Metamorphosis in the United States Patent and Trademark Office
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I. Introduction

Patent prosecution may be perceived as an arcane adventure through the well-defined labyrinths of the Patent Statutes[2] according to the rules and regulations promulgated by Congress[3] and by the United States Patent and Trademark Office ("PTO")[4]. This, of course, is generally true: the mission of the patent attorney is to seek patent protection in the PTO for an inventive concept by advocating its merits and concomitant significance in the marketplace, and to be granted claims on behalf of a patentee commensurate with the patentee's disclosure, properly limited by the prior art. But, patent prosecution practice is not always characterized by routine movement along a straight line defined by Office Actions and responses thereto, with the goal of ultimately achieving the Patent Grant.

Occasionally, a challenge arises during prosecution which presents an opportunity for the adventurous patent attorney to explore beyond the regions defined by the intersection of these rules and regulations. Such challenges may arise under circumstances in which the rules and regulations are not well defined, on the one hand, or may arise under circumstances not contemplated by these rules and regulations, on the other hand. Two unusual patent prosecution scenarios will be described which involve either liberal construction or morphing[5] of these rules and regulations to essentially metamorphose[6] pending

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[1]Harrison & Egbert, Houston, Texas.

[2]35 U.S.C. § 100 et seq.

[3]37 C.F.R. § 101 et seq.

[4]Manual of Patent Examining Procedure ("MPEP").

[5]Morphing is a contemporary term which generally refers to changing the fundamental configuration, attributes and characteristics of an image using special "morphing" computer software.

patent applications into applications congruous with particular commercial objectives.

As an example, morphing the image of a face, i.e., contorting its shape and normal color distribution, might attempt to capture a patent attorney's expectable reaction to an examiner's strong objections under 35 U.S.C. § 112 and comparable rejections under 35 U.S.C. § 103, to a pending patent application.

[6]Metamorphosis is a term perhaps dramatized and popularized by Franz Kafka's classic novelette entitled "The Metamorphosis" in which an insurance agent is metamorphosed into an insect, who, in this anomalous form, is wholly rejected by his family. Ergo, for the purposes of this paper, metamorphosis is considered to be a change in form more significant than connoted by the more mellow words "conversion" and "transformation." A typical definition of convert is to change something into another form, substance, state or product; or to change something from one use, function or purpose to another; or to adapt to a new or different purpose. The American Heritage Dictionary of the English Language, Third Edition (1992), cited in Microsoft Bookshelf 1995. Similarly, a typical definition of transform is to change markedly the appearance or form of something; or to change the nature, function or condition of something. Id. (Emphasis supplied). By contrast, a corresponding definition of metamorphose is to change something into a wholly different form or appearance. Id. Accordingly, while transforming something arguably produces more change than converting the same thing, clearly an even greater change is produced when that thing is metamorphosed into something else.

II. Metamorphosing An Elected Group of Claims

First, consider the scenario in which a patent attorney has been requested to make an election[7] in response to a requirement for restriction.[8] Such a requirement for restriction imposes upon the patent attorney the task of electing with which examiner-established set or group of claims to proceed in the current application, either with or without traverse.[9] The PTO is authorized to limit the claims in a pending patent application to particular subject matter under circumstances wherein the claimed inventions are sufficiently distinct to justify co-examination, thereby avoiding unnecessary examiner effort and expense.[10] This narrowing of the scope of a patent application to one invention presumably promotes efficient PTO administration and collection of filing fees and the like commensurate with the breadth of subject matter

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[7]An election is a designation by a patent attorney of which group of claims will be prosecuted in a pending patent application. See MPEP § 818.

[8]The patent attorney typically is notified of a requirement for restriction by a telephone call from the examiner who recites the grouping of claims from which an election must be made. See MPEP § 812.01. The attorney's response(s) should conform to 37 C.F.R. §§ 1.142-1.145.

[9]If the patent attorney disagrees with the requirement for restriction, then a provisional election with traverse is made. Then a request for reconsideration and withdrawal or modification of the requirement is made. See 37 C.F.R. § 1.143; MPEP § 818.03.

[10]35 C.F.R. § 121.

> § 121. Divisional applications.
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> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a referenced either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

included in an application.

The PTO's restriction practice is a practical concern because of the apportionment of specific technologies among its various art units. Each patent examiner in an art unit is assigned pending applications in the unit on the basis of the class and subclass suggested by the subject matter disclosed therein.[11] That is, each pending application is assigned to one examiner in one art unit; there is no provision for shared responsibility among examiners across art units. Indeed, the multiple docketing and control that such cross-examination would demand obviously would increase the work and expense prerequisite for prosecuting pending applications. Thus, restriction practice permits the prosecution of one group of claims with subject matter belonging to a particular class and subclass, and holds all other claims in the application in abeyance.[12]

Other bases for requiring restriction of the claims in a pending application include the nature of the claims in the original application precluding a single search of the prior art, because different art is relevant to different groups of claims. Under these circumstances, restriction practice promotes the orderly distribution of workload assigned to examiners in art units throughout the PTO. Such an orderly distribution of work presumably assures that examiners throughout the PTO receive approximately the same volume of work. From the patent attorney's vantage point, in turn, this uniform examiner work assignment arrangement theoretically promotes predictability of the elapsed time between filing and allowability and issuance, helping clients plan for commercialization and the like.

Once contacted by a examiner regarding a requirement for restriction, the patent attorney usually discusses the situation with the client and then preferably advises the examiner by telephone which group of claims are elected.[13] This, of course, expedites the prosecution process. If such an election is not made by telephone within a reasonable period of time, the examiner issues an official restriction letter.[14] If a response thereto is not timely made, the application becomes abandoned.[15] Assuming that an election has been made according to the rules and regulations in the PTO, what if applicant has a change of mind and requests that patent counsel elect another group of claims?[16]

Making a "re-election" of a group of claims is against the general policy of the PTO not to permit

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[11]For an enumeration of the classes and subclasses allocated among the art units in the PTO refer to Manual of Classification § III (Rev. 3 - June 1994).

[12]37 C.F.R. § 1.142(b).

[13]MPEP § 812.01.

[14]Id.

[15]37 C.F.R. §§ 1.134-1.136.

[16]While claims group I normally is elected because it contains the broadest claim, i.e., claim 1, occasionally an applicant may prefer to initially proceed with apparatus claims, or with method claims, etc., notwithstanding having earlier advised patent counsel to the contrary.

an applicant to "shift" to claiming another invention after an election is already made and an action issued on the elected subject matter.[17] Notwithstanding an applicant not being entitled to make such a shift as a matter of right, the PTO may permit an applicant to metamorphose the elected claims a shift under circumstances in which shifting from one claimed invention to another results in no additional work or expense, and, indeed, preferably, reduces an examiner's work.[18] For example, in general, where such a shift simplifies nonobviousness issues and places the newly elected claims[19] into a condition of allowance, a waiver of an applicant's initial election and shift of the elected group of claims is apt to be granted. To receive permission for this waiver-and-shift maneuver, patent counsel must clearly demonstrate that the re-elected (amended) claims overcome all of the examiner's rejections of the previous elected group of claims. Thus, it should be convincingly shown that, based upon the prior art searched by the examiner and the prior art known to applicant, the amended re-elected claims reduce the examiner's work and expense by simplifying the issues and the like. Absent such a showing of reducing the examiner's work, a showing of causing no significant additional work and expense to the examiner may be sufficient, but has a narrower window of having the waiver-and-shift maneuver being permitted.

III. Metamorphosing A PCT Application Into A U.S. Patent Application

A second challenging scenario in the PTO relates to metamorphosing a PCT[20] application filed in the PTO[21], claiming priority based upon a foreign patent application, into a U.S. patent application also claiming such priority. Attorneys practicing patent law in the United States may serve as local patent counsel for foreign associates who are responsible for prosecuting patent applications throughout the

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[17]MPEP § 819.

[18]MPEP § 819.01.

[19]The newly elected claims are frequently amended in view of the examiner's rejections — typically on the basis of 35 U.S.C. §§ 103 and 112.

[20]PCT is an abbreviation for the Patent Cooperation Treaty which constitutes an international agreement among member nations for the purpose of unifying and simplifying the prosecution of patent applications in the several member countries, based upon an earlier application originally filed by an applicant as a resident or national of a particular member country. A PCT application defers the costs associated with prosecuting applications in the individual member countries, e.g., translation fees, foreign associate and government fees, from 18 months to 30 months, thereby allowing applicant additional time to decide whether such legal expenses are justified. PCT Article 39. For the full text of the PCT, see MPEP App. T.

[21]The PCT application is filed in the PTO on the assumption that the PTO is a proper Receiving Office.

world.[22] Frequently, such foreign associates forward instructions to U.S. counsel, just prior to filing deadlines. Under such exigent circumstances, local counsel must act quickly to prepare suitable documents and file them along with supporting materials in the PTO usually via Express Mail.[23]

When such a U.S. filing is made under the PCT, the PTO must be a proper Receiving Office for the filing to be effective.[24] If, subsequent to making a filing in the PTO, patent counsel receives notice of a defect in an international application, then prompt action must be taken to correct the defect.[25] If the defect cannot be corrected under the PCT rules and regulations as construed by the PTO, then patent counsel must seek conversion of the PCT application into a U.S. application to preserve the right to obtain patent protection based upon an earlier filed application.

An example of such a uncorrectable defect under the PCT is the filing of an international application in the U.S. which lacks residency and nationality prerequisites for being filed with the U.S. Receiving Office.[26] According to these requirements, the application papers must show applicant having a nationality

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[22]Such activity is expected to significantly increase because of the momentum effectuated by the North American Free Trade Agreement (NAFTA) and the General Agreement on Tariffs and Trade (GATT).

[23]See 37 C.F.R. § 1.10 (c).

[24]The Receiving Office is the Patent Office of the member country of which an applicant or one or an applicant's representative is a resident or a national. See PCT Rule 19.

[25]Notice of defects is styled "Invitation to Correct the Purported International Application" under PCT Article 11(2)(a) and Rule 20.6.

[26]PCT Article 11 in pertinent part states:

> Filing Date and Effects of the International Application
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> (1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that that Office has found that, at the time of receipt:
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> (I) the application does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,....
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> .
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> (2)(a) If the receiving Office finds that the international application did not, at the time of receipt, fulfill the requirements listed in paragraph (1), it shall, as provided in the Regulations, invite the applicant to file the required correction.
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> (b) If the applicant complies with the invitation, as provided

or residence in the U.S.; otherwise, the PTO is an improper Receiving Office. While such a defect under the PCT could ordinarily be corrected,[27] the PTO has elected not to observe this fail-safe procedure that functions as an applicant rescue operation.[28] The PTO believes that Administrative Instruction 329 is inconsistent not only with the filing requirements of Article 11, but also with more than thirteen years experience of PCT practice in the U.S.; furthermore, it is believed that Administrative Instruction 329 is inconsistent with Article 11 and Rule 20.4(a) which require a prompt determination of whether or not the applicant lacks the right to file an international application— on the basis of either residency or nationality.[29] Thus, unless the PCT application shows evidence of U.S. residency or nationality, including visa status and the like, on its face, for any of applicants or a representative thereof, then an Article 11(1) defect is incurable.

To satisfy this strict requirement, an applicant merely needs to designate an agent who has the right to represent applicant in the PTO; ergo, local patent counsel, if designated on the face of the PCT application, may function as applicant's representative in addition to being applicant's patent counsel. But again, absent any showing of colorable residency or nationality in the U.S., the PTO will not function as a competent receiving office.[30] If there is still time to refile an international application without loss of priority

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> in the Regulations, the receiving Office shall accord as the international filing date the date of receipt of the required correction.
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See also PCT Rules 18 (The Applicant) and 19 (The Competent Receiving Office).

[27]PCT Administrative Instruction 329 allows an applicant to correct an Article 11(1) defect.

> Where, in response to an invitation to correct a defect under Article 11(1)(I), evidence is submitted indicating to the satisfaction of the receiving Office that, in fact, the applicant had, on the date on which the international application was actually received, the right to file an international application with that receiving Office, the invitation shall be considered to be an invitation to correct a defect under Article 14(1)(a)(ii) and Rule 4.5 in the prescribed indications concerning the applicant's residence and/or nationality, and the applicant may correct those indications accordingly. If such correction is made, no defect shall be considered to exist under Article 11(1)(I).

[28] PCT Administrative Instruction 329 is not followed because the PTO believes that it is incongruous with PCT Article 11. See 58 Fed. Reg. 4335 (1993) and 1147 Off. Gaz. Pat. Off. (Feb. 9, 1993).

[29]58 Fed. Reg. at 4337, Comment 1.

[30]PCT Rule 19.1(a).

rights[31], then patent counsel should act accordingly. It should be appreciated that even if the PTO honored Administrative Instruction 329, the filing date in the PTO as a Receiving Office would be the date that the filing defect was corrected, not the date of the original filing therein.[32] If, however, refiling in the PTO would cause applicant to lose priority rights, then patent counsel should file a petition in the PTO requesting that the instant PCT application be metamorphosed into a U.S. patent application with the same filing date as the earlier filed PCT application. Since the PTO regulations do not expressly contemplate such a transformation, a petition should be filed under the catch-all provision styled "Questions Not Specifically Provided For."[33] Provided that the PCT application (designating the U.S. as the Receiving Office) included all of the necessary items required for the filing of a U.S. patent application[34] and in the interest of justice, the PTO is likely to grant the petition, thereby converting the PCT application into a domestic application with the requested filing date, thereby preserving the priority date of the earlier filed foreign application.[35]

IV. Conclusion

While the strictures of the PTO may occasionally present seemingly insurmountable barriers to applicants' objectives, the imaginative patent attorney can nonetheless perform a novel kind of metamorphosis to place a patent application into a form amenable to the intended prosecution. The spirit manifest in the PTO's rules and regulations may be used as a device for overcoming obstacles manifest by the rules and regulations, per se.

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[31]See 35 U.S.C. § 119.

[32]PCT Rule 11(2)(b).

[33]37 C.F.R. § 1.182.

[34]See 37 C.F.R. § 1.53(b).

[35]See 35 U.S.C. § 111.