

From: Todd [mailto:todd@juneaupartners.com]
Sent: Monday, August 15, 2005 2:24 PM
To: Unity Comments
Subject: Request for Comments - Restriction Practice

To: Commissioner for Patents

Dear Sir,

My background has involved prosecution in the pharmaceutical and biotechnology fields. Performing prosecution as well as conducting validity and freedom to operate searches, I have an appreciation for both sides of this issue.

I understand the financial burden that restriction practice places on clients when a single application suddenly morphs into 10, 12, or even 50 different applications. It makes me wonder about the "contract" between the applicant and the government and whether this practice is, in practice, requiring applicants to put their technology into the public domain without receiving the statutorily guaranteed patent grant. In effect, it seems like a "government taking", as prohibited by the 5th Amendment of the U.S. Constitution, is occurring. Restriction practice also gives applicants the feeling that the government has them "over a barrel", i.e. is using them to generate excess income, since applicants cannot appeal these decisions unless the restriction is clearly ridiculous, as seen by an SPE. At worst, clients feel that restriction practice is equivalent to the "Patent Lawyers Full Employment Act" by splitting, presumably, one project into dozens.

I also have some understanding of the USPTO burdens, expectations, and responsibilities. It is clearly not fair to require an Examiner to help manufacture a somewhat valid patent grant while only giving him or her a limited time to do it, e.g. 14 hours. When applications are abusively long, e.g. 400 pages or 250 claims, etc., it cannot be expected that the process will not become "garbage in, garbage out".

Thus, paying more, under Option One, makes sense so long as the additional money goes directly to giving the Examiner more time. In other words, one fee, one invention, one search, one examination, one 14 hours allotment. Proportionately, two inventions, two fees, two search/examinations, two allotments of time, or 28 hours worth. I would not like to see the USPTO 'pocket the extra money' and dump the same burden on the Examiners and expect different results.

One last idea:

Would it be possible to make restrictions solely on the basis of whether the invention falls into one of the statutory categories?

Specifically, 35 U.S.C. 101 states, in part,

"Whoever invents or discovers any new and useful

process,
machine,
manufacture, or
composition of matter, or
any new and useful improvement thereof... ..".

Since 35 U.S.C. § 121 states "if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions", then why not interpret "independent and distinct" as referring to one of the five statutory classes listed above?

This would be clear to all involved, relieve some of the Examiners burden, and hopefully, establish reasonable expectations on both sides, applicants and Examiners.

Of course, if or when "clever" attorneys, within this "statutory class system", would continue to load their claims with excessively large swaths of property in order to 'game the system', the USPTO could merely implement Option One on a discretionary basis. Although it is a given that there are sometimes claim sets which are unusual in nature, I would submit that most experienced patent lawyers and experienced Examiners know a reasonable claim set when they see one. It seems a shame to institute 'a general rule' on the basis of the abusive behavior of a few. However, a more workable solution is definately in order.

Todd L. Juneau
Juneau Partners, pllc
2506 Clay Street
Alexandria, VA 22302
703/836-7026 office
703/785-8144 mobile