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Subject: Request for Comments on Green Paper Concerning Restriction Practice

I realize this is somewhat belated.

I believe that the comments submitted by AIPLA and IPO (Intellectual property Owners) and by me as an individual in response to the 2003 Request for Comments are all still applicable to the June 2005 Green Paper. In essence, all three agreed that the PCT's **procedural** approach (invitation to pay additional fees) is good, and the current two-part test ("independent and distinct" and "substantial search burden") **substantive** test for multiple inventions could be adjusted slightly to substantially reduce costs for both the PTO and for applicants.

However, the Green Paper fails to even ask the two most important questions.

First.

The single easiest-to-correct problem with restrictions - and indeed with examination in general - is the current way that "counts" are allocated. Examiners, like everyone else, bend their behavior to meet the incentives they're given. Many examiners aggressively "game the system" with ill-founded restrictions and "hide the ball" tactics of examination, with the transparent goal of running up more counts for examining the same subject matter.

Solution. To a first approximation, counts should be proportional to filing fees for claims that are actually examined. It's much closer to fair than the current "flat rate" system, easy to administer, and at least reduces some of the incentive for gaming. It encourages examiners to keep closely-related issues together, which is obviously most efficient for both examiners and applicants.

Second.

The biggest big problem - but obviously much harder to correct - is the consistency with which the Patent Office ignores, refuses to enforce, and rewards the breach of, its own rules. I regularly block quote a provision of the MPEP or 37 C.F.R. to an examiner, and get back a paper that simply ignores the rule at issue. I then phone the examiner and ask about the particular rule, and how the examiner believes he/she complied with it. Amazingly often, the examiner tells me that he/she simply refuses to follow the rule. It's worst among senior examiners: at least a half-dozen

times, I've been told "I've been here in the Office for x years, and I've never had to do that before. I don't have to do it now." When they don't wholesale ignore the rules, examiners make up exceptions on the fly any time a rule is "inconvenient." Examiners know that they'll be rewarded with their three counts, no matter how many rules they ignore or how little of the application they actually examine - and some are quite aggressive about it.

The people that should be enforcing the rules are in some ways the worst offenders. Six weeks ago, I had a phone conference with a T.C. Director, in which he literally said that he did not consider the written rules to be "helpful" in deciding a petition; he stated that he was deciding the issue purely on his own authority. Sure enough, he completely ignored all the written authority in his written decision. To quote his decision (from memory - I don't have the literal text in front of me) "Petitioner should be advised that there is no rule that requires an element by element or limitation by limitation comparison of a claim to the prior art during the regular examination process." "Contrary to the citations of [Federal Circuit and CCPA] caselaw cited by Petitioner, it cannot be seen..." and then the T.C. Director makes up an exception out of thin air to exclude himself from the reach of the PTO's rules.

Any rule change is rather immaterial if PTO employees are free to ignore the rules or make up exceptions any time they feel like it.

Solution. Apparently, folks get promoted to T.C. Director for their management skills, and legal skills are neither rewarded nor exercised. The role of adjudicating petitions, and enforcing PTO rules, should be removed from T.C. Directors' responsibilities. An Office of Ombudsman that reports to Commissioner Doll or to GC Toupin? Examiners will not take the rules seriously until the Petitions process is given some real teeth and judicial due process, to prevent counts from being awarded for applications that were not examined within the rules.

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