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**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 27536-39 (May 20, 2003)**

Issue 1(a): 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?

Response to Issue 1(a). The “unity of invention” standard for recognizing multiple inventions is fundamentally incompatible with U.S. substantive law, and should not be adopted. However, as noted in “Response to Issue 10, part B,” below, I would favor supplementing the existing standard of MPEP § 803 with an additional requirement relating to “lack of unity of invention.”

A. Incompatibility with Substantive Law. As the question itself notes, the treatment of claims under United States substantive law, both during examination and after issue, is entirely different than the treatment of claims under European substantive law. The United States abandoned the “central claiming” approach of the 19th century. For the USPTO to adopt procedural rules based on this abandoned approach would place the USPTO in fundamental conflict with the rest of the U.S. patent system.

It is therefore absolutely crucial that PTO procedural rules permit an applicant to present multiple independent claims to a single invention. For example, an applicant must be able to present claims that literally and directly cover any use of the invention, without reliance on induced, contributory, or equivalents infringement. Claims must account for technical rules for imports and exports, kits for assembly, component parts and built-up systems, the buyer and the seller as independent infringers in commercial transactions (even if the other party is outside the U.S.), claims covering the sender, receiver, and internal forwarding nodes of a communications network, repairable components, products of patented processes, the result accomplished and the apparatus used to accomplish the result and the underlying techniques used to achieve that result, “computer-programmed-to,” mating components, means-plus-function, product-of-process, product-by-process, the method performed by each of several components with inferential recitation of the steps performed by other components, etc. The *Festo* decisions create a high burden on applicants to “foresee” equivalents, and to present claims directed to them.

Attorneys for applicants are under an ethical obligation to react to the increasing demands of U.S. substantive law. The increasing complexity in applications is in no way “applicant behavior” in need of “modification,” as proposed in last year’s draft of the Strategic Plan. The PTO should not impose procedural requirements that are incompatible with the realities imposed by substantive law.

B. Opportunity for the PTO. The PTO should embrace the increasing complexity of applications as both reality and a genuine opportunity. When an applicant presents multiple independent claims directed to the same invention, the PTO's costs per claim go **down** while revenues go up linearly. The PTO can simultaneously increase efficiency, fee revenue, and customer value by turning multiple independent claims into a true win-win situation for both the PTO and applicants. See "Response to Issue 2," below.

The problems that arise appear to be entirely an artifact of the today's "flat rate count" system and the unfairness that this system imposes on examiners. This unfairness should be addressed by the reform discussed in "Response to Issue 10, part C," below.

C. "Common technical feature" is not meaningful with respect to U.S. combination claims. "Common technical feature" is a useful factor to consider in combination with other factors; it is poorly suited to be the "one size fits all" test. For example, in many arts, there is often nothing that can be characterized as a "feature that makes a contribution over the prior art" – the invention lies in a combination of known elements, or application of a known technique in a new context. The "invention" may be the combination of elements ABCDEFG, where most combinations of six of the seven elements are known, and thus the invention is properly claimed by one group of independent claims directed to combination ABCDEF and another to ABCDEG. These are frequently easy to search and examine together, and the public would be exposed to harassment if they were divided, but no one element qualifies as a "common feature that makes a contribution over the prior art." "Common technical feature" will force division that is contrary to public policy.

On the other hand, where there is a "common technical feature that makes a contribution over the prior art," then there will rarely be a "serious" burden in searching the claims that recite this feature. As discussed further in "Response to Issue 10, part B", a note should be added to Chapter 800 of the MPEP to the effect that a "common technical feature" should prevent restriction in all but exceptional cases.

D. Impracticality. The Request for Comment itself concedes the impracticality of a "common technical feature" standard for recognizing multiple inventions: "The determination of whether an invention makes a contribution over the prior art can only be done after a prior art search for the common feature has been performed" (top of the second column of page 27537), and that a "unity of invention" issue could therefore be raised at any time during prosecution.

Frequently the proper response to new prior art is to cancel an independent claim, and amend two or more dependent claims into independent form. Under a "common technical feature" standard, this would result in restriction. In order to reach this point in prosecution, the two claims were closely-enough related to be examined without serious search burden. They will often be so closely related that the public would genuinely be burdened with multiple harassment, limitations on exhaustion, etc. if they were divided. It would be contrary to public policy to divide them into two separate patents.

In the old 17-years-from-issue patent term regime, this was not so important. But in a 20-years-from-filing regime, when many applications are getting first Office Actions at four years of pendency, being forced to divide claims at the end of prosecution would result in severe prejudice to an applicant's substantive rights.

Issue 1(b): Should the USPTO emphasize the examination of independent claims and modifying the examination of dependent claims in the same fashion as the EPO?

Issue 1(c): 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?

Response to Issues 1(b) and 1(c): PTO procedure must always be subservient to the substantive law. Until a particular proposal to significantly amend United States substantive law exists, proposals to amend examination procedure are too speculative and premature to allow comment.

Currently, the PTO examines claims that are dependent on rejected claims, and does not significantly examine claims that are dependent on allowed claims. This is a proper allocation of efforts. In addition to the obvious benefits of compact prosecution, in cases where the rejection of an independent claim is based on an examiner's misunderstanding of the claim or of the reference, the examiner's comments on dependent claims often provide an applicant with information helpful in determining how to help the examiner.

Issue 2(a). 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?

Response to Issue 2(a). Any opportunity to examine related claims together in a single application should be seized. This is one of the greatest steps the PTO could take to increase overall efficiency and reduce backlogs. The PCT-style "Additional Invention Fee" procedure proposed in "Issue 2" benefits both the Office and applicants and should be adopted, even if (as urged above) the "unity of invention" standard of Issue 1 is rejected.

In the practice of almost every member of the patent bar, it is overwhelmingly clear that administrative overhead, time to refamiliarize oneself with an application each time it has to be considered anew, transferring an application to a new associate, etc., strongly favor maintaining related claims together in a single application. We practitioners strongly suspect that these same factors apply just as strongly to examiners. In almost all cases, the inventions in any single application are so closely related that significant inefficiencies arise when they are divided, and division can only efficiently occur when administrative concerns – such as examination in totally different art units – are overwhelming. Significant efficiencies could be realized if these claims were examined together, as would be allowed by this Additional Invention Fee procedure.

Similarly, when claims are related closely enough that an applicant chooses to present them in a single application, an insight often becomes apparent from one set that is important to understanding the other. Examination of related claims, as permitted by the "Additional Invention Fee" proposal, will improve both quality and efficiency.

When two inventions are distinct enough to genuinely raise costs for the PTO (for example, by meeting the test of MPEP § 803), an Additional Invention Fee is a very fair way to allocate those costs. However, concomitantly, the currently-pending proposal to dramatically increase "excess claims" fees should be withdrawn. Under present law, the filing fee for claims in excess of 20 cost is about the same as the first 20 claims. This is exactly proper: additional claims – even if directed to a "different invention" in a single application – will almost always be

closely-enough related to other claims of the application that the PTO's marginal costs per claim go down. The proposal currently pending before Congress, to nearly triple "excess claim" filing fees, is not calibrated to costs. If combined with an "Additional Invention" fee, the proposal to raise "excess claim" fees is "double dipping," and creates inefficient skewing of incentives. The PTO should offer an "Additional Invention Fee" option (while leaving conventional divisional practice available as an option) and leave excess claim fees more or less where they are (claims in excess of 20, when directed to the same invention, should cost about the same as the first 20 claims). Maintaining "excess claim" fees at a rate proportional to the "base claims" is more than fair to the PTO, and will act as an incentive to the PTO to exploit the efficiencies that can be gained by examining related claims together.

Issue 2(b). 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?

Response to Issue 2(b). It is difficult to see why any such adjustment would be warranted.

Issue 2(c). 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?

Response to Issue 2(c). The factual premise of this question is suspect, for reasons noted above in "Response to Issue 2(a)." Adopting the Additional Invention Fee procedure of Issue 2 will almost certainly substantially decrease overall examination delays, by improving efficiency.

Issue 3: 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?

Response to Issue 3: Under any standard or procedure adopted, the applicant should retain the opportunity to elect the group of claims to be examined. Providing this option is, in most cases, a minimal cost for the PTO – a telephone call for an election. Both the PTO and the applicant benefit when PTO resources are focused on the invention that is most important to the applicant. The applicant should have the opportunity to make a choice based on information that may not have been available when the application was filed years earlier.

Issue 4(a). 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?

Response to Issue 4(a). There may well be some efficiencies to be gained by stopping examination at a true “roadblock” rather than forcing an examiner to fully examine an application that the examiner does not understand. However, I would urge that examiners should phone applicants more often, certainly before any termination of examination. A significant percentage (easily half, in my experience) of all first Office Actions are simply wasted because the examiner failed to understand well-known terms of art, or completely misread the reference. Often, a telephone interview results in productive examination of the claims, *with no amendment*, demonstrating that lack of clarity lies with the examiner, not the application. An applicant should not be penalized by the delays inherent in “partial examination” in such cases.

One key advantage of present practice is that it requires an examiner to write down enough of his thought process to allow an applicant to diagnose where the examiner is having difficulty. If any “partial examination” procedure is adopted, some countervailing procedure should be adopted as well, to prevent the opacity of Office Actions that would likely result.

Issue 4(b). 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?

Response to Issue 4(b). The requirements of §§ 101, 102, 103, 112 and 121 are distinct. Any blurring of these distinctions during examination can only lead to delay.

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?

Response to Issue 5: I oppose adoption the unity of invention standard of Issue 1. If such a standard is adopted by the USPTO, and that adoption raises the PTO’s costs (as I believe will inevitably occur), then the USPTO should absorb those costs. Applicants should bear the not have to pay for adoption of a less-efficient procedure by the USPTO. In contrast, as noted above, the Additional Invention Fee procedure of “Issue 2” will almost certainly reduce overall costs, by allowing more interrelated examination tasks to be performed together.

Fees should be calibrated to the “relatedness” of the inventions.

If the PTO maintains something analogous to its current standard for dividing subject matter (whether that standard is MPEP § 803 in present form, MPEP § 803 in modified form, or

some form of “unity of invention”), where the major criterion is simple numerosity of claims, then the fee should so reflect, and the “excess claim fees” should be all that is charged.

Where there are multiple distinct inventions that can be searched by the same examiner, a single Additional Invention Fee should be payable at the time a restriction requirement is raised. The amount should be less than a filing fee (analogous to a PCT Additional Invention Fee, which is equal to the Search Fee). If a restriction is entirely unrelated to the statutory requirement that there be multiple “independent and distinct inventions,” then there should be no increase in issue or maintenance fees.

In cases where there are truly multiple “independent and distinct” inventions (the only inventions among which restriction is authorized by 35 U.S.C. § 121), then I would favor options (2) and (4). It would be entirely fair to charge an Additional Invention Fee as examination begins, and to charge an Additional Invention Fee surcharge on issue and/or maintenance fees. If there is an Additional Invention surcharge on issue or maintenance fees, the applicant/patentee should have the option to file a statutory disclaimer of certain claims and stop paying maintenance fees on those claims, while maintaining the rest of the patent in force.

Fees should be structured to provide incentives to keep related tasks together (where they can be performed most efficiently), and to fairly allocate costs to applications with multiple inventions. Applicants should retain the option to divide the application, as an alternative to the Additional Invention Fee.

The PTO may well find that the “Additional Invention Fee” procedure of Issue 2 results in higher collection of maintenance fees – where a single patent claims all aspects of an invention, a patentee is less likely to allow the patent to lapse.

Issue 6: 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?

Response to Issue 6: The PTO should have case-by-case flexibility to employ whatever procedure may appear best for a specific application, to ensure that an application receives a thorough examination, efficiently, while providing an applicant with a point of contact with clear negotiating authority. However, as discussed in more detail in “Response to Issue 10,” below, the PTO should adopt a number of reforms to ensure that this flexibility is exercised responsibly, and that whatever procedure is applied is applied consistently and subject to meaningful supervisory review.

“Team” approaches tend to drive up costs and dilute accountability, and their use should be minimized.

The patentability report procedure is one effective way to balance incompatible goals – because each portion of the Office Action is signed by a specific examiner, it is clear who has negotiating authority and responsibility for each issue.

Whether any change is adopted or not, where the inventions are completely “independent and distinct,” and search in two different art units is required, the PTO should have procedural options or a fee structure that ensures bilateral fairness. PTO rules may provide a significant fee incentive to outright division, or the authority to mandate division. Conversely, where the inventions should be examined in the same art unit, the burden on the examiner to show multiple inventions should be rather higher than it is currently. The incentive to the examiner to get “free counts” for dividing and examining the same subject matter over again should be reduced.

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 Unit 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?

Response to Issue 7: The basis for the question is unclear. If other claims “include the features of the allowed claims which make a contribution over the prior art,” no restriction could properly exist in the first place (either under a “unity of invention” standard or under the existing “serious search burden” prong of MPEP § 803 and the “linking claim” rule of MPEP § 809), and no further procedure need be created. If a claim “depends from” an allowed claim, then only a modest quantum of further examination is required, a quantum already covered by the “excess claim” fee, and there is no basis to impose a further fee.

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?

Response to Issue 8: It is extremely important that claims be examined efficiently. When claims are closely enough related to be presented in a single application, it will be a rare instance that they are more efficiently examined in serial, divided by years and possibly an entirely new examiner, rather than in parallel. The proposal of Issue 8 discards this great source of efficiency.

PTO procedure should allow for prompt examination of all related claims (thus, I favor the adoption of the Additional Invention Fee procedure of Issue 2, in any circumstance). A procedure that requires an applicant to hold allowed claims in abeyance, and delay initial examination of others, will seldom be used.

This may be an attractive option in some cases, and could well be provided as an alternative.

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)?

Response to Issue 9: Absent a thorough overhaul of U.S. substantive law to revert to “central claiming,” any discussion of a unity of invention “standard” for determining when multiple inventions exist is at best premature, and fundamentally incompatible with U.S. substantive law. I oppose any such proposal.

Statutory amendments to implement the “Additional Invention Fee” procedure of Issue 2 would be confined to 35 U.S.C. § 41, authorizing the PTO to impose such a fee. Amendments to 37 C.F.R. would parallel PCT Article 17(3)(a) and PCT Rules 13.3, 13.4 and 40.

Issue 10: Do you have other solutions to offer which are not addressed in this notice?

Response to Issue 10:

A. Background. Restriction exists to balance a number of policy concerns. Examiners should be compensated in relation to the amount of work they do, and fees should follow. Examiners should not be asked to examine subject matter far afield from their expertise. The PTO must **always** provide some procedural route under which claims as drafted by an applicant will be examined for patentability under the substantive law – the PTO must **never** refuse to examine a claim. Application of any multiple-invention standard or procedure should directly reflect any increased fees paid for examination and an applicant's need to meet the myriad legal requirements imposed by the courts. The public should not be burdened with two patents on two closely related inventions.

Note that there are only two of these concerns extend outside the PTO to affect substantive patent rights - multiple harassment by multiple patents, and an applicant's need to meet all requirements of the substantive law. The standard for dividing an application must never divide two claims that should be kept together, or make it impossible to claim an invention as required by U.S. substantive law. As the PTO itself notes, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION", MPEP § 803.01, emphasis in original. Note that every other consideration underlying restriction practice is a "fairness" examination issue that can be addressed by fee structures, examiner compensation structures, etc.

The existing definition of restrictable inventions in MPEP § 803 *et seq.* is a collection of very pragmatic rules that are well-tailored to balance these concerns. The MPEP § 803 standard requires that claims be kept together when there is a compelling reason to do so - either the inventions are so related that they are neither independent nor distinct, or there is no serious burden in examining them together. This is a good framework on which to build.

B. Alternative to the Proposal of "Issue 1". "Lack of unity of invention" should be added to MPEP § 803 as an element that must be satisfied to determine whether multiple inventions are present. Lack of any "common technical feature" could be added as a third conjunctive prong to the existing MPEP § 803 standard. Alternatively, "common technical feature" could be folded into the "serious search burden" prong (if there is a "common feature" that can be searched, then that common feature would show no "serious search burden" and no basis for restriction, absent any exceptional facts).

C. The PTO must deal fairly with examiners, so that examiners will be able to deal fairly with applicants. The May 20 Request for Comment repeatedly mentions "undue burden" of examination as a concern. Most of the problems cited in the Request reflect an unfair examiner compensation system, in which each application earns a fixed number of counts, no matter how large or complex. Each problem identified in the Request for Comment could much more directly be addressed by retailoring the "count" system, so that an examiner is compensated fairly for the amount of work required to examine larger or smaller applications. No change to restriction standard or procedure can overcome this fundamental unfairness of the PTO to its employees.

Here is the economic reality: when an application has many claims, the applicant has determined that this is an important, valuable invention. Large applications are the applications most likely to mature into litigation. The current "flat rate" count system creates perverse incentives that go directly contrary to these realities:

- I have been told several times by examiners at all levels that more complex applications are given only cursory examination. Examiners view the "average" time budget as a "fixed" time budget, with no accommodation for greater or fewer number of claims, more or less novel subject matter, etc.
- Applications with many claims are taken up only after extraordinary delay. This is directly contrary to the priorities of applicants. Early issue and thorough examination are most important for these applications.

- For the public, large applications should issue earliest, so that the public will have proper notice. Large applications should be examined most carefully to guard the public from worthless patents.
- For the PTO, the current “flat rate” count system encourages examiners to “gain the system,” to get multiple counts for doing the same work over and over for a family of divisionals. The PTO faces under-compensating honest examiners, and greater difficulty in hiring and retention in art units with more demanding applications.

A new system of examiner productivity counts should be created, with “new counts” allocated to reflect the complexity of an application, just as fees are currently calibrated to complexity. “New counts” should reflect a base number for the purely administrative “fixed cost” of every application, with further “new counts” reflecting the number of claims, the number of independent claims, the number of inventions, the number of references filed in IDS's, and perhaps the size of the specification and the general complexity of the technology. Some applications would get less fewer “new counts” than the present average, some would get more, reflecting the varying time budgets. “New counts” could be allocated to maintain the average productivity goals in the PTO, raise them, or lower them.

Under current practice, an examiner has every incentive to divide an application into as many divisionals as possible, in order to maximize the number of counts for examining one invention. It is difficult to identify anyone in the PTO who currently has any incentive to curb abuses. The PTO should design management incentives and controls to recognize when the PTO is giving more counts - and more compensation - for less work.