

DEPARTMENT OF COMMERCE
Patent and Trademark Office

Statement of the Bar Association of the
District of Columbia PTC Section concerning USPTO Green Paper on
Restriction Practice, Official Gazette Notice, 28 June 2005.



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The Bar Association of the District of Columbia, Patent, Trademark & Copyright Section (“Bar Association”) appreciates the opportunity to present the following testimony to the United States Patent and Trademark Office’s Request for public comments on Green Paper Concerning Restriction Practice [(PTO) Docket No.: 2003-P-018], as published in the USPTO Official Gazette of June 28, 2005 (“the Green Paper”).

The Bar Association is one of the senior intellectual property Bar associations in the United States uniquely situated in the Nation’s capital having a broad cross-section of members from government, industry and private practice, with some members specializing in patents who are involved primarily in patent procurement, some entirely in litigation and counseling, some with a mixed practice and others who may participate in patent procurement issues by advising others on strategy. Since members frequently represent Applicants for patent and trademark before the PTO, they are thus concerned with any changes affecting the rules of practice before the PTO. The interest of the Bar Association is entirely *pro bono* and intended to help advance the patent profession. The views expressed

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herein only represent those of the PTC Section of the BADC, and not those of the BADC or of its Board of Governors.

The Bar Association fully supports the PTO's study of the Restriction practice, which finds its origin in the study for adoption of a PCT-style Unity of Invention in the United States. According to the Green Paper, the PTO considered four options developed for further study based on public comments. Of those, the third and the fourth options were considered impractical by the PTO and will not be discussed here.

The first option retains the current restriction practice but provides applicant the opportunity to pay additional fees for examination of the restricted inventions.¹ To the extent that the object of the underlying study is the adoption of a standard consistent with the PCT-style Unity of Invention, the first option falls short. Moreover, inasmuch as the standard for identifying different inventions within a group of claims remains the same, the Bar Association is concerned that the first option would have no impact on the quality of the restriction requirements and merely introduce a new cost to the applicants. The Bar Association also recognizes the additional burden of examining multiple inventions in one application and to the extent that the cost is judiciously apportioned to address the burden, the first option provides a certain degree of practicality.²

¹ At page 5, the Green Paper defines the first option as follows:

The current 35 U.S.C. § 121 "independent or distinct" standard would be retained and applicants would be given the option to request and pay for examination of up to 2 additional **independent or distinct** inventions beyond that which would be examined in the current practice. Applicants would also have the option to request and pay for examination of up to 10 species separately claimed, or claimed within a genus or Markush group, at an additional per species cost. (Emphasis original.)

² At page 17, the Green Paper proposes an additional search fee of \$500 and an examination fee of \$200 per additional invention. Applicant may also request examination of up to 10 species per invention at a cost of \$250 per species. Additional filing fees will not be die and all other prosecution fees (e.g., claim fees, extension fees, etc.) would remain the same.

It should be noted that the feasibility of the first option depends on the examination fees for each additional invention. If the additional fees are substantially higher than the cost of filing a divisional application, then applicants would have little incentive to exercise this option as compared with filing a divisional application. It should also be noted that the additional examination fees can be cost prohibitive for individual inventors and small-entity applicants.

The second option, identified as the modified PCT unity of invention, more closely traces the PCT model.³ The Green Paper notes that under this option, the applicant would be invited to identify a reference invention among several inventive concepts for the PTO's initial examination. See, Green Paper at page 7. The second option achieves a closer uniformity with the PCT practice. However, the first option provides for examination of up to ten additional species separately claimed, or claimed within a genus or Markush group, at an additional per-species cost. Consequently, the second option appears more restrictive than the first option. Finally, the second option requires revisions to 35 U.S.C. § 121 which will inevitably introduce further modifications and/or unintended changes to the existing practice.

Finally, the Bar Association is concerned about the examination delays anticipated with implementing either the first or the second option. The Green Paper acknowledges the Office's inability to hire sufficient examiners to address the additional workload. See *id* at page 15 and the Table captioned "Overall Pendency Increase Due to Production

³ At page 12, the Green Paper defines the second option as follows:

The current PCT "unity of invention" standard, modified to require that any purported special technical/common feature comply with 35 U.S.C. § 112, 1st Paragraph (in addition to being novel and non-obvious), would be applied to all US applications. Applicants would be given the option of concurrent examination of up to two additional inventions that lack unity of invention for additional fee.

Decrease.” Should the first option be exercised, the increase in First Action pendency would be particularly pronounced in Technology Center 1600. See *id* at page 16 and the Table captioned “Relative Pendency Increase per Technology Center.” Further determination is needed to evaluate whether any additional revenue generated by the exercise of the proposed options can be dedicated to hiring and training new examiners.

In conclusion, the Bar Association applauds and supports the PTO’s initiative in implementing this study and for its efforts in improving the Restriction practice. While the first option appears advantageous, a more detailed analysis of both options are warranted before a conclusive determination. The Bar Association would welcome any opportunity to assist the PTO in this endeavor.

Respectfully submitted,



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