

From:

Sent: Friday, August 13, 2010 3:34 PM

To: Restriction_Comments

Subject: Comments regarding Restriction Changes as announced in Federal Register / Vol. 75, No. 113 / Monday, June 14, 2010 / Notices

Ms. Therkorn,

I have attached some comments with respect to the proposed revision of Chapter 800 of the Manual of Patent Examining Procedure.

Thank you for requesting such comments.

Very truly,

Robert J. Webster

Reg. No. 46,472

Please copy all instructions to mailroom@bskb.com to ensure proper handling.

This transmission is intended for the sole use of the individual and entity to whom it is addressed, and may contain information that is privileged, confidential, and exempt from disclosure under applicable law. You are hereby notified that any dissemination, distribution, or duplication of this transmission by someone other than the addressee or its designated agent is strictly prohibited. If your receipt of this e-mail is in error, please destroy the transmission (and any copies thereof) immediately.

Restriction_Comments@uspto.gov

Attn: Ms. Linda S. Therkorn;

Please consider the following comments in response to the recent OG Notice of June 14, 2010 pertaining to proposed changes to MPEP Chapter 800:

- Regarding what is required in a showing of whether a serious burden exists, I think a serious burden exists between only some different statutory classes of invention and not others regardless of where the different statutory classes of invention are classified. For example, an electrical engineer or physicist may examine active solid state semiconductor device structures (classified in Class 257) whereas usually chemists or chemical engineers examine methods of making active solid state semiconductors (classified in an entirely different class than Class 257). Historically, there is a presumption of a serious burden for a Class 257 product/device examiner to examine a method of making such a device, and *vice versa*, i.e., for a chemical technology examiner to examine the class 257 device.

On the other hand, historically, and in my experience, an examiner who examines machines or systems usually is not considered to face a serious burden to also examine methods of use of those machines or systems.

The point I am trying to make is that simply citing different classifications for different statutory classes of invention, alone, is not necessarily conclusive regarding whether a serious search or examination burden exists.

In order to understand how to realistically show an undue search or examination burden, I suggest using common sense and not merely an allegation of different classifications for the allegedly distinct inventions.

With respect to indicating that the allegedly independent and distinct inventions will require different areas of search, Chapter 800 should explain that just citing different classes and/or subclasses to be searched for the allegedly independent or distinct inventions be presented does not reflect the actual search burden on examiners, especially since examiners now search those classes and subclasses electronically with computer assisted key word searches for many inventions. Where drawings must be searched for specific detail in certain arts, that factor should be addressed and taken into consideration.

For reasons such as this, it may be useful to look at search notes in the Manual of Patent Classification to determine search burden that an Examiner is expected to do in the normal course of making a reasonably comprehensive search of the prior art for a specific application and use that as a factor in determining whether a serious search burden would exist.

However, primarily basing undue burden on differences in filing dates or different fields should not be sufficient to justify a serious burden.

- With respect to the proposal to take into consideration (regarding the existence of a serious or undue search or examination burden) statutory requirements other than prior art search and examination, I do not recommend that it be followed. I believe that an Applicant pays to have all of the statutory requirements of the claimed invention evaluated in an Office Action, and do not recommend justifying a serious requirement by saying that the allegedly independent or distinct claims might raise other than prior art statutory issues.

- With respect to genus-species restriction/election of species (R/ES) requirements MPEP Section 800 should remind examiners that species must be mutually exclusive to be independent or distinct. This means, for example, that dependent claims which are directed to different species, but depend from the same generic claim, cannot possibly be mutually exclusive, because all the dependent claims contain the subject matter of the generic claim.

While on the subject of genus-species issues, it is my understanding that, at one time, the USPTO considered five species to be a reasonable number of species, as evidenced by the previous version of 37 CFR §1.141, which permitted an Examiner to limit what was searched and examined to five species. This Rule of Practice was amended to be consistent with Rule 13 of the Patent Cooperation Treaty (PCT), after the PCT was passed by Congress. It is Applicant's understanding that the amendment to 37 CFR §1.141 removed the "five species" language to permit Examiners to consideration and examination of claims directed to more than five species, to be consistent with PCT Rule 13. Reference is made, in this regard, to the Commissioner's Decision in *In re Caterpillar Tractor Co.*, 228 USPQ 77

(Com'r Pats. 1985). I recommend that this information be made available in MPEP Chapter 800.

- With respect to the Office's proposed rejoinder practice, I agree with the proposal and recommend that the above paragraph regarding what a reasonable number of species is should be considered when an allowable generic claim is found and the claims directed to different species are independent or dependent.

- With respect to distinctness showings regarding restriction requirements, I recommend that, unless the Office can justify why one situation only requires one-way distinctness and another situation (e.g., combination-subcombination) requires two-way distinctness, all requirements should use the same test, e.g., a two-way distinctness test. Using a two-way distinctness test in all situations is also consistent with the fact that as a result of a restriction requirement, an Applicant will be subject to substantial additional prosecution costs associated with a number of divisional applications, and the costs associated with maintaining divisional applications in consonance with the aforementioned "safe haven" provisions of 35 USC §121.

- Concerning the USPTO's request for additional proposals, I respectfully present a number of proposals for the Office's consideration *based on the following background remarks*.

In the years that I have been prosecuting patent applications on behalf of Applicants before the USPTO, I have routinely traversed scores of restriction requirements and elections of species requirements on the merits. For years prior to that, I drafted all Rule 181 petition decisions for the TC directors with whom I worked as a Special Program Examiner.

In my own personal experience, I learned restriction practice as a Special Program examiner (for approximately eight years) by enlisting the help of a former PTO Restriction/Election of Species practice instructor to review many Rule 181 petitions with respect to which I had to draft decisions for my TC Director. In other words, I learned by doing with positive feedback on a case-by-case basis, while reviewing the merits of

dozens of Rule 181 petitions, from an excellent, experienced specialist in restriction and election of species practice until I learned and mastered R/ES practice (as taught for decades by that experienced instructor) in the PTO Academy.

This extensive experience in handling the merits of over one hundred restriction requirements and election of species requirements has convinced me that restriction practice in the USPTO needs to be improved.

STATEMENT OF EXISTING R/ES PRACTICE PROBLEMS:

Firstly, although R/ES practice is taught “by the book, i.e., as set forth in MPEP Chapter 800, by instructors, using “canned” lectures in the Patent Academy, I have been told by at least one former experienced Patent Academy Restriction/Election of Species Practice instructor that when he taught Examiners who had been working in TCs for several months, they said that they were taught to make restriction and election of species requirements differently than what this instructor was telling them to do. In other words, R/ES practice as practiced in the TCs differs from the way it is taught in the Patent Academy.

Secondly, it appears that restriction practice differs among different TCs, the most pronounced differences being between the Chemical /Biotechnical TCs and the other TCs. It may be that the differences are in the level of detail of the restriction and election of species requirements, which is something that I have observed when I am asked by practitioners to review restrictions and elections of species in the biotechnical TCs.

Thirdly, in my experience, Examiners do a better job on election of species requirements than they do with respect to restriction requirements. One factor influencing this is a format followed by drafters of certain patent applications which list numerous different embodiments, characterize them as different embodiments, and itemize specific drawing figures with regard to each specifically identified embodiment. If the Application does not contain a generic claim, and recite claims directed to different embodiments as dependent claims (from a generic claim), then Examiners have an easy way to make a sound election of species requirement. Notwithstanding this, other species and subspecies requirements which I have reviewed, usually confuse subcombination claims with species, and do not appreciate the fact that a species can never be a claim.

Fourthly, with respect to restriction requirements, a number of those which I have reviewed mis-characterize the nature of the inventions being restricted and use an incorrect test for showing the inventions sought to be restricted are independent or distinct.

For example, I find myself often traversing (1) restrictions between different independent claims which are mischaracterized as subcombinations usable together; or (2) restrictions which mischaracterize claims reciting a combination and a subcombination as claims directed to subcombinations usable together, or (3) restrictions which mischaracterize claims directed to a product and claims reciting a method of using a product, as claims directed to a product and claims directed to making the product; or (4) restrictions which mischaracterize claims directed to product and claims directed to a method of using that product in making another product, as claims directed to a combination and claims directed to a subcombination; or (5) restrictions directed to claims mischaracterized as a combination and claims directed to a subcombination, which are claims directed to different combinations.

Fifthly, even if the restriction requirement correctly characterizes the category and type of inventions being claims, and even uses the correct distinctness test in MPEP §806.05, most often the test is incorrectly applied, i.e., it is not applied with respect to the *claimed* invention.

Sixthly, even when restriction requirements use the proper distinctness test(s), they often do not apply the correct tests to the CLAIMED invention, and use non-claimed subject matter to allegedly justify the distinctness test they are applying.

Seventhly, another problem that I havenoticed with restriction and election of species requirements is that they often completely fail to address the requirement (in MPEP §803) that they do not even allege, let alone provide reasonable support for, the existence of a *serious search and/or examination burden* on the examiner if restriction and/or election of species requirement(s) (R/ES) are not made.

For example, if the Examiner alleges that there is a serious search and/or examination burden without restriction and/or election of species, the type of showing made in support of such a conclusion differs greatly throughout the TCs. Typically, an R/ES requirement will say that the restricted inventions involve different fields of search.

Often, the different specified fields of search are what I would consider mandatory fields of search for all of the allegedly independent or distinct inventions and, in a few instances, I have found that some of the alleged subclasses in which an invention is said to be searched do not exist.

One interesting form paragraph directed to establishing a serious search/examination burden that I have received in a number of R/ES requirements, but have not found in the MPEP, lists five mainly *hypothetical* reasons that are simply not applied to the facts of the application in which the R/ES requirement is being made. The first of these five reasons is always that the inventions have acquired a different status in the art, yet the only reason given to support this conclusion is that they have different classifications. Unfortunately, typically, absolutely no statement of what these different classifications are or why that demonstrate that the inventions have acquired a different status in the art is presented. Even when specific different classifications are given, sometimes the subclasses are not found in the Manual of Classification, and when they are, all of the specified different classifications are mandatory areas of search for all allegedly independent and distinct inventions.

The second hypothetical reason is that the inventions have acquired a separate status in the art due to their recognized divergent subject matter. Unfortunately no statement of how these claimed inventions diverge so as to demonstrate that the inventions have acquired a different status in the art is ever presented. In fact, where the claimed inventions are related as combination and subcombination inventions, there really is no divergent subject matter.

The third hypothetical reason is that the inventions require a different field of search. Unfortunately, often no evidence of this is presented whatsoever and, as noted above, when different USPTO classifications are alleged, they sometimes are inaccurate or nonexistent and often the Examiner will have to search the same subclasses for any and all of the allegedly independent or distinct inventive groups.

The fourth hypothetical reason is that the prior art applicable to one invention would not likely be applicable to another invention. Unfortunately, no explanation of why this general statement applies to the claimed inventions is ever made. Moreover, as pointed out above, a reasonably comprehensive search of the prior art of the allegedly

independent or distinct inventions often will entail a search of the prior art applicable to all of those inventions.

The fifth hypothetical reason is that the inventions are likely to raise non prior art issues under 35 USC §101 and/or 35 USC §112, first paragraph. Again, no explanation of the applicability of this hypothetical statement to the claimed inventions is ever made. Moreover, the R/ES requirement is usually made in Applications in which there were no such rejections pending of record in any previous the last Office Action on the merits, and there is no indication where the basis for such rejections is found to exist. Additionally, I thought that examining claims for all statutory requirements were part of an Examiner's normal such job description duties and should not be used to justify an undue search burden.

PROPOSED IMPROVEMENTS TO R/ES PRACTICE:

- Establish a R/ES Unit in each Technology Center that is staffed by examiners experienced in R/ES practice, who have been trained in depth by experienced Patent Academy R/ES instructors, and who review not only R/ES petitions and draft R/ES petition decisions, but review all proposed restriction requirements and elections of species requirements and approve or disprove them, and help examiners draft proper R/ES requirements.

- Hold R/ES conferences should to approve R/ES requirements and, also to draft R/ES petition decisions for a TC Director's review.

- To give Examiners incentives to become restriction/election of species specialists, examiners should be given a limited time detail to learn restriction/election of species practice as I did, in an on-the-job situation, and when they have mastered the practice, they should be given points (similar to Masters level arte points and Expert level in the arts points toward promotion. This will encourage lower grade examiners to apply for these jobs. Also, any applicable PTO or OPM aptitude tests should be given to such individuals who volunteer for this job to select the most qualified candidates. Career enhancing Examiner details to R/ES units should be authorized,

- Prohibit mailing of any restriction or election of species requirements unless and until they have been reviewed by a panel of two experienced restriction and election of

species practice specialists, whose job it is not only to critique proposed restrictions and election of species requirements, but to determine if restriction and/or election of species requirements are proper in a specific application and, if so, draft a proper requirement for the Examiner. If a proposed restriction and/or election of species requirement is not sound, then one of the experienced specialists should explain why, in writing, to the Examiner who made the proposal.

- Examiners assigned to a TC R/ES Practice unit should act as ombudsmen to Applicants, practitioners, and examiners alike, and try to see to it that only proper restrictions and elections of species are made. They should help examiners and applicants by helping to draft proper R/ES requirements, and by disapproving improper R/ES requirements. They should also be readily available to answer R/ES questions from examiners, practitioners and Applicants.

- Require periodic meetings of all TC R/ES unit Examiners to promote uniform R/ES practice throughout the Entire USPTO Examining Corps.

- Permit handling of all R/ES petition drafts to be done in the TC R/ES units.

Time limits should be placed on deciding R/ES petitions to avoid the catch-22 situation that Applicants are placed in when they petition a restriction requirement with the six month statutory reply date coming up within a month, for example. Applicants are forced to pay for a Notice of Appeal to keep the Application in a pending status or to file a Request for Continued Examination (RCE) because the SPRE shop handling the petition says they have a two month backlog. This is extremely unfair to Applicants.

One suggestion is to decide a R/ES petition within a specified time period from when it is filed, or withdraw the R/ES requirement.

In this regard, a database of R/ES petition decisions should be made available as are decisions of the Board of Patent Appeals and Interferences as a learning tool for examiners, practitioners and applicants.

- I also respectfully suggest that, the USPTO should consider proposing legislation permitting the filing of reissue applications with regard to issued patents that contain improper R/ES requirements to permit the patentee to obtain claims that

the patentee should have been examined on their merits had proper R/ES requirement(s) been made in the application that matured into the patent.

In this regard, if a R/ES requirement is improper and is not successfully traversed, it will be difficult if not impossible for the Applicants to maintain them in child applications, and may lose patent rights in child applications for failure to comply with the “safe harbor” provisions of 35 USC §121, Cf., *Boehringer Ingelheim International GmbH v. Barr Laboratories, Inc.*, No. 09-1032 (Fed. Cir. Jan. 25, 2010), and the second is that, when the unsound R/ES requirement is successfully traversed, the Examiner will have to reopen prosecution with respect to claims improperly withdrawn from consideration on their merits, and the next Office Action cannot be made a final Office Action.

Respectfully submitted,

Robert J. Webster, Reg. No. 46,472