

**From:** KLau@mofo.com  
**Sent:** Friday, July 18, 2003 2:41 PM  
**To:** Unity Comments  
**Cc:** dblevins@mofo.com  
**Subject:** Attn: Robert Clarke

Dear Sir:

I am a former Primary Examiner in Technology Center 1600 and have been in private practice for about 4.5 years now. I believe that a shift to a Unity of Invention standard raises more issues than those set forth in the Federal Register (Vol. 68, No. 97, 27536, May 20, 2003). This is based upon my former work as an Examiner and what I have encountered since my departure. They are, however, my personal views and not those of my employers or law firm.

One particular issue is the lack of clarity and misapplication of the "special technical feature" which must be present for unity of invention to be present. Because a "special technical feature" is defined as a "contribution over the prior art", the possible need for a search prior to determination of unity has been recognized. But there are additional questions.

For example, if the assertion of a lack of a contribution over the art is based upon an assertion of a lack of novelty over the art, does this give rise to estoppel issues under the recent Festo decisions when an Applicant permits the examination of only some of the claims based on the asserted lack of unity?

Additionally, what constitutes a "contribution?" While usually viewed as an issue of novelty over the art, a contribution may actually also require non-obviousness over the art. Support for this view is found in the PCT Regulations (Rules) for the definition of, and approach to, prior art during the search and examination phases (see Rules 33.1, 64.1 and 65.1). Therefore, could an assertion of non-obviousness be used as a basis for a lack of unity of invention? If so, would this expand the scope of the search required before examination begins? If a search sufficient to cover both possible novelty and inventiveness issues is conducted for unity of invention purposes, isn't the search burden reduced or essentially eliminated?

Moreover, if obviousness may be used as a basis for a lack of unity, could there again be estoppel issues based upon the Festo decisions?

Furthermore, how would challenges to an asserted lack of unity of invention based on either a lack of novelty or non-obviousness be handled? Are they to be treated as rejections based upon art and so subject to appeal or would they remain only petitionable?

The above are questions are already present in the U.S. PTO when acting in its PCT capacity as a Search and Examination Authority. But I believe that they have not been addressed adequately because they are perceived to have limited impact, as PCT applications are not binding with respect to a U.S. application. Perhaps for the same reason, there has also been significant variation in how U.S. Examiners apply the lack of unity standard.

But if the lack of unity standard is adopted for U.S. applications, the above concerns would be very real concerns for U.S. applicants as well as Examiners handling the applications. Therefore, and in the absence of full consideration of these critical details, I would advocate against a move to a lack of unity standard at this time.

Sincerely,

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