

From:

Sent: Friday, August 13, 2010 7:28 PM

To: Restriction_Comments

Subject: Comments on Proposed Changes to Restriction Practice in Patent Applications

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Re: Comments on Proposed Changes to Restriction Practice in Patent Applications

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Please see the attached comments.

Best regards.

Linda M. Saltiel

<<Restriction Comments.pdf>>

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Re: Comments on Proposed Changes to Restriction Practice in Patent Applications

In response to the June 14, 2010 Federal Register Notice, we submit the following comments regarding the United States Patent and Trademark Office's (USPTO's) June 14, 2010 Request for Comments on Proposed Changes to Restriction Practice in Patent Applications (Restriction Proposal).

Oloff & Berridge, PLC is a nationwide law firm specializing in intellectual property matters. Its patent practice serves corporations and individuals from every industrialized nation and prosecutes thousands of matters before the USPTO. The perspective and depth of experience gained by such an extensive practice before the USPTO provides insights into the U.S. restriction practice.

We applaud and support the USPTO's continued efforts to improve the quality and consistency of examination of patent applications, and we believe that some of the changes considered in the Restriction Proposal may indeed improve the quality and consistency of restriction practice at the USPTO. We provide some suggestions in the following replies to the six questions set forth in the Restriction Proposal. We also provide an alternative approach to U.S. restriction practice in its entirety.

1. What should be included in an Office Action that sets forth a restriction requirement?

The Restriction Proposal indicates that the USPTO is considering clarifying the MPEP to indicate that a restriction requirement (including an election of species requirement) must always set forth the reasons why the inventions are independent or distinct and why there would be a serious burden in the absence of a restriction requirement. The Restriction Proposal further indicates that the USPTO is considering changing the burden requirement. The current rationale to support why there is a serious burden is based on the prior art search. The USPTO is considering whether to revise the MPEP to indicate: (1) there would be a serious burden if restriction is not required when the prior art applicable to one invention would not likely be

applicable to another invention; (2) a serious burden on the examiner encompasses search burden and/or examination burden to determine whether the claimed invention meets the statutory requirement for patentability under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, first paragraph; and (3) that in setting forth the various species from which an applicant is required to elect, the examiner should group together species that are not patentably distinct from each other, and should not require applicants to elect a specific species within a grouping of patentably indistinct species. Each of these considerations is discussed in detail below.

We agree with the USPTO's proposal to require examiners to have a strong and clearly stated rationale for requiring restriction and to provide appropriate support for the restriction. However, we do not recommend defining a serious burden in terms of whether prior art applicable to one invention would likely be applicable to another invention. Specifically, under this scenario, to traverse the requirement, the applicant would be required to acknowledge on the record that prior art is applicable to his/her/their invention(s). No reasonable applicant would be willing to do so. Thus, applicants would be hesitant to traverse the requirement even if it is clearly improper. This would likely increase the number of improper restriction requirements, as examiners would know that the applicant would likely not traverse the requirement under this rationale.

The USPTO proposes to revise the MPEP to state, in addition to the rationales currently set forth, that a serious burden exists because the inventions are likely to raise different non-prior art issues under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, first paragraph. If the only rationale required to support a serious burden if restriction is not required is that some but not all claims are likely to be rejected under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, first paragraph, then we believe there would be a substantial and unnecessary increase in restriction requirements. For example, under such a proposal, an application with only two claims that share the same inventive feature, but one claim has an easily correctable § 112, first paragraph issue, would be subject to restriction, even if a search and examination of both claims would be encompassed by the search and examination of only one claim. In essence, we believe the proposal of a serious burden being based on the rationale that the inventions are likely to raise different non-prior art issues under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, first paragraph, would allow an examiner to rationalize that if there are at least two claims that are independent and distinct, that there would be a serious burden on the examiner to search/examine the claims as long as at least one claim included an informality. The examiner could then justify a restriction requirement even if a search and examination of all claims would be encompassed by the search and examination of only one claim. At least, such a criterion should be defined in terms of actual burden, e.g., would it take more than two additional hours of examining time to address the additional issues.

The USPTO is also considering revising the MPEP to indicate that in setting forth the various species from which an applicant is required to elect, the examiner should group together species that are not patentably distinct from each other, and should not require applicants to elect a specific species within a grouping of patentably indistinct species. We would agree with this

proposal and believe this would improve the quality of examination of patent applications, and would reduce the number of divisional applications pursued, which would help to decrease the significant backlog at the USPTO, as long as applicant's election is not considered an admission of whether the species are patentably distinct or indistinct.

2. **What practice changes would result in more effective ways to seek higher level review of restriction requirements?**

The Restriction Proposal invites suggestions as to how to improve the traversal or request for reconsideration process within the framework of the current rules to achieve more consistent, accurate, timely and cost-effective review. In this regard, we recommend that once an applicant traverses a restriction requirement and the examiner is not persuaded to withdraw the restriction requirement, then a supervisory patent examiner (SPE) must review the restriction requirement and the traversal prior to the restriction requirement being made final to: (1) ensure that the examiner has properly issued the restriction requirement; and (2) confirm that the traversal by the applicant is not sufficiently persuasive. This procedure should reduce the number of unwarranted restriction requirements without the need to pursue a petition. Accountability by examiners in this regard would also likely produce restriction requirements that are more thoughtfully considered before being implemented in the first instance.

3. **How could the USPTO clarify requirements for restriction between related product inventions or related process inventions where the relationship is not specifically provided for in MPEP Chapter 800?**

The Restriction Proposal states that the USPTO is considering explaining that to support a restriction requirement between two or more related product inventions, or between two or more related process inventions, that are not otherwise provided for in MPEP §806 through §806.05(j), there must be two-way distinctness and a serious burden if restriction were not required. We agree with this consideration, and with the USPTO's consideration to further define that inventions are distinct if: (1) the inventions as claimed have mutually exclusive characteristics; (2) the inventions as claimed are not obvious variants over each other; **and** (3) each invention as claimed can be made by, or used in, a materially different process or product. We agree that this would likely reduce the number of improper requirements for restriction between related product inventions or related process inventions, as long as at least all three of these burdens are met. However, an improvement to this proposal would be to further require that there be no common special (e.g., novel) technical feature in the claims in order to support a restriction requirement.

We further agree with the consideration that examiners should not require restriction between claims where claims of an application define the same essential characteristics of a

single invention, e.g., the claims vary from each other only in breadth or scope (ranging from broad to detailed). In fact, we believe such a proposal is more in line with the unity of invention rules required in national phase applications, and used by most foreign patent offices.

4. *How could the USPTO modify Markush practice?*

We understand the USPTO is considering whether to revise Markush practice in three particular ways. Each consideration is discussed below.

First, the USPTO is considering whether to revise restriction practice with regard to Markush-type claims such that if the examiner determines that the elected species in a Markush-type claim is allowable, the examination of the Markush-type claim will be extended to the extent necessary to determine the patentability of the claim (i.e., to determine whether any non-elected species is unpatentable for any reason, and if determined to be unpatentable, the Markush-type claim would be rejected, and the search and examination would not be extended to cover all non-elected species). We believe that this would be highly counterproductive, and violate the second paragraph of 35 U.S.C. §112. Limiting the claimed invention to a single elected species would be inequitable. Applicants would be denied the right to claim all that they could claim, or would be forced to pursue separate divisional applications for multidimensional species, if the applicant could afford to do so. This would unnecessarily increase the backlog at the USPTO and severely disadvantage small entities.

Second, the USPTO is considering revising the treatment of amended Markush-type claims to clarify that whether an Office Action may be made final is determined under the conditions in MPEP § 706.07 and not dependent upon whether the examiner previously required a provisional election of species. This proposal is vague. Is the USPTO proposing that an Office Action including a new election of species requirement can be final as long as the claims are being twice rejected on the merits? Such a proposal would not allow applicant to make an election or traverse the election of species requirement before it becomes final. Once the full scope of a claim has been initially examined, there should be no new election of species requirements, when it is narrowed.

Third, the USPTO is considering situations where restriction may be proper between a subcombination and a combination when a subcombination sets forth a Markush grouping of alternatives. In particular, the USPTO is referring to a subcombination that (i) encompasses two or more subcombination embodiments within its scope, and (ii) lists those embodiments using Markush-type claim language, i.e., lists the embodiments as a group of alternatives from which a subcombination embodiment is selected. Under this scenario, we recommend instead recommend simply considering whether the claims share a common special technical feature.

5. **How could the USPTO improve rejoinder practice?**

We understand that the USPTO is considering changing rejoinder practice to institute more uniform treatment of claims directed to non-elected subject matter upon the determination that all claims to the elected invention are allowable. Specifically the USPTO is considering whether to define rejoinder as a practice of withdrawing a restriction requirement as between some or all groupings of claims and reinstating certain claims previously withdrawn from consideration that occurs when: (1) all claims to the elected invention are allowable; and (2) it is readily apparent that all claims to one or more non-elected inventions are allowable for the same reasons that the elected claims are allowable. Claims that meet the second condition for rejoinder may include: (1) claims that properly depend from an allowable elected claim, (2) claims that include all limitations of an allowable elected claim, or (3) claims in which no further search and/or examination would be required for a determination of patentability. The Restriction Proposal also states that claims that may not be eligible for rejoinder would include, for example those that require additional consideration of the prior art or raise utility, enablement or written description issues not considered during examination of the allowable elected claims.

We do not believe it is necessary to state that all claims to an elected invention need to be allowable in order to obtain rejoinder. Specifically, a withdrawn claim that closely corresponds to merely one independent claim should be rejoined once that independent claim is allowed, if no further search is required. We do not believe it is necessary that all of the claims that depend from that allowed independent claim be separately considered for rejoinder. Dependent claims that depend from an allowed independent claim should be rejoined because no further search or substantive examination of the non-elected claim dependent claim would be required.

An important consideration is whether an actual substantial burden is placed on the examiner by a search and examination of non-elected claims after any of the elected claims have been allowed. Of course, if it is readily apparent that all of the claims to one or more non-elected inventions are allowable for the same reasons that the elected claims are allowable, the non-elected claims should be rejoined with the application. Non-burdensome § 112, § 101, or the like issues should be addressed in connection with the rejoinder. Not doing so would increase the backlog at the USPTO due to an increased number of divisional applications being filed. Furthermore, it may appear as if examiners are attempting to artificially increase the amount of credit received by forcing applicants to pursue divisional applications directed to the non-elected subject matter when it is known that the non-elected claims could readily be allowed.

We agree with the USPTO's consideration of instructing examiners that when all claims directed to an elected invention are allowable, non-elected claims must be considered for rejoinder and withdrawal of the restriction requirement. This would provide for enhanced examination.


6. **What other areas of restriction practice can the USPTO improve and how?**

We believe that the USPTO should consider entirely doing away with U.S. restriction practice. Instead, the USPTO should consider harmonizing with the rest of the world in simply using a unity of invention standard when determining whether claims should be properly restricted. The standard is well-defined and fair. This would simplify restriction practice and would save time and effort by both patent examiners and applicants. That practice also comports with 35 U.S.C. § 121.

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As discussed above, we would support many of the considerations discussed in the Restriction Proposal. However, we believe the best option would be to simply follow the unity of invention rules, as followed by the patent offices in most industrialized nations.

Respectfully submitted,



Linda M. Saltiel

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