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Subject: USPTO Request for Comments on the Study of the Changes Needed to Implement a Unity of Invention Standard in the United States (RFC)

The Request for Comments on the Study of the Changes Needed to Implement a Unity of Invention Standard in the United States (RFC) appears to be mistakenly based on the idea that restriction practice is not based on a unity of invention standard because it is based on 35 USC 121. On the contrary, restriction practice is based on a unity of invention standard, as is commonly understood, for example, by allowance of a linking claim that demonstrates unity of invention preventing restriction or requiring rejoinder of restricted inventions.

The primary purpose of restriction practice and unity of invention practices (PCT, EPO, and JPO) is to prevent an examiner being overwhelmed by claimed inventions with separate features in one application. That can only be prevented by (a) limiting the number of inventions examined in the one application or (b) giving an examiner extra time to examine extra inventions in the one application. Either technique (a) or (b) requires additional money from the applicant in order to examine additional inventions.

Restriction practice operates on the basis of (a) above, and PCT unity of invention practice operates on the basis of both (a) and (b) above. However, in both restriction practice and PCT unity of invention practices, separate features of inventions (related to an *a priori* reasonable assumption of patentable distinctness) rules division of inventions, but unity of invention overrules that division. However, PCT unity of invention practice obscures that fact by never addressing the issue of patentable distinctness to which the separate features directly relate.

The RFC poses questions (under the first nine numbered "Issues") that relate generally to three issues: (1) how to choose (elect) one divided invention for certain examination in the application; (2) how to enable examination of nonelected divided inventions; and (3) how to examine the claims of a divided invention. Those questions generally concern how to control examination of inventions that have been properly divided for possible separate examination and have not been shown to have unity of invention so that an examiner in the USPTO is not overwhelmed by examining multiple inventions. That has always been one concern of restriction and unity of invention practice. I have dealt with that concern in my restriction paper published in the October and November, 2002, Journal of the Patent and Trademark Office Society (JPTOS) in two parts. (Attached is a corrected version of that paper that includes corrections noted in my letter to the editor published of the December 2002 JPTOS and other corrections. Also attached is a draft of a second restriction paper, file name "Restriction Article 4 052503," that concerns simplifying restriction practice by uniformly dividing inventions based on separate features of the inventions.)

However, unfortunately, only the two questions of Issues 9 and 10 of the RFC allow consideration of an issue that is more important than issues (1) - (3) noted above and that also

relates to the topic of the RFC of how a unity of invention standard should be implemented. That more important issue, issue (4), is how to properly divide inventions in one application for possible separate examination. Issue (4) is more important than issues (1) - (3) because issue (4) determines if issues (1) - (3) will even arise and, if issues (1) - (3) do arise, preferred ways of handling issues (1) - (3) do little or nothing to reduce the extra effort required to examine more than one invention, whether the other inventions are examined in the same application or in a different application.

The failure of the RFC to directly address issue (4) is related to the common misconception that unity of invention practices teach a reliable way to divide inventions in one application for possible separate examination. In fact, unity of invention practices do not teach a reliable way to divide inventions in one application for possible separate examination. That is because unity of invention practices attempt (or pretend) to control division based on the concept of unity of invention. In fact, in PCT unity of invention practice, for example, an examiner can generally arbitrarily either divide inventions based on assuming lack of unity of invention or not divide invention based on assuming unity of invention.

In more detail, the basic flaw in PCT unity of invention practice in dividing inventions may be pointed out by first considering two identical claims. The inventions of the two identical claims can be reasonably assumed to have unity of invention or alternatively be reasonably assumed to lack unity of invention (based on the inventions being obvious over the prior art). Therefore, no considerations of unity of invention alone can reliably determine the propriety of division. The "solution" to this dilemma is point out that there is no additional burden to searching and examining an identical claim. That is, one switches the question of division from unity of invention to the burdens of searching and examining the inventions.

However, in the real world, where claims are not identical, that requires one to state the standard of preventing division (when one must assume unity of invention) not in terms of *no* additional burden but rather in terms of *no excessive* additional burden. But PCT unity of invention practice provides no standards for determining when examining one or more additional inventions would create an excessive additional burden, nor can a reasonable standard of *no excessive* burden be agreed upon without such standards. That is, one has merely substituted one arbitrary and capricious standard of division for another.

When the "switching" argument is refuted, as set forth in the previous paragraph, one may return to arguing for dividing inventions based on unity of invention in the real world where claims are not identical by proposing that division is determined by weighing the apparent relative importance of common features (and possibly apparent corresponding special technical features) and of other different features of two inventions (even though unity of invention practice actually never considers differences in features of two inventions). However, such a procedure is obviously too complex and too subjective, certainly before substantial search and examination, to be practical for determining division of inventions. But more important, such a procedure completely confuses the issues of unity of invention and patentable distinctness. That is because unity of invention relates only to the importance of common features (and possibly

apparent corresponding special technical features) and patentable distinctness relates only to the importance of the other different features of two inventions.

Therefore, one is led in a circular fashion back to determining unity of invention based only on the common features (and possibly apparent corresponding special technical features) that the beginning example of two identical claims above demonstrates does not work.

In fact, it is the unreasonableness of an assumption of patentable distinctness between the two inventions that prevents division of two identical claims or two inventions with only trivial differences in both restriction practice and PCT unity of invention practice. But PCT unity of invention practice makes no provisions for considering patentable distinctness in determining division of inventions. In contrast, for better and worse (based on the flawed teachings of the MPEP), restriction practice defines in detail when restriction may be made based on the reasonableness of an assumption of patentable distinctness unless unity of invention is found.

Still, a misconception generally exists that unity of invention practice is less arbitrary than restriction practice in dividing inventions for possible separate examination. That is based on PCT unity of invention practice, with regard to issue (4), how to divide inventions in one application for possible separate examination, preventing division in rare situations of only one-way distinctness for inventions in different categories of claims as set out in the Administrative Instructions Under The PCT. However, the applicability of that rare exception is frequently exaggerated, thereby suggesting that PCT unity of invention practice is generally stricter that restriction practice with regard to issue (4).

Additionally, the often improper *application* of restriction practice is often taken as evidence of restriction practice being more arbitrary or at least more liberal than PCT unity of invention practice in *authorizing* excessive and unnecessary division of inventions for possible separate examination. However, in fact, although restriction does broadly allow division based on separate features of inventions when unity of invention has not been shown, as it must be in order to prevent claims with separate features and without a showing of unity of inventions overwhelming the examination process, restriction is stricter and less arbitrary in dividing inventions for possible separate examination than is PCT unity of invention practice. In fact, it is the greater strictness and lesser arbitrariness of restriction practice, as taught in the MPEP, that enables one to show in many different ways that a restriction requirement is improper without a showing of unity of invention. In contrast, it is generally impossible to show a holding of lack of unity of invention is improper without a showing of unity of invention because, as explained above, any two claimed inventions can reasonably be assumed to lack unity of invention until unity of invention is shown, as, for example, by allowance of a linking claim.

In fact, adopting PCT unity of invention practice with regard to issue (4), how to divide inventions in one application for possible separate examination, would allow division in general as is currently done with election of species requirements in restriction practice, except that it would not require a reasonable assumption of patentable distinctness in order to support division of the inventions. Because I am in favor of a general application of the standards of election of species requirements to dividing inventions in general, as set out in the attached paper, file name

"Restriction Article 4 052503," and I believe that the USPTO will never implement division of inventions for possible separate examination when an assumption of patentable distinctness between the inventions is unreasonable, I believe the USPTO should consider adopting unity of invention practice with regard to issue (4), how to divide inventions in one application for possible separate examination. However, in adopting unity of invention practice with regard to issue (4), it is critical that the USPTO and patent practitioners recognize that PCT unity of invention practice provides no basis for division of inventions other than a reasonable assumption of patentable distinctness and no basis for overruling an otherwise proper division except (a) based on a showing of unity of invention or (b) based on requiring a reasonable assumption of two-way patentable distinctness when only one a reasonable assumption of one-way patentable distinctness is present. As stated above, adopting unity of invention practice with regard to issue (4) would provide the same results as allowing all divisions as is currently done in election of species requirements in restriction practice. That fact is further explained in the ADDENDUM below in the response to the question of Issue 9 of the RFC.

ADDENDUM: The above remarks respond to the question of Issue 9 of the RFC as it is directed to issue (4) how to properly divide inventions in one application for possible separate examination, which is of primary importance to a patent system based on search and examination in the United States or elsewhere. The last part of the response to the question of Issue 9 below provides additional comments on issue (4) that are more directly based on an understanding the general content of the attached papers. However, as recited above, the RFC also poses questions (under the nine numbered "Issues" 1 through 9) that relate generally to the three other issues: (1) how to choose (elect) one divided invention for certain examination in the application; (2) how to enable examination of nonelected divided inventions; and (3) how to examine the claims. In order to complete my response, I address the questions of the ten "Issues" of the RFC, including the questions of the nine "Issues" of the RFC as related to issues (1) - (3). However, although I believe strongly, for example, that the principle of "one invention (with unity of invention), one patent" should be maintained, I also believe that none of issues (1) - (3) raise critical questions for the patent system, unlike issue (4) discussed above.

Issue 1, answer to first question: I believe the reference to studying "ways to adopt EPO claim treatment practice" relates to issue (3) how to shorten examination of the claims. There is nothing wrong with "studying" any approaches to shortening examination of the claims, but the way the question appears to reverse the logical order of "if" the USPTO should adopt EPO practice before "how" in terms of reciting "study ways to adopt....and why" suggests an agenda biased in favor of adopting changes. Limiting an applicant to one independent claim per category of invention will shorten examination of claims in some applications, but only for the more conscientious applicants who only file independent claims that they consider likely to be

allowable. The less conscientious applicants will simply file a broad independent linking claim and claim the various inventions with separate features that they really want in dependent claims. I do not believe it is a good idea to penalize an applicant for being conscientious in that way, and therefore I am against that specific proposal even though it would shorten examination in some cases.

Issue 1, answer to second question: I believe this question also relates to issue (3) how to examine the claims. I don't know what "in the same fashion as the EPO" means. Specifically, the phrase appears to relate to "central claiming" and not being "unduly concerned with respect to the dependent claims" if the independent claim is found allowable. I don't know how that differs from current USPTO practice. Once an independent claim is found allowable in current USPTO practice, the concern with dependent claims greatly decreases. If the difference is supposed to relate to ignoring problems of indefiniteness under 35 USC 112, second paragraph, problems of lack of enablement under 35 USC 112, first paragraph, or other statutory requirements in dependent claims, I am against it. Examiners in the USPTO do too much shortcutting of examining dependent claims as it is. To make such shortcutting Office policy would only further encourage doing more shortcutting, whether in accordance with Office policy or not.

Issue 1, answer to third question: Because I am not in favor of shortcutting examination of dependent claims, I see no reason for the basic presumption of validity to be any different for those claims.

Issue 2, answer to first question: This question relates to issue (2) how to enable examination of nonelected divided inventions, and the answer is, "No." The principle of "one invention (with unity of invention), one patent" should be maintained by not allowing the payment of additional fees to enable examination of nonelected inventions. The failure of the USPTO to properly implement the additional fee approach at the PCT international stages makes that evident.

Issue 2, answer to second question: Not applicable because the answer the first question is, "No."

Issue 2, answer to third question: Not applicable because the answer the first question is, "No."

Issue 3, answer to both questions: These questions relate to issue (1) how to choose (elect) one divided invention for certain examination in the application. An applicant should be free to elect among divided claimed inventions. There is no good reason not to allow him that freedom. Therefore, the answer to both questions is, "No."

Issue 4, answer to the first question: This question relates to issue (3) how to examine the claims. The answer is, "No," because the standard of "unduly burdensome" is too vague and shortcuts examination in an unnecessary way.

Issue 4, answer to the second question: This question relates to issue (3) how to examine the claims. The answer is, "No," because the absence of industrial applicability makes sense only in terms of lack of utility which is already covered by patent law.

Issue 5, answer to the question: This question relates to issue (2) how to enable examination of nonelected divided inventions, specifically, how to pay for increased costs of examination related to "under Unity of Invention" changes. No changes that will increase operating costs in any really new way need to be implemented if the principle of "one invention (with unity of invention), one patent" is maintained. As at present, with changes, additional payments will be necessary if that principle no longer applies.

Issue 6, answer to all questions: This question relates to issue (3) how to examine the claims. The premise of the questions at the start of Issue 6 is in error. Issue 6 begins: "Adopting a Unity of Invention standard would impact the number of inventions that would be examined in a single application, and require examining multiple inventions that cross multiple disciplines in a single application." That is not true. Current restriction practice is a unity of invention standard and many changes to that unity of invention standard can be made without requiring examination in one application of claims that are considered to lack unity of invention. Additionally, examiners already examine inventions in different disciplines, based, for example, on combinations and subcombinations or products and processes being claimed together and not being reasonably assumed to be patentably distinct. The USPTO continuously considers how that examination can be improved by getting more than one examiner involved in various ways. However, maintaining examination primarily with one examiner who will talk to other examiners and seek their assistance when appropriate has been found to be the most efficient approach.

Issue 7, answer to all the questions: This issue and the questions are unclear and do not appear to relate to any of issues (1) - (4) discussed above. As far as understood, the issue relates to maintaining the principle of "one invention (with unity of invention), one patent" through RCE practice as is currently done.

Issue 8, answer to the first question: This question relates to issue (2) how to enable examination of nonelected divided inventions. It is unclear if Issue 8 is proposing that an applicant could pay for examination of an additional invention (a) even when allowed claims to an invention lacking unity of invention are in the application or (b) only when no allowed claims to another invention lacking unity of invention are in the application. The principle of "one invention (with unity of invention), one patent" should prevent the option proposed in Issue 8 in situation (a) but allow it in situation (b).

Issue 8, answer to the second question: If allowed per situation (b), an appropriate fee would be required in order to allow continued prosecution in the application.

Issue 9, answer to the question: The question relates to all of issues (1) - (4) discussed above. With regard to issue (1) how to choose (elect) one divided invention for certain examination in the application, there is no good reason to modify an applicant's right to free election among divided inventions as is currently done in restriction practice. Additionally, with regard to issue (2) how to enable examination of nonelected divided inventions, the basic principle of "one invention (with unity of invention), one patent" must be maintained to avoid a multitude of needless complications. Furthermore, with regard to issue (3) how to examine the claims, there is no good reason to change the substantive examination of the claims that is presently in accordance with the unity of invention standard of restriction practice.

With regard to issue (4), the alternatives of Issue 9 relate to the conclusion above, before the ADDENDUM, of being in favor of adopting unity of invention practice with regard to issue (4), how to divide inventions in one application for possible separate examination, but recognizing that issues of patentable distinctness would actually form the basis of dividing the inventions for possible separate examination.

The following comments further explain the answer with regard to issue (4) above for those who are familiar with the content of the two attached papers. As explained in the attached papers, restriction practice actually divides inventions based on the inventions being "independent and distinct" inventions as set out in 35 USC 121, first sentence. "Independent" inventions are inventions that are reasonably assumed to lack unity of invention and "distinct" inventions are inventions that are *a priori* reasonably assumed to be patentably distinct inventions. Determining the inventions to be "distinct" inventions enables division but determining the inventions not to be "independent" inventions overrules that division.

PCT unity of invention practice essentially neglects the requirement that the inventions be "distinct" inventions and attempts (pretends) to divide inventions based solely on the inventions being "independent" inventions. Thus PCT unity of invention practice eliminates the necessity of recognizing that "independent" inventions of 35 USC 121, first sentence, are inventions that are reasonably assumed to lack unity of invention, which has always been a major impediment to understanding restriction practice. In fact, PCT unity of invention practice oversimplifies division of inventions for possible separate examination in a way that makes no sense because, as explained above, issues of unity of invention can never serve to help divide inventions, only to prevent division. Because reasonable people will soon recognize this fact, and because such people will be quickly led to recognize that issues of patentable distinctness in fact determine division of inventions for possible separate examination, I believe adopting unity of invention practice with regard to issue (4), how to divide inventions in one application for possible separate examination, may benefit the USPTO.

No statutory changes would be necessary to make that change. Rather the current USPTO nonsensical interpretation of "independent and distinct" inventions of 35 USC 121 would be temporarily interpreted to relate to only the issue of unity of invention, and when that would in turn be recognized to make no sense, the proper definitions of "independent" inventions as inventions that are reasonably assumed to lack unity of invention and "distinct" inventions as

inventions that are reasonably assumed to be patentably distinct would be recognized. Thus the understanding of the only reasonable general basis for dividing inventions for examination purposes would be recognized.

Subsequently, the complex and confused teachings of Chapter 800 of the MPEP with regard to the issue of division could be reexamined with regard to various less important related subissues, such as whether the USPTO wants to retain the *a priori* aspects of the reasonable assumption of patentable distinctness for division and when the USPTO wants to allow division based on only a one-way reasonable assumption of patentable distinctness. No statutory changes would be necessary to make those changes. In fact, adopting a unity of invention standard in that manner is essentially the same as interpreting current 35 USC 121, first sentence, in a way that makes sense as set out in the attached paper.

Still later, issues (1) - (3) would be considered, including considering changes that would require statutory changes. For example, as set out in Issue (9), Part 1, a statutory change might be required for an applicant to pay additional fees in order to have additional inventions that are reasonably assumed to lack unity of invention to be examined in the same application.

In summary, with regard to issue (4), how to divide inventions for possible separate examination, it may be helpful to recognize that inventions always have been and always will be divided for possible separate examination, whether in restriction practice or unity of invention practice, based on their differences. Additionally, those differences must be more than differences in wording, and, in fact, must support a reasonable assumption of patentable distinctness because that essentially determines the likelihood of a burden of search and examination of multiple inventions that will tend to overwhelm the examination process. Furthermore, a reasonable assumption of two-way patentable distinctness of two inventions, without a showing of unity of invention, mandates either division of the invention or accepting a probable substantial increase in the burden of searching and examining the two inventions together. In such a case, only the USPTO should be able to decide whether division is required, and that decision should be based on assuring applicants are prevented from overwhelming the examination process.

Whether one implements division on that basis in terms of "adopting a unity of invention standard" or by reasonably interpreting "independent and distinct" inventions or 35 USC 121, first sentence, as set out above, makes little practical difference with regard to issue (4), how to divide inventions for possible separate examination.

Issue 10, answer to the question: In order to obtain "other solutions," or any "solutions," one needs to define a problem. I am unsure what particular problem Issue 10 is addressing.

Respectfully submitted,
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