

RESPONSE TO THE USPTO REQUEST FOR COMMENTS
Green Paper Concerning Restriction Practice
Submitted by: The National Association of Patent Practitioners
Government Affairs Committee

Introduction

The following comments are presented in response to the USPTO request for public comment concerning the “Green Paper” on restriction practice reform appearing in the Federal Register Vo. 70, No. 107 (70 Fed. Reg. 32761) dated Monday, June 6, 2005.

The National Association of Patent Practitioners (NAPP) is a nonprofit trade association for patent agents and patent attorneys. NAPP has approximately 500 members in 13 countries. The patent practices of the practitioner members are focused primarily on patent prosecution practice, namely practice before the USPTO. As part of NAPP’s mission statement, we aim to create a collective nationwide voice to address issues relating to patent prosecution practice. For more information about NAPP visit www.napp.org.

NAPP acknowledges the PTO’s interest in reforming restriction practice and its diligence in carrying out its analysis of reform options to date and we welcome the opportunity to comment on the Green Paper. In preparing this document, comments from members of NAPP, who participate in our daily e-mail discussion group, were collected and summarized. Therefore, the information provided herein is representative of those NAPP members who responded to postings on the daily e-mail discussion list.

Observations with respect to current restriction practice

In general, members of NAPP file patent applications having claims directed towards what is believed to be a single invention and its alternative embodiments. These alternative embodiments can be depicted in the drawings, described in the detailed description section, and/or recited in one or more dependent claims. These practices enable applicants to provide a complete and full disclosure of their inventions to the public in a single application. In essence, through this practice, applicants provide the public with the absolute metes and bounds of what is considered to be the invention.

Currently, it appears that many Examiners restrict claims based on alternative embodiments, or restrict between combination and subcombination claims. Many practitioners and applicants view these types of restriction as artificial and arbitrary. As a result, applicants are forced to spend extra time and money either traversing restriction requirements or filing divisional applications or both. This leads to economic waste because applicants must pay for all the claims presented in an original application and are then forced to pay again (or several times over) when withdrawn claims are re-filed in

subsequent divisional applications. Often small entity applicants¹ will abandon the option of pursuing divisional applications due to a lack of financial resources. In fact, PTO data indicate that a majority of claims withdrawn from an application as a result of a restriction requirement are not pursued in divisional applications. However, the PTO has failed to investigate the reason why – applicants (in particular, small entity applicants) lack the financial resources necessary to file and prosecute multiple patent applications.

Restriction standards are not consistent within the Examining Corps. It has been our observation that restriction requirements, especially those being made final, often are not supported by facts and evidence, as required; but are based merely on conclusory statements, sometimes ones premised on technical error. In some cases, it appears that restriction procedures are being abused by examiners (possibly to meet their production quotas) to the detriment of applicants. Accordingly, reforms to current restriction practice are urgently required.

The PTO has repeatedly emphasized its concerns regarding the increasing pendency of applications, quality of examination, and improving predictability in examination. Current restriction practice contributes to all of these problems. Clearly, the necessity of prosecuting several applications to cover multiple embodiments of the same invention results in more applications being filed, contributing to backlog. Time spent by the PTO preparing restriction requirements, time spent by applicants responding to and traversing restriction requirements, time spent by the PTO considering and responding to traversals, time spent by applicants petitioning restriction requirements, and time spent by the PTO considering petitions all contribute to an increase in average pendency. Non-uniform practices with respect to the issuance of restriction requirements puts a strain on the system by causing confusion and a lack of predictability with respect to whether or not a given set of claims will be examined together or will be restricted. The time spent by Examiners preparing and defending restriction requirements could more profitably be devoted to search and examination. Finally, the piecemeal search and examination devoted to inventions that are separated into a number of divisional applications results in a negative effect on patent quality.

Comments on Options Presented in Green Paper

Statutory standard for restriction

The PTO has purposely failed to adhere to the law, as codified in 35 U.S.C. § 121 and as promulgated in the rules in 37 C.F.R. §§ 1.141 and 1.142. The standard for restriction is explicitly stated as requiring that inventions be, *inter alia*, “independent **and** distinct” (emphasis added) in order for restriction to be proper. In contrast to the clear intent of the law, the PTO has, on its own initiative, erroneously interpreted the law to apply a standard in the alternative, viz, “independent **or** distinct”. The PTO has no authority to fail to adhere to that which Congress has enacted as law. Therefore, we urge the PTO to

¹ For the purposes of this document, “small entities” are considered to include both independent inventors and small businesses, although the latter must sometimes file under large entity status (*e.g.*, if their application is licensed to a large entity)

follow the law and apply the “independent and distinct” standard for restriction, rather than risk the possibility of facing challenges in court.

In its summary dismissal of Option 4, the PTO presents the statutorily mandated “independent and distinct standard” as being needlessly cumbersome to the point of unworkability. In contrast to the PTO’s analysis, however, we note that standards for independence are already set forth in the MPEP at, *e.g.*, §§ 802.01 and 806.04. Furthermore, Examiners are already applying criteria for distinctness in current restriction practice.² Therefore, it would not seem an overwhelming task (compared to the scenario described for Option 4 in the Green Paper) simply to train Examiners to apply criteria for independence as well as the criteria for distinctness they are currently applying, and review claims under an “independent and distinct” standard, as required by 35 USC §121.

The continued failure of the PTO to abide by the statute is likely to generate increased frustration among applicants, possibly leading to a greater number of restriction requirements being petitioned, and thus negatively impacting examiner productivity and pendency rates. The PTO should reconsider its methods for implementation of Option 4. Adoption of the statutory standard for restriction would address many of the problems noted above, particularly those besetting small entity applicants.

Option 1

Option 1 represents little or no change from current practice, except to penalize small entity applicants, who are more likely to be unable to afford to pay for examination of multiple groups of claims in the same application (for which they have already paid an application fee based on the number of claims presented). Therefore, this option will likely result in disadvantages to small entity applicants resulting from issuance of their claims being delayed as compared to wealthier applicants, or not issuing at all due to a lack of financial resources.

It is noted that, under Option 1, an applicant would be provided an opportunity to request and pay for examination of additional groups of claims and/or additional species. To assist in evaluating this option, it would have been helpful to have had an estimate of the amount of the proposed fees, as well as the amount of additional time that will be provided to the Examiner, upon payment of the fee(s), to search and examine the additional claims and/or species.

Option 2

In the absence of a serious effort by the PTO to explore mechanisms that would bring its restriction practices into conformity with the statute, NAPP would support a system in which current restriction standards are replaced by a Unity of Invention standard. However, the proposed procedure for assessing unity appears, again, unduly cumbersome by requiring that, before restriction, any special technical feature must be examined for compliance with 35 U.S.C. § 112, first paragraph. If a unity standard is adopted, it

should be a PCT-type unity standard requiring a common technical feature defining over the art but not requiring examination for compliance with written description, enablement and best mode requirements.

Option 3

Inasmuch as the PTO has indicated that this option is too difficult to implement, NAPP provides no comments at this time.

Alternative Options

Since compliance with statute was deemed unworkable by the PTO, and because neither of the PTO's two preferred options (Options 1 and 2) are entirely satisfactory to those members of NAPP who expressed their opinions, we offer the following additional suggestions for improvement of restriction practice and hope that the PTO will evaluate and consider these alternatives in the final White Paper it apparently plans.

Suggestion 1

The PTO should consider a modified unity standard, whereby current restriction practice would be maintained but applicants would be given the option to rejoin any withdrawn claims that share a common technical feature with a claim of the elected group, after allowance of the elected claim (as occurs in present rejoinder practice). Take, for example, an application in which claims for a composition of matter, method of making, and method of use are presented, which is restricted and in which applicant elects the composition of matter claims. If the composition claims are allowed, the applicant can then elect to rejoin all withdrawn claims containing the common feature (*i.e.*, the composition of matter). The examiner would examine the rejoined claims for compliance with section 112 and allow any that contain the common technical feature, as part of the same patent.

In this way, the PTO could continue existing restriction practice, but all claims that contain a patentable common inventive feature would eventually be considered in a single application and issue in a common patent. Moreover, efficiency of examination is increased because the same examiner is examining all the claims having a common technical feature. This procedure also has the advantage, compared to Option 2, of not requiring examination for compliance with Section 112 prior to restriction. Finally, it reduces the number of divisional applications requiring subsequent examination, hence reducing the overall number of applications in the backlog.

Suggestion 2

As an improvement to the implementation of Option 2, initial examination could be restricted to independent claims. Under this proposal, an Examiner would first review the independent claims, to determine whether restriction should be required. If any of the

independent claims are independent **and** distinct from one another, a restriction/election requirement would be issued. If there is no restriction, the independent claims would then be examined. If any independent claim is found to be allowable, all claims dependent therefrom would then be examined. Examination in this fashion would entail far less work than with the current system because for any independent claim that is allowable over the prior art, it follows that all of its dependent claims must also be allowable over the art and would therefore need to be examined only for compliance with Section 112 and possibly double patenting. By contrast, under the current system, if an independent claim is rejected, the Examiner must reject each of the dependent claims individually. This time consuming step would be virtually eliminated.

If the independent claims are not allowable, an Office Action would be issued which would encourage the applicant to place the independent claim(s) into condition for allowance. If the applicant's response does not put the independent claim into condition for allowance, the Examiner would issue a final action, and suggest non-mandatory restriction of the dependent claims. The applicant would then have three options:

(a) comply with the examiner's suggestion, in which case prosecution would be reopened, and the elected claims would be examined;

(b) file an RCE in an attempt to bring the independent claims into condition for allowance; or,

(c) appeal to the BPAI.

Initial examination of only independent claims greatly reduces the Examiner workload; even option (a) would probably involve no more work on the part of the Examiner than under the present system. The Examiner would not need to spend time responding to traversal arguments, and petition of restriction requirements would become far less likely.

Suggestion 3

Alternatively, or in addition to the previous suggestions, the PTO should consider allowing an applicant to present one or more multiple dependent claims depending from a multiple dependent claim. This would result in fewer claims being initially presented for examination, facilitating identification of common technical features and requiring less examination time. Any claims depending from an allowable independent claim would then require examination only for compliance with Section 112 and possibly double patenting. A variation of this idea would allow singly dependent claims to be converted to multiple dependent claims depending from allowable independent claims.

Suggestion 4

Lastly, the PTO should implement a policy of examining restricted claims immediately after a parent application is allowed or finally rejected, thereby avoiding lengthy delays while the divisional application proceeds through OIPE and Examiner queues. If divisionals were examined "back to back," or even concurrently, there would be less PTO time lost in "rework," because the Examiner would have the original specification and

restriction requirement in mind as subsequent divisionals were being examined. For the same reason, patent quality is likely to improve.

Conclusion

NAPP appreciates the willingness of the PTO to review and improve its current restriction practice and thanks the PTO for the opportunity to provide its comments. NAPP remains willing to work with the PTO to explore methods for improving the current system and facilitating implementation of such improvements.

Respectfully submitted,

Joy L. Bryant, Executive Director
National Association of Patent Practitioners
napp@napp.org

August 5, 2005