity determinations in PPH application where the USPTO acts as OLE will provide meaningful results.

Methodology:

We suggest the following methodology:

1. Identify U.S. applications which contain a granted petition for acceptance into the Global/IP5 PPH program, where the USPTO is the OLE, to create Subset 1.
2. Review the PPH-accepted applications of Subset 1, identify those which contain a written restriction requirement, including a lack of unity determination, to create Subset 2.
3. Confirm that the U.S. applications of Subset 2 were actually eligible for PPH program: Review the claims correspondence chart to ensure that (i) all claims in the U.S. application are of same or similar scope, (ii) no claims have been added which are directed to a different statutory category of invention and (iii) all claims are entitled to the same effective filing date as that of the corresponding application filed in the OEE.³ The resulting applications would be called Subset 3.

² "Implementation of the Global and IP5 Patent Prosecution Highway (PPH) Pilot Programs with Participating Offices" available at <http://www.uspto.gov/patents-getting-started/international-protection/patent-prosecution-highway-pph-fast-track>

³ U.S. applications which fail Step 3 appear to have been ineligible for the PPH program.

4. Sort the applications in Subset 3 into two groups:
 - A. Those filed under “the Paris Route” – under 35 U.S.C. 111(a) as U.S. applications which are eligible for review under the “independent and distinct” standard of 35 U.S.C. 121 and MPEP Chapter 800, to create Subset 4A and
 - B. Those filed as national phase entries in compliance with 35 U.S.C. 371, which would be eligible for review under the “Unity of Invention” standard of PCT Rule 13 and MPEP Chapter 1800, to create Subset 4B.
5. For Subset 4A, review the USPTO’s Restriction Requirement for compliance with the “independent and distinct” standard of 35 U.S.C. 121 and MPEP Chapter 800.
6. For Subset 4B, review the USPTO’s Lack of Unity Determination for compliance with PCT Rule 13 and MPEP Chapter 1800.

We propose that the results obtained from Item 5 would be useful for comparing the differences between the implementation of US Restriction Practice to that of PCT Unity of Invention. Because the USPTO is the only patent office in the world to practice US restriction, the USPTO is in a unique position to be able to study the differences (number and types of claims under examination) between US Restriction Practice and PCT Unity of Invention Practice.

We propose that the results obtained from Item 6, would be useful on several levels. The Unity of Invention determination hinges upon the identification of prior art to show that the same or shared corresponding technical feature does not make a contribution over the prior art. First, the failure to cite prior art in a lack of unity determination would suggest non-compliance with PCT Rule 13. Second, improperly citing prior art (i.e., citing prior art which does not meet the limitations of the claims or citing prior art which is published after the effective filing date) would indicate lack of compliance with PCT Rule 13 and potential concerns with respect to anticipation and obviousness rejections. Third, identification and proper application of prior art in the USPTO’s Lack of Unity Determination which had not been found or relied upon by the OEE would identify areas where harmonization efforts can be improved.

Relationship to Patent Quality: Our proposal relates to Pillar 1- Excellence in Work Products. Office actions which contain incorrect restrictions 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 requirement, including unity of invention determinations, would enhance the quality of non-final and final office actions. Conversely, identifying applications for which the USPTO has found prior art upon claims of same or similar scope in the corresponding application that the OEE had found patentable or allowable, may help USPTO determine the extent to which they may rely upon the findings of an Office of earlier examination. Overall, by studying how the USPTO and other patent offices restrict claims for examination on the same groups of inventions, this proposal will help advance the goals of international harmonization and work-sharing.