



THE NAPLES ROUNDTABLE

Exploring Ways to Strengthen & Improve the Patent System

THE COMMON-SENSE SOLUTION TO THE ALLEGED ABUSES ARISING FROM “PATENT THICKETS” BASED ON SERIALY-ISSUED “CONTINUATION” PATENTS

- Repeal 35 U.S.C. §120, authorizing the filing of continuation, continuation-in-part, and divisional patent application filings, such that a single, nonprovisional application for patent can never result in the issuance of more than a single, original patent.
- Modify “restriction requirement” practices that currently necessitate the filing of divisional applications in order to secure claims to independent and distinct inventions through reforms that would permit a patent examiner to require restriction of independent claims to a single, general inventive concept, but otherwise require that all application claims must be fully examined for patentability as presented in the original, nonprovisional patent application.
- Expand the patent reissue statute to eliminate the “error” limitation on all reissue applications and, for and only for reissue applications filed within six years from the original, nonprovisional filing date, abrogate the claim recapture doctrine and permit the broadening of claims otherwise in such reissue applications, *but not in reissues sought thereafter*.

The common-sense solution could be implemented together with a revised fee structure that would impose heightened fees for patents issuing with more than three independent claims, i.e., claims that reflected additional general, inventive concepts being claimed. Such fees could be akin to—and of the same magnitude as—the separate issuance and maintenance fees that would have been incurred had divisional patents been sought.

PROS: Any potential abuses arising from “patent thickets” created through the serial filing of continuation applications for patent would be eliminated. A nonprovisional patent filing could at most produce only a single patent, whether a single original patent or a reissue thereof. The six-year prohibition on “claim recapture” doctrine and six-year limitation on broadening claims would protect the public from patent claims being continually redefined throughout the entire 20-year patent term and accelerate the point in time at which the outer “metes and bounds” of the claimed subject matter would be established with finality. At the same time, patent owners would be relieved of the need to file “copending” continuation applications for the sole purpose of keeping open any possibility of securing broader claims once a patent had issued. For products eligible for only a single patent term extensions under 35 U.S.C. §156, term extension would be available for claims that currently cannot be extended on account of existing restriction practices. Most importantly, the foregoing *file-once-examine-once-issue-once* reforms would permit a single, compact examination in the USPTO of all the claims, thereby affording the potential for greater efficiency and thoroughness in the patent examination process.

CONS: Patent owners would lose the current flexibility to continually redefine the scope of protection being sought, which today continues throughout the entire 20-year patent term. The six-year “*put-up-our-shut-up*” period might be too short to be fair for at least some inventors.