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OFFICE OF PETITIONS

In re Application of :
Steven Yellin Schondorf et al. :
Application No. 11/740,360 : ON PETITION
Filed: April 26, 2007 :
Attorney Docket No. 81148864 :

This is a decision on the petition filed December 14, 2010 under 37 CFR 1.181, requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated October 14, 2010, which refused to grant the request to withdraw the election of species requirement mailed February 16, 2010.

The petition under 37 CFR 1.181 to overturn the decision of the Technology Center Director dated October 14, 2010, is **DENIED**[1].

BACKGROUND

A restriction requirement was mailed February 16, 2010. The restriction identified three patentably distinct species.

Applicant responded on March 15, 2010 with an election and traverse of the restriction.

A non-final Office action was mailed June 14, 2010 which acknowledged the election and responded to applicants' traverse of the restriction. The restriction was deemed proper and made final.

A petition to the Technology Center Director under 37 CFR 1.181 was filed June 25, 2010 requesting withdrawal of the requirement for restriction. This petition was Denied in a decision mailed October 14, 2010.

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[1] This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

The instant petition was filed December 14, 2010.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

MPEP 808.01 states in part:

> **808.01 [R-3] Reasons for Holding of Independence or Distinctness**
> The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

MPEP 808.01(a) states in part:

> **808.01(a) [R-5] Species**
> Where there is no disclosure of a relationship between species (see MPEP § 806.04(b)), they are independent inventions. A requirement for restriction is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction is not required. See MPEP § 803 and § 808.02.
> Where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

MPEP 806.04(b) states in part:

> **806.04(b) [R-3] Species May Be Independent or Related Inventions**
> Species may be either independent or related under the particular disclosure. Where species under a claimed genus are not connected in any of design, operation, or effect under the disclosure, the species are independent inventions.

MPEP 806.04(f) states in part:

> **806.04(f) [R-3] Restriction Between Mutually Exclusive Species**
> 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

The restriction requirement, mailed February 16, 2010, identified three patentably distinct species identified as illustrated by Figures 9, 10 and 11. The requirement indicated that the species were independent or distinct because the claims to the different species recite "mutually exclusive characteristics". It was also stated that the species are not obvious variants of each other based on the current record and finally, the examiner indicated there would be a search burden due to the mutually exclusive characteristics.

Petitioners argue that the Technology Center Director's decision ignored the deficiencies in regard to the search burden requirement. Although the examiner had failed at any time in prosecution to identify a specific search burden, the Technology Center Director's decision sets forth on page 2, an explanation of the different search queries required for each of the three indicated species thus satisfying the requirement to state the search burden. As noted above, the examiner identified three distinct species identified as figures 9, 10 and 11. Figures 9, 10 and 11 illustrate a first, second and third method to calibrate and/or validate a map in a vehicle as discussed on pages 12 through 14 of the specification. The figure 9 method changes input parameters across a range of values. The figure 10 method determines a desired output value wherein an input value is chosen to produce the desired output value. The figure 11 method measures environmental conditions during a map calibration and/or validation. The Technology Center Director's decision sets forth the search burden.

Petitioners argue that the mutual exclusivity issue raised by the examiner in the restriction requirement has not been properly addressed. The file record shows that although the examiner raised the mutual exclusivity issue in the original restriction requirement, he dropped this argument in his response to applicant's traverse in the non-final Office action mailed June 14, 2010. Thus there would be no reason for the Technology Center Director to address this issue.

Petitioners argue that the Technology Center Director's decision that there is no disclosure of a relationship between the species is incorrect. The petition identifies portions of the specification that shows evidence of relationships between the three species. However, MPEP 808.01(a) indicates that a requirement for restriction between species is permissible if there is a patentable difference between the species as claimed and there would be a serious burden on the examiner if restriction was not required. The Technology Center Director's decision indicated that the record was reviewed and the species were found to be independent and distinct from each other. A review of the specification indicates no disclosure that species 1 and 2 are usable together. In fact, they are referred to as "another approach" and "yet another approach", "first exemplary method" and "second exemplary method". There is no specific disclosure that species 1 and 2 are usable together. The distinctness of the species was based on applicant's failure to indicate the species were obvious variants of each other and thus the application record indicated the species were distinct. Thus, the decision set forth that there was a patentable difference between the species and there was a search burden. Therefore, distinctness based on lack of disclosure of a relationship is not at issue.

Petitioners argue that the withdrawal of claims 5 and 18-23 in the final Office action reinforces applicant's arguments. This was not an issue raised in the petition to the Technology Center Director. This point appears to be nothing more than further discussion of the points raised above.

DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of October 14, 2010. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion. It is emphasized that this is review of the Technology Center Director's petition decision, as petitioned, not a review of the examiner's restriction requirement.

The petition is granted to the extent that the decision of the Technology Center Director of October 14, 2010 has been reviewed, but is denied with respect to making any change therein. As such, the decision of October 12, 2010 will not be disturbed. The petition is denied.

Telephone inquires concerning this decision should be directed to Carl Friedman at (571) 272-6842.

Andrew Hirshfeld
Associate Commissioner
For Patent Examining Policy