

COMMENTS OF JOHN SMITH-HILL

This is in response to the request for comments dated May 9, 2003 included in the Notice published in the Official Gazette on June 17, 2003.

I applaud the PTO's interest in adopting a unity of invention standard in the United States. I hope that the PTO will pursue its study of the issues raised by this change and that the PTO's efforts will eventually lead to adoption of a unity of invention standard to implement the authorization in the first sentence of 35 USC 121. In addition, I hope that the PTO's interest in becoming a responsive organization supporting a market-driven intellectual property system will induce examination of other aspects of PTO practice that might be considered to be outmoded in this new century. I have in mind here the final rejection practice, which responds in a draconian fashion to an applicant who is seeking in good faith to address a rejection by narrowing his claims and has little incentive to delay prosecution.

Before addressing specifically the issues on which comments were requested, I wish to offer some preliminary observations concerned with claims to a single statutory class of subject matter, such as a machine or a composition of matter.

Preliminary Observations

A. I think that the notion that the PTO searches and examines every claim, independent and dependent, is more theoretical than factual. In reviewing the prosecution histories of issued patents, I have seen several cases where a dependent claim has been indicated as being allowable when it is directed to features that appear on their face to be trivial or mere matters of choice. The examiner might not have seen the subject matter of the dependent claim in the prior art that was used to reject the independent claim, but it seems highly unlikely that the dependent claim received critical attention during examination.

B. The statement of Supplementary Information in the Notice explains that the current United States restriction practice was developed to balance the interest of granting an applicant "reasonable breadth of protection" against the burden on the PTO but does not mention the interest of the general public.

The current restriction practice, coupled with the practice of examining all claims with respect to all requirements for patentability, benefits an applicant whose independent claim is rejected over the prior art but receives an indication that two or more dependent claims are allowable. An applicant who chooses not to contest the rejection over the prior art can simply rewrite the allowable dependent claims in independent form and pay any additional independent claim fees that might be due, and the application will then be allowed with at least two independent claims that are, by definition, of different scope and may be such that an activity that infringes one independent

claim does not necessarily infringe any other independent claim.

The applicant/patentee thus obtains, in effect, multiple patents based on a single application, a single prosecution, a single issue fee and a single set of maintenance fees. The applicant never has to evaluate whether the second independent claim defines subject matter that is of sufficient value to justify payment of a filing fee, less still an issue fee or a maintenance fee.

I expect that all practitioners who have been asked to advise on validity or infringement of a patent have seen one of the consequences of the current practice. In the case of a patent with several independent claims, one might have to evaluate the validity or infringement issue with respect to three, five or even ten independent claims. An entrepreneur who wishes to introduce a new product or service but is concerned about liability for patent infringement is constrained by a barrier that appears to be a single patent but is, in effect, multiple patents, each having a statutory presumption of validity. The delay, expense and uncertainty associated with introduction of the new product or service is thus compounded.

I submit that there is no benefit to the public as a whole from allowing an applicant to receive a patent containing multiple independent claims in the same statutory class. The main benefit to the public of the patent system is that, in exchange for granting an exclusive right for a limited period of time, the public receives a full disclosure of the patented subject matter. The applicant/patentee brings no more to the table when the patent contains ten independent claims than when the patent contains only one independent claim.

The current restriction practice deprives the PTO, and hence the general population of users of the services provided by the PTO, of benefits that could arise from cost savings and fee income if a different practice were followed. A patent having multiple independent claims directed to "patentably indistinct inventions" will cost more to examine, print and distribute than a patent that is issued as a result of a more rigorous restriction practice, leading to a higher average cost of processing a patent from filing to issue. An applicant who decides that the subject matter defined in a second independent claim is truly of value will be willing to pay at least a filing fee, an issue fee and maintenance fees for protection of that subject matter, leading to higher fee income for the PTO and possibly delaying fee increases for users of the PTO's services.

An applicant who decides that the subject matter defined in a second independent claim is not of significant value, even though it might be patentable, will be less likely to incur the additional costs associated with a divisional application, thus automatically preventing erection of barriers and benefitting the public at large.

C. The statement of Supplementary Information also explains that the restriction practice permits an examiner to limit an applicant to one set of "patentably indistinct inventions" per

application.

I find it difficult to grasp the concept of "patentably indistinct inventions" in a single patent application except in the context of a broad claim and a claim (dependent or independent) that is narrower in scope than the broad claim. Let us assume a broad claim 1 that recites subject matter A and two narrower independent claims that recite subject matter A + B and subject matter A + C respectively. The only subject matter that the narrower claims have in common is A, and we have determined that A is not patentable, so how can the two narrower claims possibly define patentably indistinct inventions? Logically speaking, in order for two claims to define patentably indistinct inventions, they must have patentable subject matter in common. For example, if the two narrower claims recited A + X + B and A + X + C, and X (or A + X) were patentable, we would have patentably indistinct inventions.

The discussion in MPEP 802.01 suggests that "patentably indistinct" might mean not patentable over each other, but this suggestion is made in the context of subjects that are related, for example as combination and part thereof. This relationship (combination and part thereof) might apply to claims that respectively recite A + B and B but it does not apply in the case of claims that recite A + B and A + C. Furthermore, the issue of claims being patentable over each other is not before the examiner.

I note in passing that MPEP 802.01 defines "independent" as without a disclosed relationship and defines "distinct" as related (plus other requirements)¹. If two inventions must be unrelated in order to be independent and related in order to be distinct, I am not sure how inventions can be both independent and distinct, as recited in the first sentence of 35 USC 121.

D. I respectfully suggest that in determining what changes should be made pursuant to the study that is now being initiated, the PTO should strive to make its end product, i.e. the issued patent, easier for the public, both patentees and potential infringers, to use. The patentees will then have a clearer understanding of their rights and the potential infringers will have a clearer understanding of their duties. Ease of use is not promoted by multiplicity of independent claims.

E. Restricting an applicant/patentee to a single independent claim in a given category of statutory subject matter might in some cases prove to be too severe a remedy. One way to alleviate the harshness would be to liberalize reissue practice, by allowing filing of a post-issue divisional without a two-year restriction on broadening, but subject to adequate assurance that the patentee was acting in good faith and to proper intervening rights for those who had invested in activities that infringed the patent issued on the post-issue divisional but did not

1. Only in the MPEP have I have seen a definition of "distinct" that requires two subjects to be related in order to qualify as "distinct."

infringe the original patent. A carefully crafted reissue/post-issue divisional statute could avoid the need for the courts to rely on the doctrine of equivalents with its unpredictability: a patentee who loses on infringement could file a post-issue divisional and see if he can obtain allowance of claims that are broad enough to cover the accused activity. Settlement would be encouraged because both the patentee and the alleged infringer would have a much clearer idea of the likely outcome.

Response to Request for Comments

I have the following specific comments on the issues raised in the Notice.

Issue 1

I believe that the PTO should move towards allowing only one independent claim per class of statutory subject matter. If an applicant wishes to present two or more independent claims to inventions in the same statutory class, this should be permitted only when the applicant shows that there is an allowable claim that is generic to the proposed independent claims. I believe that this measure is necessary because it is the only way of ensuring that the claims to the particular class of statutory subject matter are patentably indistinct.

There is something to be said for the PTO's aversion to piecemeal prosecution, but examining an application with respect to all requirements is not perfect either. Subject to comments below on Issue 4, I believe that the PTO should continue to examine all claims with respect to formal matters, utility, definiteness and enablement but should focus its efforts regarding patentability over the prior art on the independent claims. If an independent claim that satisfies the requirements of utility, definiteness and enablement has been found to be allowable over the prior art, a true dependent claim is, by definition, allowable over the prior art and any effort expended in searching the dependent claim as such and examining it for patentability over the prior art would have been wasted. Thus, examination would be expedited.

Provided that there is no dilution of the requirement that the dependent claims be properly examined for requirements other than patentability over the prior art, it appears unnecessary to change the presumption of validity of those claims.

Issue 2

I question the underlying assumption that adoption of a unity of invention standard would frequently require examination of multiple inventions in a single application. In my experience, the frequency of the cases in which an applicant files multiple independent claims in the same statutory class without receiving a restriction requirement is considerably greater than the frequency of the cases in which an applicant files independent claims in different statutory classes, e.g. process for making a product and the product made, and in which a

requirement for restriction is made.

The PCT practice allowing an applicant to pay for the search and examination of claims to inventions that are out of unity with the first claimed invention makes sense precisely because there is no opportunity under PCT to file a divisional application. Since U.S. national practice allows filing of a divisional application, the reason that underlies the PCT practice of allowing payment of additional search and examination fees is not applicable to U.S. national practice. However, I have no objection to giving an applicant the option of paying an additional examination fee to facilitate prosecution of claims directed to a second invention, provided that the patent that is eventually issued claims a single invention. Thus, the applicant should be required eventually to file a divisional application in order to obtain patent protection for the second invention.

If the applicant is given the option of paying an additional examination fee, the fee paid should be credited against the filing fee for the divisional application, so the applicant who used this option would be no worse off than an applicant who chose to file a divisional application straight away.

I am not aware of any circumstance that leads me to believe that a change to patent term adjustments under 35 USC 154(b) would be called for in the event that the PTO adopted a unity of invention.

Again, I take issue with the premise that adoption of a unity of invention standard would require examination of multiple inventions in a single application substantially more often than occurs at present. In many arts, such as mechanical structures and electrical circuits, a unity of invention standard would likely expedite examination. I do not think that any change to patent term adjustments under 35 USC 154(b) would be called for in order to compensate for examination delay in other applications due to diversion of resources to examine an application that contains independent claims in multiple statutory classes, since all applications are protected by the guarantees of 35 USC 154(b)(1).

Issue 3

If the PTO adopts a unity of invention standard, it will need a mechanism for determining which claims to examine, and the mechanism should be predictable and readily understood by applicants and practitioners.

An approach of always examining the first claimed invention has the advantage of predictability but might be deemed too rigid and to be unfair to an applicant who is acting pro se. One alternative would be to give the applicant an opportunity to elect an invention to be examined but require that the applicant provide a reply within a relatively brief term in order to avoid a constructive election of the first claimed invention.

Issue 4

Excessive breadth of claims, seen as a major cause of issues that may render examination unduly burdensome, will generally

result from an attempt to cover multiple structures or methods with a generic claim.

It is important to avoid wasting effort in examination. The PTO's current practice, of examining all claims with respect to all requirements of patentability, carries the risk of wasting substantial effort. I believe that in the case of an application containing a very broad claim that covers multiple structures or methods, the PTO's limited resources would be better used by carrying out a search that is sufficient to narrow the issues, for example by showing that the broad claim is probably not patentable and thereby inducing the applicant to retreat to a claim that is specific to a preferred embodiment. The reduction in examiner's effort would at least partly offset the additional administrative effort involved in issuing an action based on a partial search and receiving a reply.

If, in response to the partial search, the applicant limits the independent claim to a structure or method for which a problem of enablement or utility found in subsequent prosecution turns out to be insoluble, the applicant will not only be able to file a divisional application with claims to another disclosed structure or method but will also have learned a valuable lesson.

Issue 5

If adoption of a unity of invention standard should result in a need to increase official fees, the increase should be borne equally by all users. Thus, it is my opinion that the increases should be (1) and/or (3).

Issue 6

It appears that the main circumstance that would give rise to a need to examine multiple independent claims in a single application under a unity of invention standard would be where there are claims to a product and a method, for example a semiconductor integrated circuit device and the method of fabricating the device. I believe that an examiner who is sufficiently familiar with, e.g. IC device structures, to render an opinion on patentability over the prior art of claims directed to the structure would be familiar with device fabrication also.

After all, one does not learn about technologies in a vacuum. Under current practice, the examiner who makes a restriction requirement between product and process for making the product must be sufficiently familiar with both technologies to articulate a plausible basis for the requirement.

Issue 7

It appears that the current statute would allow the PTO to adopt a unity of invention standard. Under the first sentence of 35 USC 121, "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one invention." It is axiomatic that an invention is measured by the claim. If one has two independent claims in the same statutory class but without patentable subject matter in common, the inventions defined by

the respective independent claims are independent and distinct and they can only be permitted in the same application if the Director has chosen not to exercise the authority in the first sentence of 35 USC 121.

The background discussion of Issue 7 refers to an allowed claim and a pending claim that is dependent on the allowed claim or otherwise includes the features that distinguish the allowed claim over the prior art, yet implies that the pending claim might be drawn to a different invention from the allowed claim. I submit that for purposes of unity of invention, the pending claim and the allowed claim should always be considered to be in unity.

I am opposed to the option as explained because it does not solve the problem of a single patent containing multiple independent claims in the same statutory class and without patentable subject matter in common. Further, an applicant who prosecutes an independent claim to allowance should not have to pay an additional RCE fee in order to obtain examination of dependent claims that are already of record and that are, by definition, patentably indistinct from the allowed independent claim.

Issue 8

I am opposed to the option explained in the discussion of Issue 8 for the reasons given in connection with Issue 7. The divisional application route provides an applicant with the possibility of obtaining examination of claims drawn to an invention that is independent and distinct from the invention elected in the parent application.

Issue 9

(1) -- No. As discussed above, statutory change does not appear to be necessary.

(2) -- No. Maintaining the current procedure does not solve the current problem.

(3) -- Yes.

Issue 10

No.