

PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken in advisement in this project.

*109. Comment:* One comment suggested that PTO follow the wording of 35 U.S.C. 121 and only require restriction where an application claims two or more independent and distinct inventions rather than two or more independent or distinct inventions.

*Response:* In making restriction requirements, the PTO has always followed the wording of 35 U.S.C. 121 to require restriction if two or more independent and distinct inventions are claimed in an application rather than independent or distinct as suggested by the comment. The term "independent" includes species and related inventions such as combination/subcombination and process and product. Restriction is proper if these independent inventions are patentably distinct (see section 802.01 of the MPEP).

*110. Comment:* One comment suggested that the standard for determining whether an application contains independent and distinct inventions should only be the "unity of invention" standard used for PCT applications.

*Response:* The suggestion has not been adopted. The current restriction practice for 35 U.S.C. 111(a) applications is governed by 35 U.S.C. 121 and §§ 1.141, 1.142 and 1.146. The PCT "unity of invention" standard only applies to PCT applications and applications filed under 35 U.S.C. 371. The PTO is currently reviewing the restriction practice in view of the implementation of the 20-year patent term. It is noted that a change in restriction practice without changes to other fees would have a negative impact on funding needed to operate the PTO.

*111. Comment:* One comment suggested that the PTO apply the PCT unity of invention standard as interpreted by the EPO and that § 1.475(b) be amended to permit a broad range of claims in a single application.

*Response:* The PTO is currently undertaking a project to reengineer the entire patent process. The suggestion will be taken under advisement in this project.

*112. Comment:* One comment suggested that the PTO examiner should not be permitted to issue a restriction requirement or an election of species requirement if the ISA and the IPEA have found that an application complies with the unity of invention requirement.

Another comment suggested that the PTO consider allowing applicants to retain all claims in a single application

when the claims are related, e.g., method and apparatus claims.

Another comment suggested that all species be searched before the first Office action regardless of whether one species is found to be unpatentable.

Another comment suggested that election of species requirements be prohibited.

*Response:* The suggestions have not been adopted. These issues were not addressed in the Notice of Proposed Rulemaking. However, the PTO is currently undertaking a project to reengineer the entire patent process. The suggestions will be taken under advisement in that project.

*113. Comment:* One comment suggested that decisions on whether to issue a restriction requirement be made within two-three months of the application filing date, and, if the requirement is traversed, the examiner should determine within four-five months of the filing date whether to maintain the requirement. Decisions on petitions to withdraw a restriction requirement should be decided within one month.

*Response:* The suggestion has not been adopted. Current practice dictates that restriction requirements be made at the earliest appropriate time in the pendency of a given application, e.g., in the first Office action. It would be difficult to issue a restriction requirement within two-three months of the application filing date as suggested since a large number of applications are filed with missing parts and applicants are given a time period to submit the missing parts. Furthermore, applications must be processed by the Application Branch and must be screened by Licensing and Review for national security. Petitions to withdraw a restriction requirement should be acted on by the Group Director expeditiously.

*114. Comment:* One comment argued that the phrases, "so as to be pending for a period of no longer than 12 months" and "under no circumstances will the provisional application be pending after 12 months", in § 1.139 were repetitious and suggested that one or both of the phrases be deleted.

*Response:* The suggestion has not been adopted. The statements are included for emphasis.

*115. Comment:* One comment suggested that § 1.139 clearly state that if the revival petition is filed later than 12 months after filing of the provisional application, then the revival is for the sole purpose of providing copendency for a 35 U.S.C. 111(a) application filed during that 12-month period.

*Response:* The suggestion has not been adopted. The proposed language is not necessary.

*116. Comment:* One comment stated that 35 U.S.C. 154(b) as contained in Public Law 103-465 does not give the Commissioner any authority to decide the period of extension. Therefore, proposed § 1.701 is without statutory basis.

*Response:* 35 U.S.C. 6(a) gives the Commissioner authority to establish regulations not inconsistent with law. Section 1.701 is consistent with 35 U.S.C. 154(b) and furthermore, the Commissioner has the authority under 35 U.S.C. 154(b)(3)(C) to establish regulations to address the standards for determining due diligence.

*117. Comment:* One comment questioned whether patent term extension under 35 U.S.C. 154(b) is available for patents issuing: (1) Before June 8, 1995, with a 17-year patent term or a 17/20 year patent term; (2) on or after June 8, 1995, on applications filed before June 8, 1995, with a 17-year patent term or a 17/20 year patent term.

*Response:* None of the patents set forth in the examples are eligible for patent term extension. Under the terms of the statute, patent term extension is only available for patents issued on applications filed on or after June 8, 1995.

*118. Comment:* Several comments questioned whether a patent issued on a continuing application is entitled to a patent term extension under 35 U.S.C. 154(b) due to interference, secrecy order, or appellate review delays occurring in the examination of the parent application.

*Response:* If the delay in the parent application contributed to a delay in the issuance of a patent in the continuing application, the patent granted on the continuing application may be eligible for an extension under 35 U.S.C. 154(b).

*119. Comment:* One comment suggested that the patent term be extended for a period of time equal to the time necessary to revive an application improperly abandoned due to PTO error. Another comment suggested that patent time extension be available for other PTO delays.

*Response:* The suggestions have not been adopted. Section 154(b) of title 35, United States Code, only permits patent term extension for delays due to interferences, secrecy orders, and/or successful appeals.

*120. Comment:* One comment suggested that the period of an extension granted under § 1.701 be printed on the face of the patent.

*Response:* The PTO will publish on the face of the patent any patent term