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Sent: Wednesday, May 03, 2006 8:10 PM

To: AB94Comments

Subject: 3M IPC Comments on Changes to Practice for the Examination of Claims in Patent Applications

Respectfully submitted,

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The Honorable Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office

Attn: Robert A. Clarke
Deputy Director, Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Re: Comments on Proposed Rules: “Changes To Practice for the Examination of
Claims in Patent Applications”
71 Fed. Reg. 61 (January 3, 2006)

Dear Under Secretary Dudas:

The United States Patent and Trademark Office (PTO) has recently proposed “Changes To Practice for the Examination of Claims in Patent Applications.”¹ The PTO has identified at least two objectives as justification for the proposed rule changes: (1) improving patent quality by allowing the PTO to perform a better, more thorough and reliable examination by focusing on an initial claim set identified by the applicant; and (2) improving efficiency by shifting some of the burden of examination onto the applicant in cases involving an excessive number of claims (i.e., greater than ten). These objectives are clearly worthy of consideration and 3M Innovative Properties Company (“3M IPC”) appreciates the PTO’s ongoing efforts to address them.

3M is a diversified manufacturer across multiple technologies including healthcare (medical devices, pharmaceuticals, and information systems); industrial products (adhesives, abrasives, cleaning products); and telecommunications (semiconductors, electronic materials) to name a few.² As such, 3M IPC can offer a viewpoint on the proposed rule changes and their potential impact across multiple technology fields.

As a prolific applicant in the PTO,³ 3M IPC has supported past efforts to increase quality, efficiency, and speed. For example, 3M IPC supported fee increases to fund the hiring and training of new examiners. 3M IPC has also embraced opportunities to interact with the PTO and other interested applicants, assignees, and practitioners in addressing these areas of common concern, including the recent development and introduction of the Electronic Filing System. It is with this spirit of cooperation that 3M IPC has approached this opportunity to comment on the proposed changes to 37 C.F.R. §§ 1.75, 1.104, 1.105, 1.117, and 1.261.

¹ 71 Fed. Reg. 61-69 (January 3, 2006).

² 3M IPC appreciates the different challenges arising in diverse technology areas, as 3M IPC files utility applications in each of the PTO’s Technology Centers (i.e., 1600, 1700, 2100, 2600, 2800, 3600, and 3700).

³ In 2005, 3M IPC filed 688 nonprovisional applications, including 236 continuing applications, on behalf of a large number of inventors.

Rather than imposing the new rules as currently proposed, 3M IPC believes that the process of patent prosecution could be improved if both the PTO and applicants had a more cooperative problem-solving approach to the issues facing each other throughout the current process. While the present opportunity to comment on the proposed rule changes and the Town Hall meetings are steps in that direction, 3M IPC encourages the PTO to consider taking further steps including, e.g., round table discussions, focus groups, and pilot programs before making significant changes in the rules governing patent prosecution.

The effect of the proposed rule changes to claim examination is further compounded by the proposed rules entitled “Changes To Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims.”⁴ While the proposed rules to limit the number of claims may be more palatable if modified (as discussed further below) in the context of the existing patent examination procedures, any limit on the number of claims would be unduly restrictive if the proposed rules relating to limitations on continuations and RCE’s are also enacted. For example, the limitation on continuations would motivate practitioners to file more numerous claims in an effort to provoke restrictions for divisionals and capture all potentially patentable subject matter, as discussed more fully in 3M IPC’s comments to the proposed rule changes on continuation practice, filed separately. If the proposed rules on continuations and RCEs are enacted, patent applications with less than ten independent claims for examination may no longer be “a rare occurrence” as suggested by the PTO.⁵

As currently proposed, the rule changes may address issues faced by the PTO; however, from an applicant’s perspective, some of the changes appear to be unnecessarily burdensome, to have limited potential for achieving the above-stated objectives, and to have unintended adverse consequences. Absent more fundamental changes to the patent system such as those proposed in patent reform legislation,⁶ implementation of these rule changes at the present time poses a significant risk that the expense and burden imposed on the PTO, its examiners, and applicants will be unwarranted to the extent the proposed rule changes are inconsistent with, or unnecessary in view of, the ultimate overriding statutory language.⁷

In summary, 3M IPC is not opposed to the selection of representative claims for initial examination if at least the following changes are made to the proposed rules:

- (1) the requirement of an examination support document under proposed Section 1.261 (and other proposed rules associated with the ESD) is eliminated;

⁴ 71 Fed. Reg. 48-61 (January 3, 2006).

⁵ 71 Fed. Reg. 61

⁶ For example, the requirements of an Examination Support Document as proposed under Section 1.261 will pose significant risk of inequitable conduct charges against practitioners who use them under the current statutory, jurisprudence and 37 CFR 1.56 requirements. See the reforms proposed in the Coalition Print developed in response to H.R. 2795.

⁷ 35 U.S.C. § 2(b)(2) (“The [United States Patent and Trademark] Office ... may establish regulations, not inconsistent with the law ...”)

- (2) the nondesignated claims that receive deferred examination are examined under the same statutory requirements as the representative claims; and
- (3) the proposed rules to continuation practice are abandoned.

Further in view of these general comments, and the following specific comments, 3M urges the PTO to consider the following steps:

- (1) implement incremental changes to claim examination as discussed below without implementing (or at least before implementing) any proposed rule changes on continuation and RCE's; and
- (2) engage the patent community in a more cooperative effort to brainstorm solutions regarding pendency, communication, and patent quality.

Comments Regarding the PTO's Underlying Assumptions

According to the PTO, the current practice of examining each and every claim, independent and dependent, is less efficient because effort is "wasted" on those claims that stand or fall with the independent claim from which they depend.⁸ In order to address this problem, the PTO is proposing to restrict the number of claims for initial examination to ten claims designated by the applicant. However, according to the PTO's 2005 statistics, only 1.2% of all nonprovisional applications are filed with greater than ten independent claims.⁹ The PTO concludes that the vast majority of applicants will be unaffected by the limit to ten representative claims.

Based on 3M IPC's experience, a greater percentage of applicants filing nonprovisional applications would be affected. For example, the proposed rule changes limiting continuations and RCE's will likely drive the opposite effect, namely increased filing of applications. In an attempt to compensate for the inability to refine patent strategy as the technology develops during the patent prosecution process (i.e., through the selection of divisionals and continuations to pursue alternative claim strategies where appropriate), applicants may file larger less-focused applications with numerous claims to ensure coverage of all possible patentable features and their subcombinations.

In addition, these rule changes may have unintended adverse effects on future filing practices. For example, the proposed rule changes may drive applicants to pursue a patent strategy that includes a provisional application first, followed by a PCT filing to lengthen the prosecution process and avoid designation of representative claims and/or excessive claim fees. However, this essentially creates a de facto deferred examination that further delays prosecution, rather than addressing the underlying problems the PTO is attempting to address.

In the U.S., many interactions between the examiner and an applicant are driven by the applicants' need to protect themselves and their patents from adverse consequences during litigation. For example, applicants are motivated to increase the number of the

⁸ 71 Fed. Reg. 62.

⁹ See Id. at 62.

claims in a single application and pursue claims of varying scope in multiple applications in light of restrictions in the availability of Doctrine of Equivalents (DOE). Moreover, applicants are motivated to minimize any argument or amendment to avoid the impact of prosecution history estoppel. Despite these valid objectives to adequately protect the scope of his or her invention, an applicant's behavior can appear inefficient to the PTO in some instances.

Perhaps of most concern, the rules proposed by the PTO (particularly those relating to the examination support document or "ESD" requirements) create increased risk to the applicant such that, despite his or her best efforts to assist the PTO in examination, the applicant may face charges of inequitable conduct. Absent concomitant changes to the rules regarding inequitable conduct and other reform currently pending before Congress, the examination support document ("ESD") poses significant risks to applicants as currently proposed.

Comments on Specific Rule Changes

1. 37 C.F.R. § 1.75

Section 1.75(b) (introductory text)

The proposed changes to the introductory text of 1.75(b) provide that examination of a dependent claim may be "held in abeyance until the application is otherwise in condition for allowance" unless the dependent claim is designated as a representative claim.

3M IPC has several concerns with this proposed change. First, the proposed rule fails to specify exactly what level of examination the undesignated claims will receive (see also comments to Section 1.104 below). Second, the proposed rule fails to clarify how claim amendments will be addressed when a representative claim is amended during prosecution to incorporate the limitations of a dependent claim that was not designated as a representative claim.¹⁰

If the proposed rules are enacted, 3M IPC requests that the following issues be clarified and incorporated into the proposed rules:

- a) once the representative claims are held allowable, those dependent claims held in abeyance would be examined under the same statutory requirements (i.e., §112, §101, §102, §103) as the representative claims to avoid any adverse effect on the presumption of validity that all examined patentable claims currently have;
- b) any amendment that incorporated the limitation of a dependent claim that had not originally been presented as a representative claim would be permitted and examined, despite the fact that additional search may be necessary to address the new limitation.

¹⁰ Absent clarification, the applicant faces uncertainty in a potentially more restrictive environment, if the proposed rules to continuation practice are also imposed. For example, the inclusion of a limitation from a nondesignated claim in a response to a final office action would likely not be admitted as requiring additional search. Applicant is then forced to consume one of his or her limited number of filings with an RCE, petition to establish why the amendment "could not have been submitted prior to the close of prosecution in the application," or file an appeal under the proposed changes to continuation practice.

3M IPC considers these clarifications necessary to preserve the determination of patentability as to all claims and to advance prosecution based on all claims.¹¹ 3M IPC suspects that these requirements would not unduly burden the Examiner in most instances. However, with the clarifications, 3M IPC is concerned that examination could in fact become less efficient in a greater percentage of cases than the 1.2 % of all nonprovisional applications (with greater than 10 independent claims) that the PTO currently seeks to address. In particular, piecemeal examination would become more commonplace, with multiple searches necessitated by the above requirements. Accordingly, 3M IPC questions to the need for the rule changes in light of its possible unintended effects.

Section 1.75 (b)(1)

The proposed changes to 1.75(b)(1) provide that an applicant must submit an examination support document (ESD) under proposed rule 1.261 if: (1) the applicant files more than ten independent claims; or (2) the applicant designates more than ten representative claims comprising both independent and dependent claims.

In defining a dependent claim, the proposed rule change requires that a dependent claim designated for examination must depend from a claim or claims that have also been designated for examination. 3M IPC considers this requirement unnecessarily restrictive to applicants. For example, consider the following hypothetical (based on a representative fact pattern that can frequently occur):

1. A composition, comprising the reaction product of:
 - (a) a first polymer ; and
 - (b) a chain extender;wherein the composition has a continuous phase comprising an X-Y mixture having at least twenty weight percent X.
2. The composition of claim 1, wherein the ratio of chain extender to first polymer is 1:1 to 2:1.
3. The composition of claim 1, wherein X in the X-Y mixture is selected from the group consisting of A, B, and C.
4. The composition of claim 2, wherein the X-Y mixture has a ratio X to Y of at least 50:50 by weight.
- ...
11. The composition of claim 1, wherein the chain extender is selected from the group consisting of water, alcohol, ethylene and propylene.
12. The composition of claim 11, wherein the chain extender is water .

¹¹ See 35 U.S.C. § 282 (“Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though depending on an invalid claim.”)

Under the proposed rule changes, 3M IPC hypothetically selects claims 1, 4, and 12 as its representative claims. However, the selection of these claims would result in claims 2 and 11 also being considered “designated” despite the fact that the selection of the original three claims alone may focus the Examiner’s initial examination of the claims more effectively. The inclusion of claims 2 and 11 add additional burdens on the Examiner, and may be less desirable to the applicant for any number of strategic reasons. Any selection of dependent claims as representative claims should be at the applicants’ discretion.

If the proposed rule changes are enacted, 3M IPC also requests that the PTO consider increasing the number of representative claims to 20, independent or dependent, consistent with the point at which excessive claim fees become due.

The PTO has requested comments regarding the treatment of claims written in the alternative form (i.e., claims with markush groups) for purposes of determining number of claims under proposed Section 1.75(b)(1). 3M IPC suggests that a claim containing a markush group be considered a single claim. Markush groups are typically used to exemplify the embodiments of a generic term used in a preceding independent claim and/or may be used where no generic term is adequate. For the same reasons that an Examiner can effectively search a generic term that covers multiple embodiments, an Examiner can effectively examine a markush group representing multiple embodiments. A requirement that applicants characterize a “common core principle” effectively forces applicant to create a definitional statement that unnecessarily limits the scope of the invention without statutory justification (e.g., a rejection based on § 112, first paragraph, for written description or enablement, or § 102 and/or § 103 based on the prior art).

For comments regarding the proposed rule changes to add Section 1.261, see the discussion below.

Section 1.75 (b)(2)

The proposed change to 1.175(b)(2) provides that if a claim referring to another claim either (1) does not incorporate by reference the limitations of the other claim or (2) is in a different statutory class than the other claim, then the claim will be treated as an independent claim for purposes of both independent claim fees and representative claim selection under 1.75(b)(1).

Thus, presumably, the following claim would be considered an independent claim:

2. A medical article, comprising the pressure sensitive adhesive composition of claim 1.

3M IPC in general supports the payment of fees for independent claims that require separate search and examination. The search and examination necessitated by independent claims of different statutory classes appear to support the designation of these claims as independent regardless of referral to another claim. However, 3M IPC

would desire more collaborative discussion on the second category of claims that are arguably within the same statutory class yet are not considered by the PTO to incorporate by reference the limitations of the claims to which they refer.

Section 1.75 (b)(3)

The proposed rule change to Section 1.75(b)(3) provides that in an application containing greater than ten independent claims or ten designated claims, the applicant will be notified of the omission and given a one-month opportunity to respond if the omission was inadvertent and prosecution remains open. The applicant can avoid filing an ESD pursuant to proposed Section 1.261 if the applicant either (1) files an examination support document; (2) cancels claims to reduce the number to ten or less designated claims (independent and any dependent claims) or (3) suggests a restriction requirement and an election without traverse to no more than ten designated claims (independent and any dependent claims).

In 3M IPC's experience, those cases with significant numbers of claims also likely claim multiple inventions. This correlation would only increase under the combined effect of the proposed rules to continuation practice and the 1.75(b)(4) requirement to combine patentably indistinct claims. If the proposed rules are enacted, 3M IPC suggests that the Examiner's first action on review of a case evaluate both the number of total claims and number of patentably indistinct claims, rather than having the applicant propose a restriction requirement. The Examiner could then propose a restriction requirement or a notice of more than ten designated claims, as appropriate. In many instances, the restriction requirement may obviate the need to select ten representative claims. With the restriction determination in hand, the applicant could respond with the designated claims relative to the elected claims as necessary.

Alternatively, 3M IPC suggests removal of the inadvertent omission requirement. If the proposed rule is enacted however, 3M IPC requests further clarification on the standard for evaluation of an inadvertent omission, and the vehicle for determining whether the omission was inadvertent (such as by petition, or by a showing to the Examiner's satisfaction). 3M IPC further requests clarification of the process in the event the restriction requirement proposed by the applicant is not accepted by the Examiner.

As indicated above, the ESD requirements under Section 1.261 as currently proposed would be avoided by applicants in view of the risks presented by allegations of inequitable conduct. Absent a change in the rules regarding inequitable conduct, the practical effect will be that applicant will only have the choice of canceling claims or proposing a restriction requirement.

Section 1.75 (b)(4)

The proposed rule changes to 1.75(b)(4) would provide that in the event an application contains at least one patentably indistinct claim relative to other nonprovisional applications that either have a common inventor or are commonly owned, the Examiner

can require that the patentably indistinct claims be eliminated from all but one application. If the patentably indistinct claims are not eliminated, the Examiner will treat the representative claims designated in each nonprovisional application as present in all the nonprovisional applications containing the patentably indistinct claims for purposes of determining whether an ESD is required under proposed Section 1.261.

3M IPC recommends against implementing this proposed rule change. 3M IPC considers the current provisional obviousness-type double patenting rejections offered in applications, and their timing in prosecution, to be more appropriate in addressing concerns of patentably indistinct claims in multiple applications. In particular, the ability to preserve the patentably indistinct claims through prosecution allows for possibility that further prosecution may obviate the original rejection.

If the proposed rule change is implemented, 3M IPC requests further clarification on the practical consequences in prosecution. For instance, if the representative claims specified in each nonprovisional application are patentably distinct, it is unclear why the representative claims would be additive based on the mere presence of one or more undesignated patentably indistinct claims. Moreover, the proposed rule fails to provide whether applicants can overcome the requirement by argument that the claims are patentably distinct.

37 C.F.R. § 1.104

The proposed rule changes to Section 1.104 are written to correspond with the representative claims specified in the proposed changes to Section 1.75. In particular, Section 1.104(a)(1) provides that the Examiner's investigation of the available prior art and compliance with applicable statutes, rules and patentability will be limited to the "independent and designated dependent claims."

As discussed above in reference to 1.75, 3M IPC requests clarification regarding what level of examination undesignated claims will receive once the representative claims "are otherwise in condition for allowance." Absent further clarification, 3M IPC remains concerned that undesignated dependent claims will not be afforded the same presumption of validity as that afforded all claims of a patent under the current examination practice.¹²

37 C.F.R. § 1.105

The proposed change to 1.105 provides that an Examiner can request that an applicant set forth where the specification (by page and line number or paragraph number) provides written description support for the invention as claimed under 35 U.S.C. § 112, first paragraph. 3M IPC considers the identification of support for a claim or limitation in a claim a common practice in responses prepared by practitioners to a written description rejection by the Examiner under § 112, first paragraph.

¹² See 35 U.S.C. § 282 ("Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though depending on an invalid claim.")

Assuming the scope of a response to the 1.105 request for information under the proposed rule change is relevant to patentability, 3M IPC is not opposed to the proposed rule change. Moreover, the use of a 1.105 request for information regarding support for § 112, first paragraph in an application could presumably be used by Examiners prior to a first office action on the merits, and thus avoid unnecessary § 112, first paragraph rejections for written description in subsequent office actions.

37 C.F.R. § 1.117

3M IPC in general supports the concept of a refund made on claims cancelled before examination on the merits.

37 C.F.R. § 1.261

Proposed rule 1.261 specifies the requirements of an examination support document (ESD), including:

- 1) a preexamination search, including search parameters, files searched, and date;
- 2) and IDS citing the references most closely related to all representative claims;
- 3) identification of all claim limitations in the references;
- 4) explanation of the patentability of the representative claims over the cited references;
- 5) a statement of utility of each independent claim;
- 6) a showing of where each limitation in the representative claims finds support in the specification for the purposes of written description in § 112, first paragraph.

The PTO compares the ESD requirements to those required under a Petition to Make Special (MPEP 708.02)(VII) for accelerated examination. 3M IPC submits that the requirements of proposed Section 1.261 go well beyond the current accelerated examination requirements, particularly as it relates to the following: scope of the preexamination search (1); identification of limitations (3); the statement of utility (5); and the showing of § 112, first paragraph support (6).

While 3M IPC has projected that the ESD will be avoided by applicants, 3M IPC is concerned that the combination of the proposed rule changes will increase the likelihood that an ESD will be required by the PTO for a given application. As discussed above, absent changes that reduce the exposure of applicants and their representatives to claims of inequitable conduct, the requirements of the ESD will increase the cost of prosecuting patent applications (for individual inventors and small businesses, as well as large corporations) and the risk to applicants of inequitable conduct charges in prosecuting patents before the PTO.

Summary

3M IPC is committed to continuing to work with the PTO to address common concerns regarding the quality, efficiency and speed of the patent prosecution process. 3M IPC also has a goal of optimizing the intellectual property rights of its clients and believes that significant advances in quality, efficiency and speed can be achieved with significantly impacting 3M IPC's ability to achieve that goal. This belief is reflected in the comments presented above.

3M IPC appreciates the PTO's ongoing efforts to improve the patent prosecution process, including the efforts expended and preparing the current proposed rule changes. However, as discussed above, 3M IPC believes further refinements are necessary to achieve the results desired by the PTO without unnecessarily burdening applicants and inventors. 3M IPC thanks the PTO for considering its views, and would welcome additional opportunities to address the issues impacted by the proposed rule changes.

Sincerely,

A handwritten signature in cursive script that reads "Nancy M. Lambert".

Nancy Lambert, Reg. No. 44,856

Thomas M. Spielbauer, Reg. No. 58,492

on behalf of 3M Innovative Properties Company