

Response to  
*Request for Comments on the Study of the Changes Needed To Implement  
a Unity of Invention Standard in the United States (68 FR 27536)*

Introductory Comments

3M Company submits the following response to the Request for Comments published at 68 FR 27536-27539 (May 20, 2003).

3M is a \$16 billion diversified technology company with leading positions in a wide variety of businesses and technologies ranging from sandpaper to optical films, from pharmaceuticals to electronics and telecommunications. To protect our investments in these varied businesses, we rely heavily on the U.S. patent system: last year, 3M was granted over 600 U.S. patents, placing it 13<sup>th</sup> among U.S. companies for the number of U.S. patents granted. 3M is also one of the leading users of the PCT system. We draw upon our extensive experience in the U.S. Patent and Trademark Office (“USPTO”), combined with our extensive experience with other patent offices throughout the world, in responding to the issues raised in the Request for Comments.

In general, we acknowledge the legitimate need for some type of restriction practice, whereby the USPTO can restrict a single patent application to one of a plurality of truly patentably distinct inventions. The particular standard now being applied in U.S. national applications to determine which inventions are patentably distinct, which standard is set forth in detail in the Manual of Patent Examining Procedure (“MPEP”) and is closely associated with the USPTO’s ever-expanding classification system, has unfortunately led to the current situation where, in our view, U.S. restriction practice is getting out of hand. Growing numbers of Examiners are taking advantage of the expanding classification system to make onerous restriction requirements between very closely related inventions, with little recourse available to the applicant. This growing practice produces a wasteful multiplication of patents (for those applicants with sufficient stamina and funding), which can burden not only the applicant but third parties and the USPTO as well. One of the many burdens on the applicant is an increased complexity and duplication of effort required in handling and citing prior art in all of the restricted applications.

Although we would not be opposed to other improvements to the currently practiced approach, we support the adoption of a Unity of Invention standard

if properly implemented. Such a standard would not only overcome the abuses of the present system, but would bring the U.S. into greater harmony with the EPC and PCT, and would also simplify internal USPTO practices so that a single standard could be applied to both international applications and national applications. International applications are currently supposed to be treated by U.S. Examiners under the Unity of Invention standard, as outlined for example in MPEP § 1875, but in practice we have found this procedure lacking, in part because the Examiners are more familiar with the standard U.S. restriction procedure.

### Issue 1

*Unity of Invention as practiced in the EPO is interlinked to EPC-style claim drafting and EPO claim treatment practice, including certain limitations on claiming that are not present in current United States patent practice. For example, the EPO (under EPC rule 29(2)) usually allows only one independent claim per category of invention (category of invention is that of product, process or apparatus of use), and emphasizes the search and examination of independent claims. In contrast, the USPTO searches and examines every claim, independent and dependent, and every limitations of every claim. In addition, EPC-style claim drafting is generally termed “central claiming”. In central claiming, the inventive concept is essentially claimed in the independent claim. If the independent claim is found allowable, the EPO examination will not be unduly concerned with respect to the dependent claims, according to EPO Guidelines, C-III, 3.6.*

*Should the USPTO study ways to adopt EPO claim treatment practice, including normally allowing only one independent claim per category of invention, when considering ways to adopt a Unity of Invention standard, and why?*

*Should the USPTO emphasize the examination of independent claims and modifying the examination of dependent claims in the same fashion as the EPO?*

*If so, would there be any reason to consider changes to the presumption of validity under 35 U.S.C. 282 of those dependent claims?*

We do not recommend the adoption of EPC-style claim drafting or of making it a USPTO practice to “normally” allow only one independent claim per category of invention. European and U.S. patent laws have independently developed different approaches to patent prosecution and enforcement. U.S. patent laws concerning claim interpretation and prosecution history estoppel are just two examples where significant differences exist. Therefore, it is of great importance that patent practitioners retain the flexibility to present multiple independent claims in a single category in their U.S. applications.

With respect to “EPO claim treatment practice”, contrary to statements in the Request for Comments, our experience indicates that the USPTO and the EPO have, effectively, the same practice of examining each and every claim

and claim limitation, when the independent claim is rejected. EPO search reports indicate the applicability of cited references to most, and typically all, of the dependent claims. In our experience responding to EPO (and EPO examined PCT) written opinions, if an independent claim is rejected, the patentability of each of the dependent claims is also determined and discussed. It is also our experience that USPTO Examiners follow this same practice. On the other hand, where an independent claim has been allowed, USPTO Examiners rarely apply art-related rejections to any of the dependent claims, just as with EPO Examiners.

Accordingly, we see no reason to change the presumption of validity of dependent claims under 35 U.S.C. § 282 (even assuming that such a change were within the scope of the USPTO's rulemaking authority). On the contrary, treating independent and dependent claims differently by removing the existing presumption that dependent claims are valid will further complicate patent litigation, and promote patent infringement by shifting the burden of proving the validity of dependent claims to the patentee. Because of the almost assured conflict with current U.S. patent law in this area, and the significant uncertainty that would be faced by patent practitioners and applicants, we believe that the USPTO's study should be focused on reforming the current restriction practice and not directed to unrelated issues that would have such far reaching ripple effects.

## Issue 2

*In United States restriction practice, the applicant can file a subsequent application that is directed to an invention that was divided out of the parent application. These are called Divisional applications. Divisional applications are typically subsequently filed and are not normally examined concurrently with the parent application. Divisional applications retain the benefit of the filing date of the original application if the conditions set forth in 35 U.S.C. 120 are met. This allows an applicant to continue to pursue protection for the inventions subject to restrictions that were in the original application without being affected by double patenting. All member states of the Paris Convention for the Protection of Industrial Property (1967) (including Japan and all EPC member states), as well as the EPO, also provide for the filing of Divisional applications. However, the PCT does not yet provide for the filing of Divisional international applications. Consequently, the PCT rules provide for applicant to pay for the search and examination of additional inventions that "lack unity" in a single international application. Adoption of a Unity of Invention standard could, in some instances, require examining more inventions during the examination of a single application than occurs presently, thereby possibly causing delay in the examination of other applications if examination resources are limited. This could increase the USPTO's average patent pendency time.*

*If the USPTO adopts a Unity of Invention standard, should the USPTO provide applicants the option of a PCT-style Unity of Invention practice to pay for additional inventions that lack Unity of Invention in the same application?*

*If so, should the USPTO consider any changes to patent term adjustment under 35 U.S.C. 154(b) for applications which have more inventions examined in a single application under a Unity of Invention standard than are permitted under current practice?*

*In view of the fact that examining multiple inventions in a single application could cause examination delay in other applications, what other revisions to patent term adjustment provisions under 35 U.S.C. 154(b) should be considered by the USPTO, or should the USPTO also consider revising the order that cases are taken up for examination?*

We recommend that the USPTO allow for additional, related inventions that lack unity to be searched and examined in a single application, thus reducing the unnecessary and often burdensome restrictions currently favored by the USPTO. Further, we recommend that the USPTO continue to permit divisional application practice for truly independent and distinctly claimed inventions. Regarding fees, additional fees would be appropriate only to the extent they reflect the actual additional work. The additional fees should not merely be a multiple of the statutory fees. In our experience there is often very little incremental work done when pending claims are subject to restriction/election.

We do not believe that any revisions to patent term adjustment will be necessary. It is speculative at best to assume that the introduction of a Unity of Invention standard will introduce a substantial examination delay; in our experience in many cases, the restricted applications are examined by the same Examiner and with little or no additional searching. We recommend that the USPTO continue without an adjustment to procedures in 35 U.S.C. § 154(b).

### Issue 3

*Under the PCT, examination proceeds on the basis of the first claimed invention if applicant does not pay for additional inventions that lack unity.*

*Should the USPTO adopt, for national applications, the practice currently used under the PCT of examining the first claimed invention where there is a holding of lack of Unity of Invention?*

*Optionally, where Unity of Invention is lacking: (1) Should the USPTO examine the first claimed product, or the first claimed invention if there are no product claims; or (2) should applicant be given the opportunity to elect an invention to be examined?*

We recommend that the applicants should retain the right to elect which inventions (group of claims) should be examined. The applicants should

have right to make this election and to reserve the right to file divisional applications for the non-elected inventions or to pay additional fees to examine related inventions. If applicants fail to make an election, the USPTO should examine the invention defined by the first set of claims.

#### Issue 4

*A determination of lack of Unity of Invention is predicated on assessing whether a common feature (referred to as a “special technical feature” in the context of PCT Rule 13) defines a contribution over the prior art. Certain PCT member states assess this requirement only with respect to patentable advances over prior art. However, issues of lack of support, enablement, clarity, or conciseness, generally resulting from excessive breadth of claims or excessive numbers of claims, may occur that render examination unduly burdensome. In such circumstances, some International Authorities will make a “partial search” declaration to limit the extent of search and examination. The USPTO does not follow this practice. On the other hand, it may be viewed that if the common feature or “special technical feature” is not adequately supported by the disclosure or lacks utility (“industrial applicability” in the PCT context), the special technical feature does not make a contribution over the prior art.*

*When adopting the Unity of Invention standard, should the USPTO follow the practice of performing only a “partial search” if the examination of the entire scope of the claims is unduly burdensome due to non-prior art issues?*

*Alternatively, should the USPTO assess adequacy of the disclosure and industrial applicability in addition to the prior art when determining whether the claims’ common features makes a contribution over the prior art?*

We do not recommend that the USPTO consider unrelated issues better suited to substantive examination. Issues such as lack of support, enablement, clarity, or conciseness correspond to review of a patent application for compliance with other provisions of U.S. patent law, e.g., 35 U.S.C. § 112, first and second paragraphs. A study to evaluate the Unity of Invention standard should be limited in scope as a replacement for current restriction practice in the USPTO.

If interpreted correctly, the USPTO’s question in Issue 4 seems to ask whether substantive issues of patentability should be considered along with Unity of Invention as a means of designating a “partial search.” We note that the Unity of Invention standard is influenced by but separable from substantive examination for patentability over prior art. See e.g., 37 C.F.R. § 1.476(d), which states that “Lack of Unity of invention may be directly evident before considering the claims in relation to any prior art, or after taking the prior art into consideration . . .”

Consider Example 1 of Appendix B (Administrative Instructions of the PCT):

1. A method of manufacturing chemical substance X.
2. Substance X
3. The use of substance X as an insecticide.

Unity of invention exists between independent claims 1-3 based on technical aspects of substance X without the necessity of review over the prior art. Review of the prior art may subsequently reveal during search and/or examination that substance X lacks novelty or inventive step which may or may not affect the conclusion regarding Unity of Invention. In that regard, Unity of Invention is similar to current restriction practice in the U.S., in that it can be raised or withdrawn at any time during prosecution. See 37 C.F.R. 1.142(a) and MPEP § 811. Consideration of unrelated substantive issues would go beyond the question of addressing problems with the current restriction practice in the U.S.

#### Issue 5

*The USPTO's 21<sup>st</sup> Century Strategic Plan is predicated on a certain level of revenue to provide the resources needed to meet quality and timeliness goals. The Plan currently does not account for any additional resource requirements, and any corresponding revenue shortfalls, that may result from adopting a Unit of Invention standard. Statutory fees under 35 U.S.C. 41(a) and (b), in the aggregate, are set to cover USPTO operating costs. If the average cost of processing patent applications goes up, the USPTO will need to increase fees. Assuming that there will be extra costs of examination under Unity of Invention, possible increases would be: (1) all filing fees; (2) all filing fees and an additional fee for examination of claims that lack Unity of Invention with an elected invention; (3) increased issue and/or maintenance fees of all applications; (4) increased issue and/or maintenance fees for applications paying the additional invention fee; or (5) a combination of two or more of (1) through (4) above.*

*Which of the above approaches should the USPTO propose in regard to any fee increases?*

We believe that any plan adopted by the USPTO for increasing fees should be structured so that only those applications that truly result in an increased workload for the Examiner incur increased fees.

#### Issue 6

*Adopting a Unity of Invention standard would impact the number of inventions that would be examined in a single application, and require examining multiple inventions that cross multiple disciplines in a single application. Due to the current level of technical specialization in the Patent Examination Corps, the USPTO will have to consider the impact any change would have on the ability of the USPTO to maintain high quality examination.*

*How should work be assigned to ensure that examination quality would not suffer if examiners have to examine multiple inventions from different disciplines in a single application?*

*Should the USPTO consider: (1) Using team examination, similar to the EPO where applications are examined using three-person teams called “examination divisions”; (2) extending the use of patentability report procedures provided for in section 705 of the Manual of Patent Examining Procedure (8<sup>th</sup> ed. 2001) (Rev. 1, Feb. 2003); (3) maintaining the current process of a single examiner on an application; or (4) using some other option of how work is performed by examiners?*

We believe that the technical expertise of the Examining Corps is such that examining multiple related inventions would not prove to be burdensome for U.S. Examiners. It is our experience that divisional applications, even those related to different categories such as product and process, are often examined by either the same Examiner or within the same Art Group. Truly unrelated and unique inventions may require a transfer from one Art Group to another. The existing patentability report procedures set forth in the MPEP § 705 (8<sup>th</sup> ed. 2001) (Rev. 1, Feb 2003) could prove useful in this regard.

#### Issue 7

*One way of adopting aspects of Unity of Invention without making any statutory changes would be for the USPTO to use its authority under the continued examination provisions of 35 U.S.C. 132(b) (authorizes request for continued examination or RCE practice) to permit applicants to pay an RCE fee and submit or rejoin claims to additional inventions after prosecution has been closed on a first invention, so long as the claims presented with the RCE fee either depend from or otherwise include the features of the allowed claims which make a contribution over the prior art. In this option, most applications will continue to be examined under the USPTO’s current restriction practice. Under any new provisions to implement this option, when a claim is determined to be allowable, the applicant would be entitled to request continued examination under the Unity of Invention standard. The required submission would be additional claims that either depend from or otherwise include the features of the earlier-examined claims that are in condition for allowance (if such additional claims were not previously pending in the application).*

*Should the USPTO consider this option?*

*Should this option be available only to applicants whose applications are published?*

*If so, how should the new RCE fee be set relative to the current fee structure?*

We do not recommend that the USPTO consider “hybrid” options that mix current restriction practice with a Unity of Invention standard. The goal of greater harmonization is not served by placing a patch on the current U.S. restriction practice. Moreover, excessively complicating the rules of practice does not serve the long-term interests of either the USPTO or patent practitioners. Confusion that we have observed in some instances regarding which restriction practice to follow should be avoided.

We also submit that any restriction-related options available to practitioners should not depend on whether the application is to be published.

### Issue 8

*As a second example of adopting aspects of Unity of Invention without making any statutory changes, the USPTO could use its authority under continued examination to permit requests that the USPTO continue examination of claims which were withdrawn from consideration. This option would require applicants to make a decision to request continued examination rather than file a divisional application, to pay a fee for the treatment of one additional invention, and to present claims drawn only to that additional invention. This option would be available in addition to the continuing option of filing a divisional application.*

*Should the USPTO consider this option?*

*If so, how should the loss in issue and maintenance fee collections be offset relative to the current structure?*

We recommend that this option should not be considered for the purposes of the USPTO's limited study. The option as described omits important details that would be necessary for an informed recommendation. More importantly, the option is peripheral to the study of the Unity of Invention standard, since it could be implemented not only with a Unity of Invention standard but also with the existing U.S. restriction practice or indeed any other restriction procedure.

### Issue 9

*In view of the previous questions and the range of issues and options, should the USPTO consider: (1) seeking a change to 35 U.S.C. 121 to adopt a Unity of Invention standard (and if so, what would such statutory change be, including whether such a statute would provide for applicants to pay for additional inventions that lack Unity of Invention to be examined in the same application); (2) maintaining the current restriction practice in the USPTO; and/or (3) modifying the USPTO rules and procedures to adopt aspects of Unity of Invention practice without making any statutory changes (if so, in what manner should rule changes be made)?*

We are not in a position to comment whether a statutory change is required to 35 U.S.C. §121, but we note that 37 C.F.R. § 1.475 provides the rules for Unity of Invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage. Rule 475(a) is very similar in language to that of Rule 13.1 and 13.2 PCT relating to the "Requirement" of Unity of Invention and to the "Circumstances in Which the Requirement of Unity of Invention Is to Be



Considered Fulfilled,” respectively. Thus, there are existing rules that U.S. Examiners can rely upon in implementing a Unity of Invention standard.

We recommend that one standard, the Unity of Invention standard, be applied to U.S. patent applications and international applications designating the U.S., and be used in place of the current restriction requirement practice.

#### Issue 10

*Do you have other solutions to offer which are not addressed in this notice?*

We have no other solutions to offer at this time.

#### Conclusion

We again commend the USPTO for taking the first steps to a more fair and harmonious restriction practice.