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Sent: Wednesday, July 16, 2003 5:46 PM
To: Unity Comments
Subject: Comments on Issues

The following are the comments of the undersigned and not necessarily those of any employer or client, past or present.

Issue 1

Unity of invention (UOI) does have as an underpinning the assumption/starting point of one independent claim per category. If the USPTO adopts a version of UOI, I would not be opposed to a limitation that a finding of UOI applies to one independent claim per category; if I want to present one or more add'l independent claims in a category, I would be willing to do so in a separate application. This still would be a HUGE advance over the system that has built up in the PTO over the past few decades.

My personal experience with the EPO has not found examination as "independent claim centric" as suggested in the request for comments. Starting with the Search Report, which includes a claim-by-claim breakdown of the relevance of a particular reference, European examination does tend to note distinctions added by dependent claims. I don't think adoption of UOI would require a change in substantive examination practice.

The validity presumption issue should be a non-issue based on the preceding paragraph.

Issue 2

The USPTO should allow for a PCT-style pay-to-play-again option as, in many circumstances (e.g., where an applicant presents method of making, method of using, composition, and article 1 and article 2 claims), an examiner would find it easier to handle the additional invention at the same time as the other inventions are being examined.

Term adjustment denials based on a refusal to pay an additional fee would seem to be fair -- applicants are given the opportunity to keep all inventions moving at the same pace, and a failure to choose that option perhaps should carry some penalty (like a refusal to grant add'l term).

Issue 3

Where an applicant fails to pay an add'l fee, that applicant should be forced to elect as opposed to the type of statutory default structure suggested in the notice.

Issue 4

No comment. I have had no personal experience with this type of problem when filing/prosecuting PCT applications.

Issue 5

Timeliness actually might get better if the multiplicity of applications caused by present restriction practice is reduced/eliminated. Thus, I'm not convinced that a fee increase will be necessary. However, if one does become necessary to keep the USPTO w/in its pay-as-it-goes framework, my preference would be option (2), if necessary in combination with option (4).

Issue 6

This issue would seem best addressed by asking for input from the EPO, which has more than 20 years of experience with multidisciplinary examination. Nevertheless, I think that this might be a straw man. Consider the situation of a claimed polymer, adhesive composition, and pressure sensitive adhesive tape. USPTO practice might be to treat each separately but, in reality, the examiner looking at the tape claims realizes quite quickly that the new feature in the claims under consideration is the adhesive portion of the tape and ends up looking at much of the same art as the examiner who considered the adhesive composition. European examiners seem to have adapted quite nicely.

Issues 7 and 8

I don't like the feature that certain claims get set aside until after others are considered. A new composition and a method of making that composition can and should be treated together . . . simultaneously, not sequentially.

Issue 9

In view of the fact that the USPTO has consistently misapplied 35 U.S.C. § 121 as presently written (treating the conjunctive as a disjunctive), I'm not sure that changing the statute matters as much as how it gets interpreted and implemented on a day-to-day basis. Regardless, something needs to be done because restriction practice as presently constituted is primarily a time management (and performance rating management) tool for examiners. Applicants are forced (needlessly) to pay multiple prosecution costs, multiple issue fees, multiple maintenance fees, etc., all for what really is a "single inventive concept" that an attorney/agent had the wisdom to claim in several statutory categories. This multiplicity has ripple effects as well -- double patenting rejections of subsequent applications can become comical in view of the number of patents which must be disclaimed, corporate reorganizations resulting in assignment recordation fees of 5 or 6 figures, etc., etc.