

**From:**

**Sent:** Tuesday, August 10, 2010 11:03 PM

**To:** Restriction\_Comments

**Subject:** Comments on Restriction Practice

Appended are my comments on Proposed Changes to Restriction Practice in Patent Applications.

These comments are specifically in response to the request for comments in the FR notice published June 14, 2010 in 75 FR 33584.

**ROBERT J. SPAR**  
ATTORNEY AT LAW  
3201 BIRCHTREE LANE  
SILVER SPRING, MARYLAND 20906  
TEL (301) 460-1231 FAX (301) 460-1889  
E-mail: bobspar1@comcast.net

Comments on USPTO FR notice on June 14, 2010 re  
Proposed Changes to Restriction Practice in Patent Applications  
By Bob Spar  
August 10, 2010

General Comments: There is a great, great need for the Office to revise the current Office guidelines for restriction requirements with respect to:

a) How restriction requirements are made - because:

- many restriction requirements are just not proper,
- many requirements are not made per the MPEP guidelines, as it is apparent that the MPEP guidelines for the various specific scenarios are not followed by the examiner, probably because the MPEP has not been, or is not currently reviewed or read, or possibly because the MPEP is just ignored. The Office does not insist upon compliance with the guidelines for making restrictions as is set forth in Chapter 800 of the MPEP.
- many restrictions are (just) made to reduce the number of claims to examine to a smaller, manageable number for examination expediency and efficiency - without the examiner being concerned about the propriety of how the restriction requirement is outlined, or how it is justified,
- improper restrictions lead to filings of divisionals - which cannot be rejected on double patenting. Thus, improper restrictions are completely unacceptable because they preclude double patenting rejections of any future filed divisionals, but also for a number of other reasons.
- there is very inconsistent review of restrictions by junior examiners before they are made in actions, and
- there is no review of restrictions by primary examiners in Office actions.

Despite the fact that many restriction requirements are improperly made, they are usually just accepted by the patent bar because it is the most expedient course of action. This is because it is just too expensive, time consuming and frustrating for a practitioner to fight an improper restriction requirement (e.g., many times a (proper) traverse is routinely

(improperly) rejected, then the 1st and 2nd petitions are not timely decided in the TC, and the examiner is usually (improperly) affirmed), and the prosecution is not stayed (so prosecution costs/decisions continue). Moreover, if the restriction is just accepted, the filing of one or more divisionals leads to more work for the practitioner, and is easy. Thus, from an applicant's and a practitioner's perspective, all the existing incentives are linked to just accepting a restriction requirement, even if it is improper; and moving on with the prosecution and possibly filing one or more divisionals in future. There is little for an applicant to gain by fighting a restriction requirement and, for this reason, there is little risk for an examiner to make an improper restriction requirement.

b) how the propriety of restrictions are reviewed because:

- proper traversals are routinely held to be not persuasive (by the same examiner that made the initial requirement), with the requirement being repeated, and made final, in the next office action,
- petitions of restriction requirements are, many times, not objectively reviewed in view of the MPEP requirements, and the examiner's restriction, even if improper/wrong, is frequently rubber-stamped by the TC official(s) deciding the petition(s),
- traversals, and petitions, do not stay the need to elect, and then to respond - so the prosecution continues,
- petitions are not timely decided; thus, even if the restriction is eventually reversed, or modified in a petition decision - it is, de facto, just way too late for relief (corrective action) from applicant's perspective for a number of reasons, notably delaying further the way too long pendency of the examination process just doesn't make sense,
- there is little, if any, negative impact on (the performance rating of) an examiner who has made an improper restriction requirement, and
- restriction training should be given to examiners who make improper requirements, not overlooked, or ignored.

My comments are given below in numbered paragraphs that correspond to the numbered issues in the FR notice:

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

Answer. The supporting reasons for making a restriction requirement should always be given in an Office action, including:

- a) the reasons why the inventions are independent or distinct, and
- b) why there would be a serious burden in the absence of a restriction requirement.

Mere conclusionary statements that the inventions are independent or distinct, and that there is a serious burden - are not, and should not be, sufficient

*1. B. Possible new types of justifying when a serious burden exists:*

*When prior art applicable to one invention would not likely be applicable another invention -*

Answer: I can see where scenarios might, or might not, justify a serious burden, as follows:

- Scenario where it might raise a serious burden: I do think there might be a serious burden if it was because of a different field of art (in other words, a different field of search would be required), but the examiner should explain this scenario.
- Scenario where I do not think a serious burden should be found: I do not think there would be a serious burden if because one (claimed) invention had a different effective filing date than another (claimed) invention, as only the applicability of the prior art would be affected.

*1. C. In addition to the "search" burden situation, can a serious burden be based on an examination burden?*

Answer: Yes - where the rationale is that the inventions are likely to raise different non-prior art issues under 101 and/or 112, para 1. This is a realistic scenario - as added non-prior art issues can significantly increase the examiner's burden of performing the examination. The examiner should, however, be required to provide an explanation of the different non-prior art issues that are actually present.

*1. D. Should species that are not patentably distinct be grouped together for election purposes?*

Answer: yes, so an election of a single species, or a single grouping of patentably indistinct species can be required.

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

Answer: One or more of the following should be considered:

2. a) Effective Review of Restriction Requirements: A panel review by senior examiners with a demonstrated knowledge of proper restriction practice, similar to the 3 person panel that is convened for a pre-appeal brief conference, or for an appeal conference, should be convened to consider: a) the initial traverse in the response to the restriction requirement, as well as, b) the arguments in any subsequent petition. This would indicate that there will be a serious review of restriction requirements, and that improper requirements will be noticed, and not rubber-stamped or overlooked. A clear message should be communicated to examiners, and to the patent bar, that the Office will no longer tolerate improper requirements.

Letting the examiner who made the requirement (e.g., signed the action), who would be either a single primary or SPE from a TC, be the sole reviewer of a traversal, or a petition, is unreliable, and it would tend to continue the current system where the examiner who made the improper requirement would be the one who gets to reconsider it, and he/she could easily rubber stamp it upon review. Further, it would, most likely, perpetuate the current unreliable system, lead to inconsistent treatment, and not lead to only proper restriction requirements being upheld. One possible exception - where it might be appropriate to have only a single reviewer of a traversal - would be where the primary has recently been fully trained, and has been qualified as a restriction requirement expert - by the editor of the MPEP, or OPLA.

Thus, when a traversal has been filed, the single restriction requirement expert, or the panel of knowledgeable restriction requirement reviewers, would have to review the restriction requirement and the traverse, and if the restriction requirement is to be maintained, or modified, or even withdrawn, the expert, or the panelists, would have to initial off on the next Office action which would respond to the traversal.

Note: the examiner should not be able to just withdraw or modify a restriction requirement after a traversal, and thereby bury a marginal or an improperly made requirement as the restriction issue should have to be brought to the attention of the TC's restriction

expert, or the TC's restriction panel. This way, erroneous restriction requirements will not be able to be buried, or kept secret by the examiner, and the examiner will be advised by the restriction expert(s) as to what a proper restriction requirement is (per the guidelines set forth in the MPEP), and how it should be made. This review requirement (by one other than the examiner(s) who made the requirement) is very important. Hopefully, proper training in restriction practice, and reviews of requirements (by other examiners with the proper knowledge about restriction practice as is in the MPEP) - with feedback to the examiners - will lead to consistent, correct restriction requirement practices - much in the way that the appeal, and pre-brief appeal, panels have been effective to improve final rejections.

One of the panelists would have to be one who is considered to be a fully knowledgeable and competent restriction expert. Each TC should have at least one such expert, perhaps one of the SPREs, and hopefully more than one. Each restriction expert should be fully trained on the restriction practice guidelines as set forth in the MPEP, and should be required to pass some sort of internal test on current restriction requirements - given, or overseen, by the editor of the MPEP, or OPLA.

2. b) Timely (fast) Review of Petitions: Once a petition has been filed, the petition should be decided promptly, and with sufficient time left so applicant will have enough time (at least 1 month) to file a response to the outstanding Office action. Clearly, if the petition were granted, it would most likely render moot a reply to the Office action. Timely action on a petition may/will be difficult - but delayed action is unfair to the applicant - because the filing of a petition does not stay the prosecution, under current Office practice.

Stay of SSP if petition decision is not promptly mailed: The Office can, sua sponte, however, waive the requirement(s) to also file a reply if a petition re the restriction requirement has been filed. Thus, the requirement in Rule 1.144 as to the need to make any reply due on the remainder of the Office action, or the statement in Rule 1.181(f) that the filing of a petition will not stay any period for reply running against the application - could be waived, sua sponte, by the Office. The waiver could be linked to an early filing of the petition, such as if it is filed within one month of the mail date of the Office action that repeats and makes the restriction requirement final. The Office could

announce such a pilot program to waive the requirement to file a reply, and set forth all desired conditions associated with the pilot program, such as filing the petition w/i one month of the mail date of the action, and a decision on the petition not mailed w/i 2 months of the mail date of the Office action.

The Office could/should impose an internal processing priority to promptly act on all petitions re restriction requirements - and set a target for doing so within one month of the filing of the petition. Actual performance should then be measured against the set target. Coupled with having panels for deciding the petitions - establishing these internal practices would clearly send a signal to the patent bar, and the examining corps, that only proper restriction requirements will be permitted.

Another option could be to automatically extend the SSP by 1, 2 or 3 months, up to a max of 6 months if a petition re the restriction requirement is promptly filed (e.g., w/i 1 month of the mail date of the action in which the restriction requirement was repeated and made final), and a decision on the petition (affirming the restriction requirement) is not promptly mailed (e.g., within 2 months of the mail date of the action). The SSP should be auto extended so applicant is given at least one month to reply after the petition decision (affirming the restriction requirement) is mailed. This would be similar to the current after final practice. Of course, if the petition decision revises or reverses the restriction requirement, the Office should issue a replacement Office action, which will moot out the need to reply to the original Office action.

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

Answer: Adding a new section to the MPEP chapter 800 re restrictions between 2 or more related product inventions or 2 or more related process inventions - and to indicate that 2 way distinctness per MPEP § 802.01 would be the required showing - for situations not otherwise provided for - makes sense.

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

Answer: The 3 proposals re revising Markush practice seem reasonable.

In particular, if an elected species is found allowable, it is reasonable to extend the examination of the Markush-type claim to the extent necessary to determine the patentability of any of the non-elected species (in the claim) vis-à-vis any of the statutory sections 35 U.S.C. § § 101, 102, 103 or 112, or the non-statutory ground of double patenting.

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

Answer: The proposed rejoinder practice changes make sense, and are supported. After all claims to the elected invention have been determined to be allowable, rejoinder of some or all of the claims to non-elected subject matter should always be considered, and in every application. The noted exceptions (for when rejoinder would not be permitted) - for claims that require additional consideration of prior art or raise utility, enablement, or written description issues that were not considered during examination of the allowable elected claims - are appropriate.

The adding of an instruction to the examiners to always consider rejoinder (and withdrawal of a restriction requirement) - when all claims directed to an elected invention are allowable - is supported, although it was/is my understanding that it was/is the current practice to do so.

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

Answer: The Office should adopt such changes as are necessary to ensure that:

a) restriction requirements are properly made (in accordance with the existing guidelines in the MPEP, or as these guidelines may be revised in the future) before applicants have to elect over the phone, and/or before the restrictions go out the door in Office actions; and

b) timely and knowledgeable review is given whenever a restriction requirement is traversed and/or is petitioned, such that applicants get a timely decision on their traverse/petition without having to continue on with the prosecution which is just limited to the elected invention. Without such timely knowledgeable review, and review decisions, examiners will continue to make restriction

requirements that may or may not be in compliance with the Office's guidelines in the MPEP.

Right now, most practitioners just feel that it is a waste of time, effort and money to try and fight a restriction requirement, even if they feel, or even know, that the requirement is not properly made at all. This is a ridiculous situation - which needs to be fixed.