

July 21, 2003

Honorable Nicholas P. Godici
Commissioner for Patents
Box Comments - Patents
Washington, D.C. 20231

REQUEST FOR COMMENTS ON THE STUDY OF THE CHANGES
NEEDED TO IMPLEMENT A UNITY OF INVENTION STANDARD
IN THE UNITED STATES
68 FED. REG. 27536 (MAY 20, 2003)

Dear Commissioner Godici:

Thank you for the opportunity to provide comments on the study of changes needed to implement a unity of invention standard in the United States. I first wish to state that I do not support any of the changes proposed to the extent they may increase the total cost of obtaining patent coverage that is equivalent to that obtainable today, unless Congress stops fee diversion. Otherwise, any changes that raise the fees may simply increase the present tax on patents and trademarks with no enhancement in the services provided.

I believe it is very premature to support a unity of invention standard given that the only framework aside from the EPO standard (which is unacceptable) is the framework relative to PCTs. The PCT standards are extremely vague leading to a very subjective standard. It would seem that if two claims that were otherwise identical, varied even the slightest in wording of the novel "technical feature," an examiner could require restriction. Although the present restriction practice is not perfect, it is at least a more objective standard to apply.

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?*

Comment:

No. There is no need for the USPTO to study ways to adopt EPO claim treatment practices. EPO claim treatment practices are not well-suited for U.S. patent practice due to the vastly different claim interpretation given to claims particularly by U.S. courts. There is presently a trend towards favoring public notice over the Doctrine of Equivalents. Thus, the only way to ensure adequate coverage for an inventor is to file many claims of different and varying scope to improve his/her chances of a holding of literal infringement. Nearly all seminars on patent drafting emphasize the need to file many independent claims. The added cost that would be required to pursue separate applications/patents on the various independent claims that would be required for adequate coverage, would be prohibitive for most inventors. This would force the inventor to choose to pursue only one or two independent claims resulting in less than adequate coverage.

There is already a perception by some that patents are not worth the cost because they can be readily designed around. This type of perception is not healthy for the patent system. The adoption of EPO claim treatment practices would result in less protection for inventors thereby perpetuating this misconception. Alternatively, it makes the cost of obtaining adequate coverage much higher. Ever since the EPO adopted their present practice, the effective cost of obtaining adequate patent coverage has skyrocketed for many applicants.

Although patent litigation in the United States generally focuses on the limitations of a few independent claims, the patentee generally needs many independent claims from which to choose in order to have the greatest chance of thwarting an actual or potential infringer. Any shift to a European style claim structure should not be voluntarily made merely for the purpose of harmonization since the United States could use this change to push for concessions from the EPO.

- B. 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?*

Comment:

No, each claim, whether independent or dependent, must be considered on its own merits with respect to patentability, particularly with respect to dependent claims where the associated independent claim is rejected. I believe the examination of dependent claims speeds the prosecution of applications as it may provide an applicant with an early indication of what the examiner believes is patentable. While it is true that dependent claims are allowed whenever

independent claims are allowed, it is typical to have independent claims rejected in a first office action while some dependent claims are allowed. I have seen many applications where an applicant then simply rewrites the allowed dependent claims in independent form while canceling all rejected claims.

In addition, if dependent claims are not searched and examined, what presumption of validity attaches to these dependent claims once patented?

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 for lack of unity of invention in the same application?*

Comment:

Yes, applicants should have the option to pay for the examination of additional inventions in the same application. Within reasonable limits, it is appropriate for an applicant to be able to dictate the subject matter claimed in a single patent. However, the PTO should provide additional examining time for the examiner to search and examine each additional invention. This may be achieved by providing extra "counts" for each additional invention.

- B. *If so, should the USPTO consider any changes to the 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?*

Comment:

No. It is considered speculative at best to think that such a change of permitting applicants to pay for the examination of additional inventions in a single application would have a significant negative impact on actual pendency. Indeed, the USPTO may find that by permitting the examination of multiple related inventions in a single application greater efficiency in the overall process will be realized and delays in the USPTO reduced.

Also, the public would benefit by having an earlier decision as to the patentability of the other claims in the application rather than having to wait while the applicant files one divisional at a time.

- 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 out for examination?*

Comment:

The patent term adjustment provisions are already too complex. Therefore, no further changes should be considered unless they simplify the PTA provisions. There does not appear to be any reason for revising the order of examination.

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?

Comment:

No, applicants should be given the opportunity to elect which invention is to be examined first. As a former examiner, my experience was that it did not take too long just to call the applicant for an election. Also, an applicant's priorities may change after an application is filed based upon further testing or market studies. Furthermore, by giving applicants an opportunity to elect from among a plurality of inventions identified by the examiner, applicants at least have an opportunity to persuade the examiner of the impropriety of the requirement or seek immediate supervisory review before any search and examination time is wasted. It makes little sense for the USPTO to waste scarce examining resources on the search and examination of an invention in which applicants are no longer interested in patent protection.

Issue 4:

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 feature makes a contribution over the prior art?

Comment:

No. The circumstances where a complete search would be unduly burdensome are somewhat rare. Performing as complete a search as possible would enable the examiners to make a more accurate assessment of the need for a restriction thereby leading to less wasted time where the restriction may otherwise be withdrawn.

Issue 5:

Which of the following approaches should the USPTO propose in regard to any fee increases: (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)-(4) above.

Comment:

The USPTO should undertake a very careful analysis of the impact on its workload before proposing any increase in fees to accompany a proposed adoption of unity of invention practice. While it is clear that increased costs will be associated with some applications where the applicant chooses to have multiple inventions examined in a single application, and that there will be an associated loss of additional filing, issue, and maintenance fees from what would have been multiple applications and patents to protect the same subject matter, there will also be clear cost savings to the USPTO realized through reduced filings, publications, patents, and increased efficiencies, particularly where a single examiner is able to examine multiple inventions at the same time. Accordingly, an assumption that the average cost of applications will increase is highly speculative at this time, particularly until an overall plan is developed. Regarding approach numbers (1) and (2), I do not see why there would be any need to increase filing fees. If anything, the filing fees may be subject to a decrease since the PTO's total

clerical processing costs associated with applications would be lessened as less divisional applications would be filed, examined, and issued.

If increased costs are to be associated with the adoption of the unity of invention practice, it is only fair that the costs be borne by those who benefited from the change in practice. It seems the fees for the additional inventions should be set sufficiently high to cover any costs associated with examination of those claims.

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 MPEP 705; (3) maintaining the current process of a single examiner or an application; or (4) using some other option of how work is performed by examiners?

Comment:

The question makes reference to multiple inventions from different disciplines but fails to provide a definition of a discipline. A difference in classification in the U.S. patent classification system should not result in a different discipline. From the standpoint of simplicity and efficiency of the examination process, efforts should be made to maintain the current practice of assigning an application to a single examiner. Most examiners are well qualified to perform a competent examination of most inventions that would be presented in a single application. I believe examiners are already examining multiple inventions from different disciplines in single applications.

Issue 7:

Should the USPTO use its authority under the continued examination provisions of 35 U.S.C. § 132(b) (authorizes requests for continued examination or RCE practice) to permit applicants to pay an RCE fee and submit or rejoin claims to additional inventions after a 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? 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?

Comment:

The USPTO does not need to exercise its authority under 35 U.S.C. § 132(b) to make this option available to applicants. Claims to any “additional inventions” would not be to any different invention if they the claims rejoined either depend from or otherwise include the features of the allowed claims of the examined invention. No change in the current fee structure appears warranted.

Issue 8:

Should the USPTO use its authority under continued examination to permit requests that the USPTO continue examination of claims which were withdrawn from consideration? If so, how should the loss in issue and maintenance fee collections be offset relative to the current structure?

Comment:

To the extent of that multiple inventions will be searched and examined in a single application, it would appear most beneficial to applicants, the USPTO, and the public if this examination of multiple inventions was conducted concurrently rather than sequentially. There is no necessity to impose a fee in a pilot project to experiment with this procedure as restriction is always discretionary with the USPTO.

Issue 9:

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)?

Comment:

It is premature to consider any statutory change in 35 U.S.C. § 121 or § 41 to adopt a unity of invention standard at least until the USPTO clearly describes the practice that it intends to adopt under that standard. Although there are significant differences of opinion about the advisability of adopting a unity of invention standard for national restriction practice, a meaningful debate is not even possible until the USPTO describes the practice it intends to adopt under a unity of invention standard. For example, to the extent that a unity of invention standard would necessarily be accompanied by a restriction on the number of independent claims, an option to provide a second class examination of dependent claims, partial searches, and prohibitive increases in fees, such a change is not likely to attract any significant support among users of the system. While there may be problems with the present restriction practice, it is not at all clear that these would be solved by adopting a unity of invention standard or whether we would be simply substituting the miseries of a system that we don't know for the miseries of a system that we do know. In areas of the USPTO that are attracting the most criticism on restriction practice, the USPTO should promptly initiate at least a survey of restriction practice in those areas to determine whether the problem is with the restriction standard and guidelines and/or with the implementation and application of that standard and guidelines by USPTO patent examiners and/or some other contributing factors.

Issue 10:

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

Comment:

Train the examiners to better understand and apply the current practice, particularly election of species requirements.

Also, it appears that some examining groups are issuing written restriction requirements just prior to the end of the 14 month timeframe in which the PTO is to issue an Office Action to avoid a term adjustment, in order to prevent an applicant from receiving such a term adjustment. A study of this practice should be conducted to ensure that restriction practice is not being abused.

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Additionally, Examiners often use the form paragraph indicating that indicates that the examiner called to obtain an election, but the call did not result in an election being made, when, in fact, the examiner never even called. A study of this practice should also be made.

At present, examiners in the US PTO are practicing under a unity of invention standard with respect to PCTs and U.S. national stage applications. The PTO should first study how and how well examiners are employing the appropriate unity of invention standards.

The views reflected in this letter do not necessarily reflect those of other members of the author's firm nor of the firm's clients.

Sincerely,

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