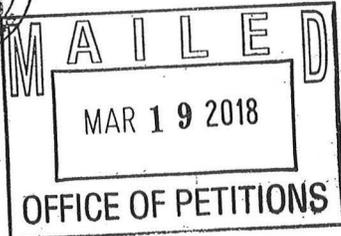




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In re Application of: George C. Rutt et al. :
Appl. No.: 14/809,051 :
Filed: July 24, 2015 :
Attorney's Docket No.: SGI1820-1 : **DECISION ON PETITION**
Title: PROTEIN RICH FOOD :
INGREDIENT FROM BIOMASS AND :
METHODS OF PREPARATION :

This is a decision on the petition under 37 CFR 1.181, filed January 16, 2018, requesting that the Director exercise supervisory authority and review the decision of November 15, 2017, by the Director of Technology Center 1700 (Technology Center Director), which decision upheld the restriction requirement made final in the Office action issued on May 31, 2017.

The petition to withdraw the restriction requirement made final in the May 31, 2017 Office action is **DENIED**.

BACKGROUND

The above-identified application was filed on July 24, 2015 with claims 1 through 26.

An Office action was issued on March 14, 2017. The Office action of March 14, 2017 included a restriction requirement that required the petitioner to elect one of three groups: (1) claims 1 through 13 and 19 through 22, drawn to a method of producing a protein from biomass; (2) claims 14 through 18, drawn to a method of making a food product; and (3) claims 23 through 28, drawn to a protein food ingredient, classified in C07K 14/405¹. The Office action of March 14, 2017 also included a requirement for an election of one of the following species: (A) cereals such as breakfast cereals; (B) a snack or nutritional bar; (C) a soup or stew; (D) a binder for bulk artificial meats; (E) artificial cheese; and (F) animal feed.

¹ It was clarified in an interview summary issued on March 29, 2017 that a typographical error was made in the March 14, 2017 restriction requirement. The groups of claims were intended to be as follows: Group 1, claims 1-12 and 17-20; Group II, claims 13-16; and Group III, claims 21-26.

A reply to the March 14, 2017 Office action was filed on May 15, 2017, which included an election with traverse of Group II, claims 13 through 16, and an election of the species directed to a nutrition bar, as related to claims 13 and 14. In the May 15, 2017 reply, it was noted that claim 14 was a proper Markush group² and asserted that the members of the Markush group are sufficiently few in number and closely related such that a search of all species in claim 14 could be made without a serious burden on the examiner.

A non-final Office action was issued on May 31, 2017. The non-final Office action of May 31, 2017 made final the restriction requirement in the Office action of March 14, 2017. The Office action of May 31, 2017 treated claims 13 and 14 on the merits, and held claims 1 through 12 and 15 through 26 withdrawn from consideration as being drawn to nonelected subject matter.

A petition was filed on June 22, 2017 challenging the restriction made final in the Office action of May 31, 2017. A decision by the Technology Center Director was issued on November 15, 2017.

The instant petition under 37 CFR 1.181 was filed on January 16, 2018. The petition of January 16, 2018 requests supervisory review by the Director of the USPTO of the Technology Center Director decision of November 15, 2017 and asserts that the species of claim 14 is a proper Markush group and that the members of the Markush group should be examined together.

STATUTE, REGULATION, AND PROCEDURE

35 U.S.C. § 121 provides:

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.

² A "Markush" claim recites a list of alternatively useable members. *In re Harnisch*, 631 F.2d 716, 719-20 (CCPA 1980); *Ex parte Markush*, 1925 Dec. Comm'r Pat. 126, 127 (1924). The listing of specified alternatives within a Markush claim is referred to as a Markush group or Markush grouping. *Abbott Labs v. Baxter Pharmaceutical Products, Inc.*, 334 F.3d 1274, 1280-81, 67 USPQ2d 1191, 1196-97 (Fed. Cir. 2003) (citing to several sources that describe Markush groups). See MPEP § 2117.

37 C.F.R. 1.146 provides:

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable. However, if such application contains claims directed to more than a reasonable number of species, the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application.

MPEP § 803.02 III. A. provides, in pertinent part:

Following election, the Markush claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. Note that where a claim reads on multiple species, only one species needs to be taught or suggested by the prior art in order for the claim to be anticipated or rendered obvious. See, e.g., *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1298, 92 USPQ2d 1163, 1171 (Fed. Cir. 2009)(the entire element is disclosed by the prior art if one alternative in the Markush group is in the prior art).

If the Markush claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. As an example, in the case of an application with a Markush claim drawn to the compound X-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, XA, XB, XC, XD, or XE. The Markush claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species.

If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush claim and claims to the elected species will be rejected, and claims to the nonelected species will be held withdrawn from further consideration.

Should applicant, in response to a rejection of a Markush claim, overcome the rejection by amending the Markush claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush claim will be examined again. The examination will be extended to the extent necessary to determine patentability of the Markush claim. In the event prior art is found during this examination that anticipates or renders obvious the amended Markush claim, the claim will be rejected and the action can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37

CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry if they do not comply with the requirements of 37 CFR 1.116. See MPEP § 714.13.

MPEP § 806.04(f) provides:

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.

OPINION

Petitioners assert that the requirement for election of species is improper because (1) “at least the species of claim 14 comprise a proper Markush group and [] the members of the Markush group must be examined together”; (2) the members of the Markush group “are sufficiently few in number, and sufficiently closely related (all common protein-containing foodstuffs), that a search of all species can be made without a serious burden to the Examiner”; and (3) “the species do not recite mutually exclusive characteristics, and [therefore] the decision of the Director is based on unsupportable findings.”

With regard to petitioners’ first argument, the presence of a proper Markush group is not itself a sufficient basis for requiring all members of the Markush group to be examined together. Unless there would be a lack of serious burden (as discussed below), members of a Markush group are only required to be examined together if they are not patentably distinct from each other. The examiner determined that “these species are not obvious variants of each other based on the current record,” and petitioners have not contested that determination.

Petitioners appear to acknowledge that the presence of a proper Markush group is not itself a sufficient basis to require that all members of the group be examined together. Petitioners assert that because the Markush group is proper, “the proper procedure is to require the provisional election of a single disclosed species as a starting point for examination using form paragraph 8.02. The Markush-type claim should then be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the claim is not allowable, the provisional election is then to be given effect and examination limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.”

In setting forth the election of species requirement, the examiner followed the procedure set forth in MPEP § 803.02 as described by petitioners. The examiner required election of a single disclosed species as a starting point for examination. The election of species requirement mailed on March 14,

2017 specified that “Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted **if no generic claim is finally held to be allowable.**”(Emphasis added.) This is a provisional election requirement because it is conditioned on the non-allowability of a generic claim. Petitioners elected “nutritional bar” as the food product. Generic claim 13 was rejected under 35 U.S.C. § 102 as anticipated by the prior art, and claim 14 was rejected under 35 U.S.C. § 103 because the elected species was determined to be obvious in light of the prior art. Although claim 14 of the instant application contains a Markush group, only one species needs to be taught or suggested by the prior art in order for the claim to be anticipated or rendered obvious. *See* MPEP § 803.02 III.A. In accordance with MPEP § 803.02 III.A., because the examiner determined that the Markush claim is not allowable, the provisional election was given effect, and examination was limited to claims that read on the elected species (i.e., claims 13-14). Thus, consistent with MPEP § 803.02 the Office has not refused to examine that which applicant has invented, because claim 14 has been examined to the extent necessary to determine that it is not allowable. Claims drawn to species patentably distinct from the elected species were withdrawn from further consideration (i.e., claims 15-16).

Petitioner next asserts that there would not be a serious burden to examine all the members of the Markush group, as set forth in claim 14, and notes that the named species are not separately classified and are all foodstuffs. The March 14, 2017 requirement for an election of species sets forth why there is a search and/or examination burden for the patentably distinct species, i.e., they require “a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries); and the prior art applicable to one invention would not likely be applicable to another invention.” The Technology Center Director’s petition decision provides an example of the latter reason (e.g., a binder for artificial meat would not render obvious a soup or stew). The examiner has provided sufficient reasoning to support the determination that there would be a serious burden if an election of species was not required.

Finally, petitioners argues that contrary to the statements of the examiner and Technology Center Director, “the species do not recite mutually exclusive characteristics, and [therefore] the decision of the Director is based on unsupported findings.” Petitioner is correct that the species claimed do not recite mutually exclusive characteristics because some of the species overlap in scope (as explained in MPEP § 806.04(f)). However, for the reasons noted above, the determinations that species of Markush claim 14 are patentably distinct, and that there would be a serious burden in the absence of an election of species requirement, are supported by the record.

DECISION

The petition is granted to the extent that the Technology Center Director’s decision has been reviewed, but is **DENIED** with respect to overturning the Technology Center Director’s decision of November 15, 2017. This decision is final on this petition and no further requests for reconsideration of the election of species requirement will be entertained.

If applicant amends the Markush claim to exclude the species rendered obvious by the prior art or otherwise overcomes the prior art rejection of record, the Markush claim will be examined again to the

extent necessary to determine the patentability of the claim. *See* MPEP § 803.02 III.A, final paragraph. Should applicant obtain allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

This constitutes a final decision on this petition. No further requests for reconsideration of the election of species requirement will be entertained. Judicial review of this petition decision may be available upon the entry of a final agency action adverse to the petitioner in the underlying proceeding or examination to which it relates.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692.



Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy