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The Honorable Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Re: Docket No. PTO–P–2022–0025; Request for Comments on USPTO
Initiatives To Ensure the Robustness and Reliability of Patent Rights

Undersecretary Vidal:

This submission is offered in response to the USPTO request for “initial public comments on proposed initiatives directed at bolstering the robustness and reliability of patents to incentivize and protect new and nonobvious inventions, while facilitating the broader dissemination of public knowledge to promote innovation and competition” published at [87 Fed. Reg. 60130-60134](#) on October 4, 2022. The USPTO request for comments has raised numerous questions that to go the most fundamental aspects of the USPTO processes for patent examination.

In response, I offer below a set of proposals for USPTO consideration. The development of this set of the proposals was principally motivated by my belief that growing public concerns over the integrity of the U.S. patent system—many of which focus on patent examination—pose a serious threat to its vitality. While these proposals are a work in progress that I hope to continue to refine, they reflect my view that patent community must be more open to innovative—possibly even revolutionary—ideas for elevating the quality and the integrity of the patent system, with one objective being promoting greater public respect for the patenting process.

During the past decade, I have urged proponents of a strong patent system to take seriously the challenge of creating a high quality, high integrity patent examination process, with an emphasis on the need to streamline and simplify current examination procedures, reduce the costs of patenting, shorten the time needed to fully secure protection on a patent filing, and afford innovators and the public far greater confidence that patentability determinations in the USPTO can be accurate and complete. To these ends, the comments below offer proposals for making what—by any measure—would be profoundly significant changes to the patent examination process that go well beyond what the request in the Federal Register may have contemplated.

I would urge the USPTO to nonetheless consider whether the seriousness of the challenges that patent system today faces—and that the USPTO is being asked to confront—require a more fundamental rethinking of what measures that might be warranted to revamp the patenting process, to better assure that the work of the USPTO can remain a pivotal engine for incentivizing investments to develop and commercialize innovations.

Topic #1 – Limiting “Prior Art” to Subject Matter *Available to the Public*

1. Identify any specific sources of prior art currently available through the Patents End-to-End Search system that you believe examiners should be searching. How should the USPTO facilitate an applicant’s submission of prior art that is not accessible in the Patents End-to-End Search system (e.g., “on sale” or prior public use)? [Emphasis added.]

Topic #1 focuses on how the USPTO should best address prior art that is *not* available to the public, e.g., §102 prior art arising from “in public use or on sale” activities that may not result in any subject matter becoming available to the public. As discussed below, I believe that the USPTO should address this complicated and unique aspect of the U.S. patent law, but *not* by building better mechanisms for considering such “secret prior art” during patent examination. Rather, a preferable change to the U.S. patent system would be to simplify patent examination by eliminating *non-public* “in public use or on sale” activities as a form of prior art and addressing the consequences of placing an invention *secretly* “in public use or on sale” solely as a question of patent enforceability. Making this change to the patent statute would confine “prior art” to be considered during patent examination to subject matter made available to the public.

An important reason for so limiting prior art is the contribution this change would make to building a high-integrity patent system—with highly accurate, highly reliable determinations of patentability being made routinely and consistently during the examination of hundreds of thousands of patent applications each year. The law on patentability needs to support *simplicity and predictability in patentability determinations*. Such goals are facilitated if USPTO’s search capabilities need only be focused on subject matter that has been available to the public. The term “secret prior art” should be recognized for what it is—an oxymoron.

Outside the United States, patent laws limit prior art to subject matter that has been made available to the public. In Europe, prior art is “everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the ... patent application.”¹ The transparency in prior art affords European patent examination the potential to execute simpler, more objective, and more reliable assessments of novelty and non-obviousness over the prior art. Self-evidently, it does so because the “prior art” used to assess novelty does not need to account for any *secret* activities, i.e., disclosures not available to the public.

I urge the USPTO consider abandoning efforts to *facilitate an applicant’s submission of prior art that is not accessible in the Patents End-to-End Search system* in favor of instead encouraging Congress to amend the patent statute to remove all non-public disclosures from any relevance to a novelty or non-obviousness determination. The Leahy-Smith America Invents Act attempted to do so for all first-inventor-to-file patent filings. The Supreme Court decision in *Helsinn*, however, frustrated this effort.

¹ European Patent Convention, Article 54(2).

Thus, on this first topic, I would urge that the USPTO propose to Congress that the *Helsinn* holding of the Supreme Court be legislatively overruled—to harmonize the “public availability” aspect of “prior art” with that of essentially every other industrialized country in the world. Congress could readily do so by *limiting prior art based on use or sale activities to subject matter made available to the public*—in effect, the reform intended by Congress in enacting the AIA.

To this end, I would urge that amendments be made to title 35, United States Code, to remove the words “in public use or on sale” from section 102.² Were Congress to make such a change to the U.S. patent statute, it would likely face criticism from amici who urged the Supreme Court to affirm the Federal Circuit’s decision in *Helsinn*, e.g., the [Brief of amici curiae of 45 Intellectual Property Professors](#), “Going all the way back to the foundational case of *Pennock v. Dialogue*, ... the rationale for the [“in public use or on sale”] statutory bars has been to prevent the extension of the patent monopoly.”³

To address any concern over “extension of patent monopoly,” I have proposed coupling the elimination “in public use or on sale” with a new “patent application filing laches” unenforceability defense to infringement. This defense would render a claimed invention in a patent unenforceable if placed in public use or on sale more than six years⁴ from the date the

² I have recently proposed amendments to the patent statute to do so in the following manner:

SEC.X. VALIDITY AND ENFORCEABILITY OF CLAIMED INVENTIONS IN PUBLIC USE OR ON SALE.

(a) INVALIDITY GROUNDED ON ACTIVITIES NOT AVAILABLE TO THE PUBLIC ABROGATED.

(1) FIRST-INVENTOR-TO-FILE PATENTS.—In section 102(a)(1), strike “or in public use, on sale.”

(2) FIRST-TO-INVENT PATENTS.—In sections 102(b) and 119(a), as in effect on the day before the enactment of the Leahy-Smith America Invents Act, strike “in public use or on sale” and insert “otherwise available to the public”.

(b) UNENFORCEABILITY DEFENSE SUPERSEDING INVALIDITY DEFENSE.—In section 282, , insert at the end:

“(d) APPLICATION FILING LACHES DEFENSE.—If the inventor or a joint inventor, directly or indirectly, had placed a claimed invention in public use or on sale in the United States more than six years prior to the effective filing date of the claimed invention, the patent claiming the invention shall be unenforceable unless, prior to the date on which the patent was initially issued, the patentee had disclaimed under section 253(b) at least the term of the patent extending beyond 20 years from the date on which the claimed invention was first placed in public use or on sale in the United States by the inventor or a joint inventor.”

(c) EFFECTIVE DATE, TRANSITION PROVISIONS, AND EFFECT.—

(1) EFFECTIVE DATE.—The amendments made by this Section shall be effective upon enactment, except that such amendments shall not—

(1) apply to a civil action involving a patent that was brought before the date of enactment of this Act or
(2) limit the enforceability of any claimed invention of a patent issued before the date of enactment to the extent that the claimed invention otherwise would have been enforceable absent the enactment of this Section.

(2) DISCLAIMERS RELATING TO PUBLIC USE OR ON SALE ACTIVITIES.—Notwithstanding section 282(d), for a claimed invention of a patent issued before six months after the date of enactment that, absent the amendments under this Section 1 would have been invalid under section 102 based on in public use or on sale activities, the period for filing the disclaimer required under section 282(d) shall be 1 year from the date of enactment of this Section.

³ 45 Professors’ Brief at p. 16.

⁴ The six-year period for laches is identical to the six-year period for recovery of damages under 35 U.S.C. §286, which was the basis for patent damages “laches” prior to the Supreme Court’s decision in *SCA Hygiene v. First Quality Baby Products*, 137 S. Ct. 954 (2017) and substitutes for the 1-year and 2-year “grace periods” that have applied at various times, e.g., §24, Patent Act of 1870, Ch. 230, 16 Stat. 198-217 (July 8, 1870), barring a patent for a claimed invention “in public use or on sale for more than *two years prior* to [the patent] application.” [Emphasis

patent was initially sought unless—before the patent containing the claim issued—the inventor had disclaimed the term of the patent extending more than 20 years⁵ from the date the invention was first placed in public use or on sale.

The amendment would not only allow all patent examination to be limited to prior art available to the public, but would allow post-grant reviews to proceed with this identical limitation—as well as any other forum addressing patent validity. Moreover, with the patent filing laches unenforceability defense, this simplification and streamlining of patentability and patent validity determinations could proceed without sacrificing any public interest in seeing that patent monopolies not be extended for any unwarranted period.

Topic #2 – Eliminating §120 Continuation Practice and Clarifying §112 Claim Support

Topic #2 is directed to issues of “claim support” and continuation application practice. In any quest for a higher quality, higher integrity patent system, these §112/§120 issues necessarily play a key role. Much criticism of the operation of the U.S. patent system has arisen from the latitude given inventors to seek an unlimited number of additional patents, based on a single original patent filing—and do so throughout the entirety of the 20-year patent term. In addition, the specific questions posed by the USPTO under Topic #2 demonstrate that the issues of claim support and continuation application practice are interrelated.

This interrelation arises because adequately addressing §112 “claim support” issues during patent examination is complicated when patent examiners have the ability to require divisional application filings, and patent applicants have the ability to pursue unlimited numbers of continuing applications. Both divisional and other forms of continuing applications for patent can complicate the effectiveness of USPTO examination efforts because both divisional and other continuing applications are typically filed in a serial manner—a successor application is filed as an earlier-filed application is about to issue. The effect can be to prolong the examination process in the USPTO for a decade or longer—with new or amended claims being presented for examination over the entire period of pendency of such a series of patent filings.

The comments below offer proposals that reflect the centrality of §112/§120 issues to the quality and integrity of the patenting process. As a result, they reflect *an ambitiousness commensurate with the challenge Topic #2 presents*. With this objective foremost, these proposals have been designed *entirely vanquish the severe criticisms of the U.S. patent system arising from continuation application practice by eliminating it*—cutting off at the source any potential for

supplied.] The six year period was designed to be simultaneously fair to inventors, protective of any public interest, and sufficiently long to assure that the defense would arise in only relatively rare circumstances where the unenforceability penalty might be warranted based on an unacceptably long delay in seeking a patent.

⁵ Under the Uruguay Round Agreements Act of 1994, Congress authorized a 20-year patent term from the nonprovisional patent application filing date, which sets a *maximum period for exclusive rights* of 20 years, assuming a patent could be issued without delay following the patent application filing. However, an inventor is entitled to delay the start of the 20-year term through use of the 1-year period for a provisional patent filing following the 1-year “grace period” after an inventor-attributable disclosure, e.g., such as placing a claimed invention in public use or on sale. This 20+1+1 period, thus, forms the maximum extent for a possible patent term permitted for a U.S. patent without creating an unwarranted “extension of the patent monopoly”—and forms the basis starting the proposed 20-year disclaimer period upon placing an invention in public use or on sale.

abuse of the patent system through these serial application filings practices that can permit inventors to transform a single nonprovisional patent application filing into a “thicket” of patents with highly similar claims.

A. *Eliminating All Forms of Continuing Applications for Patent*

2. How, if at all, should the USPTO change ... continuation practice to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents?

Three of the specific queries under Topic #2 are premised on the assumption that the current ability of inventors to file continuing applications for patent under 35 U.S.C. §120 will continue.⁶ Rather than accepting the implicit assumption in these queries—and assuming the current “continuation” practice should represent the starting point for any new thinking about improving the quality and integrity of the U.S. patent system—I urge the USPTO to consider an alternative to this assumption. That alternative would moot the need to address these §112 issues as they relate to the examination of “continuation” applications for patent.

Based on nearly 50 years of experience in drafting and prosecuting patent applications, I have concluded that the single biggest impediment to a high-quality, high-integrity patent examination process lies in the combination of *restriction practice* and *continuation practice*. Both practices multiply the number of patents that can emerge from a single, nonprovisional patent application filing. Both practices add costs, delays, and complexity to the operation of the U.S. patent system. Neither practice is essential to assure that inventors can realize the fullest and most complete protection for the inventions that are disclosed in the nonprovisional patent applications they file. For the public, both practices can contribute to a prolonged and unnecessary delay in understanding the full scope of protection that an inventor will eventually realize.

For these reasons, I urge the USPTO to consider asking Congress to consider an alternative approach to tinkering with the §112 examination procedures in continuation applications. This alternative approach would moot these §112 concerns by adopting what I have described as the “file once, examine once, issue once” principle. Under this principle, *35 U.S.C. §120 would be repealed*. No form of continuing application for patent would remain—no divisional applications, no continuation applications, and no continuation-in-part applications.

⁶ One specific query raised in the Federal Register notice was whether to “require applicants to explain or identify the corresponding support for each claim, or claim limitation, in the written description of *every prior-filed application for which the benefit of an earlier filing date is sought, under, e.g., 35 U.S.C. 119, 120, 121, or 365*?” [Emphasis added.] Another query sought to “require applicants to explain or identify the corresponding support for each claim, or claim limitation, in the written description of *every prior-filed application for which the benefit of an earlier filing date is sought, under, e.g., 35 U.S.C. 119, 120, 121, or 365* (including requiring such support whenever a benefit or priority claim is presented, including upon the filing of a petition for a delayed benefit or priority claim and upon the filing of a request for a certificate of correction to add a benefit or priority claim)?” A third query asked whether to “require applicants to describe *what subject matter is new in continuing applications* (e.g., continuation, continuation-in-part, and divisional applications) to explain or *identify subject matter that has been added, deleted, or changed* in the disclosure of the application, as compared to the parent application(s)?” [Emphasis again added.] Other queries under Topic 2 (those in paragraphs a, d, and e) are addressed in the section of this submission that follows.

Under the file-once-examine-once-issue-once principle, a patent examiner would be charged with reviewing the entire application specification, examining all the presented claims, and addressing all issues of patentability for all the claims presented for examination—and accomplishing all this in the first substantive communication with the patent applicant after the application is filed. Once the examination of all presented claims was completed, a single patent could issue on the claims found allowable. The only additional examination opportunities that would be available to the inventor after the issuance of this single patent would be further consideration of new or amended claims during *ex parte* reexamination or through reissue, under a liberalized reissue statute that would remove the requirement for showing “error.”

Appendix A offers a sample legislative proposal for a complete overhaul of the patent examination process that is premised on the repeal of 35 U.S.C. §120. To afford a statutory “fresh start,” the proposal repeals each of 35 U.S.C. §120-§122, and offers substitute statutory provisions rewritten from the ground up as replacements, i.e., new 35 U.S.C. §136-§138.

Appendix A’s elimination of “restriction” practice would mean that a patent examiner could no longer require any claims presented for examination to be pursued in separate divisional patent applications. As an alternative, new 35 U.S.C. §137 would provide patent examiners with authority to require that independent claims could be restricted to a single general inventive concept,⁷ the standard for unity of invention under Rule 13.1 of the Patent Cooperation Treaty.⁸

While this new §137 authorizes an examiner to restrict the scope of any independent claim, it does not permit the examination of the application for patent to be deferred. As a result, all the claims presented for examination are made the subject of the initial examination and any claims that are determined during the examination process to meet the requirements for patentability, and remain pending, will issue in a single patent, albeit the independent claims may be restricted under new §137.

Further, the proposal in Appendix A calls for a new 35 U.S.C. §43 that provides for additional fees to be paid for applications and patents containing more than three independent claims. Section 43(a) provides that, for each independent claim in excess of three, an additional filing fee, examination fee, issue fee, and maintenance fee is required. These fees effectively mimic the fees that would have been applicable absent the repeal of section 121 had divisional applications for patent been filed in lieu of the submission of additional independent claims confined to a single general inventive concept.

⁷ New §137 renders such requirements for restriction to limit scope of independent claims to a single general inventive concept reviewable by petition to the USPTO Director. In addition, as with the practice under §121, the failure to require restriction is not a basis for challenging the validity of a claim.

⁸ This is the standard referenced in 37 C.F.R. §1.475, which is applicable “when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2” and does so “when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. §111.” Manual of Patent Examining Procedure [R-10-2019], <https://www.uspto.gov/web/offices/pac/mpep/s1850.html>

In addition, under this new examination paradigm in Appendix A, a new 35 U.S.C. §43(b) provides for additional fees to be paid for applications and patents containing more than 30 dependent claims. For each 10 dependent claims in excess of 30, an additional issue fee and additional maintenance fees are required. This requirement discourages the potential for abusive claiming practices in which an unreasonably large number of claims is presented for examination. See *Hyatt v. Hirshfeld*, 998 F.3d 1347 (Fed. Cir. 2021).

Other simplification/streamlining aspects of the proposed statutory changes in Appendix A would simplify the inventor's oath requirement under 35 U.S.C. §115. In brief, under amended §115, the applicant for patent need only identify the inventor and, prior to the issuance of a patent on the application, submit statements by each individual identified as the inventor or a joint inventor that the filing of the application was authorized by such individual and that the individual signing the statement regards himself or herself as the inventor or a joint inventor. Unless this streamlined statement is provided in an assignment of the application by the individual, §115 provides the statement must be separately provided to the USPTO before a patent can issue on the application.

Lastly, Appendix A offers an amendment to 35 U.S.C. §251, the patent reissue statute, to remove the requirement for "error" during the original examination to qualify for a reissue. The amendment would allow a "no fault" reissue opportunity for patent owners.

This liberalization of patent reissue practice would afford patent owners the ability to refine patent claims following issuance. The liberalization offers a means for offsetting the potential for unfairness to patent owners of "the one and done" prosecution regime under the file-once-examine-once-issue-once principle.

Amended §251 would also make a second significant change to the reissue statute. It would replace the two-year deadline from patent issue date for filing broadening reissue applications with a new six-year deadline calculated from the application filing date. This change removes any possible incentive on the part of patent applicants to delay patent issuance in order to delay the expiration of prohibition on seeking broadened reissue claims. At the same time, for applicants securing prompt patent issuance, the amendment provides for a more generous period in which to seek a broadening reissue.

As discussed below in connection with the remaining topics, Appendix A contains further modifications to existing patent examination practices, e.g., proposed statutory changes that would address concerns with the current RCE or "request for continued examination" practices. These are detailed in the discussion of subsequent topics.

When taken in their entirety, the changes proposed in Appendix A were designed to *avoid prejudicing the ability of inventors to secure full and complete protection for the inventions they seek to patent*. With this principle as one predicate for designing them, the proposed modifications to existing patent examination practices were otherwise deliberately constructed to produce a profound elevation in the integrity of the patent examination process and foster far greater public respect for the process of securing patents.

By any measure, the Appendix A proposals eliminate any possible abuse of the patent system arising from the opportunity to file and secure continuation patents. Perhaps more importantly, these proposals would assure patent examiners could conduct patent examination in a more focused and efficient manner. One consequence will be an enhancement of the examiner's ability to spot and raise §112 "claim support" issues—particularly as compared to current practices that can involve multiple examiners handling multiple continuing applications over multiple years as patent applicants continue to present new and amended claims.

B. Changing the Paradigm for Addressing Claim Support

2. How ... should the USPTO change claim support Specifically, should the USPTO:

"a. require applicants to explain or identify the corresponding support in the written description for each claim, or claim limitation, upon the original presentation of the claim(s), and/or upon any subsequent amendment to the claim(s) (including requiring a showing of express or inherent support in the written description for negative claim limitations)? ...

"d. make clear that claims must find clear support and antecedent basis in the written description by replacing the 'or' in 37 CFR 1.75(d)(1) with an 'and' as follows: 'The claim or claims must conform to the invention as set forth in the remainder of the specification, and the terms and phrases used in the claims must find clear support ~~or~~ and antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description?'"

"e. require applicants to provide detailed analysis showing support for genus or Markush claims, and require applicants to identify each claim limitation that is a genus, and explain or identify the corresponding support in the written description for each species encompassed in the claimed genus? ..."

1. Identifying a New/Amended Claim's Antecedent Basis as a "Best Practice" to Codify by Regulation

Over the course of my career, I have had the primary responsibility for the prosecution of hundreds of patent applications, in almost all of which I have presented new or amended claims for examination. In situations in which I have done so, my consistent practice has been to concisely identify for the patent examiner the basis upon which I believed the patent specification provided support, i.e., the antecedent basis, for such new or amended claims.

This practice was not undertaken on my part gratuitously. It was not done solely to provide a roadmap for the patent examiner in examining such claims, but also to create an explicit record in the USPTO that the issue of sufficient support under 35 U.S.C. §112—and the lack of new matter under the last sentence of 35 U.S.C. §132—had been fully considered and resolved during the examination process. The presence of such an examination record may bolster the presumption of the validity in situations where the patent examiner has accepted the patent applicant's specific contentions on the manner in which new or amended claims are supported in the patent specification.

The questions raised in Topic 2.a and 2.d above, based on my experience as a patent practitioner, could be seen as a “best practice” whether or not the USPTO makes any changes to the rules of practice in Title 37 of the Code of Federal Regulations. Indeed, codification of these “best practices” appears fully consistent with overall efforts to improve the integrity of the patent examination process.

The proposed changes in practice under Topic 2.e. are of a different ilk. Codifying such changes to patent practice under Topics 2.a. and 2.d. should largely moot the need to separately codify special rules (e.g., the presentation of a “detailed analysis”) for so-called “genus” or “Markush” claims. There is no type of claim for which the patent statute requires such a “detailed analysis.”

Depending upon what the term “detailed analysis” is intended to denote, imposing such a requirement would represent a burden on the patent applicant to create the analysis and a burden upon the patent examiner to review it. Imposing such incremental burdens for specific types of claiming does not appear to be justified for any quality or integrity purpose.

Moreover, whether or not a claim limitation results in a claim being deemed a “genus” may depend upon whether or not the claim is given its “broadest reasonable construction.” Finally, requiring the specific identification of disclosed species within a genus is unnecessary to a full and complete examination of the claim unless the issue of whether a sufficient number of described species is needed in order for compliance with 35 U.S.C. §112(a).⁹ Hence, a compelling justification for imposing new burdens on patent applicants under Topic 2.e. should be identified before the USPTO affords them further consideration.

2. Recasting Disclosure Sufficiency as a Question of Law and Modifying Claim Construction for Functionally Defined Claim Elements

The questions posed under Topic 2 assume that existing 35 U.S.C. §112 will remain unchanged. This is an assumption that I would urge the USPTO to challenge. There are “tweaks” to the disclosure and claim construction aspects of §112—specifically §112(a) and §112(f)—that could be made by Congress and, if legislated, would afford the USPTO the ability to undertake higher quality patent examinations.

An accurate and complete examination of each claim in each pending patent application depends upon each of the four pillars of patentability—eligibility, non-obviousness, disclosure sufficiency, and claiming definiteness—being fully considered by the patent examiner. In recent years, for better or for worse, the Supreme Court has weighed into three of these four pillars with notable jurisprudence, specifically on the patent law of eligibility,¹⁰ non-obviousness,¹¹ and

⁹ In the biopharma arts, claims to new molecular entities may often use generic terminology such as extending the claim scope to include “pharmaceutically acceptable salts.” This is generally understood to be a functionally defined genus that does not require any disclosed species for support. Thus, a rote recitation of all the salts species that may happen to appear throughout the specification would not assist the patent examiner in any manner—but does exemplify the manner in which the burden to prepare and provide such information would be unwarranted.

¹⁰ *Bilski v. Kappos*, 130 S. Ct. 3218 (2010), *Mayo Collaborative v. Prometheus Labs.*, 132 S. Ct. 1289 (2012), *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107 (2013), and *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347 (2014).

¹¹ *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

definiteness.¹² While the Supreme Court has not recently meddled in the §112 law of sufficiency of disclosure,¹³ the Federal Circuit has done so repeatedly, particularly on the question of “written description”—and most notably (and somewhat contentiously) with respect to biopharma inventions.¹⁴ Within the biopharma space, the knottiest §112(a) issues lie in the realm of functional claiming, e.g., in technologies such as monoclonal antibodies.¹⁵

In a recent paper,¹⁶ I have suggested that the “written description” requirement ought to be understood as fundamentally a question of law, grounded on whether the patent specification demonstrates that a claimed invention was actually made, *i.e.*, full and completely conceived. My *Landslide* paper concluded with a plea to patent practitioners to change certain commonly accepted patent drafting techniques so that the inventions for which a patent is being sought might be more readily identified. Doing so would obviously advantage inventors under the emerging law on “written description” and make the work of examination for compliance with §112 less onerous for patent examiners.

If the USPTO is seeking (or open to seeking) new examination-facilitating initiatives in which issues under 35 U.S.C. §112(a) would be more holistically addressed, I would urge consideration of a statutory change to §112(a) that affords the opportunity for all sufficiency of disclosures issues (as is already the case for eligibility, non-obviousness, and claim definiteness¹⁷) to be recognized as a question of law. Specifically, I have proposed that 35 U.S.C. §112(a) be amended to read as follows”

“(a) ADEQUATE DISCLOSURE.—A claimed invention must be disclosed in the specification of the application in such full, clear, concise, and exact terms as to *demonstrate the full and complete conception thereof*, thereby enabling any person skilled in the art to which it pertains, or with which it is most nearly connected, *to make and use the full scope of the claimed invention without resort to undue experimentation.*” (Emphasis added.)

I have similarly proposed that 35 U.S.C. §112(f) be amended to become a “savings clause” that would protect almost all claims with “functional” terminology from being invalidated for want of a sufficient disclosure, *i.e.*, by affording such claims a statutorily mandated construction that

¹² *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014).

¹³ *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 13 (1946) and *O’Reilly v. Morse*, 56 U.S. 62 (1854).

¹⁴ *Biogen Int’l GmbH v. Mylan Pharms. Inc.*, 18 F.4th 1333 (Fed. Cir. 2021), *reh’g and reh’g en banc denied*, 28 F.4th 1194 (Fed. Cir. 2022). Opinion by Judge Reyna, writing for the majority and joined by Judge Hughes, with Judge O’Malley dissenting.

¹⁵ See *Amgen Inc. v. Sanofi*, 872 F. 3d 1367, 1379 (Fed. Cir. 2017). “Congress has not created a special written description requirement for antibodies...”

¹⁶ See *Landslide*, Vol. 15, No. 1 (September/October 2022), pp. 5-9, *Do You Really Need to Make an Invention before You Can Patent It? Managing “Written Description” Issues after Biogen v. Mylan.*

https://www.americanbar.org/groups/intellectual_property_law/publications/landslide/2022-23/september-october/do-you-really-need-make-invention-you-can-patent-it-managing-written-description-issues-after-biogen-v-mylan/

¹⁷ *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018) (“Like indefiniteness, enablement, or obviousness, whether a claim recites patent eligible subject matter is a question of law which may contain underlying facts.”).

would limit claims otherwise invalid under §112(a), but only such otherwise invalid claims, to the disclosed embodiments in the patent specification and their equivalents:

“(f) CONSTRUCTION OF FUNCTIONALLY DEFINED CLAIMS.— In determining whether a claim meets the requirements under subsection (a), and in construing the claim to determine the scope of protection afforded thereunder otherwise, a claim that would otherwise be invalid as insufficiently disclosed, because one or more elements of the claim are set forth in terms of a function to be performed or a result to be achieved but without specifying the means for doing so, shall be construed to be limited to the structures, materials, or acts disclosed in the specification for carrying out the function or achieving the result, and to any equivalents thereto that would not result in the claimed invention being found to be obvious under section 103.”

The above combination of statutory amendments to 35 U.S.C. §112(a) and (f), while preserving the so-called “peripheral claiming” principle, effectively defaults claim construction to a type of “central claiming” approach—*but only when needed to preserve patent validity*. As such, these §112 amendments are designed to offer the best of both worlds: valid and enforceable functional claims if fully described and enabled—but more limited and valid patent protection for the disclosed species and equivalents if not. Moreover, these changes align with the public interest that securing a broader scope of claim should be dependent on more fulsome disclosure in the patent filing.¹⁸

In sum, the proposed statutory changes to 35 U.S.C. §112 are aimed at substantially remediating issues with functional claims—by offering inventors the ability to secure and enforce them where the functional claims are fully described and enabled and the ability to nonetheless preserve valid and enforceable patent rights in the “species” or embodiments described where the effort at functional claiming fails to meet the §112 disclosure requirements.¹⁹ Moreover, the changes to §112 proposed above—and the potential they offer for improving the ability of the patent examiner to address §112 issues—may form a predicate for successfully addressing through legislation the unsatisfactory state of subject matter eligibility law, by removing the confounding policy issue of §112-permissible claim scope from what should be the simpler §101 eligibility issue of whether a claimed invention is or is not a practically useful application of technology.²⁰

¹⁸ “The case for central claiming starts from the premise that the value of a patent ought to correspond to the value of the invention the inventor has contributed to society. ... At least to a first approximation, if an inventor produces a more valuable invention, she ought to receive a more valuable reward. This, in turn, will encourage subsequent inventors to direct their efforts to the inventions with the potential to produce the greatest value. To the extent that a central claiming approach aims first to understand what the inventor contributed, and then set the scope of the legal rights accordingly, it increases the concordance between the contribution and the reward.” Andres Sawicki, *The Central Claiming Renaissance*, 103 *Cornell L. Rev.* 645, 658. (<https://scholarship.law.cornell.edu/clr/vol103/iss3/3>).

¹⁹ Adopting this “saving clause” approach would have preserved the validity of functional claims that have been routinely invalidated by the Supreme Court, e.g., *Halliburton v. Walker* and *O’Reilly v. Morse*.

²⁰ For an analysis of the relationship between §112 and §101 issues in biopharma patenting, see *Whither Patenting of Biomedical Inventions After Mayo, Myriad, and Now Alice*, 33rd Annual Intellectual Property Law Conference,

Topic #3 – Cabining RCE Practice Through Conditional Patent Issuance Followed by §257(b)-Style Post-Issuance Ex Parte Reexamination

3. How, if at all, should the USPTO change RCE practice to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents? Specifically, should the USPTO implement internal process changes once the number of RCEs filed in an application reaches a certain threshold, such as transferring the application to a new examiner or increasing the scrutiny given in the examination of the application?

Topic #3 aims at investigating alternatives to the current RCE practice that might better align with the goal of securing robust and reliable patents. In my experience, the use of RCE practice can result from a patent examiner maintaining unwarranted rejections of claims for which the patent applicant is not yet prepared to launch an appeal—or from patent applicants needing more time to gain the ability to adequately responded to examiner rejections that may well be warranted. In either situation, there is clear policy justification for affording the patent applicant the opportunity for requesting continued examination in lieu of forcing a premature appeal.

If efforts are made by the USPTO to limit the absolute number of RCEs, such a constraint could have the unintended and perverse effect of encouraging some applicants to keep biting at the RCE apple until the full number of RCEs had been exhausted, before either appealing or accepting whatever claims might have been found allowable. The proposal for switching patent examiners following a threshold number of RCE requests might encourage an existing patent applicant to simply wait out the RCE switch threshold to see if the new patent examiner might be more malleable. Similarly, if “increased scrutiny” is to be invoked, which in theory may be fine, what end is that scrutiny to accomplish?

I would urge the USPTO to consider alternatives other than tinkering with the existing RCE practice to address the possibility that the patent examination process might become excessively prolonged. Specifically, I would urge that the USPTO should consider approaching Congress to *seek authority to conditionally issue a patent on a long-pending nonprovisional patent application—and then, upon conditional issuance, immediately subject the conditionally issued patent to a §257(b)-style reexamination.*

In Appendix A, the details of this *conditional patent issuance* proposal are set out. As proposed in Appendix A, conditional patent issuance would be an adjunct to the file-once-examine-once-issue-once paradigm for patent examination, with both these mechanisms reflecting the public interest in seeing that rigorous examination for patentability should result in prompt issuance of all claims that are found to be patentable.

Arlington, VA (April 18-20, 2018) at https://www.americanbar.org/content/dam/aba/administrative/intellectual_property_law/2018SpringMaterials/armitage_materials.pdf.

The ability to promptly issue a patent can be frustrated, however, either by the dalliance of the patent applicant or by the intransigence of the patent examiner. For this reason, I have proposed that either the USPTO *or the patent applicant* should have the option of securing the conditional issuance of a patent.

The “conditional issuance” option would be available only after a statutorily fixed period after the nonprovisional filing date. The timing that I have proposed is three years for the patent applicant and six years for the USPTO.

In Appendix A the details of this proposal are offered in a proposed new 35 U.S.C. §136, with the following features:

1. Under §136(a), the procedures on continued examination under current 35 U.S.C. §132(b)²¹ are recodified without substantive change.
2. Under new §136(b), an applicant whose nonprovisional application for patent has been pending for three years can obtain *conditional issuance of a patent on the pending claims* in the application and, upon issuance of the patent, any *outstanding issues of patentability are addressed in an ex parte reexamination* commenced upon patent issuance.
3. In a similar manner for an application that has been pending for at least six years, under new §136(c), *the Director may issue a notice of conditional allowance* of an application for patent, notwithstanding the examination has not been completed, and, if a patent issues pursuant to the notice, issue the patent on the application in order to address any outstanding issues of patentability in an ex parte reexamination that is simultaneously commenced upon the issuance of the patent.
4. Under §136(d), the procedures for a subsection (b) or (c) ex parte reexamination are set out. In these reexamination proceedings, the patent owner is not permitted to make an amendment under 35 U.S.C. §304 and the USPTO may address any issue of patentability, notwithstanding the limitation that otherwise would apply to a proceeding under chapter 30 of title 35, United States Code. The presumption that the claims of the conditionally issued patent are valid under 35 U.S.C. §282 does not apply to a patent that is under reexamination until a certificate of patentability, unpatentability, and claim cancellation issues under 35 U.S.C. §307.

The policy rationale for USPTO conditional issuance is grounded on the principle that the USPTO should be able to *de facto* end any RCE opportunity once it has assessed that further churning of the RCE process would be unproductive, which may presumptively be the case once a patent application has been pending for six years—roughly one-third of the 20-year statutory term. If progress is no longer being made towards a final decision on patentability, conditional patent issuance in such a circumstance provides the USPTO a pathway for cutting off further

²¹ 35 U.S.C. §132(b) currently reads as follows: “(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1).”

RCE opportunities—with all remaining issues of patentability being addressed post-issuance in an ex parte reexamination, in the same manner as during a supplementary examination under 35 U.S.C. §257(b).

Similarly, under new §136, patent applicants are afforded a mirror opportunity to secure conditional issuance. For applicants requesting for conditional allowance, the three-year waiting period assures patent applicants an opportunity to secure an effective post-issuance patent life of 17 years. Doing so would facilitate repeal of the existing patent term adjustment provisions of 35 U.S.C. §154(b). For this reason, the proposal in Appendix A would replace the existing §154(b) PTA provisions with a new provision limited to delays in patent issuance due to the imposition of a secrecy order, providing for a one day extension for each day of the order.

In sum, instead of making the RCE process more complex, I would urge the USPTO to consider the above proposal for conditional patent issuance, particularly given its balanced benefits for both the public and patent applicants in avoiding prolonged delays in the patent grant. With prior art being limited to subject matter available to the public and the patentability issues under §101, §103, and §112 being each a question of law (i.e., under the above-proposed amendments to 35 U.S.C. §112 discussed above), the USPTO should be positioned to routinely assure completion of examination within the three to six year time span from the initial nonprovisional patent filing.²² If so, the *conditional issuance* would be needed only in relatively rare situations.

Topic #4 – Eliminating Current Restriction and Double Patenting Practices

Topic #4 is addresses both current restriction practice arising under 35 U.S.C. §121 and the issue of obviousness-type double patenting, a judge-made doctrine with no statutory basis in Title 35, United States Code. Both restriction practice and obviousness-type double patenting rejections consume substantial amounts of patent examiner time that ideally would be redirected to examining for eligibility, non-obviousness, disclosure sufficiency, and claiming definiteness.

A. Eliminating Divisional Applications by Ending Current Restriction Practice

4. How, if at all, should the USPTO limit or change restriction, divisional, [and] rejoinder ... practice to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents?

Topic #4’s questions relating to restriction practice and alternatives, such as invoking a “unity of invention” standard for restricting the examination of claims in a patent filing²³ have been

²² Compare *Hyatt v. Hirshfeld*, 998 F. 3d 1347 (Fed. Cir. 2021) in which multiple patent applications originally filed in 1995 remained pending after a quarter century. Proposed §136 would have eliminated this possibility.

²³ The specific questions raised include whether the USPTO should:

“a. allow for the examination of two or more distinct inventions in the same proceeding in a manner similar to the practice authorized by 37 CFR 1.129(b), and, if so, consider an offset to patent term adjustment in such cases?

“b. revise the burden requirement before the examiner to impose a restriction, and if so, how?

“c. adjust the method by which an examiner appropriately establishes burden for imposing a restriction requirement?

addressed in the discussion above of the file-once-examine-once-issue-once principle as implemented in Appendix A. The proposal therein moots the “restriction practice” issues set out in Topic #4, albeit with patent examiners having the option to limit independent claims to a single general inventive concept, consistent with the proposed “unity of invention” principle.

B. Eliminating Invalidity for Obviousness-Type Double Patenting In Favor of Barring Separate Enforceability of Patentably Indistinct Claims

4. How, if at all, should the USPTO limit or change ... non-statutory double patenting practice ...? Specifically, should the USPTO ... limit or change non-statutory double patenting practice, including requiring applicants seeking patents on obvious variations to prior claims to stipulate that the claims are not patentably distinct from the previously considered claims as a condition of filing a terminal disclaimer to obviate the rejection; rejecting such claims as not differing substantially from each other or as unduly multiplied under 37 CFR 1.75; and/or requiring a common applicant or assignee to include all patentably indistinct claims in a single application or to explain a good and sufficient reason for retaining patentably indistinct claims in two or more applications?

Topic #4 addresses the issue of obviousness-type double patenting. It does so with the assumption that obviousness-type double patenting should continue to be a ground for holding patent application claims unpatentable or invalidating patent claims—subject to the filing of a terminal disclaimer to obviate the unpatentability or invalidity. As an alternative to retaining this ground of unpatentability or invalidity (and all the terminal disclaimer practice that accompanies it), I would urge the USPTO to pursue a *rethinking the entirety of obviousness-type double patenting law from the ground up*.

I believe that significant quality improvement in the patent examination process could be achieved if the law of obviousness-type double patenting were transformed from a basis for invalidating patent claims into a doctrine limiting the *enforceability* of patent rights—and patent examiners were freed from assessing obviousness-type double patenting and provisional obviousness-type double patenting issues. Such a change in the law would allow the USPTO to redirect examining resources, now deployed by the USPTO to deal with obviousness-type double patenting issues, to the core patentability issues of eligibility, non-obviousness, disclosure sufficiency, and claiming definiteness.

“d. authorize applicants, in the case of a Markush group, to suggest how the scope of the claim searched should be expanded if the elected species is not found in an effort to present closely related inventions for consideration together?

“e. adopt a unity of invention requirement in place of the restriction requirement?

“f. revise the current practice of authorizing the filing of divisional applications in a series to require all divisional applications to be filed within a set period of time after the restriction requirement is made final and after any petition for review has been resolved?

“g. make changes to the rejoinder practice after a final rejection has been made, such as giving applicants a certain time period after final rejection to provide appropriate claims for rejoinder?”

Such a transformation of the doctrine is today warranted for multiple reasons. At the outset, obviousness-type double patenting is a concept unique to the U.S. patent law. It is unknown outside the United States. Moreover, it is an entirely judicially imposed ground for invalidating patents devoid of any statutory basis.

The courts, in imposing this ground for invalidating patents, have only cited to a pair of policy justifications for the doctrine's existence:

- *Unjustified timewise extension of exclusionary rights.* The first judicial justification is the potential, when patentably indistinct claims are present in multiple patents, for an *unjustified timewise extension* of the exclusionary rights. The *unjustified timewise extension* most commonly arises with reference to the second-to-issue of a pair of patents containing the patentably indistinct claims, in which the expiration date of the second-to-issue patent is later in time relative to the expiration of an earlier-issuing patent.²⁴
- *Potential for harassment of accused infringers through assertion of patentably indistinct claims.* The second policy justification arises from the potential for harassment of an infringer in the situation where an infringement action is brought against the accused infringer to enforce a patent, in which the patent contains claims that are patentably indistinct from the claims of another patent that was previously enforced against the infringer in a separate infringement action. The most concerning harassment issue arises from the possibility that the two patents with patentably indistinct claims could be separately owned and then separately enforced—producing the prospect of “double liability” for infringement of the same patentable invention.²⁵

Under today's U.S. patent law, neither judicial justification serves any substantial purpose. Any possible policy justification for retaining obviousness-type double patenting law as a ground of unpatentability pales in comparison to the unique burden the doctrine currently imposes on U.S. patent examiners to examine hundreds of thousands of patent applications each year to spot obviousness-type double patenting issues—and then reject claims based upon those issues.

The first of these judicial policy concerns—*unjustified* timewise extension of exclusionary rights—was eliminated *de facto* with the 20-year patent term under the Uruguay Round Agreements Act of 1994. Except for the congressionally justified timewise extension of exclusionary rights under the PTA²⁶ and PTE²⁷ statutes, the possibility abuse of the patent

²⁴ See MPEP 804 Definition of Double Patenting [R-10.2019] “The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that: ‘The public should . . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.’ *In re Zickendraht*, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring). Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982). (<https://www.uspto.gov/web/offices/pac/mpep/s804.html>)

²⁵ “[T]here is a second justification for obviousness-type double patenting—harassment by multiple assignees” *In re Fallaux*, 564 F. 3d 1313, 1319 (Fed. Cir. 2009).

²⁶ 35 U.S.C. §154(b).

²⁷ 35 U.S.C. §156.

system from “double patenting” that formerly could result from the pre-URAA “stacking” of serial 17-years patent terms in patents with patentably indistinct claims no longer exists.

While such patentably indistinct, pre-URAA patent claims could have afforded exclusionary rights *with no fixed timewise limitation* on exclusionary rights—absent the mandated obviousness-type double patenting rule on terminal disclaiming—the URAA now specifies an ironclad, maximum patent life for any collection of patents with patentably indistinct claims. Under the URAA patent term, that ironclad limitation is a *theoretical maximum of 22 years*.²⁸

Given that *Congress explicitly justified a 20-year patent term* by voting to implement the TRIPS agreement, there is today no extant policy justification for imposing a non-statutory term limitation on the combined term of two patents with patentably indistinct claims *unless the combined period of exclusionary rights under two patents exceeds 20 years*. Such a 20-year period of conclusionary rights cannot be found to be an unjustified timewise extension because the 20-year patent term under the URAA inherently recognized that, but for the delays in issuing a patent to account for the USPTO examination process, *every patent would afford the patent owner a full 20 year period of exclusionary rights*.²⁹

While obviousness-type double patenting principle were self-evidently needed on account of the loophole in the pre-URAA patent statute—that imposed no statutory timewise limitation whatsoever on patentably indistinct claims—all URAA patents now have such a limitation by statute. Even if an argument can be made that the theoretical maximum period of 22 years of exclusionary rights is a longer period than Congress justified under the URAA 20-year patent term, that contention is entirely evaporates where the combined period of exclusionary rights for patents with patentably indistinct claims is 20 years or less.

The second policy justification for the judicial imposition of obviousness-type double patenting law—harassment of accused infringers through separate enforcement of patents with patentably indistinct claims—is more appropriately addressed in the context of patent enforcement. The policy concern only arises if an attempt at enforcement of indistinct claims is being pursued in a separate infringement action brought against the same infringer alleging the same acts of infringement. In other words, harassment is theoretically possible only if a separate infringement action is being brought that could not have been brought had all patentably indistinct claims been issued in the first instance in a single patent.

Thus, this second policy justification for obviousness-type double patenting could entirely disappear if the principle of *res judicata* were extended to apply to bar a separate enforcement action that *would have been barred under res judicata principles had all patentably indistinct claims been present in a single patent*. In short, in the exceedingly rare situation when such duplicative enforcement is even a theoretical possibility, applying *res judicata* principles could be a complete antidote to the *enforcement harassment* policy concern.

²⁸ This 22-year period accounts for the possibility that after a first patent issued, a second patent could be sought within provisionally following a one-year “grace period” for the first patent’s issue date and nonprovisionally filling the one-year provisional priority period. The second patent, expiring at the end of the 20-year term from its filing would result in a 22-year period of exclusionary rights from the first patent’s issue date.

²⁹

In sum, all the work of the USPTO examining patent applications for obviousness-type double patenting issues could be eliminated—with all policy justifications for the judicial impositions of obviousness-type double patenting law fully addressed—through two straightforward limitations on the enforceability of patents with indistinct claims. The first such limitation would cap the patent life for patentably indistinct claims, i.e., the period from the issue date of the earliest issued patent with such claims to the expiration date of the latest to expire patent, at 20 years. This is the justified period for exclusionary rights that Congress established for patent claims under the URAA. The second such limitation would apply res judicata principles to bar any separate infringement action involving patentably indistinct claims whenever such an action would be barred under res judicata principles had all patentably indistinct claims been issued in a single patent.

I would urge the USPTO to raise with the Congress the possibility of legislation that would recast obviousness-type double patenting law as wholly statutory law addressing patent enforceability that would have no relevance to patent examination.³⁰ This would moot the need

³⁰ Such legislation might take the following form:

SEC. X. VALIDITY AND ENFORCEMENT OF PATENTABLY INDISTINCT CLAIMED INVENTIONS.

(a) OBVIOUSNESS-TYPE DOUBLE PATENTING INVALIDITY ABROGATED.—Except as provided under the provisions of section 101 that precludes patenting of multiple claimed inventions defining the identical subject matter and section 103 that requires non-obviousness over prior art, no claimed invention of a patent shall be invalid on account of patentable indistinctiveness with respect to a claimed invention of the same or another patent. Claimed inventions in applications for patent must not be examined by the Office for similarity with respect to one another, except to assure compliance with sections 101 and 103.

(b) NEW UNENFORCEABILITY DEFENSES; OBVIOUSNESS-TYPE DOUBLE PATENTING.—In section 282, insert at the end:

“(d) ENFORCEABILITY DEFENSES IN CASES OF DOUBLE PATENTING.

“(1) DOUBLE PATENT ASSERTION DEFENSE.—A claimed invention in a patent alleged to be infringed in a civil action shall be unenforceable in such action if (A) the infringement allegation would have been barred on res judicata grounds had each of the claims of a second patent been included as claims of the asserted patent and (B) such second patent contains at least one claim that is patentably indistinct from at least one claim in the asserted patent for which neither of such patentably indistinct claimed inventions represents prior art to the other. For the purposes of this paragraph, two claimed inventions shall be regarded as patentably indistinct unless each would represent novel and non-obvious subject matter had the other constituted prior art to it.

“(2) LIMITATION ON PATENT LIFE TO 20 YEARS FOR PATENTABLY INDISTINCT CLAIMS.—Except for an extension of term under section 156, with respect to any two claimed inventions that are patentably indistinct from one another under paragraph (1), the rights granted under this title with respect to such claimed inventions shall not be enforceable after 20 years from the original patent issue date of either patentably indistinct claimed invention.”

(c) CONFORMING AMENDMENT, EFFECTIVE DATE, AND TRANSITION PROVISIONS.—

(1) CONFORMING AMENDMENT.—In the table of sections for chapter 10, insert after the item relating to section 105:

“106. Validity of patentably indistinct claims.”

(2) EFFECTIVE DATE.—The amendments made by this Section shall be effective upon enactment, except that such amendments shall not—

(A) apply to a civil action involving a patent that was brought before the date of enactment and

(B) limit the enforceability of any claimed invention of a patent to the extent that the claimed invention otherwise would have been enforceable absent the enactment of this Section.

(C) TERMINAL DISCLAIMERS.—A terminal disclaimer filed before the effective date of this Section shall have no effect on the enforceability of a patent if (i) a claimed invention in the patent is subject to a limitation on

for the USPTO to address proposals for making the law on obviousness-type double patenting even more complicated than it is today. Most importantly, it would wipe away all the complexity of obviousness-type double patenting under precedents of the Federal Circuit over the past 20 years that have made this body of law increasingly arcane for patent applicants and increasingly burdensome for the USPTO to administer.

Topic #5 – Enhancing Applicant Information Disclosure Requirements and Repealing Misconduct-Based Unenforceability, Substituting Unenforceability in Place of Invalidity for Inventorship Misjoinder/Nonjoinder, and Superseding *Mayo/Alice* Jurisprudence

5. Please provide ... any other suggestions to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents.

Topic #5 seeks additional suggestions to foster innovation and competition—looking to a patent examination system that can produce robust and reliable patents. Given the open-ended nature of this topic, I strongly urge the USPTO to give the fullest possible consideration to four measures that hold the potential for markedly improving the integrity and reliability of U.S. patents. These measures would (1) elevate the quality of required “information disclosures” from patent applicants, (2) bar unenforceability of valid patent claims on prosecution misconduct grounds, (3) transform inventorship misjoinder/non-joinder from a ground of invalidity to one of unenforceability, and (4) overrule the Supreme Court’s *Mayo/Alice* (but not *Myriad*) holdings by imposing a new requirement that patent-eligible subject matter must constitute a practically useful application of technology. Each of the proposed reforms is further described below.

A. New Patent Applicant Information Disclosure Obligations; Elimination of “Inequitable Conduct” Unenforceability for Valid Patent Claims

Of the four measures described above, the first two are linked. Together they seek to create a framework for dramatically improving the quality of the applicant input into the patent examination process.

As set out in detail in Appendix A, the first of this pair of proposals would impose elevated information disclosure obligations on patent applicants. The companion change would bar unenforceability on “inequitable conduct” grounds of any valid patent claim.

In Appendix A, the proposed new patent applicant information disclosure requirements are set out in a new 35 U.S.C. §138 that also replaces existing 35 U.S.C. §122. This new §138 contains the following new elements designed to make the patent examination process more transparent:

1. Under §138(a), all nonprovisional applications for patent are made available to the public six months after filing (i.e., essentially 18-months from the earliest possible priority date) once a secrecy review is completed or a secrecy order lifted. The current ability for opting out of publication is removed, which both improves early access to prior art under

unenforceability under section 282(d) and (ii) the disclaimed term of the patent extends more than one year after the effective date of this Act.

35 U.S.C. §102(b)(2) and the transparency of the patenting process otherwise. The USPTO would continue to publish nonprovisional applications within six months from filing, unless subject to a secrecy order. Provisional applications would continue to be maintained in confidence unless the provisional application is referenced in a nonprovisional application.

2. Under §138(b), the submission by applicants of prior art patents and other printed publication for consideration during examination must be accompanied by a concise description of the relevance of each item submitted and the applicant must pay any per-item fee established by the Director for the review of the items submitted. These new requirements would be inapplicable to any item for which a concise description of the relevance is provided in the specification of the application. These provisions collectively provide a disincentive for applicants for patent to provide, without explanation, excessive numbers of items of prior art for review by patent examiners, which are typically of no consequence to the ultimate determination of patentability. In addition, new §138(b)(3) provides that no submission of a patent or other printed publication will be regarded as having been considered by the examiner unless it meets the elevated disclosure requirements under §138(b) or is specifically cited by the examiner during examination or is listed in a search report from a related foreign or international application for patent.³¹
3. Under §138(c), the provisions providing for third-party submissions of prior art would be reenacted into law. These provisions were originally enacted under §122(e). The reenactment into law would be without any change of substance from the existing statute.

The change to the “inequitable conduct” law could be accomplished by adding a single, additional sentence to 35 U.S.C. §282(a) at the end: “*No valid claim of a patent may be found unenforceable based upon allegations of misconduct before the Office.*”

The elimination of this defense for valid patent claims addresses patent applicant concerns that the enhanced disclosure requirements would represent a “no-win” situation – simply creating fodder for a raft of “inequitable conduct” allegations based upon alleged deficiencies in any effort at providing a concise description of the relevance of items of prior art. Additionally, the proposed remediation of the “inequitable conduct” is designed to remove the incentive that patent applicants have today to mindlessly disclose huge quantities of prior art to avoid the possibility of allegations that a material prior art reference has been concealed.

³¹ This provision describing when a prior art reference will be regarded as having been considered by a patent examiner may be consequential for a trier of fact in assessing if a patent claim is valid. In the context of a jury trial, the Supreme Court has concluded: “When warranted, the [trier of fact] ... may ... consider that it has heard evidence that the PTO had no opportunity to evaluate before granting the patent. [The trier of fact may] evaluate whether the evidence before it is materially new, and if so, to consider that fact when determining whether an invalidity defense has been proved by clear and convincing evidence.” *Microsoft Corp. v. i4i Ltd. Partnership*, 564 U.S. 91 (2011) at 131 S.Ct. 2251.

Although prosecution misconduct would not be available as a ground of unenforceability of a valid patent claim,³² other deterrents to misconduct would be preserved.³³ For example, nothing in the elimination of the unenforceability defense for valid patent claims precludes a court from making a finding of patent misuse where invalid claims in a patent are found to be unenforceable, specifically on account of the perpetration of a fraud on the court arising from the assertion of such invalid claims.³⁴ When such a fraud has been perpetrated on the court through assertion of an invalid claim or the assertion of the invalid claim otherwise constitutes a misuse of the patent, the proposed change does not preclude imposing remedies under the competition laws grounded in fraudulent conduct.³⁵

As such, this combination of changes—enhanced applicant disclosure requirements coupled with “inequitable conduct” unenforceability relief attempts to thread the needle between competing policy concerns and leave patent applicants with an enhanced incentive for securing valid patent claims by freeing them to deal with greater candor with patent examiners. Together these changes should strongly discourage, if not virtually eliminate, what some critics see as the near-farcical compliance with a duty of candor and good faith under 37 C.F.R. §1.56 that results when patent applicants dump on patent examiners hundreds of prior art references for consideration—when at most a handful have any relevance to whether or not a patent can be validly issued.

³² Notwithstanding the above prohibition on the unenforceability of valid patent claims, prosecution misconduct will continue to be addressed in multiple forums, whether or not the misconduct relates to a valid or an invalid claim. In the case of an individual registered to practice before the USPTO, the Director may take action to suspend or exclude the individual from practice under 35 U.S.C. § 32 based upon misconduct before the USPTO. In the event an individual is the subject of such a proceeding under section 32, the Director may communicate any findings by the USPTO to disciplinary bodies of professional organizations in which the individual is a registered to practice for the purpose of exacting similar sanctions. All remedies for violation of the antitrust laws remain, including the first section of the Clayton Act and section 5 of the Federal Trade Commission Act, relating to unfair methods of competition based upon misconduct before the Office. Lastly, criminal prosecution for misconduct before the United States Patent and Trademark Office is possible under 18 U.S.C. § 1001(a).

³³ In recommending that no unenforceability defense based on prosecution misconduct should be maintained, the National Research Council of the National Academies of Science (*A Patent System for the 21st Century* (2004), p.122, available to download at <http://www.nap.edu/html/patentsystem/0309089107.pdf>) noted: “If invalidity, disciplinary action, and reputational concerns are not sufficient deterrent to misconduct, other civil and even criminal remedies exist—antitrust, unfair competition, common law fraud, and tortious interference. Moreover, since the creation of the inequitable conduct doctrine by the courts, other safeguards have been adopted by Congress and the USPTO to support the integrity of the patent system. These include third-party and USPTO-initiated re-examination on withheld prior art, publication of pending applications, and third-party access to pending prosecution papers and the ability to submit material information.”

³⁴ *Keystone Driller Co. v. General Excavator Co.*, 290 U.S. 240 (1933), *Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co.*, 324 U.S. 806 (1945) and *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 245 (1944), where the Supreme Court found the patent owner had engaged in “a deliberately planned and carefully executed scheme to defraud not only the Patent Office but the Circuit Court of Appeals.”

³⁵ “A patentee who brings an infringement suit may be subject to antitrust liability for the anti-competitive effects of that suit if the alleged infringer (the antitrust plaintiff) proves (1) that the asserted patent was obtained through knowing and willful fraud within the meaning of *Walker Process Equipment, Inc. v. Food Machinery & Chemical Corp.*, 382 U.S. 172, 177 (1965), or (2) that the infringement suit was ‘a mere sham to cover what is actually nothing more than an attempt to interfere directly with the business relationships of a competitor,’ *Eastern R.R. Presidents Conference v. Noerr Motor Freight, Inc.*, 365 U.S. 127 (1961); *California Motor Transp. Co. v. Trucking Unlimited*, 404 U.S. 508, 510 (1972) (holding that *Noerr* ‘governs the approach of citizens or groups of them ... to courts, the third branch of Government’).”

B. Transforming Inventorship Misjoinder/Non-Joinder Into an Unenforceability Defense When Incorrect Inventorship is Consequential to Patent Ownership

In both the examination of patent applications,³⁶ and in patentability determinations during the post-grant review procedure,³⁷ the USPTO can be called upon to make determinations of whether the inventorship of the application or patent is correct. Similarly, inventorship issues can come before the USPTO through “derivation proceedings” under 35 U.S.C. §135.³⁸

During the patenting process, inventorship determinations are often complicated because each claim in a patent or application for patent can have a different inventor. For example, as claims are amended during patent examination, addition of a joint inventor may be needed, or a joint inventor may become superfluous. Moreover, for many assigned inventions, such changes in inventorship are entirely inconsequential to the ownership of the patent. Often each joint inventor of an assigned patent is employed by the same employer, such that over-naming or under-naming of the joint inventors has no impact on the ownership of the patent. Also, simply naming joint inventors on a patent filing (which is all that 35 U.S.C. §115 requires) is not a representation as to which among the joint inventors might be the inventor of any individual claim. Thus, patent applicants making use of the one-year “grace period” still need to assure that some correspondence exists between the individual or individuals making a prior public disclosure and the inventorship of a specific claimed invention for the “grace period” to apply.

Recently, I have been exploring ideas to remove “correct inventor naming” as a patentability or patent validity issue, while preserving misjoinder/non-joinder consequences to those situations where the over- or under-naming of joint inventors would be consequential, i.e., would affect the ownership of the patent. As set out below, I believe that eliminating inventorship as a patent validity issue is both possible and desirable. The desirability comes in large measure from the reduction of issues the MPEP and patent examiners would need to address, and the USPTO’s PGR process would need to consider.

Equally importantly, I believe that the §135 “derivation proceeding” statute could be repealed and replaced with a simple provision on USPTO inventor-correction. In effect, the focus of the USPTO would be transformed from one of “rejecting” on incorrect inventorship grounds to simply “fixing” incorrect inventorship once established. The proposed statutory changes to accomplish this outcome would require fairly straightforward amendments of 35 U.S.C. §135, §256, and §291.³⁹

³⁶ See MPEP 2157, “In the rare situation where it is clear that the application does not name the correct inventorship and the applicant has not filed a request to correct inventorship under 37 CFR 1.48, Office personnel should reject the claims under 35 U.S.C. 101 and 35 U.S.C. 115.” (<https://www.uspto.gov/web/offices/pac/mpep/s2157.html>)

³⁷ 35 U.S.C. §321(b) provides that “[a] petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).” Under §282(b)(2), “[i]nvalidity of the patent or any claim in suit [may be raised] on any ground specified in part II as a condition for patentability,” which includes under 35 U.S.C. §115(a) that “[a]n application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application.”

³⁸ See 35 U.S.C. §135(b), “In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue.”

³⁹ The following additional changes could be made to 35 U.S.C.—

The key change being proposed would lie in an amended 35 U.S.C. §256:

1. The proposed revision to §256(a) would provide that the failure to correctly name the inventor of a patent cannot serve as a ground for holding that a patent is either invalid or is unenforceable. This provision, however, is subject to an exception under proposed §256(b).
2. Under proposed §256(b), a patent cannot be enforced if the correction of incorrect inventorship would produce a change in the ownership of the patent. The patent does not become enforceable until the inventorship has been corrected. At that time, the decision

SEC. X. VALIDITY AND ENFORCEABILITY OF PATENTS IN CASES OF INCORRECT INVENTORSHIP.

(a) MISJOINDER OR NON-JOINDER IN INVENTORSHIP; CORRECTION.—

(1) INVENTORSHIP OF ISSUED PATENTS.—Strike section 256 and insert:

“§256. Incorrect inventorship and correction.

“(a) INCORRECT INVENTORSHIP.—Except as provided in subsection (b), a patent shall not be held to be invalid or unenforceable for naming an individual as the inventor or a joint inventor who is not the inventor or a joint inventor of any claimed invention therein or for the failure to name as the inventor or a joint inventor an individual who is the inventor or a joint inventor of at least one claimed invention therein.

“(b) UNENFORCEABILITY.—If a patent incorrectly names the inventor and the correction of inventorship would result in a change in the ownership of the patent, such patent shall not be enforceable unless and until the naming of the inventor of the patent is corrected as provided under subsection (c).

“(c) INVENTORSHIP CORRECTION.—If either the Director under section 135, or a court under section 291, makes a determination that the facts so require, the Director shall issue a certificate of correction of the inventorship of a patent or correct the naming of the inventor on an application for patent, as the case may be.”

(2) INVENTORSHIP CORRECTIONS BY THE DIRECTOR.—Strike section 116(c) and strike section 135 and insert:

“§135. Inventorship correction by Director.

“The Director shall establish procedures for deciding petitions for the correction of the naming of the inventor of a patent or an application for patent. If all parties concerned have not joined in a petition for correction under this section, the Director may conduct such proceedings in the Office as may be required to decide the petition.”

(3) INVENTORSHIP CORRECTIONS DURING A CIVIL ACTION.—Strike section 291 and insert:

“§291. Inventorship correction arising during a civil action.

“If a court determines a patent is unenforceable under section 256(b), based on a finding of misjoinder or nonjoinder of one or more individuals as the inventor or a joint inventor, the court shall order the Director to issue a certificate correcting the inventorship of the patent.”

(3) CONFORMING AMENDMENTS.—

(i) In the item relating to sections 135 in the table of sections for chapter 12 of title 35, United States Code, strike and insert:

“135 Inventorship correction by Director.”

(ii) In the item relating to sections 256 in the table of sections for chapter 25 of title 35, United States Code, strike and insert:

“256 Incorrect inventorship and correction.”

(iii) In the item relating to sections 291 in the table of sections for chapter 29 of title 35, United States Code, strike and insert:

“291 Inventorship correction during civil action.”

(b) EFFECTIVE DATE AND EFFECT.—The amendments made by this Section shall be effective upon enactment, except that such amendments shall not—

(1) apply to a civil action involving a patent that was brought before the date of enactment or

(2) limit the enforceability of any claimed invention of a patent issued before the date of enactment to the extent that the claimed invention otherwise would have been enforceable absent the enactment of this Section.

to enforce or not enforce the patent would lie with the patent owner resulting from the inventorship correction. Where such inventor-naming changes do not affect the ultimate ownership of the patent, §§256(a) and (b) reflect what effectively is a no-harm, no-foul approach to issues of validity and enforceability. As such, they do not detract from the core provision of 35 U.S.C. §101 that all patents must have a proper applicant for patent that must be either the inventor (including any joint inventors) or the assignee authorized by the inventor to seek a patent on behalf of the inventor.

3. Under §256(c), two forums are provided in which incorrect inventorship can be corrected. The Director is authorized under a new §135 to correct inventorship upon petition of interested parties. Similarly, if a court pursuant to a new §291 has determined incorrect inventorship has resulted in a patent not being enforceable, it may order the Director to correct the inventorship of the patent.

C. Superseding the Mayo/Alice Patent Eligibility Test with a Practically Useful Application of Technology Requirement

The USPTO, the patent bar, and the inventor community (among others) continue to struggle with the current state of the law on subject matter eligibility. Recent and promising efforts to remedy the unfortunate state of affairs that has resulted from the Supreme Court’s *Bilski*, *Mayo*, and *Alice* precedents have taken place with the introduction of the [Patent Eligibility Restoration Act](#).⁴⁰ This effort, however, has already attracted [significant opposition](#) and [harsh criticism](#), notwithstanding its [strong bipartisan sponsorship](#).

If the USPTO determines that some alternative legislative approach should be added to the mix of ideas to address the Supreme Court “subject matter eligibility” precedents cited above, I would offer (as I did during the 2019 Senate hearings on this topic⁴¹) a somewhat more narrow approach that would not disturb the precedent in *Myriad*, but would assure that a simpler and more objective eligibility standard would replace the so-called two-part under *Mayo* and *Alice* (i.e., whether the claimed invention was directed to an abstract idea and, if so, whether the claimed invention contributed significantly more by way of some inventive concept).

Specifically, in 35 U.S.C. §101, I would propose to (1) strike both occurrences of “new and useful”; (2) insert “constituting a practically useful application of technology,” after “matter,”; and (3) insert an additional sentence at the end (“In determining eligibility for patenting, a claimed invention that constitutes a practically useful application of technology must not be deemed directed to a law or product of nature, a natural or physical phenomenon, or an abstract idea.”) so that the amended text of §101 would read:

Whoever invents or discovers any [~~new and useful~~] process, machine, manufacture, or composition of matter, *constituting a practically useful application of technology*, or any [~~new and useful~~] improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. *In determining*

⁴⁰ S. 4734, 117th Congress (August 2, 2022) (<https://www.congress.gov/117/bills/s/4734/BILLS-117s4734is.pdf>).

⁴¹ See <https://www.judiciary.senate.gov/download/armitage-testimony>.

eligibility for patenting, a claimed invention that constitutes a practically useful application of technology must not be deemed directed to a law or product of nature, a natural or physical phenomenon, or an abstract idea.

These amendments to 35 U.S.C. §101 are designed to limit subject matter eligibility for patenting to claimed inventions constituting a practically useful application of technology, *with the term “technology” intended to broadly reference knowledge or capabilities from any useful art* and explicitly overrule the Supreme Court’s *Mayo/Alice* line of subject matter eligibility cases, through adding the second sentence to 35 U.S.C. §101. More specifically—

1. The elimination of the word “new” represents an editorial clarification of the patent statute given the current redundancy of §101 with the requirement in 35 U.S.C. §102 (Conditions for patentability; novelty) that a claimed invention must be new or “novel” to be patentable. The elimination of the word “useful” is undertaken in connection with the second amendment to §101 that codifies the new “application of technology” requirement for subject matter eligibility for patenting.
2. The requirement that a claimed invention must constitute a practically useful application of technology in part codifies the precedent of *Brenner v. Manson*, 383 US 519 (1966), holding that a claimed invention must exhibit specific, real-world value to be “useful.” It additionally codifies a “useful arts” limitation on patenting, by requiring that a claimed invention must be technological in character to be patent-eligible, *i.e.*, constitute an application of technology.
3. The second sentence of §101 prevents any claimed invention that constitutes a practically useful application of technology from being regarded as directed to a law or product of nature, a natural or physical phenomenon, or an abstract idea. With this amendment, the *Mayo/Alice* eligibility analysis is not only rendered moot and overruled, but the holding of the Supreme Court in *Funk Bros. Seed Co. v. Kalo Co.*, 333 US 127 (1948) is similarly overruled, *i.e.*, by preventing subject matter ineligibility for product or process discoveries that are expressly limited to a practically useful applications of technology (e.g., in *Funk Bros.*, an “inoculant for leguminous plants”).

The above amendments to §101, when packaged with the amendments proposed above to 35 U.S.C. §112(a) and §112(f) should work together to improve the quality and integrity of patent examination. Such a §101/§112 package, as I noted in my 2019 testimony, “improves the manner in which the [USPTO] and the courts can regulate the breadth of patent coverage when the inventor has claimed an invention in functional and potentially preemptive terms, while at the same time freeing inventors to pursue all manner of claims directed to a practically useful process, machine, manufacture, or composition of matter contributing to a useful art.”⁴²

⁴² <https://www.judiciary.senate.gov/download/armitage-testimony>.

Topic #6 – Substituting Enforceability Limitations for “Terminal Disclaimer” Practice Would Head the Patent Law in the Wrong Direction

6. Terminal disclaimers, allowed under 37 CFR 1.321(d), allow applicants to receive patents that are obvious variations of each other as long as the expiration dates match. How would eliminating terminal disclaimers, thus prohibiting patents that are obvious variations of each other, affect patent prosecution strategies and patent quality overall?

Topic #6 addresses the issue of eliminating patents with claims that are patentably indistinct by eliminating the ability to obviate the judicially imposed obviousness-type double patenting doctrine through use of “terminal disclaimer” practice. As noted above, the better course of action would be to entirely transform the doctrine of obviousness-type double patenting law into constraints on patent enforceability, eliminating any role whatsoever for obviousness-type double patenting in the patent examination process.

The suggestion in Topic #6 for barring continuation patents containing claims to obvious variations of an earlier-issued parent patent—instead of merely requiring terminal disclaimer filing—would largely eliminate all forms of continuing applications *except those where the parent application failed to issue as a patent or a restriction requirement under 35 U.S.C. §121 had been imposed*. Thus, while this suggestion would largely eliminate the multiplicity of patents with similar claims from a single, nonprovisional patent filing, it would do nothing to stop an inventor from delaying the issuance of any patents by serially starting and stopping the examination through continuation filings. Divisional patent filings would, of course, be permitted to continue as well—since divisional patent filings consonant with a restriction requirement are immune from obviousness-type double patenting considerations.

Moreover, this suggestion in Topic #6 would continue the current burden on patent examiners to examine for patentable indistinctness. Indeed, the examination burden would undoubtedly grow as patent applicants, unable to respond to a rejection for patentable indistinctiveness with a terminal disclaimer, are forced to substantively contest any *prima facie* showing of patentable indistinctness by the patent examiner. Patent quality could erode if examination resources that otherwise would be deployed to assure non-obviousness over prior art become mired in more “obvious variation” rejections and provisional obviousness-type double patenting rejections.

As noted above, the ideal option for addressing all obviousness-type double patenting issues would be to head in the opposite direction from barring all “obvious variation” patents. Ideally, obviousness-type double patenting issues would be eliminated entirely from the patent examination process, mooted the need for the current terminal disclaimer practice. This would save substantial patent examination resources that could be redeployed to enhancing examination under §101, §103, and §112. To address any perceived abuses in continuation practice, including the possibility that continuing applications for patent might contain patentably indistinct claims vis-à-vis claims issued in predecessor applications, Appendix A provides for the outright abolition of all continuing application for patent, including divisional applications. Hence, it efficiently eliminates the possibility of using a single patent filing to create a “thicket” of patents.

Topic #7 – Linking “Obviousness” Determinations for Double Patents Represents a Misapplication of the Statutory Requirement for Non-Obviousness

7. Currently, patents tied together with a terminal disclaimer after an obviousness-type double patent rejection must be separately challenged on validity grounds. However, if these patents are obvious variations of each other, should the filing of a terminal disclaimer be an admission of obviousness? And if so, would these patents, when their validity is challenged after issuance, stand and fall together?

The two questions raised under Topic #7 can best be put into perspective with a simple example. Assume a Species A is prior art to the inventor who discovered two related Species B and B+ and initially sought to patent both Species B and B+ in a single patent filing. Further assume that this single patent filing then became the basis for two patents, a first patent claiming Species B and a continuation patent claiming Species B+ in which the continuation patent contained a terminal disclaimer (thereby effectively conceding that Species B+ was patentably indistinct or an obvious variation of Species B). Under the proposal in Topic #7—the patentability of B+ would be irrevocably tied to the patentability of Species B.

If ultimately Species B+ was commercialized based on having surprising and unexpected advantages over prior art Species A, the mere fact that Species B and B+ were separately patented should not—at least for any legitimate policy reason—mean that, if Species B ultimately failed to demonstrate non-obviousness over Species A, Species B+ should automatically be deemed obvious over Species A. Indeed, if Species B and Species B+ had been issued in the same patent, they would each be independently presumed valid, i.e., each presumptively valid over Species A irrespective of the validity of the other.⁴³ Thus, the mere fact that these two species, patentably indistinct from one another, are to be found in different patents should not by itself doom the patentability of both.

That said, as proposed above in response to Topic 4.B, the obviousness-type double patenting issues resulting from having separately patented Species B+ can be addressed if the Species B+ patent cannot be separately enforced from the Species B patent without invoking the same res judicata limitations that would have arisen had only a single patent issued with claims to both species. For res judicata purposes, patentably indistinct claims should be treated as though they were all issued as part of the same patent, such that enforcement of the Species B patent in the above example would be treated as though the Species B+ patent claims had been part of the patent in the original enforcement action of the Species B patent.

As discussed above, the proposal for eliminating obviousness-type double patenting as a ground for patent invalidity should be accompanied by two new statutory unenforceability defenses. One would address “double assertion” and the other would address “timewise extension.” With

⁴³ 35 U.S.C. §282(a): “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 dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.”

such a statutory regime in place, there should be no need for tying the patentability of a non-obvious invention to the patentability of an obvious one—particularly when the patent statute is clear their validity should be assessed independently from one another, even if found in the same patent.

Topic #8 – Imposing a “Second Look” by “Patent Quality Specialists” For Continuation Patents Is Mooted Under the File-Once-Examine-Once-Issue-Once Proposal

8. Should the USPTO require a second look, by a team of patent quality specialists, before issuing a continuation patent on a first office action, with special emphasis on whether the claims satisfy the written description, enablement, and definiteness requirements of 35 U.S.C. 112, and whether the claims do not cover the same invention as a related application?

Topic # 8 looks to understand the value of a “second look” at continuation applications for patent, subjecting them to more examination scrutiny before patents can issue on such applications. For the patent system to function effectively, rigorous requirements for patentability must be rigorously applied by the USPTO in the examination of all nonprovisional applications for patent. There is no good policy reason to have, in effect, a lesser effort at quality examination for an original patent filing compared to a continuation patent.

The file-once-examine-once-issue-once proposal set out in Appendix A is designed to focus examination of all claims at one time during one procedure in the hope that the patent examiner will be optimally familiar with the patent disclosure, the prior art, and the claims that merit patenting. The file-once-examine-once-issue-once proposal would moot the need to consider whether special procedures for examining continuation patent would be needed.

Topic #9 – Requiring “Heightened Examination” for Continuation Patents Is Unwise and Unneeded and Is Moot Under the File-Once-Examine-Once-Issue-Once Proposal

9. Should there be heightened examination requirements for continuation patents, to ensure that minor modifications do not receive second or subsequent patents?

Topic #9 raises the issue of “heightened” standards for continuation patents. Any effort at “heightened examination requirements” necessarily raises the issue of “how high?”. It also does not address the issue of proliferation of patents if the higher requirements can be met. Further, there is nothing intrinsic to a higher requirement that would preclude a second patent’s claims from being a “minor modification” of a parent patent’s claims unless both the parent patent and continuation patent were subject to the same heightened examination requirement.

A more direct route to avoiding second or subsequent continuation patents with claims that are minor modifications of the claims of a parent patent is simply to eliminate from the patent statute the ability to secure such continuation patents. As proposed in Appendix A, the file-once-examine-once-issue-once proposal in Appendix A would accomplish this objective.

Topic #10 – Barring Continuing Applications Rather Than Time-Limiting Them

10. The Patent Act requires the USPTO Director to set a “time during the pendency of the [original] application” in which continuation status may be filed. Currently there is no time limit relative to the original application. Can the USPTO implement a rule change that requires any continuation application to be filed within a set timeframe of the ultimate parent application? What is the appropriate timeframe after the applicant files an application before the applicant should know what types of inventions the patent will actually cover? Would a benchmark (e.g., within six months of the first office action on the earliest application in a family) be preferable to a specific deadline (e.g., one year after the earliest application in a family)?

Topic #10 raises the issue of time-limiting continuation application filings by reference to the statutory provisions that specify a “time during the pendency of the application” for taking action that appear in 35 U.S.C. § 119(b)(1),⁴⁴ § 119(e)(1),⁴⁵ and § 120.⁴⁶ With respect to possible USPTO rulemaking, the cited statutory provisions have no impact on the timing of the filing of continuing applications, at least so long as the continuing applications are during the pendency of the nonprovisional patent filing referenced⁴⁷ or within one year of the filing date of the provisional application or foreign-filed patent application referenced.⁴⁸ The co-pendency and/or the one-year requirement, as the case may be, are statutory provisions that the USPTO should not have the authority to negate by rulemaking. Thus, the USPTO cannot under the current patent statute implement a rule change that requires any continuation application to be filed within a set timeframe of the ultimate parent application.

In my experience, the appropriate timeframe when an “applicant should know what types of inventions the patent will actually cover” (after the applicant files an initial nonprovisional application) is largely dependent upon the *speed and quality of the patent examination* and the *issues that emerge during patent examination*. If, during examination, a rejection is made over

⁴⁴ 35 U.S.C. § 119(b)(1) reads:

“(b)(1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, **at such time during the pendency of the application** as required by the Director.

⁴⁵ 35 U.S.C. § 119(e)(1) reads in relevant part:

“No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted **at such time during the pendency of the application** as required by the Director.”

⁴⁶ 35 U.S.C. § 120 reads in relevant part:

“No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director.”

⁴⁷ 35 U.S.C. § 120 provides this explicitly: “**if filed before the patenting or abandonment of or termination of proceedings** on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.”

⁴⁸ See, for example 35 U.S.C. § 119(a): “within **twelve months from the earliest date** on which such foreign application was filed... .” [Emphasis added.]

very significant prior art, a patent examiner may insist on actual experimental evidence that substantiates asserted differences from the prior art. It may be years—if an applicant appeal is required, many years—before a patent applicant can know what might be patentable. At the other end of the examination spectrum, the patent examiner may issue an immediate allowance of all the claims sought, with the result that the patent applicant may know within a matter of months from the initial nonprovisional patent filing which claimed inventions that patent will actually cover.

For these and other reasons, in my experience, it would be inadvisable for the USPTO to attempt to set “a benchmark (e.g., within six months of the first office action on the earliest application in a family)” or “a specific deadline (e.g., one year after the earliest application in a family)” for the applicant to decide if continuation applications must be filed. The existence of a deadline of this type would, if history is any lesson, simply leading to a patent practitioner reaction of “banking” continuing applications just before a deadline imposed. This could result in wasted patent examiner time on continuing applications that the patent applicant might find unneeded.

As discussed above, a far better legislative approach would be the file-once-examine-once-issue-once approach in which no continuation application filings would be available. Such a system could be introduced—with expanded reissue opportunities as a patent applicant “safety valve”—in a manner that would fully serve the needs of inventors while promoting the integrity in the patent process that is in the public interest.

Conclusions

The efforts of the USPTO seeking comments on measures to improve the robustness and reliability of patent rights are well timed. The impassioned pleas of advocates for a strong patent system have never been more intense, sounding alarms if the U.S. patent system cannot be strengthened and made more reliable.

Such concerns by patent advocates are often matched with an equal and opposite outcry from patent system critics that the system is too open to abuse—and is being actively abused through “patent thicketing” and a “patent troll” business model that assigns value to patent rights not on account of inventive merit, but instead based on the outsized costs and unpredictability facing an accused infringer who is challenging patents that appear on their face to be devoid of merit.

The foregoing is my effort to propose a middle path between these divergent views. The above proposals are based on what hopefully represents a common belief among all who are affected by the patent system that a higher quality and higher integrity patent system makes for a stronger patent system and can vanquish any supposed abusive practices by those securing patent rights.

One objective of the foregoing submission is that the USPTO seriously consider how it might engineer the file-once-examine-once-issue-once principle. Examination practices would need to change in order for the USPTO to eliminate all forms of continuing applications for patent, including divisional applications, in favor of a new practice that—while examining all claims presented for examination—would still permit patent examiners to require that independent claims be confined to a single general inventive concept. This new “all-at-once” examination

practice would be augmented with USPTO authority to conditionally issue patents pending more than six years to allow the remaining patentability issues to be addressed through the ex parte reexamination process, in a manner akin to the existing practice under 35 U.S.C. §257(b), while patent applicants would enjoy a similar option to seek conditional issuance of patents pending more than three years—once again subject to ex parte reexamination to address any remaining issues of patentability. Such dramatic reforms to existing examination practices would require the USPTO to carefully consider both the advantages and potential pitfalls in implementing such options. Finally, as a safety valve for patent owners, the above proposals allow patents to be reissued absent any showing of “error.” This change to requires some analysis on the part of the USPTO to assure accommodation of a potentially more widespread use of reissue practice.

Another objective of this submission is to open new pathways for patent examination to focus more intensively on the four pillars of patentability: eligibility, non-obviousness, disclosure sufficiency, and claiming definiteness. It is for this reason that the proposals above seek to move issues such as obviousness-type double patenting, incorrect inventorship, and the forfeiture bar based on “in public use or on sale” activities to issues of enforceability of patent rights that would no longer need to be addressed as part of any examination process.

In addition, I would urge the USPTO to investigate fully the above proposals for elevating the information disclosure requirements on patent applicants and simultaneously eliminating the ability for valid patent claims to be rendered unenforceable based upon prosecution misconduct. Making this pair of changes to patent law and practice affords the opportunity for far more valuable applicant input during the patent examination process and far more candor in this applicant-examiner interactions.

Finally, the unacceptable state of affairs with respect to the law on subject matter eligibility must be addressed by Congress. Ideally, Congress would enact a relatively simple and straightforward proposal that recognizes that the “useful arts” clause in the Constitution envisions that patents should be available for all practically useful applications of technology, with the scope of protection being confined only to the breadth of the *inventive* subject matter found to be *sufficiently disclosed*, which can be ascertained through the §103/§112 requirements and not a §101 eligibility constraint. To this end, the above proposals offer both §101 and §112 amendments that might be added to the mix of other meritorious suggestions for addressing the unacceptable status quo on patent eligibility. In any event, I would hope that the USPTO would continue to urge that the untenable aspects of current eligibility law remain the focus of congressional attention.

In conclusion, thank you! The continuing efforts of the USPTO to explore avenues for improving the operation of our Nation’s patent system—as evidenced by this latest USPTO request for comments—is most welcome and most appreciated.

Respectfully submitted,



Robert A. Armitage

APPENDIX A – FILE ONCE, EXAMINE ONCE, ISSUE ONCE

SEC. 1. STREAMLINING AND SIMPLIFYING PATENT EXAMINATION.

(a) STREAMLINED EXAMINATION PRACTICES.—

(1) ELIMINATION OF CONTINUING APPLICATIONS.—Strike and reserve sections 120-122 and insert at the end of chapter 12 of title 35, United State Code:

“§136. Continued examination; reexamination.

“(a) APPLICANT REQUEST FOR CONTINUED EXAMINATION.—If an applicant requests continued examination of an application, the Director shall further examine such application under section 131 under such regulations as the Director shall otherwise prescribe, including the establishment of appropriate fees therefor that shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1)

“(b) CONTINUED EXAMINATION THROUGH REEXAMINATION.—Notwithstanding section 151, and upon a request made after 3 years from the filing date of an application for patent that is not subject to a secrecy order, the applicant may request the conditional issuance of a patent on the application, pursuant to the procedure set forth under this section. If the request is accompanied by the issue fee required under section 151, the Director shall conditionally issue a patent for any claims then pending in the application, irrespective of whether it appears the applicant is entitled to a patent, and concurrently order a reexamination of the patent upon its issuance to address any outstanding issues of patentability.

“(c) CONTINUED EXAMINATION AFTER CONDITIONAL ALLOWANCE.—Notwithstanding section 151, and pursuant to an order by the Director entered not earlier than 6 years after the filing date of an application that is not subject to a secrecy order, the applicant may be provided a written notice of the conditional allowance of the application under this section, irrespective of whether it appears that the applicant is entitled to a patent, and, if a patent issues pursuant to the notice, the Director shall concurrently order a reexamination of the patent to address any outstanding issues of patentability. The notice of conditional allowance shall specify a sum, constituting the issue fee, which must be paid, if at all, within three months after the date of the notice, unless any delay in payment is shown to be unintentional. Upon payment of this sum the patent shall conditionally issue. If payment of the fee is not timely made, the application shall be regarded as abandoned.

“(d) MANNER AND EFFECT OF REEXAMINATION.— A reexamination under this section shall be conducted according to procedures established under chapter 30, except that the patent owner shall not have the right to file a statement pursuant to section 304. During the reexamination, the Director may address any issue of patentability notwithstanding the limitations in chapter 30 relating to patents and printed publication or any other provision of such chapter.

“(e) CONDITIONAL ISSUANCE; PRESUMPTION OF VALIDITY.—Upon publication of the certificate under section 307(a) with respect to a patent conditionally issued under this section, the issuance of the patent shall no longer be regarded as conditional. Notwithstanding section 282(a), prior to the issuance of the certificate under section 307(a) with respect to a patent conditionally issued under this section, no claim of the patent shall be presumed valid.

“(f) PETITIONS FOR POST-GRANT REVIEW.—Notwithstanding section 321(c), the 1-year period specified therein shall commence upon the date of the publication of the certificate under section 307(a) with respect to a patent conditionally issued under this section.”

“§137. Restriction of independent claims.

“The examiner may object to an independent claim as being directed to multiple general inventive concepts and may require that each independent claim be restricted to a single general inventive concept. The applicant may request a review of any objection under this section by petition to the Director, identifying what the applicant regards as the single general inventive concept present in each independent claim. The validity of a patent shall not be questioned for failure of any claim to be restricted to a single general inventive concept.

“§138. Secrecy, public availability, and information disclosures

“(a) IN GENERAL.—Upon filing, a nonprovisional application shall be available to the public 6 months after the filing date, except to the extent such access must be deferred pending completion of a national security review or the termination of any secrecy order under section 181. Not later than 6 months from the filing date of the application or, if a secrecy order is entered, upon lifting of the secrecy order, the Director shall publish the application. A provisional application for patent shall be kept in confidence except if referenced under section 119(e) in a nonprovisional application that is available to the public under this section.

“(b) APPLICANT DISCLOSURE OF PATENTS AND PRINTED PUBLICATIONS DURING EXAMINATION.—

“(1) IN GENERAL.—A patent or printed publication that may or does constitute prior art material to patentability of a claim in an application being examined, or otherwise is of potential or actual relevance to the patentability of a claim, may be submitted by the applicant to the Office for consideration during the examination of the application only if the applicant—

“(A) provides with the submission of such item a concise description of its potential relevance to the patentability of the claims being examined;

“(B) pays any fee established by the Director for submission of such item; and

“(C) meets such other requirements as to timing and form for the submission of the item as the Director may establish by regulation.

“(2) EXCEPTIONS.—The requirements under subparagraphs (A) and (B) of paragraph (1) shall not apply to any patent or printed publication—

“(A) for which the specification of the application contains a concise description of its potential or actual relevance to the patentability of the original claims or

“(B) that is exempted from such requirements under regulations established by the Director.

“(3) CONSIDERATION BY THE OFFICE.—A patent or printed publication shall not be considered, or be regarded as having been considered, by the Office unless it—

“(A) meets the requirements under paragraph (1),

“(B) falls within the exception under paragraph (2),

“(C) is listed in an action reporting on the prior art prepared by the Office during the examination of the application or a like report prepared in connection with a related foreign or international application that has been made available during examination in a timely manner, or

“(4) is identified in a submission in connection with the application in compliance with subsection (c).

“(c) SUBMISSIONS BY THIRD PARTIES.—

“(1) IN GENERAL.—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

“(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or

“(B) the later of—

“(i) 6 months after the date on which the application for patent is first published under this section by the Office, or

“(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

“(2) OTHER REQUIREMENTS.—Any submission under paragraph (1) shall—

“(A) set forth a concise description of the asserted relevance of each submitted document;

“(B) be accompanied by such fee as the Director may prescribe; and

“(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.”

(2) REQUIREMENT TO EXAMINE EACH CLAIM.—

(A) In section 131, strike “application” and insert “each claim of the application.”

(B) In section 132, strike subsection (b) and remove the designation in subsection (a).

(3) FEES.—

(A) In chapter 4 of title 35, United States Code, insert at the end:

“§ 43. Additional fees for excess claims.

“(a) EXCESS INDEPENDENT CLAIMS.—Upon filing, or upon pendency in an application for patent otherwise, of claims in independent form in excess of 3, in addition to the fee specified in section 41(a)(2), the applicant shall incur an excess claims fee under this section in the amount of the total fee as specified in section 41(a) for the original filing, the search, and the examination of the application for each claim in independent form in excess of 3. Upon issuing a patent containing one or more claims in independent form in excess of 3, in addition to the issue fee specified in section 41(a)(4), the applicant shall incur an additional issue fee under this section in the amount of the fee as specified in section 41(a)(4) for each claim in independent form in excess of 3. At the time of payment of a maintenance fee under section 41(b) with respect to a patent, the patentee shall incur an additional maintenance fee under this section, in the amount of the fee as specified in section 41(b) for maintaining the patent in force, for each claim then in the patent in independent form in excess of 3.

“(b) EXCESS DEPENDENT CLAIMS.—Upon issuing a patent containing one or more dependent claims in excess of 30, in addition to the issue fee specified in section 41(a)(4), the applicant shall incur an additional issue fee under this section in the amount of the fee as specified in section 41(a)(4) for each 10 dependent claim in in excess of 30. At the time of payment of a maintenance fee under section 41(b) with respect to a patent, the patentee shall incur an additional maintenance fee under this section, in the amount of the fee as specified in section 41(b) for maintaining the patent in force, for each 10 dependent claims then in the patent in excess of 30.”

(B) In section 41(a)(2)(A), strike items (i) and (ii) and strike the designation for item (iii).

(4) CONFORMING AMENDMENTS.—

(A) The items relating to sections 120-122 in the table of sections for chapter 11 of title 35, United States Code, are amended to read as follows:

“120. [Reserved.]”

“121. [Reserved.]”

“122. [Reserved.]”

(B) In the table of sections for chapter 12 of title 35, United States Code, insert at the end:

“136. Continued examination; reexamination.

“137. Restriction of independent claims.

“138. Secrecy, public availability, and information disclosure.”

(C) In the table of sections for chapter 4 of title 35, United States Code, insert at the end:

“43. Additional fees for excess claims.

(b) STREAMLINED STATUTE FOR ADJUSTMENT OF TERM.—Strike section 154(b) and insert:

“(b) ADJUSTMENT OF PATENT TERM.—If the issue of an original patent is delayed due to the imposition of an order under section 181, the term of the patent shall be extended 1 day for each day of the order.”

(c) STREAMLINED INVENTOR STATEMENTS.—

(1) REQUIRED STATEMENT.—Strike section 115 and insert:

“§115. Inventor naming and required statement.

“An application for patent, including an application that commences the national stage under section 371, shall include, or be amended to include, the name of the inventor thereof, together with such identifying information with respect to the inventor as the Director may prescribe by regulation. No patent may issue on an application unless each individual named as the inventor or a joint inventor has submitted to the Office an assignment of the application, or other signed statement, stating that the application was made or was authorized to be made by such individual and such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application. For an individual deceased, under legal incapacity, unavailable after a diligent search, or obligated to assign a claimed invention but refuses to do so or to make a required statement under this section, an applicant as described in section 118 may satisfy the requirement under this section by filing a substitute statement representing that, upon an explanation of the relevant facts, such individual is believed to be the inventor or a joint inventor. Except as provided in section 256(b), no claimed invention

shall be held invalid or unenforceable based on the failure to comply with any requirement under this section.”

(2) TECHNICAL AMENDMENTS.—In section 116(a), strike “and each make the required oath”; section 152, strike “upon the application made and the specification sworn to by the inventor.”; and in section 252(c), strike “and sworn to”.

(3) CONFORMING AMENDMENTS.—The item relating to section 115 in the table of sections for chapter 11 of title 35, United States Code, is amended to read as follows:

“115. Inventor naming and required statement.”

(d) PRIORITY RIGHTS CLARIFICATION.—

(1) IN GENERAL.—In section 119, strike subsection (e) and insert:

“(e) PRIORITY BASED ON PROVISIONAL APPLICATION FILING.—

“(1) IN GENERAL.—A nonprovisional application for patent filed under section 111(a), including an application filed under section 363, with respect to a claimed invention disclosed in the manner provided under section 101(a)(3) in a provisional application filed under section 111(b) that names or is amended to name the inventor or a joint inventor who is named in the provisional application, including through amendment of the provisional application, shall have the same effect, as to such claimed invention, as though the nonprovisional application had been filed on the date of the provisional application, if the nonprovisional application—

“(A) is filed not later than 1 year after the date on which the provisional application was filed and

“(B) contains or is amended to contain a specific reference to the provisional application.

“(2) SPECIFIC REQUIREMENTS.—

“(A) IN GENERAL.—No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application

“(B) OTHER REQUIREMENTS FOR RELIANCE.—A provisional application filed under section 111(b) may not be relied upon in any proceeding in the Office unless the requirements under section 111(b) have been met, including with respect to any required fees.”

(2) CONFORMING AMENDMENTS.—In section 119—

(A) in subsection (a), strike “(a)” and insert “(a) PRIORITY RIGHT.—”;

(B) in paragraph (b)(1), strike “(b)(1)” and insert:

“(b) RESTRICTIONS AND REQUIREMENTS—

“(1) IN GENERAL.—”;

(C) in paragraph (b)(2), strike “(2)” and insert “(2) WAIVER OF RIGHT.—”;

(D) in paragraph (b)(3), strike “(3)” and insert “(3) CERTIFIED COPIES.—”;
(E) in subsection (c), strike “(c)” and insert “(c) RIGHT BASED ON SUBSEQUENT FILING.—”

and

(F) in subsection (d), strike “(d)” and insert “(d) INVENTOR CERTIFICATE.—”.

(e) STREAMLINED APPLICATION REQUIREMENTS.—Strike 111 and insert:

“§111. Nonprovisional and provisional applications for patent

“(a) NONPROVISIONAL APPLICATION.—

“(1) WRITTEN APPLICATION.—An application for patent filed under this subsection shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

“(2) CONTENTS.—An application filed under this subsection shall include—

“(A) a specification that includes at least one claim, as prescribed by section 112;

“(B) if required, a drawing as prescribed by section 113; and

“(C) an identification of the inventor, as prescribed by section 115.

“(3) FEE AND IDENTIFICATION OF INVENTOR; FILING DATE.—

“(A) IN GENERAL.—The application must be accompanied by the fee required by law unless submitted within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. The identification of the inventor may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. The inventor statement required under section 115 must be submitted at or before the payment of the issue fee prescribed by section 151.

“(B) FAILURE TO SUBMIT.—Upon failure to submit the fee or the identification of the inventor within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee or identification of the inventor, as the case may be, was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Office.

“(4) NONPROVISIONAL DESIGNATION.—An application filed under this subsection may be referenced under this title as a nonprovisional application.

“(b) PROVISIONAL APPLICATION.—

“(1) AUTHORIZATION.—An application for patent filed under this subsection shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include—

“(A) a specification as prescribed by section 112(a);

“(B) if required, a drawing as prescribed by section 113 ; and

“(C) an identification of the inventor.

“(2) CLAIM.—A claim, although required under section 112(b) for an application filed under subsection (a), shall not be required in an application filed under this subsection.

“(3) FEE AND IDENTIFICATION OF INVENTOR.—

“(A) Except as provided under subparagraph (B), the application under this subsection must be accompanied by the fee required by law and an identification of the inventor.

“(B) The fee and the identification of the inventor may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

“(C) Upon failure to submit the fee or identification of inventor within such prescribed period, the application shall be treated as though it did not contain the required specification, unless it is shown to the satisfaction of the Director that the delay in submitting the fee or identification of inventor, as the case may be, was unavoidable or unintentional.

“(4) FILING DATE.—The filing date of an application filed under this subsection shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

“(5) CONVERSION TO NONPROVISIONAL APPLICATION.—Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, an application filed under this subsection may be treated as an application filed under subsection (a). Subject to section 119(e), if no such request is made, the application filed under this subsection shall be regarded as abandoned 1 year after the filing date of such application and shall not be subject to revival after such 1-year period.

“(6) TREATMENT AS A PROVISIONAL APPLICATION.—Subject to all the conditions in this subsection and section 119(e), and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as an application filed under this subsection.

“(7) NO RIGHT OF PRIORITY.—Unless converted under paragraph (5), an application filed under this subsection shall not be entitled to the right of priority of any other application under section 119 or 365(a).

“(8) OTHER APPLICABLE PROVISIONS.—The provisions of this title relating to applications for patent shall apply to applications filed under this subsection, except as otherwise provided, and except that provisional applications for patent shall not be subject to sections 115, 131, 135, and 157.”

(9) PROVISIONAL DESIGNATION.—An application filed under this subsection may be referenced under this title as a provisional application.”

(f) ADDITIONAL TECHNICAL AMENDMENTS.—

(1) In section 100(i)(1)(B), strike “or to the benefit of an earlier filing date under section 120, 121, or 365(c)” and in section 100(i)(2) strike “patent for which reissue was sought” and insert “patent as initially issued”.

(2) In section 154(a)(2), strike “or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c), from the date on which the earliest such application was filed” and in section 154(d)(1), strike “122(b)” and insert “138”.

(3) In section 184(b), strike “, or divisions thereof”.

(4) In section 366, strike “, unless a claim for benefit of a prior filing date under section 365(c) of this section was made in a national application, or an international application designating the United States, filed before the date of such withdrawal”.

(5) Strike section 365(c).

(6) In section 374, strike “122(b)” and insert “138 and a nonprovisional application filing under section 111(a)”.

(g) EFFECT AND EFFECTIVE DATE.—

(1) IN GENERAL.—The amendments under this section repealing section 120 of title 35, United States Code, shall have effect for any application for patent that is filed after 1 year from the date of enactment and the remaining amendments under this section shall have effect for any application for patent that is filed after the date of enactment of this Act.

(2) LIMITATIONS ON REQUIREMENTS FOR RESTRICTION.—For an application filed before the date of enactment of this Act, no restriction for restriction under section 121 of title 35, United States Code, may be made in the application after 6 months from the date of enactment and, notwithstanding section 121, no divisional application may be filed pursuant to a requirement for restriction under section 121 after 1 year from the date of enactment of this Act.

(3) TECHNICAL CORRECTION.—Notwithstanding paragraph (1), the amendments under subsection (d) of this Section 5 shall have effect as though enacted as amendments under Section 4 of the Leahy-Smith America Invents Act.

SEC. 2. SIMPLIFYING REISSUANCE OF ISSUED PATENTS

(a) STREAMLINED REISSUE STATUTE.—Strike section 251 and insert:

“§251. Reissue of patent.

“A patent owner may obtain a further examination of the initially issued or a previously reissued patent upon filing an application for the reissue of such patent together with the fee required by law. If an application for reissue is filed, the Director shall examine the application for reissue in the manner set forth in section 131. If it appears that the patent owner is entitled to the reissue, upon surrender of the patent being reissued, and in accordance with any amendment of the patent being reissued, a reissued patent shall be granted for the unexpired part of the term of the initially issued patent. No new matter shall be introduced into an application for reissue. No reissued patent may be construed to have enlarged the scope of the claims of the initially issued patent unless the application for reissue was filed not more than 6 years from the date on which the application for the initially issued patent was filed in the United States.”

(b) EFFECTIVE DATE AND EFFECT.—

(1) EFFECTIVE DATE.—The amendments under this Section 2 of this Act shall take effect upon enactment and shall apply to patents issued before, on, or after the date of enactment.

(2) SAVINGS CLAUSE.—Notwithstanding the amendment under this Section 2, for any patent issued before the date of enactment, if an application for reissue of the patent is filed within 2 years from issue date of the initially issued patent, such reissue application shall not be subject to the 6-year period precluding claims of a patent reissued on the application from being construed to have an enlarged scope.