

Attached is a proposed Topic for USPTO Quality Case Study.

Thanks for this opportunity,
Rob McDermott

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RESTRICTIONS

A TOPIC FOR USPTO QUALITY CASE STUDIES

Proposal for Study: Unnecessary restrictions are a primary cause of redundant prosecutions of the same invention.

I have been prosecuting patents for 20 years, and to date have prosecuted over 1400 patent applications. For the most part, I am very impressed with the quality of examination. A substantial majority of patent Examiners are truly professional, in every sense of the word, with respect to assuring that true inventions are recognized and allowed, and questionable inventions are challenged.

Unfortunately, however, not all Examiners are interested in providing a quality product, and I've found that there are certain "tells" that forewarn me that the quality of examination is likely to be poor. One of the first signs of a problem is the issuance of an unnecessary restriction requirement, where it is apparent that the Examiner is using the restriction to reduce the number of claims that need to be examined.

A classic example of an 'unnecessary' restriction is an invention for a new communication encoding/decoding scheme, wherein independent claims address the transmitter that encodes the data using the new protocol and the receiver that decodes the data using the new protocol, and the Examiner requires a restriction among these 'distinct' inventions (transmitter patent, receiver patent). Obviously, the development of a viable encoding scheme necessarily requires a means for decoding the encoded data, and these two aspects of such an invention are not two different inventions, per se.

This is particularly problematic for small entities in that it substantially increases the cost of prosecution, and doubles the issue and maintenance fees for no apparent reason. From a quality viewpoint, each of these subsequent patents is half the value/quality of the patent that could have / should have been granted without the Restriction Requirement.

I recommend that the topic of Restrictions be addressed in this pilot program. Some example areas to be investigated are:

1. The distribution of Restrictions among Examiners: For example, if it's found that 90% of all Restrictions are generated by 10% of the Examiners, this could indicate a problem. In like manner, if 90% of the Restrictions are issued by 'junior' Examiners, this may indicate a need for improved training.
2. The speed of prosecution of the Divisionals after each restriction. If it's found that most Divisionals 'breeze through' prosecution after the parent is allowed, that would likely suggest that searching the subject matter of the Divisional did not amount to a 'significant burden' as would have been asserted in the Restriction.
3. The proportion of filed Divisionals after each restriction, by entity type. My large-entity clients routinely file a Divisional upon allowance of the parent; but many of my small-entity clients routinely decline to incur the costs of a Divisional, thereby giving up claims that rightly belonged to them, and would have been theirs absent the Restriction.
4. The proportion of Restrictions that are petitioned to the Commissioner, and the success rate. Conversations with fellow practitioners indicate that such petitions are 'a waste of time'. If filing a petition is actually a viable option, advising your stakeholders of this fact would go a long way to curing this problem.
5. The role of the Ombudsman in resolving Restriction Requirements. My experience has been that the Ombudsmen do not view solving disputes regarding Restrictions is in their areas of concern.

Thank you,
/Robert M. McDermott/
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