

August 4, 2005

Mail Stop Comments – Patents
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: Robert A. Clarke

RE: Response to the request for *Comments on Green Paper
Concerning Restriction Practice*, 70 Fed. Reg. 32761 (June 6, 2005)

Dear Mr. Clarke:

IBM Corporation submits the following comments with respect to the desirability of conducting further study of Options 1 and 2, as presented in the Green Paper:

With respect to both Option 1 and Option 2 -

1) The perceived difficulty to train examiners and achieve consistent implementation of either Option 1 or Option 2 could possibly be offset by assigning a dedicated person in each Art Unit to review all restrictions for compliance or to review all applications before assigning to an examiner to see if a restriction requirement is necessary.

2) Although there will be more claims and the complexity of the examination process may increase, the USPTO is contemplating outsourcing the search process. Therefore, if an examiner is unfamiliar with a particular disclosed technology, perhaps increased usage of patentability reports should be further explored.

3) Because the USPTO is considering outsourcing the search process, the impact on pendency and Patent Term Adjustment may not be as significant as predicted.

4) Although additional inventions would be examined for an additional fee, applicants may realize a cost savings by not having to file

divisionals - although the USPTO is predicting an increase in the number of RCE filings due to multiple inventions disclosed in one application.

5) The Office is predicting that the decrease in divisional filings will be approximately 3.5% after a period of two years. However, the anticipated complexity of the examination process may be offset by the benefit realized from having fewer divisional application filings.

With respect to Option 2 (Unity of Invention) -

1) Harmonization would make it easier to utilize search results and examinations results from the European and Japanese patent offices - possibly resulting in a reduction of pendency and application backlog.

2) Because an apparatus and process of making the apparatus are examined in the same application, fewer restriction notices and elections may be required and fewer divisional applications may be filed possibly resulting in a reduction of pendency and application backlog.

In conclusion, although the Office anticipates negative impacts on the overall patent system if either Option 1 or Option 2 is adopted, any short-term impact may be offset by long term gains.

Respectfully submitted,

Lynne D. Anderson
Program Manager
U.S. Patent and Trademark Office Liaison
IBM Corporation
Washington IP Law Dept.
lynnea@us.ibm.com
Voice: 703-299-1455
Fax: 703-299-1475