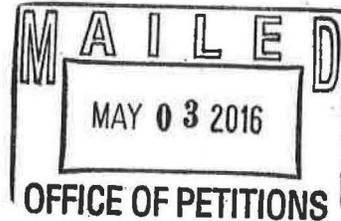




Cleveland Medical Devices Inc.
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Cleveland OH 44103



In re Application of
Craig A. FREDERICK et al.
Application No.: 11/729,524
Filed: March 29, 2007
Attorney Docket No.: CMD-050

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DECISION ON PETITION

This is a decision on the petition filed July 24, 2012, which is being treated as a petition under 37 CFR 1.181(a)(3) requesting the Director to exercise her supervisory authority and overturn the decision of May 25, 2012, of the Director of Technology Center 3700 (Technology Center Director), which decision refused to withdraw the restriction requirement in the Technology Center Director's decision of April 25, 2012.

The petition to overturn the Technology Center Director's decision of May 25, 2012 and withdraw the restriction requirement in the Technology Center Director's decision of April 25, 2012 is **DENIED**.

BACKGROUND

1. The instant application was filed on March 29, 2007, as a continuation-in-part of U.S. patent application 11/454,482. The application included claims 1 – 20.
2. An Office action was mailed on September 26, 2011, requiring a restriction between two groups I (invention encompassing claims 1 – 7 and 14 - 20) and II (invention encompassing claims 8 - 13) that were identified as unrelated inventions.
3. On April 25 2011, a response was filed that included a provisional election of Group I, with traverse.
4. On December 11 2011, a non-final Office action was mailed: (a) noting that arguments traversing the restriction were unpersuasive, the restriction requirement was made final, and (b) setting forth the rejection on the merits of claims 1 – 7 and 14 - 20 drawn to the group elected with traverse.

5. On February 9, 2012, applicant filed a petition under 37 CFR 1.144 requesting a review of the finality of the restriction requirement.
6. On March 12, 2012, the Technology Center Director mailed a decision dismissing the petitioner's request for the withdrawal of the restriction requirement. In the decision by the Technology Center Director, the original restriction requirement of September 26, 2011 under MPEP § 806.06 was withdrawn and replaced with the restriction under MPEP § 806.05(e) for reasons set forth therein.
7. On April 25, 2012, applicant filed a request for reconsideration of the Technology Center Director's decision mailed March 12, 2012.
8. On May 25, 2012, the Technology Center director mailed a decision dismissing the request for reconsideration.
9. The instant petition was filed July 24, 2012, requesting the Technology Center Director's decision of May 25, 2012 to be reviewed and reversed.
10. A Notice of Appeal was filed September 18, 2012, followed by an Appeal Brief on November 14, 2012. Claims 1-7 and 14-20 were the subject of this Appeal to the Patent and Trials Appeal Board (Board). In a reply brief filed March 18, 2013, claims 7 and 18 were withdrawn from the appeal, with claims 1-6, 14-17, and 19-20 remaining the subject of the appeal.
11. In a decision mailed February 18, 2016, the Board affirmed the examiner's rejection on the merits of all the appealed claims.
12. On April 27, 2016, the examiner mailed a Notice of Abandonment stating that the period for seeking court review of the Board's decision has expired and there are no allowed claims in the application.

STATUTE AND REGULATION

35 U.S.C. § 121 provides that:

If two or more independent and distinct inventions are claimed in one application, the Director 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 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 reference 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. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

37 CFR 1.141 provides that:

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.

37 CFR § 1.142 provides that:

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

OPINION

Petitioner specifically requests that the Director overturn the Technology Center Director's decision of May 25, 2012 and that "the Director withdraw this restriction requirement and allow the Applicants to proceed in prosecuting the full set of 20 claims originally submitted with the Applicants' specification."

The Director of the USPTO, pursuant to 37 CFR 1.181(g), may delegate the determination of petitions. The review of a petition seeking to invoke the supervisory authority of the Director of

the USPTO in reviewing a decision of a Group Director has been delegated to the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP § 1002.02(b).

Petitioner's request to withdraw the restriction requirement:

The instant application was filed March 29, 2007 with claims 1 – 20. In the Office action mailed on September 26, 2011, examiner required a restriction between two groups: Group I (invention drawn to a method of sleep disorder diagnosis, encompassing claims 1 – 7 and 14 - 20) and Group II (invention drawn to a wireless EEG Data Acquisition System, encompassing claims 8 - 13) that were identified as unrelated inventions. In the reply mailed October 25, 2011, applicant elected, with traverse, invention of Group I, encompassing claims 1 – 7 and 14 - 20. In the Office action mailed December 21, 2011, the previously set forth restriction was made final with the elected claims rejected on the merits and claims 8 - 13 remaining withdrawn. In an initial petition filed February 9, 2012, petitioner sought a review of the restriction requirement. The Technology Center director issued a decision mailed March 12, 2012, wherein, the original restriction requirement of September 26, 2011 under MPEP § 806.06 was withdrawn and replaced with the restriction under MPEP § 806.05(e) on the basis that the inventions I and II are related as process and apparatus for its practice.

MPEP § 806.05(e) specifically provides, in part, that:

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another materially different process.

The burden is on the examiner to provide reasonable examples that recite material differences.

If applicant proves or provides convincing argument that there is no material difference or that a process cannot be performed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement.

A renewed petition seeking reconsideration of the Technology Center Director's decision that was filed April 25, 2012 was again dismissed by the Technology Center Director in a decision mailed May 25, 2012. The instant petition was filed July 24, 2012, requesting the Technology Center Director's decision of May 25, 2012 be reviewed and reversed.

Petitioner states that "the Applicants believe the Director's decision to continue to maintain the restriction is based on erroneous reasoning and also disagree with the Director's handling of the

Applicant's request for an agency-wide change in restriction practice." Referring to both 35 USC 121 and 37 CFR 1.141, petitioner states that applicants require that "Examiner as well as the Director meet the statutory and regulatory standard of showing how and why claimed inventions are 'independent and distinct' one from another." Petitioner contends that "that the Director in his most recent decision on renewed petition has demonstrated neither independence and distinctness of the claimed inventions nor serious burden on the Examiner if the restriction is not required." Petitioner's arguments have been fully considered, but are not deemed persuasive for the following reasons:

Petitioner's contention that independence and distinctness is not properly established:

Petitioner contends that the implementation of the "independent or distinct" standard of 35 U.S.C. §121 by the United States Patent and Trademark Office (USPTO) in its restriction practice places "the Agency's actions squarely in conflict with the governing law." Petitioner's contentions are addressed in MPEP § 802.01, which sets out the USPTO's long-standing interpretation of the "independent and distinct" standard of 35 U.S.C. § 121.

MPEP § 802.01 specifically provides that:

35 U.S.C. 121 quoted in the preceding section states that the Director may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the inventions as between which the Director may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent, or unrelated. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the inventions between which the Director may properly require division.

The term "independent" as already pointed out, means not dependent, or unrelated. A large number of inventions between which, prior to the 1952 Act, division had been proper, are dependent inventions, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the

Director never to approve division between dependent inventions, the word “independent” would clearly have been used alone. If the Director has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term “distinct” with the term “independent”, indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, “distinct” inventions, even though dependent.

The Technology Center Director’s decision is consistent with the USPTO’s long-standing implementation of the “independent and distinct” standard as set forth in MPEP § 802.01.

Petitioner’s contention that serious burden not properly established:

Pursuant to MPEP § 803, “a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.”

MPEP § 803 specifically provides, in part, that:

For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That prima facie showing may be rebutted by appropriate showings or evidence by the applicant.

In the decision mailed March 12 2012, the Technology Center Director provided an explanation as to why the method and apparatus as restricted herein require diverse searches. In the decision on the renewed petition, mailed May 25 2012, the Technology Center Director reiterated the existence of a serious burden on the examiner based on the diverse searches identified in the decision mailed March 12, 2012. Thus, determination of a serious burden on the examiner by the Technology Center Director is in accordance with the guidelines set forth in MPEP § 808.02.

MPEP § 808 specifically provides that:

Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why each invention as claimed is either independent or distinct from the other(s); and (B) the reasons why there would be a serious burden on the examiner if restriction is not required, i.e., the reasons for insisting upon restriction therebetween as set forth in the following sections.

MPEP § 808.02 specifically provides, in part, that:

Where the inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Thus, under MPEP § 808.02, in order to show “serious burden” the examiner must show by appropriate explanation one of the following: that the restricted inventions (1) have separate classifications, (2) have separate status in the art, or (3) require different fields of search.

Petitioner’s contention that the “current practice of the USPTO in implementing an ‘independent or distinct’ standard in restriction practice stands in clear conflict with both the governing law and governing regulations” has been noted. However, the Office’s restriction practice is not in conflict with the applicable laws and rules of practice. It is based on the construction of the expression “independent and distinct” inventions as set forth in detail in MPEP § 802.01.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of May 25, 2012. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion. The Technology Center Director’s decision to refuse petitioners’ request to withdraw the finality of the restriction requirement in the petition decision of May 25, 2012 is not shown to be in error.

The petition is granted to the extent that the decisions of the Technology Center Director have been reviewed, but is **DENIED** with respect to overturning the Technology Center Director's decision of May 25, 2012 and withdrawing the restriction requirement in the Technology Center Director's decision of April 25, 2012. This decision constitutes a final decision on this petition.

On February 18, 2016, the Board entered a final decision on the appealed claims. The period under 37 CFR 90.3 for seeking court review of the decision by the Board has expired and no further action has been taken by appellant. As there are no allowed claims in the application, proceedings on the application are considered terminated and the application currently stands abandoned. See 37 CFR 1.197 and MPEP § 1214.06; see also 37 CFR 1.181(f) (filing a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings).

Petitioner should note that further proceedings with regards to the instant application can only be initiated after the application has been revived.



Robert W. Bahr,
Deputy Commissioner
for Patent Examination Policy/
Petitions Officer