

Date: June 15, 2005

Submission: Via email to: [unity.comments@uspto.gov](mailto:unity.comments@uspto.gov)

Subject: Response to request for comments on “Green Paper” as set out in “Green Paper Concerning Restriction Practice” at <http://www.uspto.gov/web/patents/greenpaper.htm> with deadline for comments being August 5, 2005

The “Green Paper” in its discussion of Option 4 couples the USPTO adopting the only reasonable and practical interpretation of “independent and distinct” inventions of 35 USC 121 with a requirement that the USPTO assume the burden of showing inventions subject to possible separate examination lack unity of invention. Thus the “Green Paper” ignores the fact that would create an almost impossible task for the USPTO, a fact that I have set out repeatedly in JPTOS articles, including as follows: “*Schneller and Caterpillar* demonstrate that a party who is given the burden of showing lack of unity of invention has an almost impossible task” (84 JPTOS 745, 820 (2002)). Based on this unnecessary additional requirement, the “Green Paper” concludes that Option 4 is not an acceptable option in order to infer that the only reasonable and practical interpretation of “independent and distinct” inventions of 35 USC 121, described in Option 4, is not a viable interpretation.

In fact, division of inventions for possible separate examination has always been and will always be based on (1) the reasonableness of an assumption of patentable distinctness between two inventions (based on differences or distinctions between the two inventions, hence “distinct inventions”) and (2) the reasonableness of an assumption of lack of unity of invention (that is, the two inventions not depending on the same invention for patentability, hence “independent inventions). Additionally, any division of inventions has always been and will always be prevented or overcome by the assumption of lack of unity of invention being determined to be unreasonable (hence “independent and distinct” always being required). All the nonsense, erroneous statements, contradictory statements, and vague statements of the MPEP, unity of invention practice, and USPTO pronouncements cannot change those facts.

Neither will that nonsense, nor those statements and those pronouncements, (1) prevent many conscientious examiners from continuing to limit examination of independent and distinct inventions to a number that the applicant has sufficiently paid for, (2) prevent many conscientious examiners from misapplying restriction practice, or (3) prevent many applicants from grumbling about restrictions whether properly applied or not.

That may continue under current restriction practice, or, according to Option 1 of the “Green Paper”, by allowing the examination of additional independent and distinct inventions in a single national stage application for appropriate additional fees, as is done in PCT unity of invention practice in international applications.

Thank you for this opportunity to clarify the current status of restriction practice in the USPTO.

Very sincerely yours,

Jon Henry

P.S. I have also attached corrected copies of the three JPTOS articles that I have written on restriction and unity of invention practice.