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Sent: Thursday, August 04, 2005 1:27 PM
To: Unity Comments
Cc: Clarke, Robert
Subject: RESPONSE to the PTO request for input on the Restriction Practice "Green Paper"
Importance: High

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This is a purely personal response to this PTO request for public input on the subject 53 page PTO Green Paper due this Friday, with the usual disclaimers about this not necessarily representing the views of any clients.

[I had hoped to be able to see, and perhaps join in with, responses from IP professional associations, but I have not yet seen any, even in committee draft form.]

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"Comment deadline date: To be ensured of consideration, written comments must be received on or before August 5, 2005. No public hearing will be held. Comments should be sent by electronic mail message over the Internet addressed to: unity.comments@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, or by facsimile to (571) 273-7735, marked to the attention of Robert A. Clarke. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office prefers that the comments be submitted on a DOS formatted 3 ½ inch disk accompanied by a paper copy.

For further information contact: Robert A. Clarke, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, by telephone at (571) 272-7735, by mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, or by

facsimile to (571) 273-7735, marked to the attention of Robert A. Clarke, or preferably via e-mail addressed to: robert.clarke@uspto.gov."

First, thank you for continuing this effort, including all the effort you have put into digesting and reporting the public inputs to the previous PTO study of this difficult issue.

Secondly, I am concerned about the inadequate attention to the *importance* of this issue to those who suffer from its consequences and pay for its costs. [In contrast, it cannot escape attention that law firms doing extensive patent preparation and prosecution work can actually financially *benefit* from excessive restriction requirements and their consequently increased divisional patent applications, as can the patent examiners making the excessive restrictions.] Excessive (unnecessary and inappropriate, and often *multiple*) restrictions [for which the PTO does not now provide a fully effective recourse by appeal, timely petition decisions, or otherwise] varying widely by certain examiners [especially *outside* of chemical generic / extensive-species claims practice, where restriction may be more justified] is costing many clients millions of dollars in unnecessary extra filing fees, extra prosecution costs, extra issue fees and maintenance fees, and lost or greatly delayed claim protection.

Furthermore, this excess divisionals practice is *highly inefficient* for BOTH the PTO and the public. It requires duplicative re-processing, re-reading, re-publishing, and re-examining the *same application specifications a year or more later*. These excess divisionals are often picked up "cold" by a different examiner and attorney. Divisionals are also a major source of dangerous "submarine patents," because the PTO typically does NOT process or examine divisionals in *priority date* order, and often takes considerable time to even set them up and assign them to an examiner. Divisionals also increase risks of "inequitable conduct" for inconsistent prosecution arguments or art citations vis a vis the parent and other divisionals. Divisionals no longer extend patent terms, they reduce patent terms for those claims. They also significantly increase the backlogs of other applications that could have been processed earlier by the PTO if less divisionals were being filed.

It is appreciated that page 3 of this Green Paper report *admits that PTO restriction requirements have significantly increased in recent years*. However, the allegation on p. 1 of the Green Paper that: "data indicates that the majority of [alleged] additional inventions presented in applications that are currently restricted are not pursued in divisional applications" is respectfully challenged. My own corporate client, for example, which is not even one of the larger patent application filers, and relatively new as a major company, has filed a total of

1,607 divisionals by actual count, most of them just since the 1970s, and does not follow any such practice. Multiply that number by the large numbers of other major PTO users.

Thus, I personally *support* the proposed PTO first choice concept on p. 17 of the Report *for a optional additional fee for additional searches*, which would presumably provide a single, un-delayed, un-duplicative and much more efficient processing of restricted claims without requiring the filing of one or multiple divisional applications (with all their respective increased costs, time delays and error opportunities), PROVIDING examiner restriction *abuse* by certain examiners is adequately dealt with by the PTO, and effective applicant recourse for that is provided. It would significantly contribute to a decrease in *actual* pendencies.

Last, but not least, I had hoped to get an answer from an IP professional association in time for my legal question below, but since I did not, I am submitting this question for PTO response.

Please explain how MPEP provisions that seem directly inconsistent with the language of the very statute they are implementing are being considered merely a 4th, and less desirable, "OPTION" by the PTO in this Green Paper?

The PTO in this Green Paper admits that: "The statutory basis for USPTO restriction practice arises from 35 U.S.C. § 121 which states "[i]f two or more independent AND [emphasis supplied] distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." The PTO also admits that "the guidelines for the application of the current USPTO restriction standard are found in the Manual of Patent Examining Procedure (MPEP) Chapter 800", but that these MPEP provisions are based on a restriction test of independent OR distinct inventions, and say that changing to independent AND distinct would be too burdensome.

Obviously the PTO cannot normally re-write statutory language for the MPEP?
Please explain.

Thank you,
Paul F. Morgan