

From:

Sent: Friday, June 18, 2010 3:29 PM

To: Restriction_Comments

Subject: Docket No. PTO-P-2010-0030

1. What should be included in an Office action that sets forth a restriction requirement?

The only consideration should be whether or not the inventions are independent and distinct. "Burden" is a vague term that has nothing to do with the statutory requirements for patentability and is, therefore, irrelevant. The PTO should do its job, not rationalize refusing to examine.

Separate status in the art is a fiction based upon an arcane classification system that does not show separate status. For example, a circuit that analyzes complex waves can be classified in 324/76.12. If a microphone is present, the same circuit can be classified in 379/406.12+. If a geophone is present, the same circuit can be classified in 367/38+. The list could be expanded to medical, military, and other environments. The point is, it is the same circuit. How can the same circuit have separate status in the art?

Years ago, separate status had some meaning because the prior art, organized by classification, was scattered throughout one or more large buildings, which meant hiking all over the place to search the physical files. Electronic searching eliminates that problem, even for publications.

The search burden is a fiction. With electronic search capability, any search is rapid. The critical element is defining the search, which some people can do much better than others. The abilities of an Examiner should not be the burden of an applicant.

"The burden imposed by the examination of patentably distinct inventions is, in many cases, as serious as the burden imposed by searching for such inventions." This presumes the existence of patentably distinct inventions to justify the burden when the burden is used to justify the conclusion that inventions are patentably distinct. In the field of logic, this is called circular reasoning.

2. What practice changes would result in more effective ways to seek higher level review of restriction requirements?

It is not good to add layers of management but any higher level of review should be given by someone with industrial experience. My quibble with restriction practice is the technically absurd reasons given for “separate status” or “materially different.”

6. What other areas of restriction practice can the Office improve and how?

Enforce Rule 104(b). This requires no additional personnel or resources.

Check out the prosecution history of U.S. Application Publication US2004/0234067. The first final rejection in this application was reviewed in a Pre-Appeal Brief Review which concluded that there was at least one actual issue for appeal. An appeal brief was filed, the final rejection was withdrawn, and prosecution was re-opened with an election requirement. There were two, subsequent non-final Office actions and a final Office action. The claims were never amended. The application is currently at the Board of Appeals.

Detail on how: Because Rule 104(b) requires that “The examiner’s action will be complete as to all matters,” a restriction or a requirement for election must be made in the first Office action, if appropriate. If the claims are amended in a way that justifies later restriction or requirement for election, then the action must be approved by a Supervisory Primary Examiner who is not the actual examiner of the application. Any restriction or requirement for election after the first Office action, where the claims have not been amended, must be approved by the Group Director because such action ratifies violation of Rule 104(b).

