Request for Comments (RFC): USPTO Initiatives to Ensure the Robustness and Reliability of Patent Rights

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Public webinar
The USPTO published an RFC on potential initiatives directed at bolstering the robustness and reliability of patent rights in the Federal Register on October 4, 2022.


- Deadline for submitting comments: **February 1, 2023**
  - Comments must be submitted via regulations.gov
  - Portal closes at 11:59 pm ET
How to submit a comment

To submit a comment:

• Visit regulations.gov on or before February 1, 2023;
• Enter “PTO-P-2022-0025” in the docket search field and click “Search.”
How to submit a comment

The search results page, where the RFC is identified as a “Notice,” with the title “Initiatives to Ensure the Robustness and Reliability of Patent Rights” and a posted date of “Oct 3, 2022”
How to submit a comment

On the search results page, click “Comment.”
How to submit a comment

The comment form page, where you may submit your comment by typing it directly into a field (solid arrow) and/or by attaching a file(s) (dashed arrow).
How to submit a comment

The comment form page requires the submitter to identify themselves as an individual, an organization, or anonymous.

- An Individual
  - If you or another single person is the author

- An Organization
  - A company, organization, or government agency

- Anonymous
  - If you do not want an entity associated with the comment
How to submit a comment

When you are ready to submit your comment, complete the reCAPTCHA (solid arrow) and click “Submit Comment” (dashed arrow).
The patent system:

- Patent disclosures facilitate the broader dissemination of public knowledge to promote innovation and competition.
- In exchange for public disclosure, if the invention meets the requirements for patentability, the USPTO grants a patent (i.e., a time-limited right to exclude others from making, using, importing or selling the patented invention).
- Patent rights both incentivize disclosures and incentivize and protect new and nonobvious innovation.
- Patent rights that are robust and reliable best fulfill their intended purpose of furthering the common good, incentivizing innovation, and promoting economic prosperity.
Robust and reliable patents:

- Clearly define the scope of the patent rights
- Meet the requirements for patentability set out in the patent statutes as interpreted by the courts
- Provide inventors, patent owners, and investors a reasonable expectation that the patent rights will survive scrutiny if challenged in proceedings at the USPTO (e.g., post-grant review, inter partes review), district court, or other forum
To obtain public input on potential initiatives directed at bolstering the robustness and reliability of patent rights:

- Enhancing examination by ensuring that examiners have the relevant prior art and clear support in the specification to examine the claims effectively and efficiently
- Revising request for continued examination (RCE) practice
- Revising restriction, divisional, and rejoinder practice
- Revising non-statutory double patenting practice
- Addressing a concern raised in a June 8, 2022, letter to the USPTO from six United States senators
Examiner searching initiatives
Examiners search and review prior art

What is prior art?

• Information available to the public before the effective filing date of a U.S. patent application

• Examples:
  – U.S. patents and published patent applications
  – Foreign patents and published patent applications
  – Journal and magazine articles
  – Books, manuals, and catalogs
  – Websites, social media, and other online publications
  – Conference proceedings
  – Scientific papers
What are the public use and on sale bars?

• Under the patent statute, patentability may be precluded by evidence that the following took place before the effective filing date of the claimed invention:
  – Uses that are public anywhere in the world
  – Sales or offers for sale, without regard to where the sale activity took place

• Certain uses or sales are excepted by the statute.
  – E.g., uses or sales by the inventor or a joint inventor (or that originated with the inventor) that precede the effective filing date by less than one year

• Evidence of these bars to patentability are typically less accessible to examiners.
RFC questions: Examiner searching

- Are there specific sources of prior art not currently available to examiners that examiners should be searching?

- How should the USPTO facilitate an applicant’s submission of prior art that is not accessible in the Patents End-to-End system, e.g.,:
  - “On sale” information
  - Prior public use information
Claim support and continuation practice
What are claims?

• A patent application usually contains the following parts:
  – The “disclosure” or “written description,” which includes both drawings and textual information (called the “specification”) providing more information about the invention
  – One or more claims, which define the invention and what aspects are legally enforceable

• Utility applications may contain multiple claims, which define the invention in words

• Design applications contain only one claim, which covers the ornamental design for an article of manufacture (e.g., a shoe, bottle, or phone)
1. A headgear apparatus, comprising:
A headband member having a frontal portion;
a visor member removably secured to said frontal portion of said headband; and
an eye shield member removably secured to said frontal portion of said headband.
Disclosure must support claims

- To justify the grant of a patent, the law sets forth minimum requirements for the quality and quantity of information that must be contained in an application.

- For example, the claims of an application must be supported by the disclosure of sufficient information in the specification to:
  - Demonstrate that the inventor had possession of the full scope of the claimed invention at the time of filing (written description)
  - Enable those skilled in the art to make and use the full breadth of the claimed invention (enablement)
Examiners evaluate support

• A question as to whether a claim is adequately supported by the specification may arise at any time during prosecution, especially when:
  – An existing claim is amended
  – A new claim is added
  – A new claim is presented in a continuing application

• A continuing application seeks the benefit of the filing date of an earlier-filed application(s)
  – Continuation, divisional, or continuation-in-part applications
  – Each claim in a continuing application may benefit from the filing date of the earlier application if the claim is adequately supported by the earlier application
RFC questions: Support for patent claims

• How, if at all, should the USPTO change claim support and/or continuation practice?

• For example, should the USPTO:
  – Require an explanation of the support in the disclosure for new and amended claims?
  – Require an explanation of support in every prior-filed application for which benefit of an earlier filing date is sought?
  – Require that claims find antecedent basis in the written description?
  – Require a showing of support for genus or Markush claims?
RFC questions: Continuation practice

• Should the USPTO require a description of new subject matter in continuing applications?

• Senators’ questions:
  – Second look by team of patent quality specialists?
  – Heightened examination requirements?
  – Time limit for filing?
Request for continued examination (RCE) practice
RCE practice initiatives

• A Request for Continued Examination (RCE) is a procedure under which an applicant may continue examination of an application in which prosecution is “closed,” meaning the application is under:
  – A final rejection or appeal
  – A notice of allowance
  – An action that otherwise closes prosecution in the application (e.g., a Quayle action)

• An RCE must be filed together with the appropriate fee and a submission.

• An RCE is not the filing of a new application.
RFC questions: RCE practice

• How, if at all, should the USPTO change RCE practice?

• For example, should the USPTO, after an application reaches a certain threshold number of RCE filings:
  – Transfer the application to a new examiner?
  – Increase the scrutiny given in the examination?
Restriction, rejoinder, and divisional practice
Restriction practice

Restriction

• The practice of requiring an applicant to elect a single claimed invention (e.g., a product or process invention, a species within a genus) for examination when two or more independent inventions and/or two or more distinct inventions are claimed in an application
  – A determination by the USPTO that each of the restricted inventions can support a separate patent
  – Normally made before any action on the merits
  – Claims that the examiner finds are not directed to the elected invention are withdrawn from further consideration
Related but distinct inventions

- These cash registers are related, but may be considered distinct if found to be not connected in at least one of design, operation, or effect
Unrelated and distinct inventions

• The cash register is not related to a ladder, even though both are used in the same setting (e.g., a retail store where products are stored on shelves)
When restriction is proper

• For a proper requirement for restriction between patentably distinct inventions, there are two criteria:
  – Showing the inventions are independent or distinct as claimed
  – Showing that there would be a serious search and examination burden on the examiner if restriction is not required
RFC questions: Restriction practice

• How, if at all, should the USPTO limit or change restriction practice?

• For example, should the USPTO:
  – Allow examination of two or more distinct inventions in the same proceeding?
  – Revise the burden requirement for an examiner to impose a restriction requirement?
  – Adjust the method by which an examiner appropriately establishes burden for imposing a restriction requirement
  – Allow applicants, in the case of a Markush group, to suggest how the scope of the claim searched should be expanded if the elected species is not found?
  – Adopt a unity of invention requirement?
After a restriction: Rejoinder

Rejoinder

• Withdrawal of a restriction requirement, in whole or in part, between an allowable elected invention and a nonelected invention

• The formerly non-elected claims are examined on the merits.

• To be eligible for rejoinder, a claim to a non-elected invention must depend from or otherwise require all the limitations of an allowable claim.

• Example: if the examiner finds product claims to a paint brush tool allowable, it may be appropriate to rejoin process claims that are limited to using the claimed tool
After a restriction: Divisional application

Divisional application

• A continuing application for an independent or distinct invention, carved out of a nonprovisional application

• Filed as a result of a restriction requirement and may be filed serially
RFC questions: Rejoinder and divisionals

• How, if at all, should the USPTO limit or change divisional or rejoinder practice?

• For example, should the USPTO:
  – Require all divisional applications to be filed within a set time period after restriction?
  – Allow applicants a time period in which to provide appropriate claims for rejoinder?
Non-statutory double patenting practice
Double patenting

- The law prohibits “double patenting,” which is a legal term for an applicant obtaining more than one patent on the same invention.

- There are two ways in which double patenting can occur:
  - Statutory double patenting occurs when two applications or patents claim **identical** subject matter.
  - Non-statutory double-patenting occurs when two applications or patents claim closely-related subject matter that is **not patentably distinct**.
Double patenting (cont.)

- A examiner can reject claims for non-statutory double patenting on different bases, including anticipation and obviousness.

- For example, consider this situation:
  - Maria has a **patent** that claims a handheld input device with three control buttons, where the first two buttons are circular and located on the front of the device, and the third button is located on the top of the device.
  - Maria files a **patent application** claiming a handheld input device with two control buttons, where the first two buttons are circular and located on the front of the device.
  - The examiner will reject Maria’s patent application for non-statutory double patenting because the claim in her application is anticipated by the claim in her patent.
Overcoming double patenting rejections

Terminal disclaimer

• Is a binding statement in which the applicant gives up (disclaims) part of the patent term to the public

• Overcomes a non-statutory double patenting rejection if it ensures that the claims under rejection:
  – Will not expire later than the reference claims
  – Will “be enforceable only for and during such period” that they are commonly owned with the reference claims

• Procedural mechanism for obviating a rejection, and not a concession that the rejection is correct
RFC questions: Non-statutory double patenting

• How, if at all, should the USPTO limit or change non-statutory double patenting practice?

• For example, should the USPTO:
  
  – Require applicants seeking patents on obvious variations to prior claims to stipulate that the claims are not patentably distinct from the previously considered claims as a condition of filing a terminal disclaimer to obviate the rejection?

  – Reject such claims as not differing substantially from each other or as unduly multiplied under 37 CFR 1.75?

  – Require a common applicant or assignee to include all patentably indistinct claims in a single application or to explain a good and sufficient reason for retaining patentably indistinct claims in two or more applications (see 37 CFR 1.78(f))?
RFC questions: Terminal disclaimers

• Senators’ questions:
  – Should terminal disclaimers be eliminated?
  – Change practice to create an admission of obviousness upon filing of a terminal disclaimer?
Fee balance
USPTO fees for examining and maintaining patents are spread out over the patent term.

- The “up-front” fees due at the time of filing are very low (about $910 for a small entity) relative to the cost (about $6,285), to ensure broad access to the patent system.
- From the USPTO perspective, cost recovery does not occur until the second or third maintenance fee (typically about 6 to 14 years after filing).
RFC questions: Fees

• Senators’ questions:
  – Change up-front fees to reflect the actual cost of examination?
  – Increase fees for continuation applications above initial filing fees?
USPTO resources

  www.uspto.gov/MPEP
  - Includes current and archived versions of MPEP
  - “Change Summary” document explains changes since last version

- Glossary: www.uspto.gov/learning-and-resources/glossary
  - A-Z definitions of intellectual property terminology
USPTO resources

- Inventor & entrepreneur resources:
  www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources
  - Assistance, programs and other resources for independent inventors, small businesses, entrepreneurs, and university affiliated inventors

- Pro Se assistance program:
  www.uspto.gov/patents/basics/using-legal-services/pro-se-assistance-program
  - Assistance and resources for inventors filing a patent application without the help of an attorney or agent
Additional resource

- How to submit a comment: [www.regulations.gov/faq](http://www.regulations.gov/faq)
  - Click “Commenting” for the relevant FAQs
  - Includes a link to a PDF with tips for submitting effective comments