

**From:**

**Sent:** Friday, August 13, 2010 6:05 PM

**To:** Restriction\_Comments

**Cc:**

**Subject:** Comments on Proposed Changes to Restriction Practice in Patent Applications

Dear Ms. Therkorn,

Please accept the attached response to the Request for Comments on Proposed Changes to Restriction Practice in Patent Applications, posted by the USPTO on June 14, 2010. These comments are submitted on behalf of the chairs of the Patent Prosecution and IP Law Revisions Committees of the Minnesota Intellectual Property Law Association (MIPLA).

Best regards,

**Tracy Dann**

Director of Marketing

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August 13, 2010

**VIA EMAIL: [Restriction\\_Comments@USPTO.gov](mailto:Restriction_Comments@USPTO.gov)**

Hon. David Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
Mail Stop Comments-Patents  
P.O. Box 1450  
Alexandria, VA  
22313-1450

ATTN: Ms. Linda S. Therkorn

RE: Request for Comments on Proposed Changes to Restriction Practice in Patent Applications

Dear Director Kappos and Ms. Therkorn:

The Patent Prosecution and IP Law Revisions Committees of the Minnesota Intellectual Property Law Association ("MIPLA") are grateful for the opportunity to submit comments in response to the Request for Comments on Proposed Changes to Restriction Practice in Patent Applications 75 Fed. Reg. 33584 ("Restriction Practice").

The comments submitted herewith reflect the view of the chairs of the Patent Prosecution and IP Law Revisions Committees ("the Committees") and do not necessarily reflect the view or opinions of MIPLA or any of the individual members or firms of the Committees, or any of their clients.

#### **General Comments**

The members of our Committees include patent attorneys that are prosecuting a number of patent applications on behalf of clients in a variety of different arts. Our collective experience is that there is a lack of uniformity and consistency in the application of restriction requirements and species election requirements in patent applications. Our Committees applaud the Office's attempt to improve the way the Office administers restriction practice.

The Committees discussed current restriction practice and the questions on Restriction Practice posed by the Office and made the following findings:

## **1. Current Restriction Practice is Antithetical to Compact Prosecution and to Reduction of Prosecution Backlog**

In our collective experience, the current system provides examiners an extraordinary incentive to reduce the number of claims examined.<sup>1</sup> Examiners can exercise their discretion to dissect claim sets into single independent claims. That dissection can

- increase the delay in prosecution,
- increase the number of divisional filings (resulting in additional continuation filings)<sup>2</sup>,
- increase the cost in prosecution,
- decrease consistency in prosecution of multiple related filings, and
- create conflict in enforcement when divisional applications (which do not require Terminal Disclaimers) can be owned and asserted by different entities.

It is also suspected by our Committees that the burden on search imposed by additional patentably indistinct variations in independent claim sets (e.g., method vs. apparatus) is minimal in view of the full-text search options available today as compared to the manual classification search procedures that were employed at the time the current approach to restriction practice was adopted.

These same observations can be made for species election practices.

Consequently, our Committees believe that present restriction practice destroys compact, efficient prosecution and aggravates the existing backlog of unexamined patent applications.<sup>3</sup>

## **2. Challenges to Restrictions Will Be Difficult or Impossible to Administer**

Our members understand that restriction requirements can be challenged by petition, and that such petitions can be successful if the restriction requirement was improper. There are cases where the restriction requirement challenge is crucial and warranted. But the prevailing logic of the patent prosecution bar is that challenging the restrictions can usually be more detrimental to time and cost

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<sup>1</sup> For example, an examiner is given the same count for examining 1 claim as for examining 100 claims. Consequently, the present examiner counts system fails to scale credit with the amount of work being done by the examiner. This penalizes examiners who go the extra mile to examine more claims than other examiners who attempt to examine only what is necessary given current restriction practice.

<sup>2</sup> It should be noted that divisional filings do not increase the store of knowledge beyond the original parent publication (and thus contribute relatively little to the progress of science and the useful arts), but rather introduce significant delay and uncertainty in defining patent rights.

<sup>3</sup> Some of the benefits of compact prosecution and advances in that regard can be found in Director Kappos' Public Blog at: [http://www.uspto.gov/blog/director/entry/thanks\\_patents\\_team\\_compact\\_prosecution](http://www.uspto.gov/blog/director/entry/thanks_patents_team_compact_prosecution).

efficient prosecution than to accept the proposed (believed-improper) restriction and file one or more divisional patent application(s).

The Committees do not believe a good solution for consideration of petitions challenging restriction requirements exists in the current environment. The use of petition practice to challenge restriction requirements is believed to be unwieldy for the Office and unlikely to provide a time-sensitive solution to an improper restriction requirement. The same is true, of course, for appeals. It is further believed that it would be an inefficient use of Office time and funds to create a new petition or appeals option to address the problem.

### **3. The Office is in the Best Position to Reform Restriction Practice Through its own Internal Counts Incentive System**

The Committees favor a proposal from the Office for changes to restriction practice that internally incentivizes examiners using the counts system to properly restrict only patentably distinct cases, and which removes incentives for Examiners to use restriction practice solely as a tool to reduce personal workload and increase personal counts while increasing total USPTO workload. Such a proposal should provide internal controls whereby a supervising examiner can oversee any potential restriction and make corrections where necessary to implement proper and fair restrictions.<sup>4</sup> Such a system should incentivize examiners to consider claims to similar subject matter and scale credit with the number of claims examined, as opposed to the present count system which is independent of the number of claims examined. Such a system may also account for the number of independent claims versus dependent claims being examined.<sup>5</sup>

The Committees further suggest that such proposed changes recognize that advances in full-text searching have reduced or eliminated the search burden referenced in the Restriction Practice questions and in the M.P.E.P. As such, there is no longer a sufficient justification to continue to use search burden as one of the factors in restriction practice. The Committees note that it is the reliance upon the search burden factor that is the most variable factor seen across different examiners and art group units with respect to the lack of consistency in restriction requirements.

It is the Committees' further recommendation that M.P.E.P. Section 803 (stating the test for patentably distinct claims is "independent or distinct") be clarified to conform to 35 U.S.C. Section 121 which states in part "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." This clarification is believed to be more consistent with divisional practice and where not warranted, the requisite filing of terminal disclaimers.

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<sup>4</sup> Such a system may be harmonized with PCT practice.

<sup>5</sup> Such a system might also provide an option for designation of claims to be examined (independent or dependent).

It is believed that such an internal system refocused only on “independent and distinct” restrictions with an internal system for gauging proper credit for appropriate workload would

- avoid inconsistencies found in practice-specific nuances of restriction practice,
- avoid a number of unwarranted continuation filings and the commensurate documentation of justifications for restriction proposed by the Restriction Practice proposals,
- avoid the need for a new procedure for challenging restrictions and more quickly address the need for restriction at the Office,
- avoid the need for special rules for Markush claims,
- more fairly compensate examiners for thorough and compact examination of claim sets,
- bring US restriction practice more in line with current PCT “unity of invention” practice,
- reduce overall cost for applicants, and
- properly divide independent and distinct inventions as required by statute.

Sincerely,

The Patent Prosecution and IP Law Revisions Committees of the Minnesota Intellectual Property Law Association

Brad Pedersen

Tim Bianchi