

February 28, 2023

The Honorable Katherine K. Vidal  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
600 Dulany Street, Alexandria, VA 22314

**Re: Comments in Response to “*Request for Comments on USPTO Initiatives To Ensure the Robustness and Reliability of Patent Rights*” (87 FR 60130)**

Dear Under Secretary Vidal:

As inventor-stakeholders and small business owners, we are grateful for the opportunity to provide comments pursuant to the *Request for Comments on USPTO Initiatives To Ensure the Robustness and Reliability of Patent Rights*, 87 FR 60130. The commentary below is our own and does not reflect the views of any entity with which we have or have had a professional relationship.

Additionally, these comments are informed in part by our involvement with the Study of Underrepresented Classes Chasing Engineering and Science Success Act of 2018 (“SUCCESS Act”), *Pub. L. No. 115-273, 132 Stat. 4158 (2018)* and reflect our views on the origin and purpose of the various legislative provisions that Congress enacted into law through the Leahy-Smith America Invents Act (“AIA”), *Pub. L. No. 112-29, 125 Stat. 284 (2011)*.

Prior to getting into specific issues, we applaud you, Under Secretary Vidal, for listening to stakeholders, especially the voice of independent inventors and small businesses, as these voices are critical to the economy and American innovation. Now that we have passed a decade into the enactment of the AIA with many inventors and small businesses feeling its unintended consequences, it is vital to recall that Congress, when implementing changes to the patent system with the AIA, instructed that “the changes made [] are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost-effective alternatives to litigation.” H.R. Rep. No. 112-98, at 48 (2011). We are pleased to see the Director and the Office seek comments in their ongoing effort to ensure the robustness and reliability of patent rights, and we hope that the Office prioritizes the desires of the true source of American innovation—the Inventor—when seeking and investigating any changes that might affect her rights.

**The Voice of the Inventor and the Desire to be Heard**

We encourage the Office to remember that the inventor is the source of innovation, and, for each comment received pursuant to this *Request for Comments*, to consider whether the comment is being

provided by an inventor or is being provided by an entity preaching what amounts to Orwellian “doublespeak”<sup>1</sup>. Respecting the voice of the inventor is paramount, as John M. Whealan, Intellectual Property Advisory Board Associate Dean for Intellectual Property Law Studies at George Washington Law School, reminds us of the unexpected consequences of the AIA<sup>2</sup>: “A critical voice seems to have been missing from the discussion: that of patent owners—the innovators who invested thousands of dollars and months of effort in obtaining patents from the USPTO only to be later told by the same USPTO that their patents are worthless.” Whealan strongly recommended that the government consider the patentee’s perspective, emphasizing that “without the innovators, the inventors, and the patentees, none of us would be doing what we are today.” Thus, the voice of the inventor in this *Request for Comments* should be of utmost importance.

### **A SUCCESS Opportunity for the Underrepresented**

In May 2019, our family traveled to Alexandria, VA to assist the USPTO by providing commentary in the first of three SUCCESS Act hearings regarding the participation of women, minorities, and veterans in the patent system and entrepreneurial activities. *See 84 FR 17809*. We are Patricia Duran—minority female, naturalized U.S. citizen, and aspiring inventor—and Jeff Hardin—patented *pro se* inventor and small business owner. We provided both oral testimony<sup>3</sup> and written testimony<sup>4</sup>, and our concerns remain true: the ability to utilize, enforce, and defend a patent is *the critical factor* when deciding whether to pursue a patent in the first place. Unbeknownst to us at the time we spoke, we did not realize the unison of voice among those who testified. By inspecting the comments provided during this study<sup>5</sup>, an overwhelming 79% of the individual comments received by the USPTO expressed concerns that the following are obstacles to participating in the patent system: difficulty with enforcing patents, risk of PTAB invalidations, and efficient infringement.

At the core of these concerns lies the reliability of the patent right, as we presented the most pressing question facing today’s inventors when deciding whether to seek to U.S. patent:

*“What good is a patent if one cannot defend it?”*

Our written testimony included legislative recommendations for the USPTO to provide to Congress pursuant to the SUCCESS Act to increase the number of patents applied for and obtained by underrepresented inventors. Throughout our testimony, we emphasized that, to achieve success with underrepresented inventors, both dimensions – the first prong (i.e., the initial pursuit of a patent) and the second prong (i.e., the ability to use, enforce, and defend a patent once received) – must work in tandem.

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<sup>1</sup> <https://www.ipwatchdog.com/2018/10/19/iancu-risk-takers-patent-troll-narrative-orwellian-doublespeak/id=102474/>

<sup>2</sup> *The Patent Trial and Appeal Board and the Appointments Clause: Implications of Recent Court Decisions*, House Subcommittee on Courts, Intellectual Property, and the Internet, <https://docs.house.gov/meetings/JU/JU03/20191119/110260/HHRG-116-JU03-Wstate-WhealanJ-20191119.pdf>

<sup>3</sup> <https://www.youtube.com/watch?v=2ff7d9i0Km4>

<sup>4</sup> <https://www.uspto.gov/sites/default/files/documents/SUCCESSAct-Hardin-Duran.pdf>

<sup>5</sup> <https://uspto.gov/successact>

***Moreover, if patents ultimately cannot be defended by underrepresented inventors, then seeking patents becomes moot.***<sup>6</sup>

With this backdrop, if the Office has an opportunity improve upon this second prong of the patent process, it should do exactly that. Regaining trust and confidence from the inventor community and underrepresented inventors is what we desire. Additionally, this would satisfy the sense of Congress that “the patent system should promote industries to continue to develop new technologies that spur growth and create jobs across the country *which includes protecting the rights of small businesses and inventors from predatory behavior* that could result in the cutting off of innovation.” (emphasis added) *See Sec. 30. Sense of Congress, Pub. L. No. 112-29, 125 Stat. 284 (2011).*

### **Specific Questions in the Request for Comments**

1. *Identify any specific sources of prior art not 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)?*

No comment.

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

No.

b. *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?*

No.

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<sup>6</sup> <https://ipwatchdog.com/2021/11/04/raimondo-takes-helm-council-inclusive-innovation-inventors-unresolved-ask/id=139535/>

- c. *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)?*

No.

- 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?”*

No.

- 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?*

No.

- f. *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)?*

No.

Each of these suggestions would transfer Examiner responsibility to the applicant / inventor, thus increasing the burden and costs on small businesses and independent inventors while favoring more financially-enabled entities. These suggestions, if implemented, would thus go against the intent of the AIA to help small businesses and inventors. Furthermore, they would lead to poor patent quality because the Examiner would be more inclined to not read and understand the invention as a whole with the applicant carrying much of this burden.

It is the Examiner’s, not the Applicant’s, responsibility to ensure a patent application satisfies the law and is worthy of patent protection.

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?*

The RCE practice should not be changed as suggested. Changing examiners mid-course will only cause the new examiner to start from the beginning, which will cause more delay on the examination process, preventing the invention from achieving timely patent protection, and such delay would not foster innovation; rather, it would thwart it.

4. *How, if at all, should the USPTO limit or change restriction, divisional, rejoinder, and/or non-statutory double patenting practice to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents? Specifically, should the USPTO:*
  - 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?*
  - 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?*
  - h. *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? See 37 CFR 1.78(f)?*

Any changes that limit an Applicant's ability to file a divisional application at any time during pendency of a patent family should be discouraged. Currently, an Examiner can easily issue an unwarranted restriction requirement to an Applicant as a way to minimize the Examiner's workload. This limits the Applicant's right to a patent and introduces unnecessary delay. Rather than change the restriction practice by limiting Applicant's right to a patent, a better approach would be to include supervisory review of all restriction requirements prior to being sent to applicants. This would stop unnecessary restriction requirements that would help solve some of the issues here, and once that is in place, the USPTO can revisit this topic.

5. *Please provide any other input on any of the proposals listed under initiatives 2(a)-2(i) of the USPTO Letter, or any other suggestions to achieve the aims of fostering innovation, competition, and access to information through robust and reliable patents.*

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*The USPTO also invites public input on the following questions, which are presented verbatim (except for minor changes to internal citation format) as they appeared in the June 8 letter from Members of Congress. Any comments relating to fee setting will be taken into consideration when the USPTO takes up fee setting more broadly.*

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.*

Eliminating terminal disclaimers would have a negative effect on allowing applicants to receive patent protection as quickly as claims are found allowable. Many times an applicant may not agree with a double patenting determination by the Examiner, but in order to expedite prosecution, the applicant will file a terminal disclaimer to receive patent protection as quickly as possible, and will pursue "more desirable" claims in a continuation. There are various strategies applicants use to achieve protection over their inventions, and properly applied terminal disclaimers allow a patent owner to improve claims as needed to achieve a more robust and reliable patent.

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.*

No. A filing of a terminal disclaimer should not be an admission of obviousness. As explained in the previous question, many times an applicant may not agree with a double patenting determination by the Examiner, but in order to expedite prosecution, the applicant will file a terminal disclaimer to receive patent protection as quickly as possible, and will pursue “more desirable” claims in a continuation. It thus goes without saying, these patents should not stand and fall together.

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?*

No. A second look by a team of patent quality specialists should not be required before issuing a continuation patent on a first office action.

There are probably more examples, but here is one. Inventors desire to receive a patent quickly, as this helps raise funding from many investors who first need to see issued patents prior to investing in an invention. So the best patent strategy for startup companies is often to get a patent issued quickly. One strategy for applicants then is to initially seek a patent with relatively narrow claims, and then seek broader claims in a continuation application. Such a broader continuation would cover the same invention from the narrower claims.

In sum, patent owners need the ability to adopt claims using better language in their continuations.

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

No. There should not be a “heightened examination requirement” for continuation patents. Rather, *all patent applications*, continuations or otherwise, should receive the best, highest quality examination. Furthermore, there should be no discrimination against “minor modifications”, as they are at the prerogative of the applicant and her strategy, and that minor modification might be a major modification in the eyes of the applicant.

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)?*

There is no “appropriate timeframe”, as the applicant will never "know" what all types of inventions the patent will actually cover—as an invention can have multiple applications in various fields, many of them unexpected until implemented. As such, there should not be any deadlines to file a continuation other than what has already been established with today's continuation practice.

11. *The USPTO has fee-setting authority and has set [fees] for filing, search, and examination of applications below the actual costs of carrying out these activities, while maintenance fees for issued patents are above the actual cost. If the up-front fees reflected the actual cost of obtaining a patent, would this increase patent quality by discouraging filing of patents unlikely to succeed? Similarly, if fees for continuation applications were increased above the initial filing fees, would examination be more thorough and would applicants be less likely to use continuations to cover, for example, inventions that are obvious variations of each other?*

This question is predicated on the false premise that continuations are obvious variations of each other. Not so. Initial filing fees for original applications and for continuation applications should remain the same.

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The questions contained in this *Request for Comments* seem to suggest that allowance of continuation patents go against the initiative to ensure robustness and reliability of patent rights. Not so. Continuation patents help the patent office issue higher quality patents, as continuation applications allow applicants to seek new claims while providing newly discovered prior art to the Office, resulting in a much more robust and reliable patent. Consider a patent that is being litigated. The opposition will spend hundreds of thousands of dollars researching prior art and arguments in its desire and vested interest to invalidate the patent. A patent applicant can then provide that to the USPTO in a continuation, and any patent that issues as a result would very much likely be much more robust and reliable than its parents in the priority chain, considering the effort and resources put up by the opposition to invalidate it.



**Conclusion**

Thank you for your consideration, and I thank you for remembering the voice of the Inventor and the exclusive Right that is to be secured to her for her Discoveries.

Respectfully submitted,

Handwritten signature of Jeff Hardin in blue ink, with a horizontal line underlining the name.

Jeff Hardin  
*ProSe* Inventor  
Consultant on IP Strategy and Policy  
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Handwritten signature of Patricia Duran in blue ink.

Patricia Duran