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To: Unity Comments
Subject: Unity Comments - Attn Robert Clarke

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MESSAGE:

Re: Request for Comments on the Study of the Changes Needed to Implement a Unity of Invention Standard in the United States

Dear Mr. Clarke:

These comments are being submitted in response to the May 9, 2003, Request for Comments on the Study of the Changes Needed to Implement a Unity of Invention Standard in the United States. They are my personal comments, as a registered practitioner of over 20 years in a firm that handles over a thousand U.S. National, U.S. National Stage, PCT International Stage, and foreign patent applications each year, and in which I have long supervised much of the PCT and foreign application related practice and restriction requirement related practice. While they reflect the experiences of many of the firm's clients, these comments should not be construed to reflect the position of any particular client of the firm as to any particular case.

Before addressing the specific Issues for Comment identified in the Request for Comments, I would like to comment briefly on the current situation, which I consider highly undesirable. Presently, unity practice, restriction requirement practice and election of species practice are all supposed to be applied by U.S. Patent Examiners, depending on the facts of specific patent applications before them. Each of these types of practice includes subtleties of law that are complicated by subtleties of the facts of any given case. They are all routinely misapplied by Patent Examiners, who often apply the wrong standard or misapply the right standard. For example, restriction and election of species practice are often improperly applied in PCT National Stage applications, and combination-subcombination restrictions are hardly ever correctly applied. Even when correctly applied, restriction and election of species practice often lead to waste of time and resources in highly related cases, and poor quality searching and examination due to artificial distinctions being made (for example, an apparatus that is designed to practice a method and the method itself are often separately classified and examined by different examiners, leading to incomplete searching and inconsistent office actions as a result of a restriction

between them). Even the same claims can be subjected to different practices, since the unity standard applies in a National Stage application, while restriction and election of species practice apply in a continuation of that same National Stage application. The coexistence of these practices also leads to a kind of forum shopping within the PTO, as applicants often decide whether to file a National Stage application or a "Bypass Continuation" application based on an underlying PCT International application based in part on the desirability of being subject to unity practice as opposed to restriction and election of species practice.

In addition, the U.S. restriction and election of species practice leads to difficulty in management of international patent portfolios. U.S. patent applications are often restricted in significantly different ways than foreign applications, leading to significant differences among counterpart applications around the world. This causes difficulty to the patentees in managing their portfolios and difficulties to the public in analyzing the differing scopes of counterpart patents worldwide. The greater multiplication of the number of patents arising from U.S. restriction and election of species practice also seriously increases patenting costs.

For these and other reasons, I strongly support a move to a unity standard similar to that of the PCT, EPO and JPO.

Issue 1

Question 1:

The U.S. PTO should not limit the number of independent claims in any category. U.S. law is significantly different from European law in the field of claim construction and application of the doctrine of equivalents. Furthermore, European law provides more opportunities for post allowance claim amendment, both in opposition proceedings and nullity proceedings.

For example, U.S. case law creates a clear need for multiple claims in various categories to obtain a full and reliable literal scope of patent protection (e.g., composition claims and product-by-process claims in Exxon v. Lubrizol, 64 F.3d 1553, 35 USPQ2d 1801 (Fed. Cir. 1995), means-plus-function and non-means-plus-function apparatus claims in In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), step-plus-function and non-step-plus-function method claims in O.I. Corp. v. Tekmar, 115 F.3d 1576, 42 USPQ2d 1777 (Fed. Cir. 1997)). Furthermore, the U.S. emphasis on the doctrine of claim differentiation and prosecution history and estoppels created therein (not present in European practice) often require alternative approaches to claiming certain subject matter and alternative language in independent claims of the same category. Claim scope problems that could arise from limitation to a single independent claim in each category are also more easily addressed in European practice, in which claims may be amended even in the course of hearings in opposition and nullity proceedings.

Further, the increased burden on examiners is relatively insubstantial in this area, since the field of search is (or should be) generally the same for such related claims, and minor increased burdens are addressed by the substantial fees imposed for the presence of more than three independent claims.

Question 2:

I believe that one of the premises of Issue 1 is incorrect. U.S. Examiners do not routinely search and examine every claim, independent and dependent, or every limitation of every claim. Instead, they routinely focus on the independent claims. If an independent claim is found allowable, they generally do not take the time to search all of the dependent claims. Furthermore, if one or more significant

limitation of an independent claim is not found in the prior art, they often do not even search every limitation of that independent claim. Even if the independent claims are rejected, U.S. Examiners (improperly) often do not provide detailed search or examination of every dependent claim, rather waiting to see how the applicant responds to the first office action before expending substantial efforts on the dependent claims. In this respect, therefore, current U.S. practice does not differ significantly from EPO practice (in which subsidiary limitations of independent claims and limitations of dependent claims are also often addressed summarily, but at about the same level of detail as in the average U.S. case).

Because this practical approach is already in use in both the United States and Europe, there is no need to change the U.S. PTO approach to examination. In view of the fact that this system has long been in effect under the current statutory presumption of validity, and has not caused undue litigation burdens under that presumption in comparison to the examination burdens on the PTO, I see no need for any change to the presumption of validity.

Issue 2

Question 1:

I believe that the U.S. PTO should adopt the PCT option of paying for additional inventions in a single application.

The present divisional practice generally results in serial prosecution of patent applications, often with effectively overlapping claim scope (e.g., a patent on an apparatus for practicing a method often issues first, followed some years later by a divisional patent on the method). They are also generally examined by different examiners, often with different fields of search, leading to inconsistencies of examination and ambiguities as to validity. The existence of the divisional application also leads to the opportunity for the patentee to file further continuing applications modifying the scope of the claims of any prior patent in the chain (although a terminal disclaimer, which does not actually affect any patent term in most instances, may be filed). This leads to significant problems to the public, which cannot obtain any certainty as to the full scope of protection that the patentee will ultimately obtain upon issuance of the first patent. It also leads to inconsistencies in examination that can cause uncertainties as to validity to both the patentee and the public. Unified search and examination, preferably by a single examiner or cooperating team of examiners, would eliminate many of these problems. The increased burden would be ameliorated by the fees imposed for examination of multiple inventions.

In addition, the PCT system also avoids delays and inequity in the case where a unity objection is improper, since search and examination of the full application can proceed while any petition for review of the propriety of the requirement/objection is being considered. Under the present divisional system, on the other hand, search and examination must effectively start over when an improper restriction requirement is reversed on petition.

Question 2:

I do not believe that any changes to term adjustment or the order of examination should be necessary. The additional fees generated by the proposed system should allow the PTO to allocate sufficient resources to each application. Furthermore, because applicants are presently entitled to file divisionals at any time during prosecution of the parent application, there is no new inequity in shifting to the proposed fee-based approach. Maintaining the possibility of using the current divisional practice, at least as to small entities, would avoid undue burden on applicants who must string out their patent

expenses.

Issue 3

Applicants generally do, or should, draft claims based on the scope of overall protection desired, without having to worry about the order of presentation of the various claims being used to achieve that protection. In general, it is reasonable to presume that a single application is designed to address a single invention or group of linked inventions, and that the applicant is not contemplating restriction. Furthermore, applicants often cannot predict the groupings of claims applied by examiners in unity objections. Thus applicants should be given an opportunity to select the claims that they want examined first after the examiner has identified to them the groupings of claims that the examiner considers linked (which groupings are often unexpected by and in many cases incomprehensible to applicants).

This causes little delay and burden to the PTO, which can set a very short (e.g., one month) period for response to such objections (with fee-based and term-affecting extension practice available), and use telephone practice, much like it does with the present restriction practice.

Issue 4

Question 1:

In practice, most partial searches in PCT and foreign applications arise from restrictions on patentable subject matter that do not apply under U.S. law. Thus the unpatentability of methods of medical treatment and diagnosis, software, business methods, and the like under foreign laws are the usual basis for partial search and examination in PCT and foreign applications. Burden is only occasionally an issue here, arising from the presence of multiple independent claims in single categories, which is an issue that arises from the differences in U.S. and foreign law and is thus not properly applicable in U.S. cases, as discussed in connection with Issue 1 above. Accordingly, the PCT and foreign bases for partial searching are not applicable in most U.S. cases.

Furthermore, partial searching often leads to unnecessary delays and burdens. Where problem areas are identified, claims are often amended or explanations given that moot the basis for partial searching. The result is multiple, sequential searches in a single application, which unnecessarily burdens both the applicants and the PTO. Under current practice, U.S. Patent Examiners who are faced with unsearchable claims have the ability to object to the claims before any search is conducted or take other appropriate action within their discretion based on the specifics of a given application (see, e.g., MPEP 702.01).

Question 2:

The U.S. does not have an "industrial applicability" requirement in its patent laws. Thus such a requirement should not be taken into account in any PTO practice.

As noted in MPEP 702.01, the PTO may already assess adequacy of disclosure in deciding how to examine a patent application. No changes are necessary.

Issue 5

The most equitable approach would be to apply additional fees for including additional inventions for which there is no unity within a single patent application/patent. These could involve fees for making

the election not to exclude such inventions from the application at the time of a unity objection, issue fees and maintenance fees, since the result of such claims is to use a single patent to address claims that might otherwise be included in separate patents. Because of the increased efficiency of examining such inventions together in many cases, the amount of these fees need not be excessive.

On the other hand, the present restriction requirement practice artificially inflates fees for inventions that really should be included in a single patent. Thus where unity is present, the overall fee structure should apply. The present existence of excess claim and excess independent claim fees should account for any increased burden where there are many claims but still unity of invention.

Issue 6

As apparent from much of the above discussion, I disagree that the present restriction practice usually relates closely to the number of inventions in a patent application or the number of disciplines involved. For example, the artificial distinction between methods and apparatus for practicing the same invention bears no relationship to the number of inventions or disciplines. Examiners should be trained to examine claims of different types for inventions for which there is unity.

The best approach would still be to use a single examiner for a single application, especially where unity is present. Where unity is not present or an examiner is incompetent to examine a single general inventive concept in the form of different types of claims, a team approach is next best to ensure consistency and quality (as well as to improve the competence level of such an examiner). Patentability reports are awkward, and focus on written communications that are often much less complete and effective than team discussions.

Issue 7

I believe the proposal is counterproductive and contrary to all of the goals of the patent system as reflected in statute and case law.

Where claims are properly rejoined, there should be no requirement to pay additional fees or submit to additional delays by way of an RCE. Under current practice, claims that should be rejoined because they depend from or include the features of allowed claims (and thus by definition meet the unity standard and the In re Ochiai standard) are generally rejoined with little burden on the examiner, cost or delay, and this situation should not be degraded by imposing an RCE requirement on applicants and the PTO. The delay occasioned by an RCE under these circumstances is detrimental to the patentee, whose protection is delayed, and to the public, whose knowledge of the scope of the patent is delayed. It is not justified by any increased burden on the examiner, because there is minimal such burden where the patentability over the prior art has already been established by the fact that such claims depend from or include the features of allowed claims.

Issue 8

Question 1:

There is no need for implementing this option, since the present statutory standards permit implementing a unity standard and imposition of fees for additional claims (e.g., to claims that do not meet the unity standard) or could be changed to permit such fees for sets of claims that do not meet unity standards. The piecemeal examination and delays in issuance that would necessarily result from such an option requiring serial examination of claim sets overwhelm any justification for such an option. Fee structures

could be established as discussed above in relation to Issue 5.

Issue 9

Present 35 USC 121 is broad enough to permit the PTO to construe "independent and distinct inventions" as inventions that do not meet a unity standard, and is already phrased to be discretionary with the PTO. (Indeed, such a construction would be more logical than the present strained PTO construction that largely ignores these words and imposes tests for restriction that are largely irrelevant to the words of the statute.) The proposed fee changes in the current version of the Strategic Plan, particularly the excess claim and independent claim fees, and search and examination fees, could probably be used to accommodate fees for inventions without unity without any further legislative changes. However, further fee legislation to clarify their application to inventions without unity would be preferable to maintaining the present system, and need not be coupled with any revision to Section 121.

Please feel free to contact me with any questions.

Respectfully submitted,

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