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Sent: Wednesday, June 15, 2005 9:26 AM  
To: Unity Comments  
Subject: Comments on Green Paper Concerning Restriction Practice

To whom it may concern:

I have been prosecuting patent applications since 1987 and have worked both in-house and as outside counsel, where I am currently.

The greatest problem with restriction practice today is that there are no objective standards and accordingly, there is no consistency. This is important because it is impossible to give useful advice to a client regarding how many applications to file and which claims should be in which application. It is also impossible to give any useful advice about the cost of obtaining patent protection for an invention.

In practice, the current rules on restriction are that the examiner decides based on criteria known only to and important only to the individual examiner. In addition, at any time during the prosecution, the examiner may change his mind and issue additional restriction requirements. There is absolutely no appeal, petition, or response to an examiner's restriction requirement because there is no objective standard to apply. The applicant is left to arguing that they don't feel distinct or that they should be in a different classification or the like. All of which are simply statements of opinion.

The current restriction practice is rife with examiner abuse. It is used to obtain additional points, it is used as a delay tactic. It is used as a way to get a first Office action out, when the examiner does not have the time or desire to perform a search. I have also seen uncertainty develop among examiners about election of independent and distinct inventions vs. election of species. On several recent occasions, I have been asked to identify species and assign claims and drawings to them even though there is no rejection of the generic claim and the generic claim is a mechanical claim. These restriction requirements again cause additional, unpredictable expense to clients. Such occurrences undermine trust in the PTO and the Federal Government as a whole by inventors and their companies.

The beauty of the EPO rules (Rules 29 and 30) is not necessarily the principles behind them. The beauty of the EPO rules is that they spell out clearly, specifically, and objectively what claims belong in one application and what claims do not belong together in one application. 90% of all cases can be determined by looking at the examples in the rules. If you are consistent with an example, there will be no restriction requirement. (If there is a restriction requirement, pointing the examiner to the examples quickly resolves it.) If you are not consistent with an example, then the system is like the US, completely inconsistent and unpredictable.

Regardless of the fundamental principles for restriction practice that you select, please make the rules objective, simple and clear. This will save time and expense for everyone.

For restriction to species, these rules seem to have no value at all to the

public. The best rule would seem to be that an inventor can claim all the species that he invented. If he invented a genus, then he should be able to have a generic claim, and claims to the species. If the generic claim is not allowable, then the inventor is left with species claims and the general rules for restriction can be used to determine how many different species claims can be allowed in the same application. If the purpose of the election of species practice is to reduce the search burden, then it is unfair to inventors and clever practioners can probably circumvent the rules by disclosing species but only claiming the genus or some other similar procedural trick.

Thank you for your attention. This is a difficult area and I wish you luck in developing rules that enhance the reputation and predictability of the system.

Sincerely,  
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